





Part 4

International Status  
Quo and Efforts Made  
by Japan

## Chapter 1

### Efforts Made by Japan

Global business operations require the smooth acquisition and stable protection of intellectual property rights in foreign countries. Amid the globalization of business activities, further harmonization of intellectual property systems by each country and development of intellectual property infrastructures in emerging countries are strongly called for. The JPO aims to create global intellectual property systems by endeavoring to strengthen collaboration with developing countries including emerging countries in Asia; and leading discussions on system harmonization through the Meetings of the five IP offices (JPO, EPO, KIPO, SIPO, and USPTO) and the meetings among developed countries. The JPO is also implementing anti-counterfeit measures overseas and pushing forward the finalization of Economy Partnership Agreement (EPA) and other agreements which include measures on intellectual property rights.



### 1. Efforts Relating to Patents

This section presents the state of progress of discussions on patent harmonization at the IP5 Meetings and the meetings among developed countries. It also includes the JPO's efforts and achievements in the Asian Trilateral Meetings (JPO, KIPO, and SIPO), in the ASEAN-JAPAN Heads of Intellectual Property Offices Meeting (first held in February 2012), and in bilateral talks with various countries.

(1) Meeting of the five IP offices (JPO, EPO, KIPO, SIPO, and USPTO)

#### 1) Background

The number of patent applications filed in the world had been rapidly increasing after the late 1990's, particularly in China. According to the statistics of 2007, more than 70% of approximately 1.6 million patent applications in the world were filed with the JPO, EPO, KIPO, SIPO, and USPTO (including those filed with the patent offices in European countries), and approximately 30% of applications filed with one of the five IP offices were overlapping applications filed with another of the five patent offices. A framework to encourage cooperation among the five large patent offices had already existed since 1983 in the form of the Trilateral Meeting (JPO, EPO, USPTO); and the Trilateral Meeting (JPO, KIPO, SIPO) (since 2001). However, because further globalization of business activities was expected, the five Offices thought it essential to cooperate on common issues such as mutual exploitation of examination results, simplification of procedures, and improvement of quality of examinations in order to deal with the increase in patent applications, as mentioned earlier. To this end, the IP5 Heads of office (JPO, EPO, KIPO, SIPO, and USPTO) gathered to hold a meeting in May 2007. This was the first attempt for the five IP offices to hold a joint meeting. In this meeting, ten basic projects were proposed, which are to become the foundation on which to promote work sharing, with each patent office in charge of two projects.

To advance each project, vigorous discussions have been held on the working level in three working groups (WG1: Classification, WG2: Information Technology,



and WG3: Examination).

The fourth Meeting of IP5 Heads of office was held in June 2011 and it was the first meeting hosted by the JPO. In this meeting, the Heads of offices discussed patent-system harmonization for the first time.

2) Outline of each Project (the parenthesis stand for the Office in charge of each project)

a. WG1: Classification

Common Hybrid Classification (EPO)

A project for segmentalizing the International Patent Classification (IPC) using the detailed internal classification of each office. The IPC has already been issued for three project fields among the total of eighteen projects the five offices agreed to start. Discussions on the issuance of the IPC are under way with regard to the remaining project fields. In addition, discussions on the start of new project fields are under way.

b. WG2: IT-supported Business Processes

Common Documentation (EPO)

A project for providing smooth access to the database owned by each Office so that examiners at each office can search the same document scope. After policies and definitions of common documentation have been agreed, discussions on media-less data exchange are currently under way.

Common Search and Examination Support Tools (USPTO)

A project for improving common examination/search tools so that examiners at each office can achieve the same search results for the same application. Discussions are being held to compare and determine the best search tools.

Common Approach to Sharing and Documenting Search Strategies (USPTO)

A project for recording and documenting each office's search strategies and search histories and sharing them with other offices. Currently, the offices are deciding what kinds of content would be useful to share.

Common Application Format (JPO)

A project that enables applicants to submit patent application descriptions to each patent office in a common application format (CAF) to the five offices. The five offices agreed on the CAF specifications, creating them with the idea of further advancing this to other offices that adopt the CAF based on the trilateral written agreement on the CAF.

Mutual Machine Translation (KIPO)

A project for advancing work sharing by lowering language barriers through using machine translation. The EPO and the USPTO conducted a project to point out errors that resulted from machine translation conducted by the Asian offices (JPO, KIPO and SIPO). The purpose was to improve the accuracy of machine translation from Asian languages to English.

Common Access to Search and Examination Results (JPO)

A project for achieving the "one portal dossier (OPD)" which collectively displays the examination information on related applications at each office and expanding and promoting the use of electronic exchange of priority documents. This includes the use of digital access service (DAS) by the WIPO. The specifications for the OPD, which have been defined by the five offices, and the development of the OPD, are under way. The OPD is scheduled to become operational in 2013. In terms of electronic exchange of priority documents, the five offices agreed to improve measures for DAS, with discussions on their implementation on-going.

c. WG3: Examination Practice-related Projects

Common Training Policy (KIPO)

A project for holding examiners' workshops and mutually participating in seminars. The offices decided to continue to hold examiner's workshops and to mutually participate in seminars at the five offices.

Common Examination Practice Rules and Quality Management (SIPO)

A project for standardizing the rules for

examination practices and quality management systems. Based on the results of comparative studies conducted by the five offices, the offices agreed to further discussions on the common rules for examination practices. In addition, the five offices agreed to continue to discuss the standards and methods of evaluating search quality.

#### Common Statistical Parameter System for Examination (SIPO)

A project for clarifying statistic parameters (index) that have different definitions in each office and for creating comparable examination statistic parameters by each office so as to enable the exchange of statistical information related to examination processes to be possible by using the comparable statistic parameter. A dictionary summarizing definitions of parameters of each office has been created, and the creation of common statistic parameters is being examined based on it.

#### 3) 4<sup>th</sup> Meeting of the IP5 Heads of office in June 2011

The progress of international patent harmonization is an important issue, because it enables Japanese companies to smoothly acquire, with a certain degree of predictability, patent rights in foreign countries. It also enables them to conduct global business and R&D activities without fear. On a related issue, deliberations on the US Patent Reform Bill, including the transition from a first-to-invent system to a first-to-file system, were going well as of January 2011. In addition, the harmonization of patent systems became an agenda at this meeting for the first time based on a proposal made by the JPO. The idea proposed is for the five Patent Offices, which handle with more than 80% of all patent applications filed worldwide, to address the important issue of patent harmonization. As a result, the Five Offices agreed to share the importance of advancing the international harmonization of patent systems and actively participate in international discussions, still respecting the sovereignty of each country in terms of granting patent rights. Furthermore,

under the framework of the Five Patent Offices the Offices agreed to urgently conduct an investigative study (refer to IP5 Matrix Study below) on patent systems and examination practices of each country. It is very meaningful that the Five Offices, including China, that has the greatest number of patent application filings, reached this agreement toward future harmonization of systems.

At this meeting, the Five Offices also confirmed the importance of making efforts to encourage work sharing, as it relates to patent examinations by the Five Patent Offices such as the patent prosecution highway (PPH), which is being advanced by the JPO.

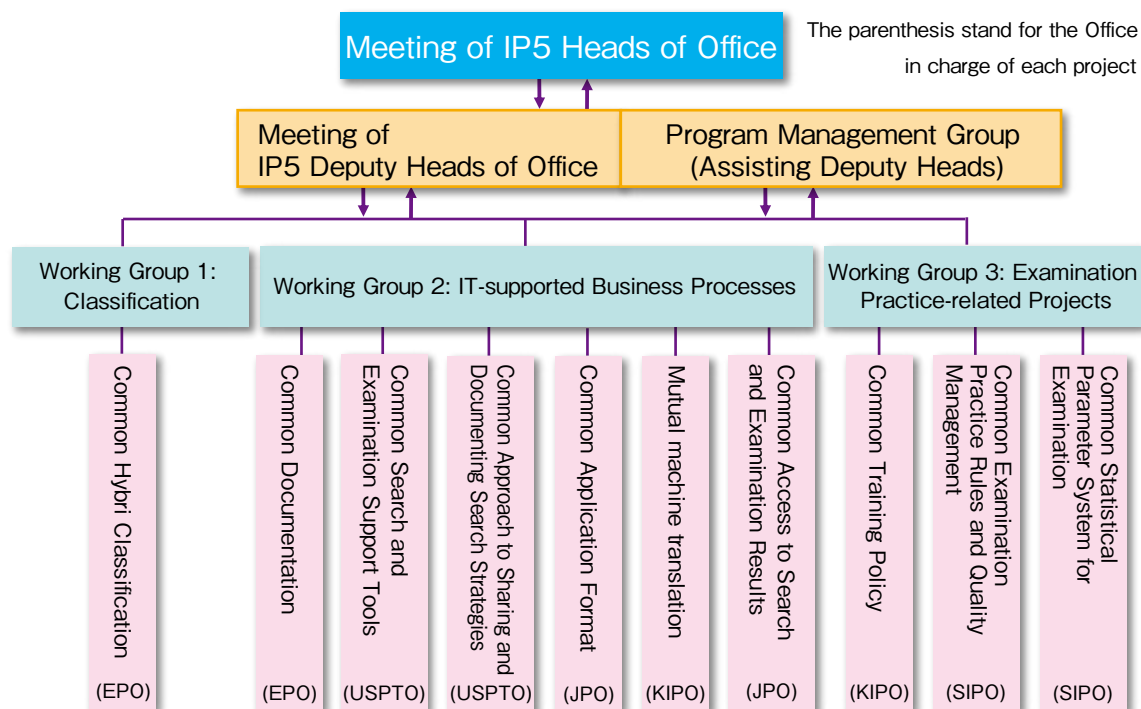
In addition, the three Working Groups reported the progress on the ten basic projects. During this report, the Five Offices agreed to speed up the development of common patent classifications among them, based on the patent classifications of the JPO and those of the EPO with regard to the project for standardizing “patent classifications.”

More detailed, common patent classifications make it possible to efficiently and comprehensively search world patent documents, raising both the stability and the reliability of patent rights. Also, since it is possible for companies themselves to easily find patents in China or the Republic of Korea related to their own technology, they are better able to prepare for IP litigation risks overseas.

#### 4) IP5 Matrix Study

At the above-mentioned 4<sup>th</sup> Meeting of IP5 Heads of office held in June 2011, the Five IP Offices agreed to urgently conduct an investigative study on patent systems and examination practices of each country. In response to this, international comparisons of systems and operations were conducted under the leadership of Japan. There were more than 40 items concerning points in question such as the first-to-file system/first-to-invent system, scope of prior art, grace period, novelty, the inventive step, secret earlier application, description requirements for claims, claim interpretations, etc. Plus, the offices analyzed the effects and difficulty of harmonization. At IP5 Meeting held in June 2012, the Five Offices

[Figure 4-1-1 The Structure of IP5 Offices]



agreed to establish Patent Harmonization Expert Panel. The panel would consist of working-level officers of each patent office that will consider the achievements of the study and advance discussions aimed at harmonization.



June 2011 4<sup>th</sup> Meeting of IP5 Heads of office (Tokyo)  
(Photo, from left to right) EPO President Battistelli, KIPO Commissioner Lee, JPO Commissioner Iwai, Minister Kaieda of Economy, Trade and Industry (then), USPTO Deputy Director Rea, SIPO Commissioner Tian, WIPO Director General Gurry

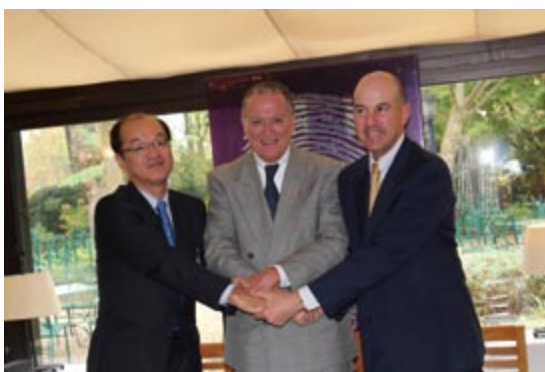
(2) Trilateral Conference of the JPO, the EPO and the USPTO

#### 1) Background

Since the first Trilateral Conference in 1983, the Trilateral Offices (JPO, EPO, and USPTO) have continuously held trilateral meetings. The Trilateral Offices take turns holding a Trilateral Conference every year in autumn.

The Trilateral Offices advance discussions at working groups held throughout the year, with a focus on the following issues: “cooperation in examination through mutual exploitation”, “efforts to reduce the procedural burden on applicants”, “efforts to harmonize systems and operations,” and “efforts for the development of information systems.” The Trilateral Offices have also been working on a broad range of projects on the dissemination of patent information and the development of PCT systems in recent years.

In 2012, the 30th Annual Trilateral Conference will be hosted by the JPO.



Trilateral Conference in November 2011  
From left: JPO Commissioner Iwai, EPO President Battistelli, and USPTO Director Kappos

## 2) Outline of Each Project

The contents and future plans for each project discussed at the 29<sup>th</sup> Trilateral Conference held in November 2011 are as follows.

### a. Cooperation in Examination through Mutual Exploitation Patent Prosecution Highway (PPH)

The Trilateral Offices agreed to extend their pilot programs of the PCT-PPH, the PPH between the EPO and the JPO<sup>1</sup>, and the PPH between the EPO and the USPTO beyond January 29, 2012. In addition, the Trilateral Offices decided to confirm the details with a view to adopting a PPH MOTTAINAI Model for the PPH between the EPO and the JPO; and between the EPO and the USPTO, working to extend the pilot programs. (From January 29, 2012, the pilot programs of the PPH MOTTAINAI Model have started for the PPH between the EPO and the JPO; and between the EPO and USPTO. In addition, this pilot program has already started for the PPH between the JPO and the USPTO from July 2011).

