



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

FICPI visits JPO and presses need for local representation, procedural simplicity and fair protection for inventors

FICPI held its annual visit to the Japan Patent Office (JPO) last week on 1 December 2017 and urged the JPO to support its recommendation to maintain a requirement for local representation for PCT national phase entry applications. In the context of ongoing Group B+ patent harmonization discussions, FICPI also urged the JPO to resist proposed “DIU” measures that would unduly complicate the patent system. FICPI also challenged the JPO over its approach to double-patenting that can lead to applicants and inventors being prevented from obtaining fair protection for their inventions. FICPI and the JPO agreed on the need to take account of the requirements of small and medium size businesses and private applicants in relation to a variety of different IP issues.

FICPI visits all major patent offices on an annual basis. Following preceding visits to IP India, SIPO and KIPO (reported separately), a FICPI delegation led by President Doug Deeth and including Vice President Julian Crump, Secretary General Roberto Pistolesi, Deputy Secretary General Jürgen Schmidtchen, CET President Coleen Morrison, CET Group 3 Chair Michael Caine and three members of FICPI Japan, visited the JPO on 1 December 2017 in Tokyo, Japan, to present FICPI’s views on a range of current patent and trademark issues to a JPO delegation headed by its Deputy Commissioner, Mr. Kunihiko Shimano.

Local representation for PCT national phase entry

The FICPI delegation presented the results of the Hangzhou EXCO meeting, including Resolution EXCO/CN17/RES/003 “*PCT National Phase Entry by Electronic Means*”. Mr. Caine emphasized the need for patent applications, especially small and medium-sized entities and private applicants, to have local representation to ensure they obtain appropriate protection for inventions according to local laws and practices. FICPI is not in favour of any system that would allow applications to be filed at the “press of a button” without involvement of local representative, but Mr. Caine questioned whether offices such as the JPO, who do not use Roman lettering, could really make use of electronic data from WIPO to avoid rekeying mistakes. For the JPO, Mr. Shinichiro Hara of the International Policies Unit, fully agreed with FICPI on the need for local representation and the EXCO’s Hangzhou resolution, and said it is difficult for the JPO to use the WIPO data because of the need for translation.

There are ongoing efforts within the IP5 (Global Dossier) and the PCT to allow greater sharing of electronic data between offices and this is work-in-progress. The JPO confirmed that it is urging WIPO to remember that large offices must cater for the needs of many different kinds of users.

Group B+ harmonization and the grace period

As from November this year, the JPO has taken on the Secretariat role for the Group B+ discussions on patent harmonization and is keen to hear from the users, especially SMEs, universities and private



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inventors. The JPO is coordinating with regional user organizations, but acknowledged FICPI's unique position as an international body of IP attorneys.

In their efforts to find common ground in relation to the grace period, the Industry Trilateral groups have been working on "Defence for Intervening User (DIU)" provisions, but the JPO is concerned that these are too complicated. In trying to find a way forwards, the JPO was interested to learn from FICPI the reasons for the apparently strong belief amongst European users that the rights of third parties to make free use of information published during a grace period should be protected, in contrast to the situation in the US for example where, even though there is now a kind of first-to-publish/first-to-file system, there is still an underlying tendency to protect the rights of inventors above those of the public. In Japan, there is a presumption that technical information disclosed to the public, for example in a scientific paper, is or will be protected: conceptually the invention is already protected, so there is less of a need to protect the rights of intervening users.

In FICPI's view, a person who gains knowledge of an invention from a public disclosure, and begins in good faith to exploit that information, should be free to do so unless a patent application has already been filed. Until an application has been filed, there is nothing to prevent anyone from making use in good faith of information that is in the public domain. Otherwise, unscrupulous inventors might change their mind and decide to file an application within the grace period if they saw that a third party was benefitting from their invention; it would be unfair on the third party to be disadvantaged in this way.

The JPO appreciated FICPI's comments, which they said helped clarify the European stance on this issue. The JPO is keen to ensure that any mechanisms that are put in place to protect third parties are as clear and simple as possible. FICPI agreed that simplicity was important.

Conflicting patent applications

Mr. Caine also informed the JPO that FICPI is continuing its work on the treatment of conflicting patent applications. Unlike the situation in the US, in Europe and Japan, earlier filed, but unpublished, patent applications do not form part of the state of the art as such, but their contents are taken into account when assessing the novelty (only) of later applications filed before the earlier one is published. FICPI is leaning towards such a simple approach with no anti-self-collision rules, terminal disclaimers, assessments for "identity" of invention or the like, but has not yet completed its studies. The results of the study would be circulated to the JPO when finished.

