

What are Japanese Patent Examiners doing ?

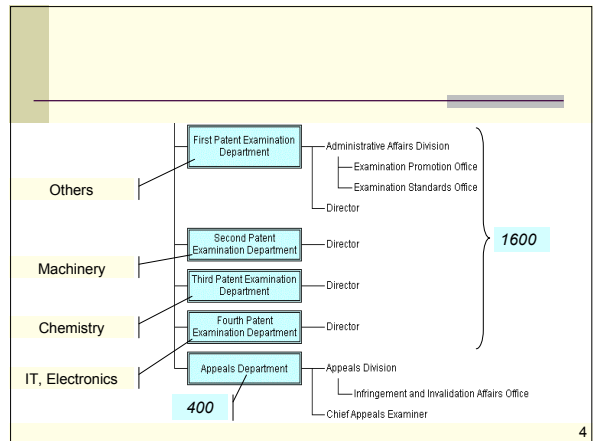
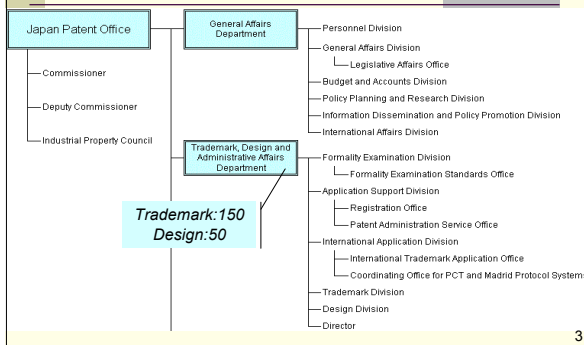
Efforts Toward Expeditious and Efficient Patent Examination

May 2008
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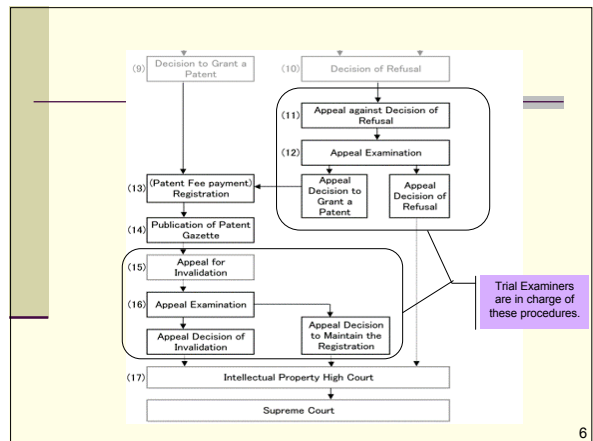
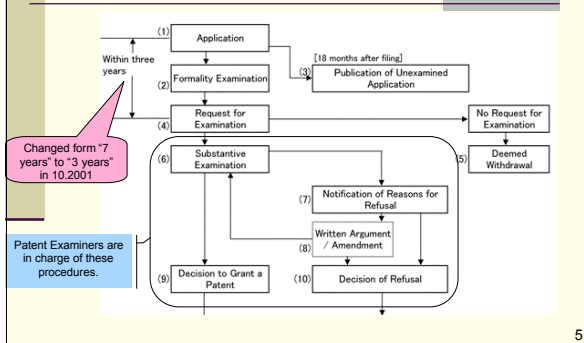
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1. Structure of JPO



3. Patent System in Japan



2. How to Examine Patent Application

Novelty & Inventive Step

Invention (A+B):

- A: Gears for automobile
- B: Teeth of the gears are round
- Effect of the invention: reducing noise

Prior Art1 (A+B):

- A: Gears for automobile
- B: Teeth of the gears are round
(completely same as the invention)

The Invention has **No Novelty**
(and **No Inventive Step**)
(refusal)

Prior Art2 (A+C):

- A: Gears for automobile
- C: Teeth of the gears have edges

Prior Art3 (A'+B):

- A': Gears for bicycle
- B: Teeth of the gears are round

The invention has Novelty, but
if it seems easy to combine
"A" of Art2 and "B" of Art3,...