### SHARE (Strategic Handling of Applications for Rapid Examination)

This framework allows mutual exploitation of search results and first actions. The Office of First Filing where the application

was filed first, releases its search and examination results first, and the Office of Second Filing can utilize the results of the Office of First Filing when it starts its own examination process. From April 2008, the JPO has adopted this system in all technical fields, calling it JP-FIRST (JP-Fast Information Release Strategy).

The EPO preferentially examines applications filed at the Office of First Filing as a standard operation. The USPTO has a pilot program called FLASH (First Look Application Sharing) in which applications filed at the USPTO are given preferential status as applications at the Office of First Filing (basis for claim of priority) in order to test the possibility of equalizing and prioritizing the examination workload.

### Exchange of Information related to Timing for Starting Examination

The Trilateral Offices started to deliberate on how to improve the usability of results of examinations coming from the Office of First Filing at the Office of Second Filing. They are considering exchanging information on the time to start examinations and adjusting the time for starting examinations at the Office of Second Filing in accordance with the timing for starting examinations at the Office of First Filing.

### Improvement of PCT

The Trilateral Offices confirmed the importance of achieving PCT reforms.

The Trilateral Offices are planning to consider various proposals in the future in order to advance the roadmap for improving the PCT, as proposed by the WIPO. As an example, from May 2010 the EPO and the USPTO have continued a pilot program of limited PCT collaborative international search and preliminary examinations as one element in the roadmap.

<sup>1</sup> See Part 3, Chapter 2, 3.(1).

## b. Efforts to Reduce Procedural Burden on Applications Common Application Format (CAF)

The Trilateral Offices started to accept applications in accordance with the common application format (CAF) from January 2009, encouraging the use of the CAF by users.

The Trilateral Offices held six working-level meetings from 2006 to 2007 and comprehensive discussions to meet the needs of users. At the 6<sup>th</sup> working-level meeting, held in November 2007, the Trilateral Offices reached a final agreement on the CAF (description items and their order in descriptions, etc.). The contents are publicized on the Trilateral website<sup>1</sup>.

It is hoped that user convenience will be improved and application-filing costs will be reduced at each Patent Office by standardizing the application description formats. The JPO started to accept applications using CAF from January 2009. In addition, under the framework of the five IP offices, the adoption of the CAF is being advanced under the leadership of Japan. In January 2012, based on the working-level agreement on the CAF concluded by the Trilateral Offices, the five IP offices reached an agreement on a document (CAF Definition) that is designed to be used by other IP offices that adopt the CAF.

## c. Efforts for Harmonizing Systems and Operations

### Comparative Studies on Examination Practices

By 2008 the Trilateral Offices had conducted comparative studies on description requirements and the inventive step, publicizing their results on their website. In 2009, they conducted a comparative study on novelty and its results were publicized on the Trilateral website<sup>2</sup> and the JPO website<sup>3</sup> in November 2009.

At the Trilateral Conference in November 2010, the first draft of Catalogue of Differing Practices<sup>4</sup> was compiled. During the meeting with the trilateral users (JIPA [Japan Intellectual Property Association], IPO [Intellectual Property Owners Association, USA], AIPLA [American Intellectual Property Law Association, USA]; and BUSINESSEUROPE) that was held around the same time, the Trilateral Offices unveiled the draft catalogue to the participants present at the meeting. Then, the Catalogue of Differing Practices in the five IP offices was created by integrating the practice of the KIPO and the SIPO. The Catalogue was officially published in February 2012<sup>5</sup>.

### Efforts Concerning Quality

The Trilateral Offices agreed to continue a study on the quality evaluation index (quality metrics). Specifically, they will conduct research to create statistical data on PPH cases based on the definition agreed by the Trilateral Offices. This is scheduled to be completed by November 2012. Moreover, they will continue their study on quality metrics aimed at assessing the quality of the International Search Reports.

## d. Efforts on the Development of Information Systems

### Promoting Computerization based on the International Standard (XML format)

Efforts are being made to encourage the use of the international XML format standard at all Trilateral Offices for the purpose of promoting electronic applications and administrative processing.

At the Trilateral Conference held in November 2011, the Trilateral Offices reported the current state of XML standardization at each office. They agreed to support WIPO standard working groups that have been set up

<sup>1</sup> <http://www.trilateral.net/projects/pct/CAF.html>

<sup>2</sup> <http://www.trilateral.net/catalogue.html>

<sup>3</sup> [http://www.jpo.go.jp/torikumi/kokusai/kokusai3/sinsa\\_jitumu\\_3kyoku.htm](http://www.jpo.go.jp/torikumi/kokusai/kokusai3/sinsa_jitumu_3kyoku.htm)

<sup>4</sup> "Catalogue of Differing Practices" is a tool aimed at identifying the differences in patent examination practice in the offices and legal grounds (laws and regulations and court precedents) of examination practices of each office in a way that they can be compared.

<sup>5</sup> [http://www.jpo.go.jp/torikumi/kokusai/kokusai2/pdf/jitumu\\_catalog/en.pdf](http://www.jpo.go.jp/torikumi/kokusai/kokusai2/pdf/jitumu_catalog/en.pdf)



to enhance each existing standard and create a XML roadmap. Based on the above-mentioned report, this includes developing new standards to exchange data for the purpose of meeting the business requirements of the Trilateral Offices.

#### Trilateral Network

The trilateral network (TriNet) is a highly secure network on which information exchange is encrypted for transmission. The network is utilized to exchange information such as priority documents and file wrapper information references, and to access the retrieval system.

The Trilateral Offices decided to conduct a study so as to allow services now provided through the TriNet to be made available on the most appropriate networks so that information exchange will be possible at all Intellectual Property Offices in the future. Currently, the five IP offices are considering this possibility.

#### Electronic Exchange of Priority Documents (PDX: Priority Document Exchange)

In addition to the electronic bilateral exchange of priority documents carried out among the Trilateral Offices, a framework for conducting electronic exchange of priority documents through the WIPO Digital Access Service (DAS) was established in April 2009. The WIPO DAS Working Group held in July 2011 agreed to expand the DAS to designs and trademarks, with the JPO making a proposal to improve the usability of the DAS. The participating countries supported the proposal. The results of the DAS Working Group were also reported at the Trilateral Conference in November 2011 and the Trilateral Offices discussed implementing the proposal dealing with improvements.

#### e. Other Efforts

##### Information Dissemination Activities

In November 2011, the EPO, the USPTO and the JPO held an exhibition to introduce the work being done by the Trilateral Offices. The exhibition, held in Tokyo, was to raise user awareness.

In addition, the Trilateral User Meeting ((JIPA [Japan Intellectual Property Association], IPO [Intellectual Property Owners Association, USA], AIPLA [American Intellectual Property Law Association, USA]; and BUSINESSEUROPE) was held twice in 2011 (in May in Germany and in November in France).

##### Classification

The Trilateral Offices completed all existing harmonization projects in 2011. The harmonization classifications of the Trilateral Offices were created for 72 projects and the conversion to the IPC (International Patent Classification) was successful. These achievements will be taken over by the CHC, a project by the five IP offices.

##### Statistics

In the past, the JPO, the EPO and the USPTO took turns every year to create and publicize a trilateral statistic report that contains the state of activities of each office and statistical information provided by the Statistical WG.

In 2009, it was agreed to change the publication's name to the Four Office Statistical Report Working Group, because the KIPO became an official member of the trilateral statistical WG.

The Five Office Statistical Report WG was established in April 2012 to include the SIPO, with each office by making adjustments to align with transition from the Four Office Statistics Group to a framework based on five IP offices.

(3) Trilateral Conference of the JPO, the SIPO and the KIPO

#### 1) Background

The JPO, the SIPO and the KIPO have taken turns holding the Trilateral Commissioner's Meeting every year since 2001 to exchange opinions on the cooperation taking place among the Trilateral Offices; and to find solution to common issues faced by them.

At the 11th Trilateral Commissioner's Meeting held in Gyeongju, the Republic of Korea, in December 2011, the Trilateral Offices discussed cooperation in the fields of patent, design, information technology, IP human resource development, agreeing on the following.

#### Harmonization

Japan introduced a course for future international discussions toward harmonization. Both China and the Republic of Korea recognized that system harmonization was a long-term issue, and understood its importance.

#### Patent Classification

The Trilateral Offices reconfirmed the importance of the five office agreement on acceleration of CHC. In addition, FI and ECLA (or CPC) has different advantage in technological field to classify. Thus, the Trilateral Offices agreed to preliminarily exchange opinions on how to advance CHC to integrate these classifications under a common interest (similar industrial structures) held by the Trilateral Offices in East Asia.

#### Cooperation in Machine Translation

Japan pointed out the importance of direct machine translation among Asian languages. China and the Republic of Korea strongly backed this idea and agreed to further advance cooperation in machine translation between Japan-China, Japan-Korea and China-Korea.

#### Report on Case Studies of the inventive step

The Trilateral Offices approved the "Report on Case Studies of the inventive step", summarizing the results of evaluations of the inventive step conducted by the

Trilateral Offices.

They discussed the evaluation results and agreed to publicize them on each office's website.

#### Comparative Studies on Utility Model Systems

The Trilateral Offices agreed to further advance comparative studies on the utility model systems of the three countries, committing to study the respective operations of each country, exchange opinions on the systematic differences in each country, and deepen their mutual understanding.

#### Cooperation in the Field of Computerization

China proposed that users be provided better information based on the offices improving the Trilateral Office website (TRIPO) and electronically exchanging priority documents. Japan and the Republic of Korea agreed to this proposal.

#### Renewal of the Roadmap of Trilateral Cooperation

The Trilateral Offices confirmed that they have steadily produced results in line with the Roadmap of Japan-China-Korea Cooperation formulated in 2007. They agreed on a revised the Roadmap of Trilateral Cooperation that includes new matters related to cooperation such as harmonization, PPH, classification, and user services.

#### Joint Announcement

The Trilateral Offices adopted a joint announcement that includes comprehensive measures that will ensure cooperation among the three countries in order to develop their intellectual property systems. These cooperative initiatives will be based on the mutual exploitation of patent examination results, strengthening protection of intellectual property rights, human resource development, service enhancements, and harmonization.

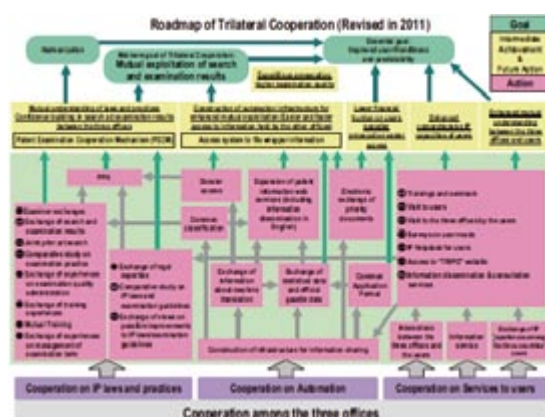
The 12<sup>th</sup> Trilateral Commissioner Meeting will be held in China.



11th Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO

From left: SIPO Commissioner Tian, KIPO Commissioner Lee, and JPO Commissioner Iwai

**[Figure 4-1-2 Revised Trilateral Cooperation]**



## 2) Outline of Each Project

The contents and future plans for each project discussed at the 11<sup>th</sup> Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO are as follows.

### a. Joint Experts Group of Patent Examination (JEGPE) of Japan, China and the Republic of Korea

At the Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO in March 2009, the Trilateral Offices agreed to establish Joint Experts Group of Patent Examination (JEGPE) of Japan, China and the Republic of Korea and conduct comparative studies on the Patent Act and examination standards proposed by the JPO. The first meeting was held in Beijing, China on November 17, 2009

and the second meeting in Japan on August 31, 2010. At the second meeting, the three countries agreed to adopt what is to be called a “Comparative Study Report on Inventive Step” at the Commissioner Meeting in December 2010 and to conduct case studies on the inventive step as a next project.

The third meeting was held in Daejeon, the Republic of Korea, on September 5 and 6, 2011, and the results of case studies on the inventive step were reported and opinions on the utility model systems were exchanged. Currently, the JPO website publicizes this “Comparative Case Study on Inventive Step”<sup>1</sup> summarizing the results of the inventive step evaluations by each office and the content of discussions based on their results.

The Trilateral Offices agreed to continue to exchange opinions on the utility model systems of Japan, China and the Republic of Korea at the Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO held in December 2011.

### b. the Joint Expert Group for Automation (JEGA)

Japan, China and the Republic of Korea agreed to establish the Joint Expert Group for Automation (JEGA) at the 2<sup>nd</sup> Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO to exchange information on IT and encourage cooperation among the three offices. This meeting has been held every year since 2003.

The three countries discussed the common application format (CAF), priority document exchange (PDX), machine translation, exchange of examination information, etc. at the 9<sup>th</sup> JEGA held in Daejeon, the Republic of Korea in October 2011. Particularly in regard to priority document exchange (PDX), the JPO asked the SIPO and the KIPO to recognize the superiority of PDX by the DAS system of the WIPO at this meeting. As a result, the SIPO has started to participate in the WIPO DAS system since March 2012 and the PDX system is now at the Trilateral Offices (JPO, SIPO, and

<sup>1</sup> [http://www.jpo.go.jp/torikumi\\_e/kokusai\\_e/comparative\\_study.htm](http://www.jpo.go.jp/torikumi_e/kokusai_e/comparative_study.htm)

KIPO) using the DAS system.

#### c. Heads Meeting of the CIPTC, IIPIT and INPIT

At the 9<sup>th</sup> Trilateral Policy Dialogue Meeting among JPO, KIPO and SIPO in December 2009, the JPO, the SIPO and the KIPO agreed to hold a meeting of organization heads to discuss mutual cooperation such as training at the IP human resource development organizations of each country. In response to this, the First Heads Meeting of the CIPTC, IIPIT and INPIT was held in Seoul, The Republic of Korea.