Double-patenting in Japan

Continuing discussions started at last year's meeting with the JPO, FICPI followed up written comments and examples it had filed in the meantime that illustrated how the JPO's approach to double-patenting appears to be out of line with other offices' practices. One example concerned a divisional application for a salt form of a therapeutic active agent, which was rejected because of double-patenting in view of the granted parent patent which contained claims to the free base form of the same agent. This was particularly damaging for the applicant because the salt form was the preferred form and had been the



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subject of clinical trials for regulatory approval. This kind of problem is not unique to Japan, but is also an issue in other places including Israel, Canada and New Zealand.

The JPO reported that they had studied FICPI's comments and examples carefully, but felt the decisions taken had been in line with Japanese patent law and relevant decisions of the Japanese courts. In Japan, two patents cannot be allowed for claims of "identical" or "substantially identical" scope. Unlike in the US, for example, "substantially identical" scope does not involve considerations of obviousness, but the JPO do look to see if the claims involve the same "technical concept"; in other words, would they make the same technical use of what is available in nature?

Crump pointed out that for applicants the grant of a patent is not the end of the matter; it was not a question of "ticking the right boxes" but it is necessary to ensure that useful patents are granted. When assessing infringement, courts do not look for use of the same "technical concept" but they rely on the wording of the claims.

The JPO took on board the need to protect an invention from different types of infringement, and invited FICPI to submit further examples to allow it to continue to review the issue.

Other topics

FICPI was interested to learn from the JPO that although the number of new patent applications being filed nationally in Japan is declining, more Japanese applicants are filing foreign applications, and within Japan more requests for examination are being filed and more patents are being granted. The JPO interprets these data to show an increasing tendency amongst Japanese applicants for quality over quantity and an increasingly international outlook.

The JPO's pendency to first action (FA) is now down to 10 months, with standard pendency at 15 months, which the JPO claimed makes it the fastest examining office in the world. Moreover, standard pendency is consistent across all technical fields and from case-to-case. The JPO has been working to achieve these goals.

The results of the collaborative search pilot study between the JPO and USPTO were encouraging. In the study, which involved 50 applications in both countries, a greater level of consistency in novelty and obviousness rejections was achieved and a greater matching rate of cited documents. The procedure has been modified so that both offices now start search and examination at the same time and then cross-share and review the results, so the applicant gets the results sooner than having the offices work sequentially as was originally the case.

The JPO is continuing to develop its patent examination team for the Internet of Things (IoT) and related new classification system (ZIT). Examiners within the IoT team consult with other examiners with specific technical expertise, and further case studies have been published on the JPO's website to increase transparency for the public.

Ms. Rie Ishizuka gave the FICPI delegation a presentation on the JPO's holistic approach to assessing the similarity of marks, which includes visual, oral and conceptual considerations, focusing on the



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overall impression or memory by consumers of the marks. The JPO's guidelines are based on a 1968 Supreme Court case¹, which is often cited in examination reports. Ms. Ishizuka reviewed a number of specific examples, including a well-known 1965 Tokyo High Court case involving the Raleigh logo, where the logos were held to be similar despite different words (STORK vs. THE RALEIGH) and a more recent 2017 IP High Court case involving marks with similar pronunciations, even though one was in Roman lettering (CHIDORIYA) while the other was in Japanese characters.

Finally, the JPO reported that efforts made since 2007 to reduce the number of unused trade marks on the register were bearing fruit, with a large drop in the number of registrations with wide descriptions of goods and services. There had been a corresponding fall in the number of applications filed by third parties for rescission of registrations. In part, this was due to increased official fees for extra classes of goods and services and, in part, due to enhanced examination of applications filed with broad descriptions.

Final remarks

FICPI's visit to the JPO was cordial and constructive. FICPI was able to advance the views of its members on a range of important issues, particularly the requirement for local representation for PCT national phase entry and double-patenting. FICPI provided the JPO with information and insights relevant to conflicting applications and the protection of intervening users' rights in the context of the grace period. It was pleasing to note that the JPO had reviewed FICPI's resolutions from Hangzhou in advance of the meeting and reflected on the extent to which their own rules and procedures were in alignment with FICPI's recommendations.

The JPO concluded the meeting by indicating that it found FICPI's input to be very helpful and it wished to continue with this forum for meeting with FICPI in 2018.

After the JPO meeting, the FICPI delegation was invited to lunch by the Japan Patent Attorneys Association (JPAA) before giving a seminar in the afternoon to JPAA members on the doctrine of equivalents in Europe and North America and Internet-related patent and trade mark issues.

Julian Crump
FICPI Vice President

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¹ Supreme Court Case number: 1964 (Gyo-Tsu) No. 101. February 27, 1968.