The Invention has Novelty
but **No Inventive Step**
(refusal)

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2. How to Examine Patent Application

STEP1: Understanding "Claim(s)"



Read an Application document,
Understand technical features of an invention,
and Understand the "Claim(s)" precisely.

STEP2: Prior Arts Search



Retrieve Databases
to find document containing arts
which is same as/ close to/
relevant to the claimed invention

STEP3: Making decision

Consider whether reason for refusal exists or
not based on the result of search,

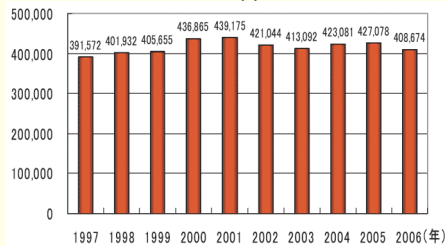
Make decision and Write an official letter
(Letter to notice reason for refusal/
Decision of Granting Patent)

Attention:
A lot of time is spend
at the STEP2 !!

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4. Statistics of Patent in Japan

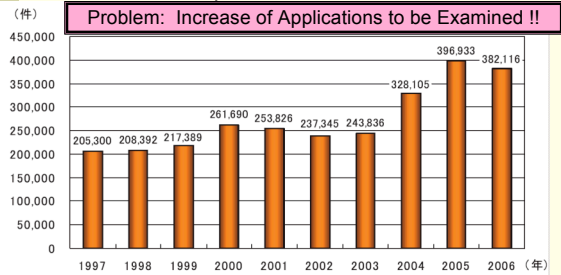
Number of Patent Applications to JPO



Cf. USPTO : 391,000 EPO: 128,000
IP Australia: 31,000 (in 2005)

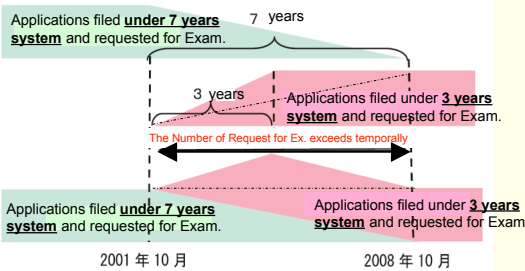
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Number of Requests for Examination



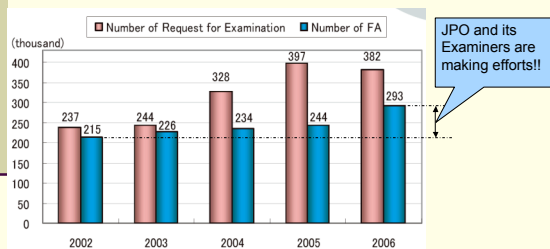
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"BUMP" in the Number of Requests of Examination



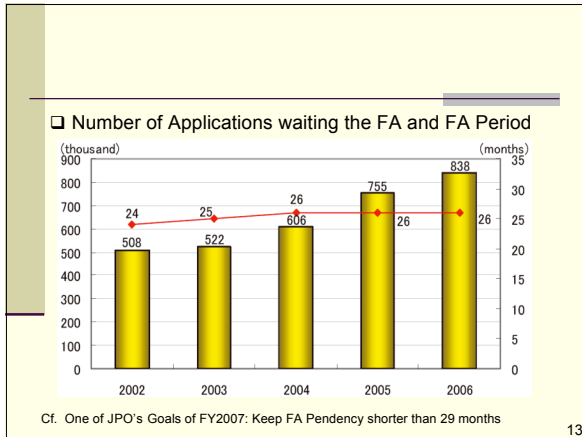
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Number of Requests for Examination and Number of "First Action"



JPO and its
Examiners are
making efforts!!

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5. Our Plan & Goals – AMARI Plan 2007

- *Recognising* the importance of early acquisition of IP rights for enhancing the international competitiveness of Japanese industry,
- Headquarters for Expeditious and Efficient Patent Examination (JPO and METI: established in Dec. 2005) set out
- “**A**dvanced **M**easures for **A**ccelerating **R**eform toward **I**nnovation **P**lan in Patent Examination” in Oct. 2006.
- And this “AMARI Plan” was upgraded to **AMARI Plan 2007** in Jan. 2007.