The second meeting was held in Tokyo on November 16, 2011. The three countries agreed to exchange information on training at each organization, support education in IP, and implement activities under the banner of a common mandate among the three organizations and work on activities involving common interests in connection with the IP human resources of the three countries.



2nd Meeting of the CIPTC, IIPIT and INPIT (photo: INPIT)

#### (4) First ASEAN-Japan Heads of Intellectual Property Offices Meeting

1) The ASEAN countries achieved outstanding economic development in recent years, looking forward to further greater innovation in the process of economic growth in the future. In addition, as national income increases in line with economic growth, it is predicted that the national needs for high-quality and high value-added products and services also increase: and that furthermore, the demand for good design and brands increases. Therefore, the need for environmental development is increasing every

year to appropriately protect intellectual property rights in the ASEAN-member countries for the purpose of creating, protecting, and utilizing innovation, design and brands. On the other hand, ASEAN intends to create a community by 2015 that will work to liberalize economic activities in the region. It is anticipated that for Japan the ASEAN region will become a huge economic sphere more important than ever. It is essential to appropriately protect R&D achievements, designs and brands in the ASEAN region in order for Japanese companies to easily conduct their business operations. Thus, improving the ASEAN industrial property systems and their operations is an important issue.

In view of these circumstances, minister-level policy talks covering a wide perspective are essential in order to make the Japan-ASEAN cooperation in the field of intellectual property more effective and work more closely in line with the current status of the rapidly growing ASEAN Region. The JPO invited the commissioners of the all ASEAN-member countries to Tokyo to the 1<sup>st</sup> ASEAN-Japan Heads of Intellectual Property Offices Meeting.



First ASEAN-Japan Heads of Intellectual Property Offices Meeting

Front row: (From left), Director San (Cambodia), Registries Head Hayati (Brunei), Commissioner Iwai, Senior Vice Minister Makino, Division Head Thitapha (ASEAN Secretariat), Division Head Dung (Vietnam), Director General Pajchima (Thailand)

Back row: (From left), Director Vibol (Cambodia), Director General Ramli (Indonesia), Director Makha (Laos), Director General Azizan (Malaysia), Deputy Director Thida (Myanmar), Director General Blancaflor (Philippines), Director General Tan (Singapore)



In this meeting, the participating countries confirmed that it is necessary for ASEAN to strengthen the protection of intellectual property in order to maintain and advance future economic growth. In addition, they agreed that Japan, under its own leadership, will provide cooperation to that end. In addition, the “Tokyo Intellectual Property Statement” was adopted as follows.

(Agreement reached in the “Tokyo IP Statement” )

- Strengthening Japan and ASEAN cooperation for mutual prosperity
- The intellectual property system is important to promote smooth trade, investments, innovation, and technical transfers so as to achieve sustainable economic development
- Japan and ASEAN cooperating together is vital to achieve the ASEAN “IPR Action Plan 2011-2015”
- Depending on the needs, cooperation should be implemented based on direct, continuous talks through related organizations including the WIPO and others, taking into account diversified needs and economic levels.
- The Second Meeting will be held in Singapore in July 2012.

The participating countries decided to advance specific cooperation in the future in order to support ASEAN members’ acceding to the Treaty; improving examination standards, processes, and administrative skills; and conducting awareness-raising activities. In addition, this minister-level meeting will be held on a regular basis so that the cooperation activities stay in harmony with the needs of the ASEAN members.

It is important to effectively utilize a framework based on dialogues with the IP Offices of the ASEAN-member countries for the purpose of supporting business activities of Japanese companies operating in the ASEAN region.

## 2) High Level IP Dialogue with Executives of Japanese Companies

After the First ASEAN-Japan Heads of Intellectual Property Offices Meeting was held,

a meeting to exchange opinions was held, with the commissioners of the ASEAN-member countries and Japanese companies participating. In this meeting, after the opening address by each office of the ASEAN-member countries, Division Head Thitapha (ASEAN Secretariat) explained the outline of the “ASEAN IPR Action Plan 2011-2015.” After that, Japanese companies were able to express their requests to the ASEAN member nations.

Japanese companies requested the following: (i) establishing an intra-regional uniform system for patent, design and trademark; (ii) establishing anti-counterfeit measures to combat counterfeit products; (iii) conducting equal and more expeditious examinations; and (iv) improving the disclosure of information. Each ASEAN member explained its own efforts in these areas.

This meeting helped Japanese companies to understand the latest circumstances surrounding intellectual property in the ASEAN-member countries and enabled them to formulate future business plans and IP strategies. In addition, all the IP Offices were able to appreciate the expectations of and matters of interest to Japanese companies. This meeting was helpful to plan future policy.

## (5) Bilateral Efforts

### 1) The United States

The JPO has established a close, cooperative relationship with the USPTO in a wide variety of fields such as mutually exploiting examination and search results, holding international examiner exchange programs, and improving IT systems. In addition, the JPO and the USPTO cooperate in various fields such as patent harmonization under the framework of the Meeting of the Five IP Offices<sup>1</sup> (JPO, EPO, USPTO, KIPO and SIPO) and the Trilateral Conference<sup>2</sup> (JPO, EPO and USPTO).

#### a. Patent Prosecution Highway (PPH)

The JPO proposed a patent prosecution

<sup>1</sup> See Part 4, Chapter 1, 1.(1).

<sup>2</sup> See Part 4, Chapter 1, 1.(2).

highway scheme at the Trilateral Conference (JPO, EPO, and USPTO) held in November 2004 and at the Trilateral Expert Group Meeting held in Tokyo in May 2006 the EPO and the USPTO agreed to start a pilot PPH program<sup>1</sup> from July 3, 2006. The patent prosecution highway not only speeds up the patent processes so as to enable applicants to acquire rights overseas but also improves the quality of the examination while reducing the workload of each Patent Office.

- July 3, 2006: Start of pilot program
- May 2007: Agreement to include PCT applications within the target
- July 2007: Agreement to extend the period of the pilot program for 6 months, that is by January 3, 2008
- January 4, 2008: Transition from pilot program to full implementation
- January 29, 2010: Start of PPH applications through international applications based on the PCT (PCT-PPH)
- July 15, 2011: A PPH MOTTAINAI pilot program started which reduced the requirements for PPH applications while expanding the number of target cases

As of December 31, 2011, the total number of applications filed through the Paris route was 4,703 (from JP to US) and 1,483 (from US to JP). The total number of applications through the PCT-PPH is 537 (from JP to US) and 10 (from US to JP) as of December 31, 2011.

#### b. Bilateral Negotiations for Systemic Improvement

The U.S. have strongly advanced bilateral negotiations with other countries since the 1980's under the pro-patent policy for the purpose of strengthening the protection of intellectual property rights not only in the United States but also in other countries. Bilateral negotiations were conducted between Japan and the United States such as at the Japan-U.S. Trade Committee Working Group on Intellectual Property Rights (1988) and the

Japan-U.S. Structural Impediments Initiative Talk (89~90).

Since then, bilateral talks have been held on a wide variety of fields including intellectual property rights while changing their names as the Japan-U.S. Framework for a New Economic Partnership, the Japan-U.S. Deregulation Talks, the Japan-U.S. Initiative on Regulatory Reform, and the Japan-U.S. Economic Harmonization Initiative.

At the First Japan-U.S. Economic Harmonization Initiative held in 2011, Japan proposed the following items as matters of interest in the field of intellectual property rights.

#### 1) Transition from the first-to-invent system to the first-to-file system

Japan requested the U.S. to change to the first-to-file system that both Japan and Europe uses, from the first-to-invent system that is unique to the U.S..

#### 2) Abolition of exceptions to the system of laying open applications

Japan requested the U.S. to eliminate its rule on exceptions, which is a system the U.S. uses to allow applicants to request that their applications not be disclosed under certain conditions.

#### 3) Improvement of the re-examination system

Japan requested that the current ex-parte and inter-parties re-examination provisions be improved because only certain reasons for invalidation of a patent are applicable in the re-examination system.

#### 4) Relaxation of standards on restriction requirements for dissatisfaction with unity of inventions

The standards on restriction requirements applied to applications other than PCT applications are stricter than the requirements for unity of inventions applied to PCT applications. Therefore, Japan requested the U.S. to relax the former standards for unification.

<sup>1</sup> See Part 3, Chapter 2, 3.(1).

## 5) Abolition of Language Discrimination (Hilmer Doctrine) of Exclusion Effect on Subsequent Applications

In Japan and Europe, national applications, on which the priority of foreign applications is based, are based on the first filing date at the country of first filing, with the entire matters of descriptions having the effect to exclude subsequent applications. In addition, the exclusion effect on subsequent applications does not differ depending on the languages in which the applications are published. On the other hand, the exclusion effect on subsequent applications is not guaranteed in the U.S.. Thus, it may limit the effectiveness of the priority system which is stipulated under the Paris Convention and the PCT system. Japan requested the U.S. to improve this aspect.

## 6) Information Disclosure Statement of Prior Art

Since requirement of the information disclosure statement (IDS) by the USPTO puts much burden on applicants, Japan requested the U.S. to make improves in this regard.

## 7) Expansion of Patent Attorney Privileges

Japan requested the U.S. to cooperate for the issue as to whether the privileges secrecy would be granted to Japanese patent attorneys in the U.S.

Japan has made requests similar to these mentioned here to the U.S. for many years. There have been some improvements due to the enactment of the America Invents Act in September 2011, such as the transition of the U.S. from the first-to-invent system to the first-to-file system, the improvement of the re-examination system, and the abolition of language discrimination (Hilmer Doctrine) of the exclusion effect on subsequent applications. This indicates that the long-term efforts by the Japanese government have brought significant results. The records of the bilateral discussions were made public in December 2011.

## 2) Europe

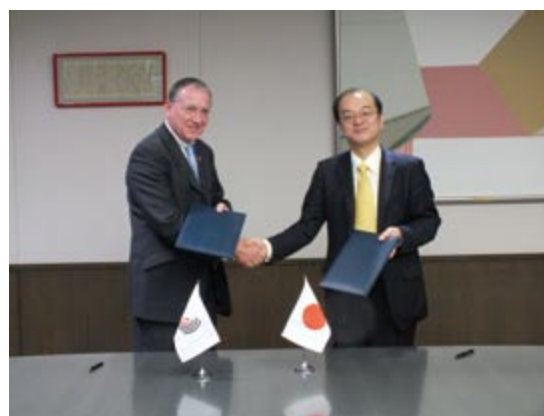
### a. Outline of Bilateral Cooperation

The JPO has built a close, cooperative system with the EPO in a wide variety of fields such as mutually exploiting examination and search results, and improving information systems.

In addition, the JPO cooperates with the EPO in many fields by making use of multilateral frameworks such as the Meetings of five offices<sup>1</sup> (JPO, EPO, KIPO, SIPO, and USPTO,) and the Trilateral Conference<sup>2</sup> (JPO, EPO, and USPTO). Moreover, the JPO has actively implemented the examiner exchange program and the patent prosecution highway (PPH)<sup>3</sup> not only with the EPO but also with the Patent Offices of European countries.

### b. Cooperation in Machine Translation with the EPO

In February 2012, the Commissioner of the JPO, Yoshiyuki Iwai, and the President of the EPO, Benoît Battistelli, signed an agreement on machine translation which will provide users of the patent system with better machine translations of patent.



Signing ceremony in February 2012  
From left: EPO President Battistelli, JPO Commissioner Iwai

<sup>1</sup> See Part 4, Chapter 1, 1.(1).

<sup>2</sup> See Part 4, Chapter 1, 1.(2).

<sup>3</sup> See Part 3, Chapter 2, 3.(1).

The EPO signed a similar agreement on machine translation with the SIPO in November 2011. The EPO started to provide machine translation program in a total of 32 languages (the 28 official languages of the EPC participating states plus Chinese, Japanese, Korean and Russian) by the end of 2014, utilizing translation technology by Google, Inc.

### c. Japan-EU Dialogue on Intellectual Property Rights

Based on the agreement of Japan-EU Summit Meeting in May 2003, the Japan-EU Dialogue on Intellectual Property Rights has been held once every year since 2003, alternately in Tokyo and Brussels, as a forum to widely discuss matters of interest related to intellectual property between Japan and the European Commission. The 9th dialogue was held in Tokyo in April 2012.

### 3) China

#### a. Bilateral Efforts with China and Multilateral Efforts on Intellectual Property System

The number of applications for patents, utility models, designs and trademarks filed in China is rapidly increasing in recent years, with a good number of applications being filed from Japan. The number of legal cases related to intellectual property in China is also increasing rapidly in line with the increase in the number of applications.

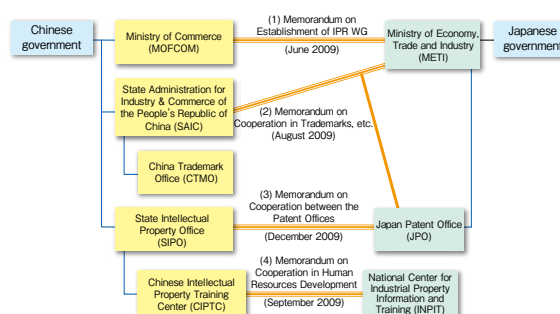
In view of these circumstances, the JPO has been using both bilateral frameworks with China and multilateral frameworks that include China so as to cooperate in the area of IP. These frameworks include the 18th Commissioner's Meeting between the JPO and the SIPO in October 2011, the 11<sup>th</sup> Commissioner's Meeting among the JPO, KIPO and the SIPO held in December 2011, and The meeting of IP5 Heads of office held in June 2011. The JPO is working with China to improve examination procedures in China, mutually exploit search and examination results, achieve harmonization, and advance computerization.



18th Commissioners Meeting between the JPO and the SIPO

From left: SIPO Commissioner Tian and JPO Commissioner Iwai (Photo: SIPO)

**[Figure 4-1-3 Relation of Memorandum of understanding on Cooperation in IP between Japan and China]**



The following memorandums were concluded in 2009 between Japan and China.

#### - Memorandum on Establishment of IPR WG (June 2009)

This memorandum was concluded between the METI and the Ministry of Commerce for establishment of Japan-China Intellectual Property Right Working Group to discuss cross-sectional themes on IP.

#### - Memorandum on Cooperation in Trademarks, etc. (August 2009)

The purpose of this memorandum is to strengthen cooperation in trademarks, cracking down on counterfeit products and preventing unfair competition between the METI and the State Administration for Industry & Commerce of the People's Republic of China.

#### - Memorandum on Cooperation between the



#### Patent Offices (December 2009)

This memorandum subjected to reinforce cooperation in patent rights, utility model rights and design rights between the JPO and the SIPO.

#### - Memorandum on Cooperation in Human Resources Development (September 2009)

This memorandum purposes strengthen cooperation in intellectual property human resources development between the INPIT and the Chinese Intellectual Property Training Center (CIPTC).

#### b. Pilot Program of Japan-China Patent Prosecution Highway (PPH)

China is the country in which the second highest number of patent applications are being filed by Japanese applicants, following the number being filed with the U.S.A. Therefore, improving the circumstances in which Japanese companies' technologies can be protected by expeditious and high-quality patent rights is an extremely important issue. This is necessary so Japanese companies can conduct smoother business operations in China.

To this end, the Commissioners of the JPO and the SIPO agreed at the Commissioners Meeting between the JPO and the SIPO held in May 2011 to start a pre-pilot PPH program using a certain number of cases.

Based on the success of this pre-pilot program, the JPO and the SIPO agreed at the 18<sup>th</sup> Commissioners Meeting between the JPO and the SIPO held in October 2011 to start the PPH and PCT-PPH pilot programs between the two countries from November 1, 2011.

#### c. Provision of Utility Model Data of China

The need to understand Chinese documents is becoming greater in line with the increase in recent years in the number of applications filed with the SIPO and in the number of patent documents being written in languages other than Japanese and English.

Therefore, at the 18<sup>th</sup> Commissioners Meeting between the JPO and the SIPO, the two countries agreed to exchange English abstract data of utility model documents of both offices in order to make advancements in

searching Chinese documents. The JPO has started to provide Japanese Abstract Data of the Chinese utility model data using machine translation since March 19, 2012.

#### d. Efforts against Counterfeit Products

Given the reality of serious damage caused by counterfeit products in China, the JPO has been requesting legal revisions and operational improvements through the International Intellectual Property Protection Forum<sup>1</sup> (IIPPF). It has also called for a joint mission by governmental organizations to send members of the public and private sectors to seminars designed for Chinese customs officers and provide training by inviting government officers of various organizations to Japan.

The Third Japan-China IPR Working Group was held on October 24 and 25, 2011 in Kobe based on the Memorandum on Exchange and Cooperation Concerning the Protection of Intellectual Property Rights between the METI and the Ministry of Commerce for the purpose of enhancing exchanges and fostering a cooperative relationship between the two countries in the area of intellectual property protection.

#### e. Cooperation for Legal Reforms

The Patent Law (equivalent to the Patent Act, the Utility Model Act and the Design Act of Japan) was amended for the third time in December 2008, and became effective on October 1, 2009. In addition, the Enforcement Bylaw for the Patent Law (equivalent to a ministerial ordinance) and the examination directions (equivalent to examination standards) became effective on February 1, 2010. This Law includes some of the matters that Japan had requested, such as a rule stipulating that publicly known elsewhere in the world, absolute novelty; and a new requirement to register non-ease of creativity in the design system.

<sup>1</sup> A body of companies and organizations aiming to solve the infringement of intellectual property rights such as piracy; and the counterfeiting of goods in foreign countries.

The JPO has actively cooperated to have laws amended by having exchanges of opinions and holding symposiums with the legal amendment investigation team of the Chinese government, exchanging opinions at places such as joint missions consisting of both public and private sectors, at the JPO-SIPO Meetings, and submitting written opinions to in response to the SIPO, the State Council of the People's Republic of China<sup>1</sup> and the National People's Congress.

In addition, regarding the Trademark Law of China, which is currently being amended, the JPO submitted its comments in July 2006, November 2007 and June 2009 on the draft amendments under consideration at the CTMO in response to the requests written in the Japanese government's comments. In March 2011, the JPO also submitted its comments in response to the request on the draft amendments from the Legislative Affairs Office of the State Council.



<sup>1</sup> A directly-supervised organization of the Central People's Government of the People's Republic of China (the highest-level administrative agency in China) in charge of processing legal works

#### 4) Korea

The JPO has held meetings with the KIPO every year such as Commissioners Meeting between the JPO and the KIPO, several kind of expert meetings on a wide variety of fields such as harmonization, computerization, and issues related to designs, trademarks, and human resources development.

In addition, patent examiner exchange program have been regularly held. in order to promoting mutual understanding between the examiners in various technical fields.

##### a. Memorandums on Cooperation with the KIPO

The following memorandums were concluded in 2010 between the JPO and the KIPO.

##### a) Memorandum on Cooperation for Developing IP Human Resources

In the second meeting for cooperation between Japanese and Korean institutions developing human resources related to IP held in May 2010, the INPIT and the Korea International Intellectual Property Training Institute (IIPTI) concluded a memorandum on cooperation. Its major contents include the exchange of information on training curriculums of the two organizations, implementation of training for private IP human resources in both Japan and Korea, etc.

##### b) Memorandum on Cooperation in Exchange of Regional Name List

In the 22<sup>nd</sup> Commissioners Meeting between the JPO and the KIPO, the two offices signed a memorandum on cooperation to exchange regionally based collective trademarks of Japan and geographical indications list of Korea in order to make use of them as reference materials for trademark examinations in the both offices. The memorandum includes cooperation in exchange, utilization and replenishment of these lists.

b. PCT-PPH pilot program with the KIPO

The JPO have been implementing PCT-PPH pilot program between the EPO and the USPTO from January 2010, that allows an applicant to apply for a fast-track examination based on a written opinion prepared by a specific International Searching Authority or a specific International Preliminary Examining Authority or positive opinion of patentability in an international preliminary examination report.

Both patent offices reached an agreement to start the PCT-PPH pilot program from July 1 2012 so as to further increase the convenience for users.



the 23<sup>rd</sup> Commissioners Meeting between the JPO and the KIPO  
(From left) JPO Commissioner Iwai and KIPO Commissioner Lee



## 2. Efforts Relating to Designs

Amid an increasing number of serious damages arising from counterfeit products, mainly being produced in Asian countries, along with the economic background of ongoing globalization of business activities and the rapid industrial development in Asian countries such as China, awareness of the need to protect designs internationally has been increasing especially in consideration of the characteristic of designs that can be easily counterfeited.

However, each country determines what designs can and cannot be registered based on their own design protection systems, so different decisions may be made from one country to another. Moreover, in order to obtain design rights, it is necessary for users to file applications in accordance with the different procedural requirements set by each country such as requirements for requests and drawings. These situations have placed a great burden on companies that plan to sell their products overseas.

Under such circumstances, with the objective of harmonizing design protection systems with other countries and to support the smooth acquisition of design rights abroad, the JPO holds various meetings with IP offices in Asian countries, including China and the Republic of Korea, and those in Europe and the United States, striving to deepen mutual understanding on each design protection system and design examination practice.

### (1) Expanded Trilateral Cooperation in Design

The Trademark Trilateral Meeting has been held once almost every year since 2001 for the purpose of fostering cooperation among the JPO, the OHIM and the USPTO in the field of trademarks<sup>1</sup>. At the 7<sup>th</sup> Meeting in 2008, the trilateral offices expanded the scope of their cooperation to design field. Since then, the offices have exchanged information and views about their statistics and operational practices on design at the trilateral design session.

In December 2011, the KIPO became a new partner in the Expanded Trademark

Trilateral Meeting, which in that year was held in Alexandria, the United States. The four IP Offices discussed examination of priority claims and view/drawing requirements at the fourth design session.

In addition, the first user session was held in the field of design, with the participants from user groups from Japan, Europe and the US, exchanging opinions on each office's design protection systems and practices.



Participants of the design session of the Expanded Trademark Trilateral Meeting

### (2) Bilateral Efforts

#### 1) JPO-SIPO Design Experts' Meeting

At the 11th Commissioners Meeting between the JPO and the SIPO in November 2004, the Commissioners agreed for examination departments and the Appeals Department of the JPO and the Patent Reexamination Board of SIPO to start with a meeting in the field of design, in order to strengthen interaction between the two offices and enhance the effectiveness thereof. In response to this, the first JPO-SIPO Appeals Meeting (Design) was held in Japan in August 2005. Since then, the two offices have exchanged information in the field of design almost every year.

At the 17<sup>th</sup> Commissioners Meeting between the JPO and the SIPO in December 2010, the "JPO-SIPO Design Experts' Meeting", with involvement of the Design Examination Department of SIPO and the above reexamination board, was newly established, and the two offices agreed to deepen cooperation in the design field.

<sup>1</sup> See Part 4, Chapter 1, 3.(1).



At the First JPO-SIPO Design Experts' Meeting held in Beijing in June 2011 in response to the agreement, the JPO and the SIPO exchanged information and opinions mainly on examination practices of applications that have priority claims, and on design right evaluation reports written by SIPO.

## 2) JPO-KIPO Design Experts' Meeting

With the aim of achieving mutual understanding of each design protection systems and exchanging views on examination methods, the JPO-KIPO Design Examiners' Meeting has been held once every year since its first meeting in 2001. (The name was changed to "JPO-KIPO Design Experts' Meeting" since the 7<sup>th</sup> meeting)

In May 2011, the tenth JPO-KIPO Design Experts' Meeting was held in Daejeon, the Republic of Korea in which the participants exchanged information and views mainly on the current status of the design registration systems and examination guidelines in Japan and the Republic of Korea, the draft revision of the Industrial Design Protection Act that the Republic of Korea is reviewing, and on the operations of specific examination practices concerning the accession to the Geneva Act of the Hague Agreement.

## 3) JPO-OHIM Design Examiners' Meeting

As the Office for Harmonization in the Internal Market (OHIM) started operation of design registration based on the Council Regulation on Community designs on April 1, 2003, JPO-OHIM Design Examiners' Meeting have been held almost every year since 2003.

The seventh JPO-OHIM Design Examiners' Meeting was held in Tokyo in November 2011 to exchange information and views mainly on the current status of the design protection systems of the two Offices, operation of the international design registration based on the Geneva Act of the Hague Agreement, the Locarno Classification and the protection of screen image designs.

## 4) Exchange of Opinions on Design Systems with the USPTO

With the aim of deepening understanding

on the design systems and examination practices of the two countries, the JPO exchanged opinions on each design protection system with the USPTO in Alexandria, USA, in December 2011. The two Offices exchanged information and views mainly on the state of preparations for the accession to the Geneva Act of the Hague Agreement, design classifications and the revision of the U.S. Patent Laws.

## (3) Japan-China-Korea Design Forum

The first Japan-China-Korea Design Forum was held in Beijing in July 2010 for the purpose of exchanging information on the design systems of the three countries and promoting mutual understanding.

At the second Japan-China-Korea Design Forum held in Seoul, in May 2011 each office made a presentation on recent system reforms, etc. in each country and the WIPO made a presentation on the outline of the Hague System. In addition, user groups from South Korea and Japan participated in the forum and exchanged opinions with IP offices on the design systems of each country.

The third Japan-China-Korea Design Forum will be held in Japan in November 2012.



Participants of the Second Japan-China-Korea Design Forum

#### (4) Cooperation and Support to the Asian Region

##### 1) Cooperation in Design Examination

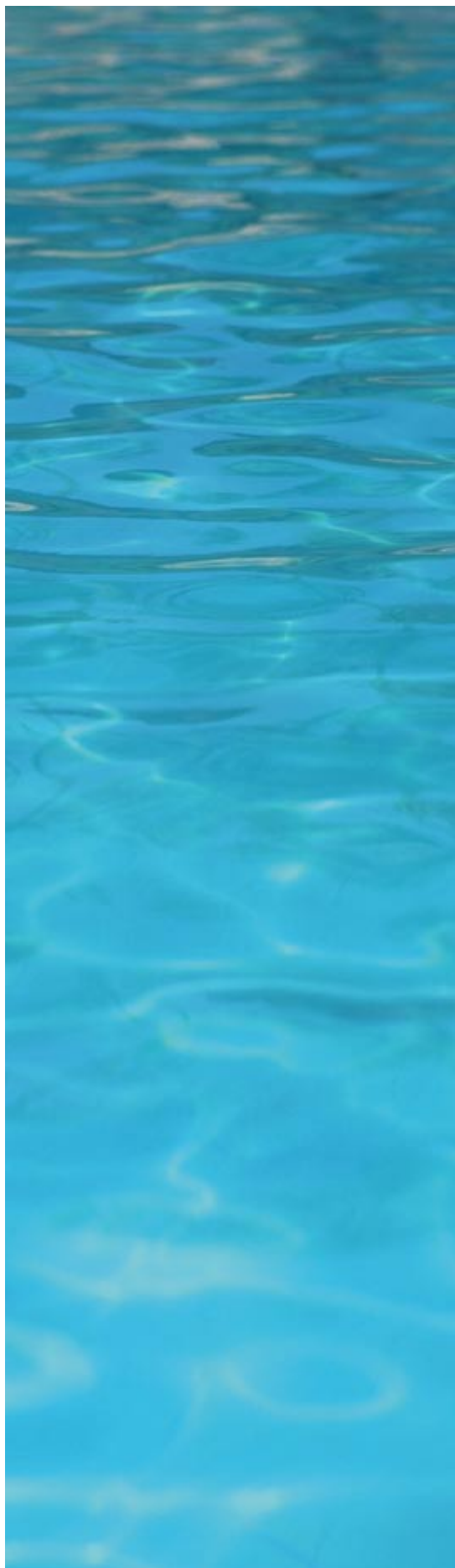
In order to support efficient substantive design examination in developing countries, the JPO has been providing certain countries with the examination results of the first design applications filed with the JPO, that are filed with the countries with priority claims, upon requests from the IP offices cooperating in design examination (Department of Intellectual Property of Thailand: started in January 2002, National Office of Intellectual Property of Vietnam: started in September 2002).