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□ Goals set out in AMARI Plan 2007

Ultimate Goal: Reduce FA Period to 11 months by 2013

	FY 2005 (actual results)	FY 2007	FY 2010
Number of Application Examined per Examiner (Base on “Claims”)	1,137	1,300 or more	1,400
Number of FA	245,000	310,000	-
FA Period	26 months	Shorter than 29 months	-

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6. Elements in AMARI Plan 2007 – Efforts related to Patent Examination

(1) Securing a necessary number of Examiners Employing *Fixed-Term* Examiner

Increase in the Number of Patent Examiners

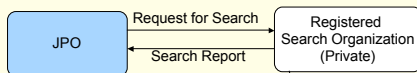
FY	2004	2005	2006	2007
Regular examiners	1145 (+19)	1162 (+17)	1174 (+12)	1175 (+1)
Fixed-term examiners	98 (+98)	196 (+98)	294 (+98)	392 (+98)
Total	1243 (+117)	1358 (+115)	1468 (+110)	1567 (+99)

❖ What does “*Fixed-Term*” mean ?

Term of employment is 10 years (5 years x 2).

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(2) Increasing in outsourcing of prior art search to private sector



Number of Applications outsourced
FY 2007: 226,000 (+14.7%)

2/3 of applications examined depend on outsourcing

Dialog-Type Outsourcing: 185,000

Criteria for Registration

- More than 10 searchers
- Equipments (i.e. computer) necessary for search
- Independent organization (not affiliated)

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□ Dialog-Type Outsourcing

When submitting Search Report to JPO, Searchers come to the JPO's office and **explain points (technical features of inventions) of applications and results of their search** to JPO's Examiner **orally and face-to-face**.

Merits:

- Oral explanations help JPO's Examiners to understand the applications in short time.
- JPO's examiners can **train the searchers face-to-face**.
- JPO'S examiners can **instruct the searchers to conduct *additional* search immediately**.

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□ Registered Search Organizations

Organization A (registered in Oct. 2004)	All Fields	1518 searchers	} <i>New</i>
Organization B (registered in Mar. 2005)	Machinery(mainly automobile),	68 searchers	
Organization C (registered in Mar. 2005)	Organic Chemistry	18 searchers	
Organization D (registered in Jun. 2006)	"Pa-chi-n-ko", Slot Machine	22 searchers	
Organization E (registered in Mar. 2007)	Optical Devices	13 searchers	

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(3) "Consolidated Examination" of relevant applications

What is "Consolidated Examination" ?

Make a **group of relevant applications**, and
Conduct examination of the group of application **at once**.

Procedure

Step 1. JPO makes **lists of applications to be examined applicant by applicant** (but major applicant only) and sends the list to the applicants.

Step 2. **Applicants make groups** of applications among listed applications, taking into account **technical features**, and feed back to JPO.

Step 3. JPO' Examiners **conduct examination group by group**.

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Merits of "Consolidated Examination"

- Examination based on **applicants' needs**
- **Saving time** spent on examination (search, understanding claims) by dealing with similar/relevant/series of applications at once.

(For example, If technical features are very similar among plural applications, we can conduct **prior art search for the plural applications all at once** by searching one certain technical area of documents.)

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(4) Promotion "Accelerated Examination" system

Usually.

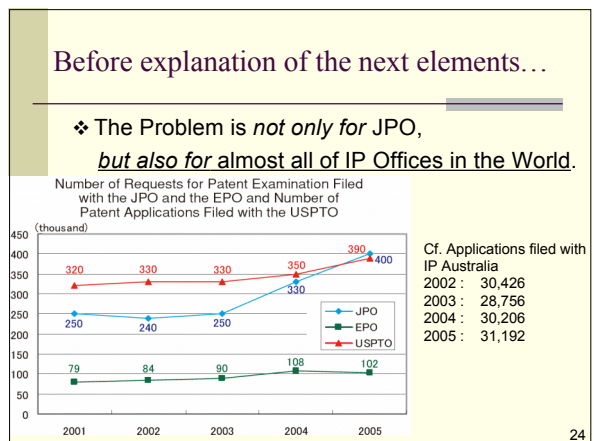
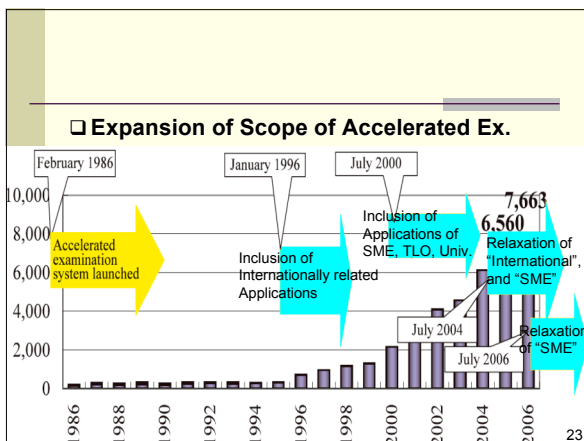
Patent examination is conducted in accordance with the **date of request of examination**.