##### 2) Cooperation in Human Resource Development

The JPO has been providing support to developing countries such as by using the WIPO Funds-in-Trust/Japan<sup>1</sup> to send experts and accept trainees almost every year. The JPO has been working to support the development of their design systems and to harmonize application procedures and examination operations in Asian countries by sharing information on the design system and examination operations of Japan with other countries based on the kind of support mentioned above.

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<sup>1</sup> See Part 4, Chapter 1, 5.(3).



### 3. Efforts Relating to Trademarks

Amid intensifying international competition among businesses in line with economic globalization, it has become increasingly important to establish highly recognized international brands and protect them in an active and expeditious manner using the trademark system. However, as trademark systems are different in one country to another, applicants need to perform different procedures to acquire trademark rights in each country, which poses a great burden on them.

In order to support companies that are facing these issues and expanding their business operations overseas, it is necessary to create an environment that allows the expeditious acquisition of stable trademark rights worldwide and the appropriate protection of those rights. Therefore, the JPO is working to harmonize the trademark systems in place in other countries and simplify procedures based on bilateral efforts with countries such as China and multilateral efforts with the WIPO and the Expanded Trademark Trilateral Offices.

#### (1) Expanded Trademark Trilateral Cooperation

The First Trademark Trilateral Cooperation Meeting was held in Arlington in the United States, in May 2001, with the aim of improving the trademark registration systems and the operations thereof through exchanging information and opinions on related matters between the Trilateral Offices (JPO-USPTO-OHIM). The meeting has been held once every year since then. The State Administration for Industry & Commerce of the People's Republic of China (SAIC) has participated in this meeting as an observer since the Tokyo Meeting was held in October 2007.

At the Trademark Trilateral Cooperation Preparatory Meeting in May 2011, the Trilateral Offices agreed to invite the SAIC and the KIPO as meeting members, and the KIPO expressed its intention to participate in the meeting. Therefore, the four Patent Offices participated in the Expanded Trademark Trilateral Cooperation Meeting held in Alexandria in the United States in December 2011 as official members, and the SAIC

participated in it as an observer. Then, as the SAIC expressed its intention to officially participate in this meeting, the Trademark Five Offices System started.

At the Expanded Trademark Trilateral Meeting, discussions were made on collaboration projects, classifications of goods and services, common statistical indicators, and IT. Moreover, the user session was held with the participation of user organizations from Japan, Europe, the Republic of Korea, and the United States.

In the discussion on collaboration projects, the four Offices agreed on the rules dealing with how to advance projects (the methodology) proposed by the OHIM, deciding that the OHIM will provide a work plan on the methodology of future projects. Moreover, the JPO proposed that a joint study be conducted on image searches of figurative marks. Under the direction of the JPO, the four Offices agreed to exchange information to determine examination procedures for figures.

In the discussion on classifications of goods and services, the four Offices agreed to continue to use a list of indications of goods and services (Trilateral Office ID list) acceptable by the Trilateral Offices and review the participation of other countries. In addition, the four Offices agreed to make new rules, after KIPO joined as a partner.

In the discussion on common statistical indicators, the participants shared statistics on major matters such as the numbers of applications and examiners, examination periods, and fees, developing meaningful statistics to compare each patent office. At this meeting, the four Offices agreed to provide their counterparts with statistical data to ensure enough time for conducting a prior review before the meeting and to include predicted values as much as possible.

In the discussion on IT, the four Offices agreed to choose a structure of common status descriptors to show the status of cases incorporating the three-tier structure, as proposed by the JPO.

In the discussion on the review on bad faith filings, which is one of the collaboration projects, the four Offices agreed to hold

seminars on bad faith filings in China, having held two not in the working group format as agreed at the previous seminar but in the conventional workshop format (seminar format).



December 2011 the Expanded Trademark Trilateral Meeting (From left) OHIM President Campinos, KIPO Director General Lee of the Trademark and Design Examination Bureau, USPTO Commissioner Cohn for Trademarks, SAIC Deputy Director General Li of China Trademark Office, JPO Director-General Hashimoto of the Trademark, Design and Administrative Affairs Department

A total of 11 user organizations from Japan, Europe, the Republic of Korea, and the United States, including three organizations from Japan (Japan Trademark Association, Japan Patent Attorneys Association and Japan Intellectual Property Association) ) were invited to the User Session as in 2010. The session was extended to half of a day to enable more opportunities to exchange opinions. The participants agreed to review the necessity of further discussions based on the opinions submitted from users.

## (2) Bilateral Efforts

### 1) High-level Exchanges with China

#### a. Meeting with Vice Minister of SAIC

In May 2011, the Commissioner of the JPO and the Vice Minister of the SAIC held a meeting in Beijing, China.

At this meeting, the JPO commented on the efforts made by the SAIC in these years concerning the problem of offending trademark applications in China, and requested that more attention be given. Furthermore, the two countries agreed to strengthen cooperation in the field of trademarks.

In December 2011, the Commissioner of the JPO and the Vice Minister of the SAIC

held a meeting in Tokyo. At this meeting, the two offices agreed to exchange trademark examiners as a means to further develop the cooperative relationship between the two offices. The two offices also agreed to continue to exchange opinions on the problem of offending trademark applications and maintain their cooperative relationship in order to solve this problem.



December 2011 Meeting between JPO Commissioner and SAIC Vice Minister

#### b. JPO-CTMO Trademark Commissioner Meeting

The first JPO-CTMO Trademark Commissioner Meeting was held in Beijing in December 1996 in order to deepen understanding on each other's trademark systems and promote exchanges between the two countries. The Meeting has been held in Japan and China alternately ever since.

The seventh JPO-CTMO Trademark Commissioner Meeting was held in Beijing, China, in January 2009 between the JPO and the CTMO, one of the offices of the SAIC.

At this meeting, the two Offices agreed to strengthen their cooperative relationships at various levels such as at seminars initiating measures to combat against counterfeit products.

In addition, regarding the problem of regional names and regional brands in Japan being applied to trademarks but being registered by third parties in China, the JPO requested fair and appropriate examinations. The CTMO answered that the applications for regional names, etc. in Japan would be determined strictly based on the law. The



CTMO also said that they will respond strictly to bad faith filings, taking into account the fact that Japan and China are neighboring countries sharing similar cultures.

## 2) JPO-KIPO Trademark Experts' Meeting

At the 12th JPO-KIPO Meeting in November 2000, the two offices agreed to establish the JPO-KIPO Trademark Examiners' Meeting in order to help trademark examination practices based on exchanging information and opinions on the trademark examination systems/operations between the JPO and the KIPO. The Meeting will also be a basis to deepen understanding of each other's systems and operations. The first JPO-KIPO Trademark Examiners' Meeting was held in Japan in June 2001.

The name was changed from the JPO-KIPO Trademark Examiners' Meeting to the JPO-KIPO Trademark Experts' Meeting from the sixth meeting, in March 2008, to discuss not only operational problems related to trademark examinations but also a wide variety of fields in which the two offices are interested such as treaty and policy matters.

The eighth meeting was held in Tokyo in April 2011. At this meeting, information and opinions exchanges on various issues were conducted. The issues consisted of examination of trademarks, including regional names and geographical indications, and progress of Korea-EU FTA and Korea-US FTA and their influence on the Trademark Act, provision of information on trademarks to other countries and improvement of examiner practices, etc. Furthermore, a list of regionally based collective trademarks of Japan and a list of geographical indications of Korea were exchanged in accordance with the memorandum concluded at the JPO-KIPO Commissioner Meeting in December 2010.

## (3) Response to Offending Trademark Applications

Applications of regional names and famous trademarks in Japan are being filed for trademark registrations and being registered by third parties in China. This problem of offending trademarks may disrupt Japanese

companies expanding their businesses in China.

Particularly in China, the Trademark Act was revised in 2001 to disallow publicly-known foreign regional names from being registered. However, it was discovered that the name "Aomori" had been filed for a trademark in 2003, and it was confirmed that many other prefecture names in Japan had been filed for trademarks since then. In response to this situation, the JPO requested the SAIC to take measures to combat the problem and protect intellectual property. As a result, the situation has improved and it was confirmed in 2011 that the filing of 12 prefecture names (Hokkaido, Akita, Fukushima, Chiba, Toyama, Ishikawa, Fukui, Nagano, Aichi, Kyoto, Nara, Fukuoka and the name of one city, Kawasaki) for trademark registrations by third parties had been rejected.

The JPO will continue its efforts in requesting the Chinese government to improve and promote cooperation at the practical and high levels by exchanging information and opinions so that the fair examinations are made.

On the other hand, in order to address this problem, the JPO created a manual on the trademark search/legal actions based on its "Comprehensive Countermeasures against Trademark Application Problems of Regional Names in Japan by Third Parties in China and Taiwan", publicizing it in June 2008. The JPO widely provides information by distributing the manual to prefectures, government-designated cities, agricultural-related organizations, etc. In addition, the JPO has established the "Special consultation sections that assist with offending trademark problems" in Beijing and Taipei and respond to concerned parties in Japan such as local governments.

Furthermore, what is important is for applicants to acquire trademark rights as a first step against offending trademark problems. In this respect, the JPO subsidizes the costs incurred by small-and-medium-sized businesses to file applications, taking into account the many costs associated with applications, patent attorneys, translations, etc.<sup>1</sup>.

<sup>1</sup> See Part 2, Chapter 2, 1.(1)2.

#### 4. Efforts Relating to International Forums

From the past, international discussions on intellectual property have been actively held in the framework of the World Intellectual Property Organization (WIPO) which is a specialized agency of the UN working for the protection of intellectual property and TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) which deals with the rules of trade under the auspices of the World Trade Organization (WTO). In addition, in recent years, intellectual property has been discussed as an important issue at forums such as the Asia-Pacific Economic Cooperation (APEC), a framework for regional-level economic cooperation; the World Health Organization (WHO); the United Nations Framework Convention on Climate Change (UNFCCC); and the Convention on Biological Diversity (CBD), all working on ways to deal with global issues such as public health and climate change based on the perspective of intellectual property.

(1) Intellectual Property Rights Experts' Group (IPEG) Meeting at the Asia-Pacific Economic Cooperation (APEC)

APEC, consisting of 21 countries and regions in the Asia-Pacific region, each called as an economy, is a regional forum aiming for the liberation and facilitation of trade and investment as well as economic and technical cooperation. At the APEC Economic Leaders' Meeting in Osaka held in 1995, intellectual property rights were adopted as one of the 15 priority areas concerning the liberation and facilitation of trade and investment. The IPEG was established as an expert-level forum specializing in the area. The IPEG carries out activities in accordance with the new Collective Action Plan (CAP) formulated in 2001 in response to the implementation of the TRIPS Agreement, in order to promote the liberation and facilitation of trade and investment.

For specific activities, the IPEG holds public and private seminars and symposia on intellectual property, in addition to holding periodic meetings usually twice every year. In January 2007, Japan proposed the APEC

Cooperation Initiative on Patent Acquisition Procedures, which includes work to simplify patent procedures, to cooperate in patent examination in the APEC region, and to improve patent examination capability, so as to enable applicants to acquire high quality patent rights in a more simplified and expeditious manner. This initiative was approved at the APEC Ministerial Meeting held in September 2007. With the aim of promoting this initiative, Japan conducted studies on practices of examination cooperation (Patent Prosecution Highway (PPH), Modified Substantive Examination, etc.) which are currently being conducted among the APEC economies. At the 28th IPEG Meeting held in February 2009, the results of those studies were publicized. A website<sup>1</sup>, which allows users to view application formats to start processes to refer to examination results of other offices, went online in March 2011.

At the Meeting of Ministers Responsible for Trade in July 2009, Japan proposed building global IP infrastructures to promote innovation, as a concept to cover the diversifying efforts related to intellectual property in the APEC and demonstrate the future course. The Statement of Chair, which said that creating such infrastructures would be a desirable direction, was publicized. Then, similar descriptions were included in the Joint Statement at the 21<sup>st</sup> APEC Ministerial Meeting in November 2009, in the APEC Leaders' Growth Strategy in November 2010, and in the Joint Statement at the APEC Ministerial Meeting. The concept of creating global IP infrastructures has been an issue under consideration at the APEC.

In line with these developments, Japan preliminary proposed an initiative (iPAC initiative) to encourage cooperation among training organizations to foster human resources in intellectual property at the 29th IPEG Meeting held in July 2009. After that, a formal proposal was submitted at the 30th IPEG Meeting. This proposal, which was unanimously approved, fosters cooperation

<sup>1</sup> <http://patent.apec.org/>

among various organizations in charge of human resources development in the field of intellectual property in the APEC region and advances the development of infrastructures for the intellectual property rights systems through information sharing, etc. Also, training programs conducted by each organization are shared through the website, with the aim of exchanging various information and expertise on human resources development. Based on the approval of this proposal, the JPO opened a website<sup>1</sup> to enable information to be shared among IP training organizations in March 2011.

In addition, at the 33<sup>rd</sup> IPEG in September 2011, Japan made the following two proposals: “Bail-out Measures Survey” and “Quality Management Survey.” These were approved. At the 34<sup>th</sup> IPEG in February 2012, matters relating to the tables of these studies were approved and they would be filled in by each country or region.

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<sup>1</sup> <http://ipac.apec.org/>

## 5. Efforts for Developing Intellectual Property Systems in Developing Countries

The intellectual property system is an effective and necessary infrastructure to develop business also in developing countries. Efforts to assist the establishment of the intellectual creation cycle and build the intellectual property system in developing countries contributes the autonomous economic development of them. This results in sustainable global economic growth. In addition, establishing the intellectual property system will lead to improving the trade and investment environment, and this will lead to the development of those developing countries in light of the increase of direct investment in them.

From this standpoint, the JPO has thus been providing vigorous means of assistance for human resources development and informatization to reinforce the protection of intellectual property rights in developing countries, mainly in the Asia-Pacific region.

More than 10 years have passed since the developing countries agreed to execute the TRIPS Agreement, and it seems that they have developed their legal systems to some degree. However, the operational aspects of the legal system are still at a developing stage in some countries. It is important to offer assistance to developing countries that are focusing on further improving their legal systems and operations. As suggested by the fact that the expiration date for LDCs to join the TRIPS Agreement was extended to the end of June 2013, it seems that their administrative systems and legal systems still have room for improvement and in need of further assistance.

Since the degree of intellectual property rights protection and the conditions for conducting trade and investments significantly differ among developing countries, it is essential to consider the priorities of each country and the fields to be targeted to meet the conditions of each country.

### (1) Fundamental Ideas in Assistance in Developing Countries

It is necessary for Japan to actively assist developing countries, taking into account the following points based on the proposal that “the Intellectual Creation Cycle should encourage self-organized, economic development of developing countries by encouraging the creation of intellectual property systems, and by sharing successful cases involving intellectual property, with developing countries in providing assistance for them” in the report of “the Study Group on Innovation and IP Policies” entitled “New IP Policies for Innovation Promotion (August 2008).”

In terms of assistance in developing countries, it is important to raise the awareness of intellectual property and encourage them to take active efforts on their own to build intellectual property systems, in order to promote their autonomous economic development.

Japan, under the aim of promoting self-organized economic development in developing countries, provides assistance to activities devoted to discovering specialty products with unique characteristics and which are deeply-entrenched in local communities. Japan works to develop those products under the concept that each country is capable of raising itself up based on its own efforts alone, such as on the “one village/one product campaign”. In order to continuously develop industries in those local communities, it is important to provide assistance so that innovations and unique brands developed in those local communities can be promoted and developed through the use of intellectual property.

Japan has gone through many experiences that in the end have improved its international competitiveness by building its intellectual property system that promotes the Intellectual Creation Cycle consisting of creation, protection and exploitation of intellectual property. Therefore, with regard to assistance in developing countries, it is considered effective to promote the building of an intellectual property system in those countries and to share successful case studies in which intellectual property has been used so as to



promote the intellectual creation cycle and self-organized economic development in those countries.

Due to economic globalization, the number of patent application has increased world wide and expediting patent examinations while at the same time maintaining the quality of examination has become a mutual issue among intellectual property offices. Japan considers it important to further deepen relationships with developing countries, mainly in the Asian region, and to assist Africa.

## (2) Expansion of Assistance to African Countries

The JPO has strongly assisted the training of IP experts, along with assistance for computerization, in developing countries mainly in the Asia-Pacific region. It has provided technical assistance in the field of intellectual property in the region through the WIPO Funds-in-Trust/Japan<sup>1</sup>. In order to develop IP human resources in Africa using the know-how on human resources development and technical cooperation obtained through those activities so far, since FY2008, the JPO has expanded the assistance to newly establish another fund for Africa under the name of the WIPO Funds-in-Trust/Japan.

This fund aims to assist human resources development targeting administrative officers, business owners and legal specialists in Africa to promote autonomous economic development utilizing intellectual property in Africa. This project particularly focuses on 1) public awareness activities to combat against counterfeits threatening people's health, safety and property, 2) efforts conducive to enhancing the capacity to link the intellectual property to inventions and creation, and then to link intellectual property to business, and 3)

development of future leaders who will be able to incorporate intellectual property into national economic and scientific policies.

## (3) Cooperation in the Development of Human Resources

### 1) Sending of Experts

The JPO sends JPO officials to developing countries through the Official Development Assistance (ODA) scheme such as the WIPO Funds-in-Trust/Japan. The experts sent mainly give on-site instructions on examination practices, computerization, and so forth.

### 2) Acceptance of Short-term and Mid-term Trainees to Japan

The JPO provides training, focusing on training programs mainly to patent examiners and administrative officers in developing countries, in order to develop human resources for strengthening the protection of intellectual property rights. The JPO has accepted a total of 3,678 government and civilian trainees from 57 countries and one region (mainly from the Asia-Pacific region) from April 1996 to March 2012<sup>2</sup>.

From FY2009, the JPO has been providing a mid-term training program (three months) focusing on search and patent examination practices. It invited three patent examiners from India in FY2011.

### 3) Acceptance of Long-term Trainees

The JPO invites to Japan those who are taking, or who will be taking, leadership roles in the field of intellectual property rights in developing countries. The program lasts six months and offers an opportunity for the trainees to conduct self-initiated studies on intellectual property rights<sup>2</sup>.

In FY2011, the JPO accepted a total of three long-term trainees, one from Brazil and two from China.

<sup>1</sup> Since 1987, the Japanese government has been providing voluntary contributions to the WIPO. "WIPO Funds-in-Trust/Japan" was established with these voluntary funds and it is used to finance various projects for developing countries which join both WIPO and the Economic and Social Commission for Asia and the Pacific (ESCAP), such as the holding of symposia, acceptance of trainees and Intellectual Property Rights (IPR) research students, sending of experts and computerization of IP offices.

<sup>2</sup> Website of Cooperation Project for IP Human Resource Development ([http://www.training-jpo.go.jp/en/modules/pico2/index.php?content\\_id=2](http://www.training-jpo.go.jp/en/modules/pico2/index.php?content_id=2))

#### 4) Holding of the Follow-up Seminars

The graduates of the training programs has created voluntary organizations called “alumni associations”, in their countries. Together with the alumni association and the local IP offices, the JPO conducts follow-up seminars every year.<sup>1</sup>

The objective of the follow-up seminar is to assist maintaining and following-up the achievements of the training in Japan, strengthening collaboration among trainees and developing awareness on intellectual property systems in their home countries. In FY2011, follow-up seminars were held in Vietnam, Thailand and Indonesia.



October 5 and 6, 2011, Follow-up Seminar in Vietnam (Hanoi)

#### 5) Implementation of Technical Cooperation Project

Making use of the ODA scheme<sup>2</sup>, the JPO sends experts to developing countries for long periods of time to assist the development of intellectual property systems, human resources, and awareness on IP in those countries.

Currently, the “Project for the Strengthening Intellectual Property Rights Protection (April 2011~April 2015)” is being implemented in Indonesia for the purpose of

strengthening the protection of and promoting the exploitation of intellectual property rights. The JPO provides technical assistance and advice through sending experts and accepting trainees. The expected achievements include: enhanced functions of IP-related enforcement institutions in Indonesia, improvement of examination capacities of the Directorate General of Intellectual Property Rights (DGIRP), and utilization of intellectual property rights at higher educational institutions such as universities.

#### 6) Holding of Forums, Workshops, etc.

The achievements of the major meetings managed by the WIPO Funds-in-Trust/Japan are as follows:

##### a. Study Program on Innovation and Transfer of Technology

This study program was held in Morocco in April 2011 for the purpose of sharing experiences on transfer of technology based on strategic utilization of intellectual property in universities, research institutions, etc. About 20 persons from 11 African countries, the WIPO and the JPO participated in this study program.

##### b. Policy Dialogue on the Role of Intellectual Property for Economic, Social and Cultural Development

This policy dialogue was held in Zambia in May 2011 for the purpose of discussing and exchanging information on successful cases, experiences, and problems of each country with regard to how to achieve economic development in Africa by utilizing intellectual property systems and forging a future course of IP policies and cooperation between regional economic communities and each patent office. About 30 persons from Africa (21 countries and organizations), the WIPO and the JPO participated in this policy dialogue.

##### c. Regional Seminar on Realizing the Development Potential of ICT-Based Business Services

This seminar was held in Zimbabwe in May 2011 for officials of each IP office with the aim of sharing knowledge on benefits of

<sup>1</sup> Website of Cooperation Project for IP Human Resource Development ([http://www.training-jpo.go.jp/en/modules/pico2/index.php?content\\_id=2](http://www.training-jpo.go.jp/en/modules/pico2/index.php?content_id=2))

<sup>2</sup> A technical cooperation project is a form of project implemented during a certain period as one project consisting of three cooperation methods (cooperation tools), sending experts, acceptance of trainees and provision of equipment.

introducing ICT (information and communications technology) in businesses and discussing how to implement it.

About 40 persons from Africa (16 countries), the ARIPO, the WIPO, and the JPO participated in this seminar.

d. National Workshops on the Enforcement of Intellectual Property Rights

These workshops were held in Cambodia and Indonesia in September 2011 with the aim of deepening the understanding of the connection between enforcement of intellectual property rights and economic development, focusing on building capacity to improve border enforcement. About 140 persons attended. The attendees included government officials involved in intellectual property rights enforcement such as customs, police and chamber of commerce, officials from the WIPO and the JPO. They shared professional knowledge on enforcement, such as the importance of strengthening cooperation among related agencies.

e. Regional Forum on University-Industry Collaboration to Promote Technology Transfer

This forum was held in Vietnam in November 2011 for the purpose of providing participants with opportunities for sharing information and exchanging opinions concerning specific measures and the role of industry, university and government to promote technology transfer with the aim of sharing the knowledge and experiences of Japan. About 50 persons attended, including individuals such as senior government officials involved in IP in the Asian region (10 countries), staff from universities and research institutions, WIPO officials, and JPO officials, who actively exchanged opinions.

f. Sub-Regional Workshop on the Utilization of Patent Examination Results to Enhance Patent Examination Capacities and Increase the Quality of Patents

This workshop was held in Malaysia in November 2011. The objective of the Workshop was to provide participants with the opportunity to understand the effectiveness of utilizing search and examination results prepared by other IP offices in reducing workloads and streamlining patent obtainment procedures. It also aimed to share the knowledge and experiences of Japan on how to make use of examination results and substantive examinations. About 30 persons, mainly patent examiners, attended this workshop. They included officials of IP Offices in the Asian region (13 countries), and officials from the WIPO and the JPO. Practical programs on patent examinations helped the participants share their knowledge and skills in terms of their respective offices.

g. Regional Workshop for the LDCs of Asia and the Pacific Region on the Use of Intellectual Property for Enhancing Economic Competitiveness and Development

This workshop was held in Bhutan in December 2011 for the purpose of raising awareness of the importance of IP for economic development for LDCs in the Asia-Pacific region and sharing information on business activities and various measures effectively utilizing IP. About 30 persons participated in the program, including government officials in charge of IP from Asia-Pacific regions (10 countries), business institutions such as chambers of commerce and industry, and officials from the WIPO and the JPO. They shared understanding on the importance of IP, the necessity of IP infrastructure and mutual issues.

h. Conference on the Role of Intellectual Property Offices in Promoting Innovation, Business Competitiveness and Economic Growth

This conference was held in Japan in February 2012 with the aim of sharing the knowledge and experiences of Japan with



regard to the importance of national IP policies and strategies in terms of their establishment and implementation. This conference provided opportunities for discussing the experiences and issues in each country, and the role of IP Offices in this regard. About 30 persons attended: senior officials of IP Offices (eight in Asia and five in Africa) and officials from the WIPO and the JPO, who actively exchanged opinions on the importance of IP policies / strategies and the methodologies for their establishment, organizational infrastructures, collaboration on innovation policies, etc.



February 2 and 3, 2012 Japan (JPO)

i. Workshop on Measures for Accession to, and Effective Use of, the Madrid System

This workshop was held in Japan in March 2012 for the purpose of encouraging developing countries in the Asia-Pacific and African regions to accede to the Madrid System. At the workshop, a JPO official spoke of the experiences of Japan at the time it acceded to the Madrid System, as well as on how to effectively use the system. About 40 persons from Asia (11 countries), Africa (2 countries), IP offices (ARIPO and OAPI), the WIPO and the JPO participated in this workshop and actively asked questions and exchanged opinions on the systemic and practical aspects of the Madrid System.