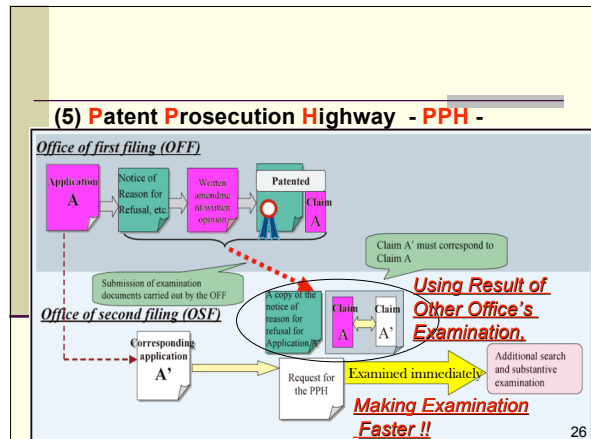
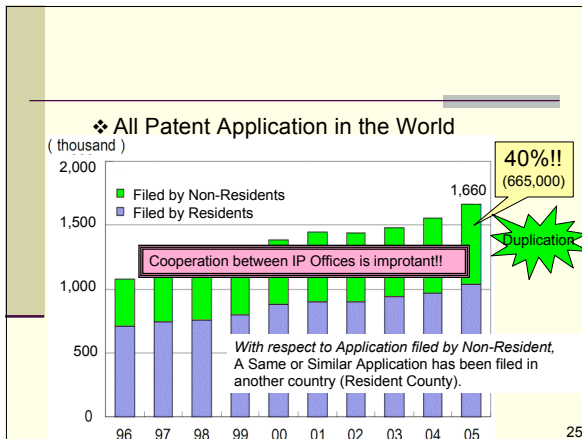
An applicant has to wait for **more than 2 years** (FA Period).

However,

if an application meets **certain criteria** and the applicants submits "**Explanation of Circumstance**" (special request), the application is **examined immediately (within 3 months)**.

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PPH with

USPTO(US): Full implementation started in Jan. 2008
(Pilot Program started in July 2006)

KIPO(Korea): Started in April 2007

UKIPO(UK): Pilot Program started in July 2007

GPTO(Germany): Pilot Program started in March 25 March 2007

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(6) Examiner Exchange Program

What is important for a Patent Examiner to use a result of examination of other IP Office's Examiner ?

➡ **Mutual Trust among examiners**

- Information Exchange and Discussion about **Patent Classifications, Search tools, Search Strategies, Criteria of patentability** etc.,
- Development of **Common Patent Classifications**

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❖ *JPO dispatches examiners to / receive examiners from*

USPTO, EPO, DPTO(Germany), UKIPO(UK), KIPO(Korea), IP Australia

❖ *JPO, USPTO and EPO hold Tri-lateral Examiner Meeting*

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Summary

- One of the problem JPO facing is Work Load in patent examination.
- JPO is conducting various efforts/solutions to tackle it.
- The Work Load Problem is common problem for many IP offices other than JPO.
- Cooperation among IP offices is a vital element to tackle the common problem.

Thank you very much!!

A-Ri-Ga-TO-U Go-Za-I-Ma-Shi-TA!!
(ありがとうございました!!)

This material is not authorized by the JPO and contains some personal views.

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