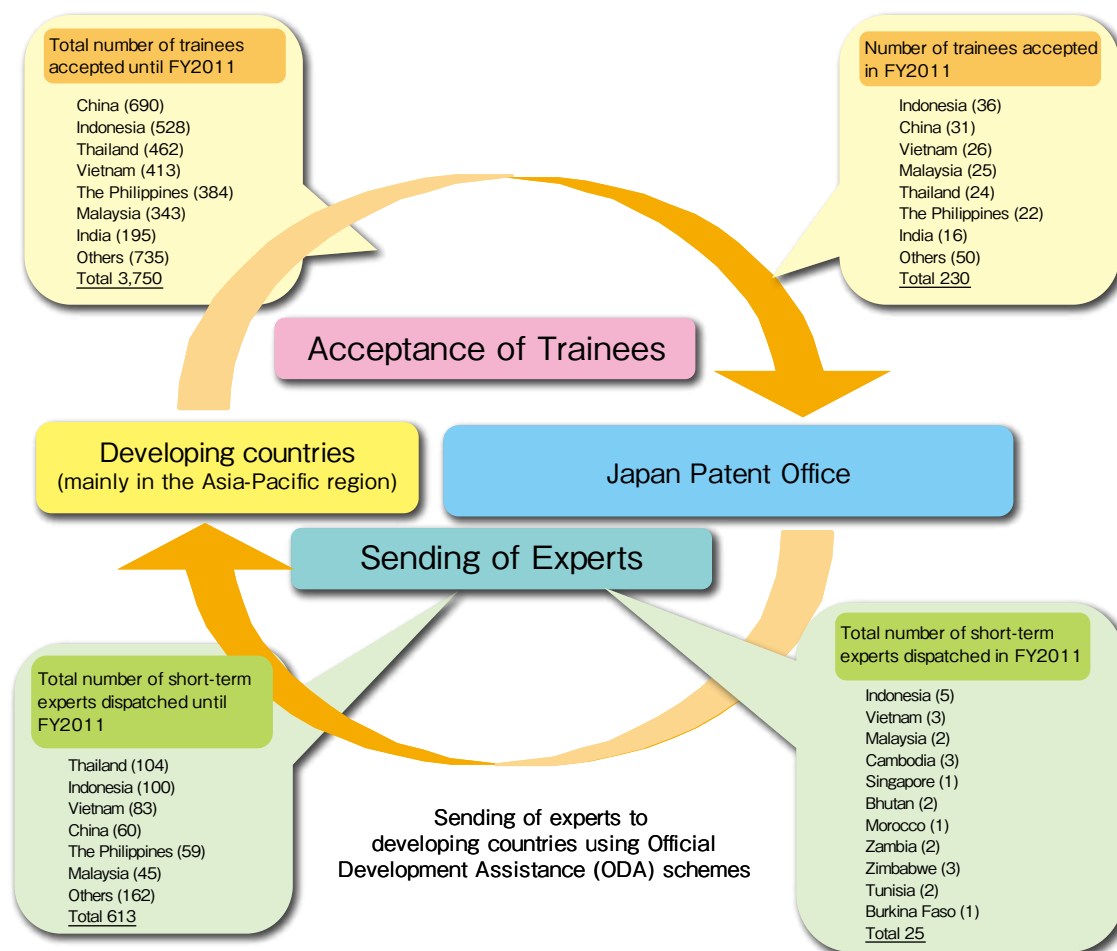






March 8 and 9, 2012 Japan (JPO)

**[Figure 4-1-4 Steadily-growing cooperation in the Development of Human Resources]**



#### (4) Cooperation on Information Technology

In Indonesia, the JPO, by sending five short-term experts to the Directorate General of Intellectual Property Rights (DGIPR), helped to establish the Industrial Property Digital Library (IPDL) system that provides information on intellectual property rights. The IPDL service was launched in February 2007.

In the Philippines, the JPO spent four years to set up the Patent Administration Computerized System (PACSYS) in order to handle applications at the Intellectual Property Office of the Philippines (IPOP) under the Japanese ODA's scheme. Furthermore, the JPO carried out the follow-up for the above-mentioned project by sending four short-term experts during this period.

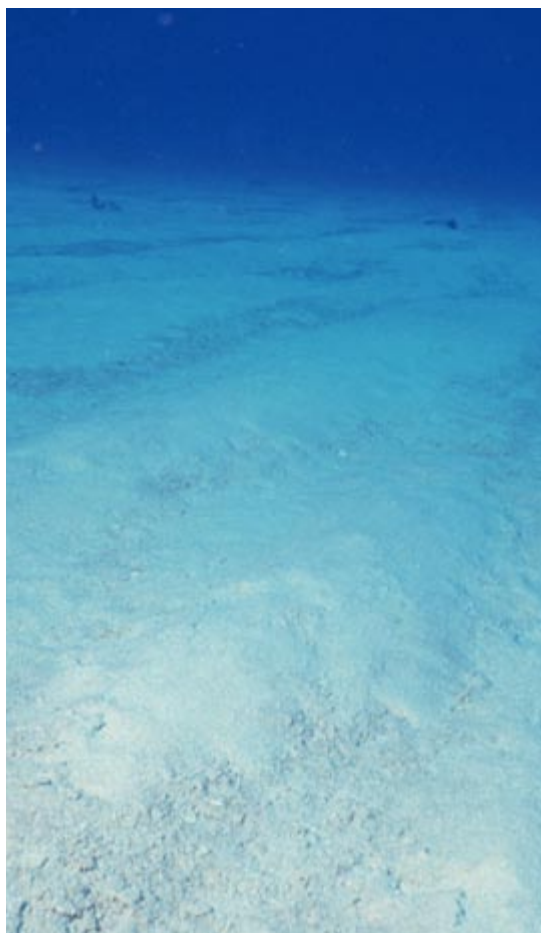
In Vietnam, the JPO, under the ODA scheme, spent four years in helping the National Office of Intellectual Property of Vietnam (NOIP) to establish the Intellectual Property Administration System (IPAS) to handle applications. Based on the results, the JPO cooperated in building search systems that include human resources development, electronic filing systems, and the IPDL<sup>1</sup>, for which the JPO sent one long-term expert.

In Thailand, the JPO supported the Department of Intellectual Property of Thailand (DIP) to establish a search system (IPDL), spending five years and working under the ODA's scheme. In addition, an administrative processing system for patents, utility models, and designs were established under the cooperation of the JPO and the WIPO for three years. Starting from 2006, the DIP expanded the stored data and started operating the administrative processing system and the search system<sup>2</sup> to which new functions were added.

#### (5) Cooperation in Examination: Provision of Advanced Industrial Property Network (AIPN)

AIPN refers to a system for providing examination information in Japan to intellectual property offices in other countries. The purposes are to reduce the duplication of work at intellectual property offices by effectively using examination results of corresponding patent applications in Japan and to expedite the acquisition of rights at these other offices. The JPO has been working to disperse the AIPN in order to cooperate in patent examinations with developing countries.

Specifically, the JPO established a system that enables examiners at intellectual property offices overseas to obtain online information in English on documents used for examination procedures, as well as information on the legal status of patent applications, cited documents, documents on examinations of post-grant claims, and patent families. As of March 2012, the AIPN was available to 56 countries/organizations.



<sup>1</sup> <http://iplib.noip.gov.vn/>

<sup>2</sup> <http://110.164.177.243/DIPSearch/PatentSearch/SearchSimple.aspx>

## 6. Countermeasures against Counterfeit Products

Nowadays still, the production of counterfeit products in countries and regions that do not have effective systems to protect intellectual property rights causes significant damage to companies in Japan and elsewhere. The global distribution of counterfeit products has become a serious problem. This section outlines the efforts that the Japanese government, including the JPO, has made to combat counterfeit products.

### (1) Current Status of Issues Involving Counterfeit Products

In line with economic globalization, counterfeit products imitating the originals produced by Japanese companies are being manufactured in developing countries and distributed worldwide as a result of insufficient protection of intellectual property rights. This is in spite of the fact that industrial technologies are being further developed. The damage caused by counterfeiting in foreign markets has become increasingly severe. Counterfeiting has had a negative impact on business activities. It not only causes a market-share loss in foreign markets, a deterioration of brand image, and an increase in the number of problems concerning product liability but also endangers the lives and health of consumers because of the inferior quality of the counterfeit parts and bogus pharmaceuticals that are being manufactured. It is hoped that immediate countermeasures will be taken. Under the aim of supporting business activities of Japanese companies overseas, the JPO, through bilateral meetings, has provided information concerning countermeasures against counterfeit products to the countries subject to damage, and approached and assisted in improving systems and operations to the governments of countries where the damage occurs.

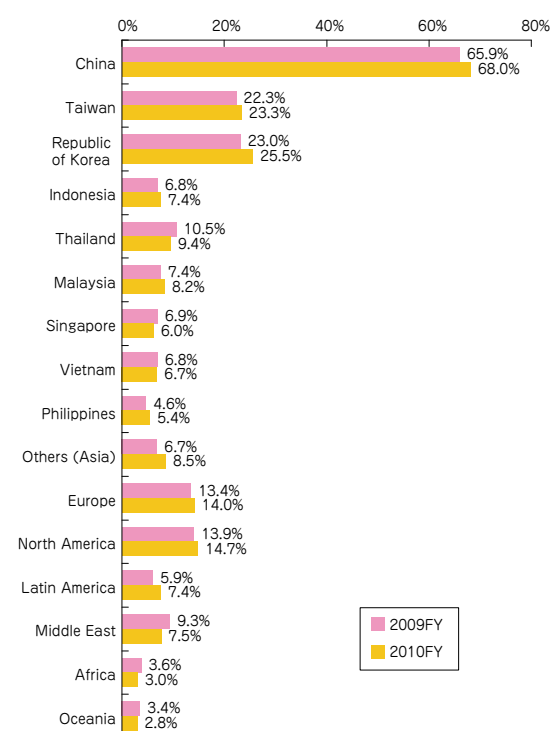
With the globalization of business activities, there has been a rapid increase in the number of applications being filed in developing and emerging countries. In order to build an environment in which intellectual property rights are properly protected, it is important to promote voluntary efforts by

developing countries in terms of not only ensuring the protection of intellectual property but also enhancing the enforcement of it too. It is also important to enhance assistance toward building intellectual property systems and improving examination capability in developing countries so that appropriate rights are given at the examination phase in developing countries. In order to achieve this, it is important to go beyond the traditional trilateral cooperation of Japan, the United States and Europe on examination and cooperation for harmonized systems.

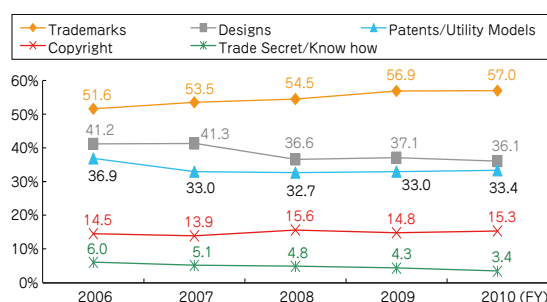
The environment surrounding global intellectual property has been drastically changing in line with the recent economic globalization.

There is a need to respond to the high level of complicated technologies being developed, as well as the need to respond to the work being done to grant and protect patents for high quality intellectual property by establishing an intellectual property system supporting international business activities.

**[Figure 4-1-5 Ratio of Counterfeiting Victim Companies Overseas (Multiple Responses)]**



**[Figure 4-1-6 Changes in the Rate of the Types of Rights Infringed through Counterfeiting (Multiple Responses)]**



## (2) JPO's Efforts to Stop Counterfeiting

### 1) Approaches and Support for Governments in Developing Countries

In the midst of globalized business activities, the number of applications being filed is rapidly increasing in developing and emerging countries such as China. With the protection of intellectual property rights being addressed as a critical infrastructural element in terms of the economic development of China, the country initiated its “action plan concerning the protection of intellectual property rights” and amended its Patent Law and Trademarks in 2009. China has vigorously addressed the issue of further enhanced protection of intellectual property rights by strengthening its examination system and further developing its human resources by rapidly increasing the number of examiners in its patent office (SIPO) in order to respond to the increasing number of applications being filed in recent years.

The JPO, in assisting and cooperating with China's efforts, holds various meetings. For example, there are meetings being held between Japan and China; among Japan, China and Korea; and the Meeting of IP Five Offices that includes Japan, the United States, Europe, China and Korea. The JPO also uses bilateral meetings to strengthen approaches against counterfeit products and emphasize the importance of strengthening the protection of intellectual property in collaboration with

advanced countries at venues for multilateral talks such as at the WTO and the WIPO.

Furthermore, as a part of its efforts in assisting with the enhancement of regulations in developing countries, the JPO invites customs officials, police, and members of the courts from the local authorities in Asian countries as trainees to Japan. The training programs, conducted annually, are on intellectual property systems. In addition, the JPO holds seminars in the countries of these officials as well.



JICA circuit seminar (enforcement)

### 2) Cooperation with Developed Countries

At the G8 Gleneagles Summit in 2005 Japan proposed the necessity of formulating the legal framework needed for preventing the spread of counterfeiting and pirated products. Since then, Japan has actively discussed this issue with developed countries and developing countries that have a high aspiration in the protection of intellectual property rights toward realizing this scheme.

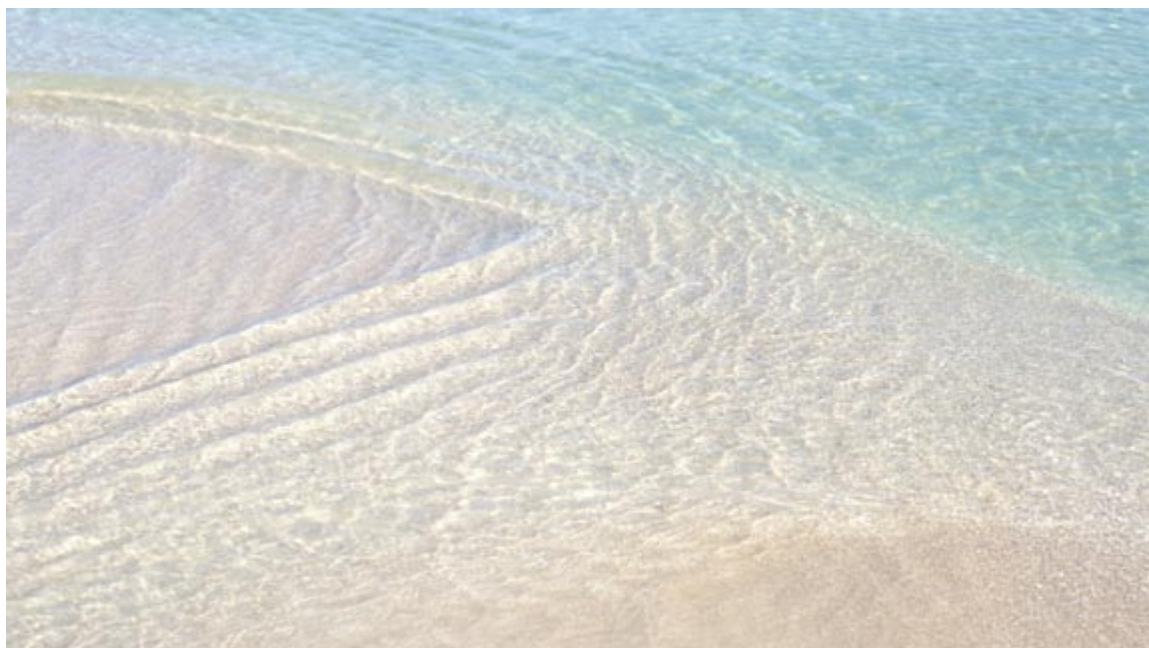
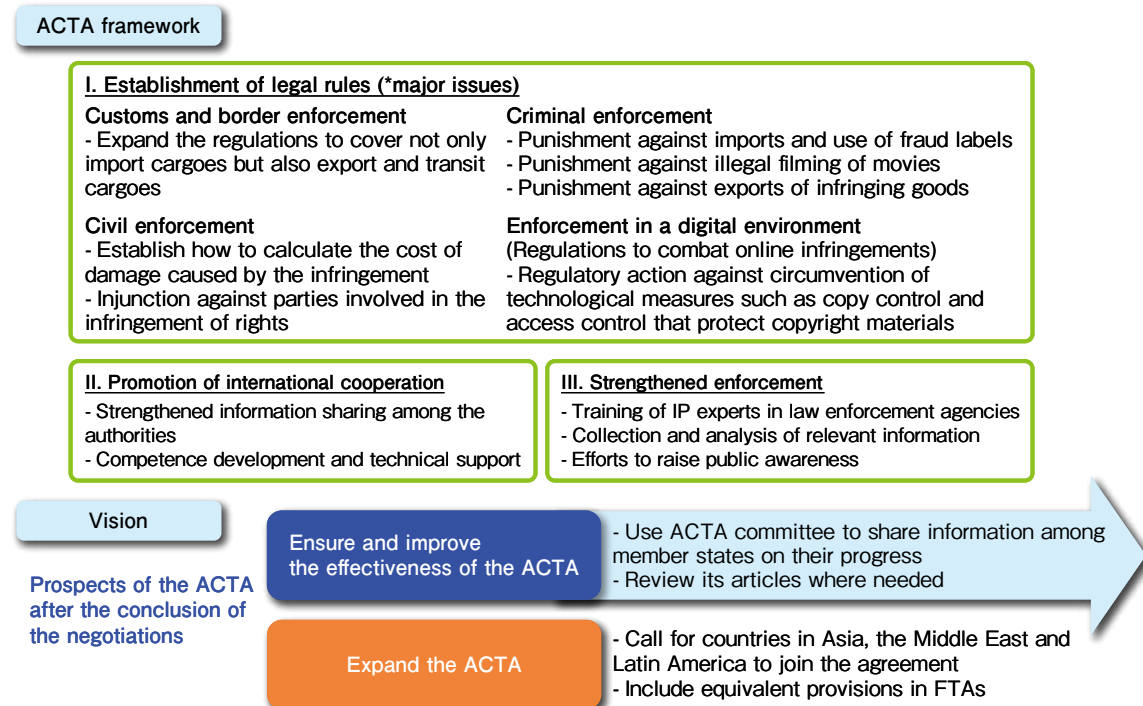
As a result, in October 2010, the “Anti-Counterfeiting Trade Agreement (provisional title) (ACTA)<sup>1</sup>,” a new international framework to strengthen enforcement of intellectual property rights, was basically agreed.

On October 1, 2011, a signatory ceremony of ACTA was held at the Iikura Guesthouse of the Ministry of Foreign Affairs of Japan.

<sup>1</sup> <http://www.meti.go.jp/english/policy/economy/chizai/acta.html>



**[Figure 4-1-7 Structure and future vision of anti-Counterfeiting Trade Agreement (provisional title) (ACTA)]**



### 3) Collaboration with the Industrial World

Some Japanese companies and industry groups have been taking active anti-counterfeiting measures. For example, some organizations, after independently conducting vigorous investigative activities to identify the manufacturers and distribution channels of counterfeit products, have been requesting local regulatory authorities to crack down on counterfeiters. However, such measures require persistent efforts, and in many cases, sufficient measures cannot be taken due to personnel and financial constraints. It is also undeniable that there is a limit to the ability of individual companies and industrial groups to negotiate with local governments and regulatory authorities.

Under these circumstances, the “International Intellectual Property Protection Forum (IIPPF)<sup>1</sup>” was established in April 2002 to promote cross-industry cooperation to reinforce anti-counterfeiting measures in collaboration with the Japanese government. The following projects have been undertaken by the Forum: to reinforce anti-counterfeiting measures, submitting requests to governments of countries where IPR infringement has been serious; exchanging information and conducting surveys; and cooperating on human resource development in countries where IPR infringement has been serious.

The JPO supports the efforts of the International Intellectual Property Protection Forum. Concerning China, in particular, high-level missions jointly involving the public and private sectors were sent seven times so far in collaboration with the Forum and the government.

The JPO has requested the development of legal systems and improvement of operations to the Chinese governmental organizations, seeking cooperation that leads to more effective and efficient enforcement of counterfeit products. An example is conducting seminars to determine/distinguish genuine and

counterfeited products; and technical seminars for regulatory authority officials.

### 4) Collection and Provision of Information for Anti-counterfeiting Measures

In order to understand the situation surrounding the damage overseas suffered by Japanese companies, the JPO conducts an annual survey and publishes the results in the “Survey Report on Losses Caused by Counterfeiting<sup>2</sup>.” In addition, with the aim of assisting Japanese companies’ business activities overseas, the JPO sends resident officers to overseas offices (Beijing, Bangkok, Seoul and Taipei in Asia) to offer consultation in local communities. It also compiles and provides “Manuals on Measures against Counterfeits,” which contain useful information regarding anti-counterfeiting measures in the countries and regions where counterfeiting frequently occurs, and the “Collection of Case Examples/Court Precedents of Intellectual Property Right Infringements,” which contains actual cases, court precedents relating to IPR infringement, and informative comments<sup>3</sup>. Furthermore, the JPO holds seminars inside and outside of Japan for Japanese companies in order to provide them with the information necessary to take measures against counterfeits.

### 5) Response to Consultations Concerning Countermeasures against Counterfeit products

The JPO responds to individual consultations concerning counterfeit products (industrial property rights infringement) from rights holders and provides necessary information by closely cooperating with the “APEC IPR Service Center” (Counterfeit Product Measure/Commercial Office, Manufacturing Industries Bureau, Ministry of Economy, Trade and Industry) and other related ministries and agencies. In addition, the JPO provides consulting services on foreign

<sup>1</sup> Founded in April 2002 (Chairman: Toshiyuki Shiga, Chief Operating Officer of Nissan Motor Co., Ltd.). As of March 26, 2012, 243 companies and organizations (153 companies and 90 organizations) participate in this forum.

<sup>2</sup> Actual status of damages caused by counterfeiting <http://www.jpo.go.jp/torikumi/mohouhin/mohouhin2/jittai/jittai.htm>

<sup>3</sup> <http://www.jpo.go.jp/torikumi/mohouhin/mohouhin2/manual/manual.htm>

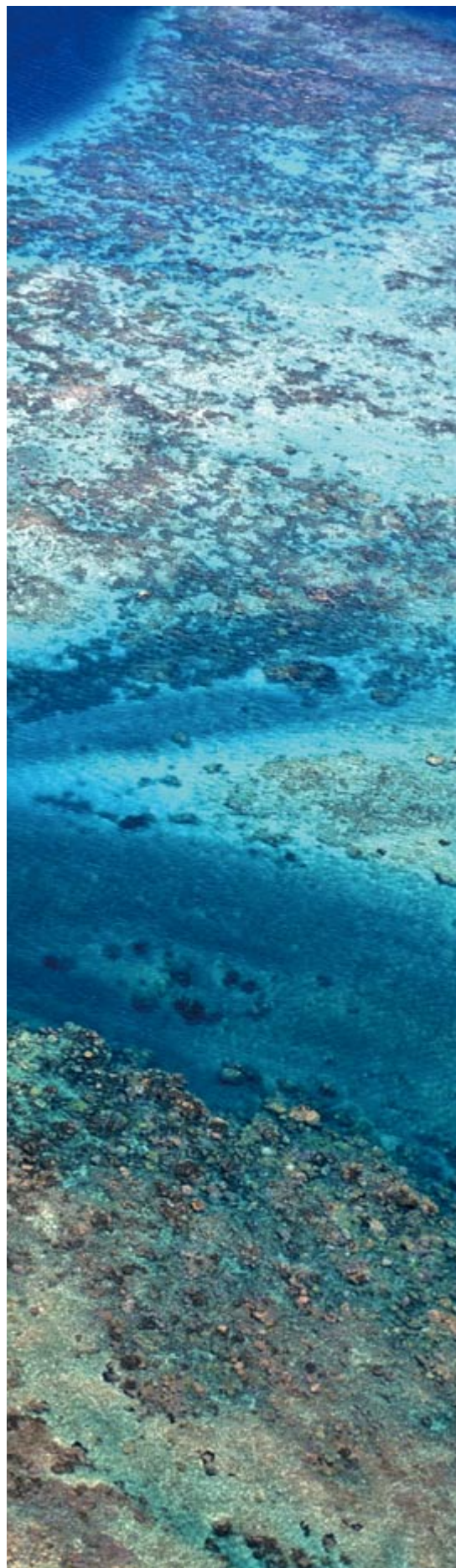
industrial property right systems and on countermeasures against industrial property infringement targeting Japanese companies.

6) Cooperation with National Regulatory Authorities/ Countermeasures at the Boarder

With the aim of efficiently cracking down on counterfeiting within Japan, the JPO aims to strengthen cooperation with Japanese law enforcement authorities by (1) addressing inquiries about infringement cases of industrial property rights from police and customs and (2) sending instructors to give training on intellectual property to Japanese customs officials, etc.

7) Activities to Raise Consumer Awareness

The JPO organizes “Anti-Counterfeiting Campaigns” every fiscal year with the objective of further raising domestic consumer awareness on the importance of intellectual property rights and informing domestic consumers that counterfeiting and piracy have adverse effects.





## 7. Promotion of Conclusion of Economic Partnership Agreement (EPA) and Free Trade Agreement (FTA)

Japan has actively concluded Economic Partnership Agreements (EPAs) and Free Trade Agreements (FTAs), mainly with Asian countries that have deep economic and cultural ties with Japan.

Moreover, in recent years, Japan has been steadily making efforts to conclude EPAs and FTAs, including the Trans-Pacific Partnership (TPP) with Asia-Pacific countries and the Economic Integration Agreement (EIA) with the European Union based on the "Basic Principles for Comprehensive Economic Partnership (cabinet decision on November 9, 2010)." Under these circumstances, the intellectual property field is one field of EPA negotiations and is part of the JPO's efforts to expand trade and investment. In the field of intellectual property, Japan aims ensure: 1) adequate, effective and non-discriminatory protection of intellectual property, 2) efficient and transparent administration over the intellectual property protection system, and 3) adequate and effective enforcement of intellectual property rights, taking into consideration trade relations and the scale of intellectual property related problems.

(EPAs already came into force before 2011)

- 1) Japan-Singapore EPA (signed in January 2002, came into force in November 2002)
- 2) Japan-Mexico EPA (signed in September 2004, came into force in April 2005)
- 3) Japan-Malaysia EPA (signed in December 2005, came into force in July 2006)
- 4) Japan-the Philippines EPA (signed in March 2006, came into force in December 2008)
- 5) Japan-Chile EPA (signed in March 2007, came into force in September 2007)
- 6) Japan-Thailand EPA (signed in April 2007, came into force in November 2007)
- 7) Japan-Brunei EPA (signed in June 2007, came into force in July 2008)
- 8) Japan-Indonesia EPA (signed in August 2007, came into force in July 2008)
- 9) Japan-ASEAN Comprehensive EPA (signed in April 2008, came into force in December 2008)

- 10) Japan-Vietnam EPA (signed in December 2008, came into force in October 2009)
- 11) Japan-Switzerland EPA (signed in February 2009, came into force in September 2009)
- 12) Japan-India EPA (signed in February 2011, came into force in August 2011)

These EPAs include measures such as more simplified and transparent procedures and strengthened protection of intellectual property rights and the enforcement thereof. The EPA with India, in particular, provides for strengthening the protection of intellectual property rights beyond the level of protection stipulated in the TRIPS Agreement. This deals with the possibility of patent protection of inventions such as computer programs, protection of widely-known trademarks, and accelerated examination of trademark applications.

(EPA came into force in 2012)

- 13) Japan-Peru EPA

Based on an agreement reached at the Japan-Peru Telephone Summit Conference on April 14, 2009, Japan started negotiating with Peru to conclude the Japan-Peru EPA from May 2009. A joint announcement on the conclusion of the negotiations was publicized in November 2010 based on the seven official meetings and interim meetings. After that, the Japan-Peru EPA came into force in March 2012. The chapter dealing with intellectual property in this EPA calls for strengthening intellectual property rights beyond the level of protection stipulated in the TRIPS Agreement. This includes the patentability of inventions including computer programs, the possibility of protecting designs for a part of an article, and the prohibition of exporting articles infringing copyrights.

- 14) Others

Japan is negotiating for an EPA with the Republic of India and Australia.