

October 17, 2012

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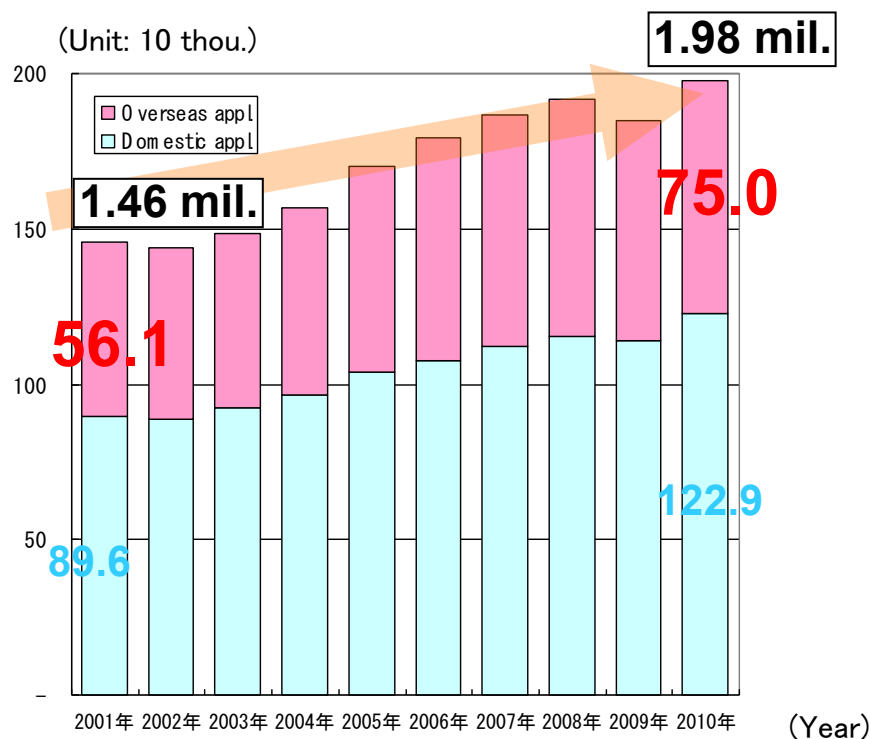
# ***Impact of American Invents Act***

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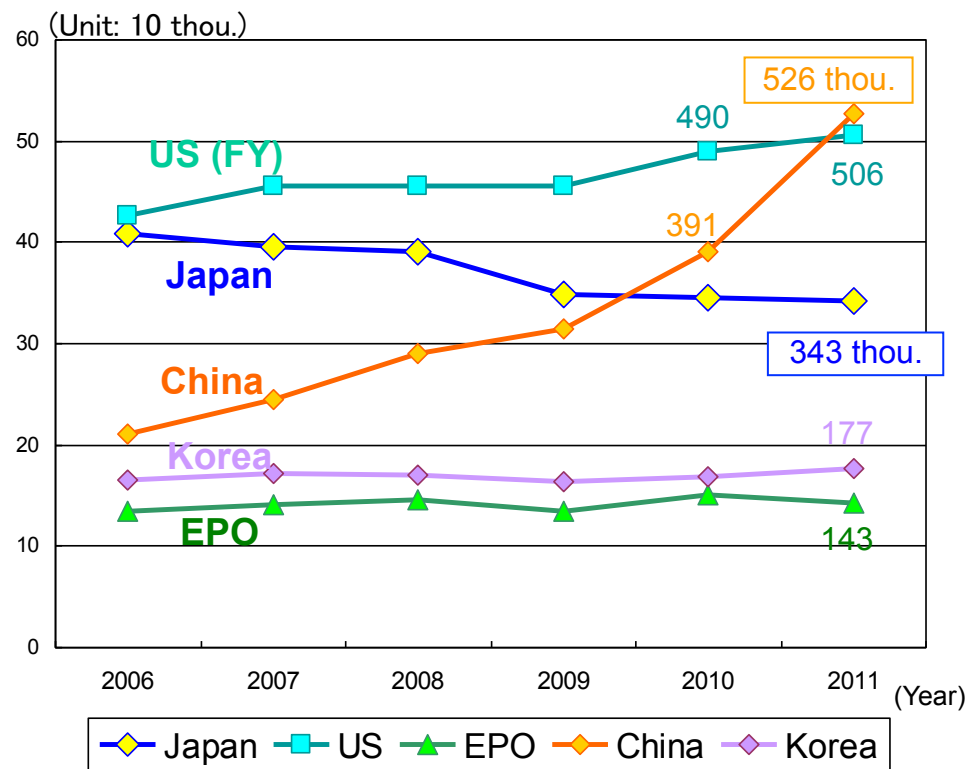
# Patent Applications in the World

- The number of patent applications in the world is increasing along with the globalization of business. In particular, the number of applications filed abroad is significantly increasing.
- Applicant files patent applications in patent offices in multiple countries for one invention.

Changes in Patent Appl. Filed in the Whole World



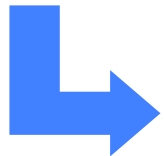
Changes in Patent Appl. Filed in Japan, US, Europe, China and Korea



Source: WIPO Industrial Property Statistics

*For Patent Offices...*

**Increase of workload**



*For Applicant...*

**Longer waiting time to obtain patent**

## Solutions

- **Harmonization of Patent Laws and Practices to facilitate work-sharing among offices**  
(reuse of examinations results delivered by other office)
- **Implementation of Strategic Measures to deal with workload problem**  
*e.g. Secure Necessary Number of examiners*  
*Investment in IT systems*

# Contents of America Invents Act

- The AIA include important elements for international discussion on Patent Harmonization.
- The AIA provides the USPTO with flexibility to take strategic measures.

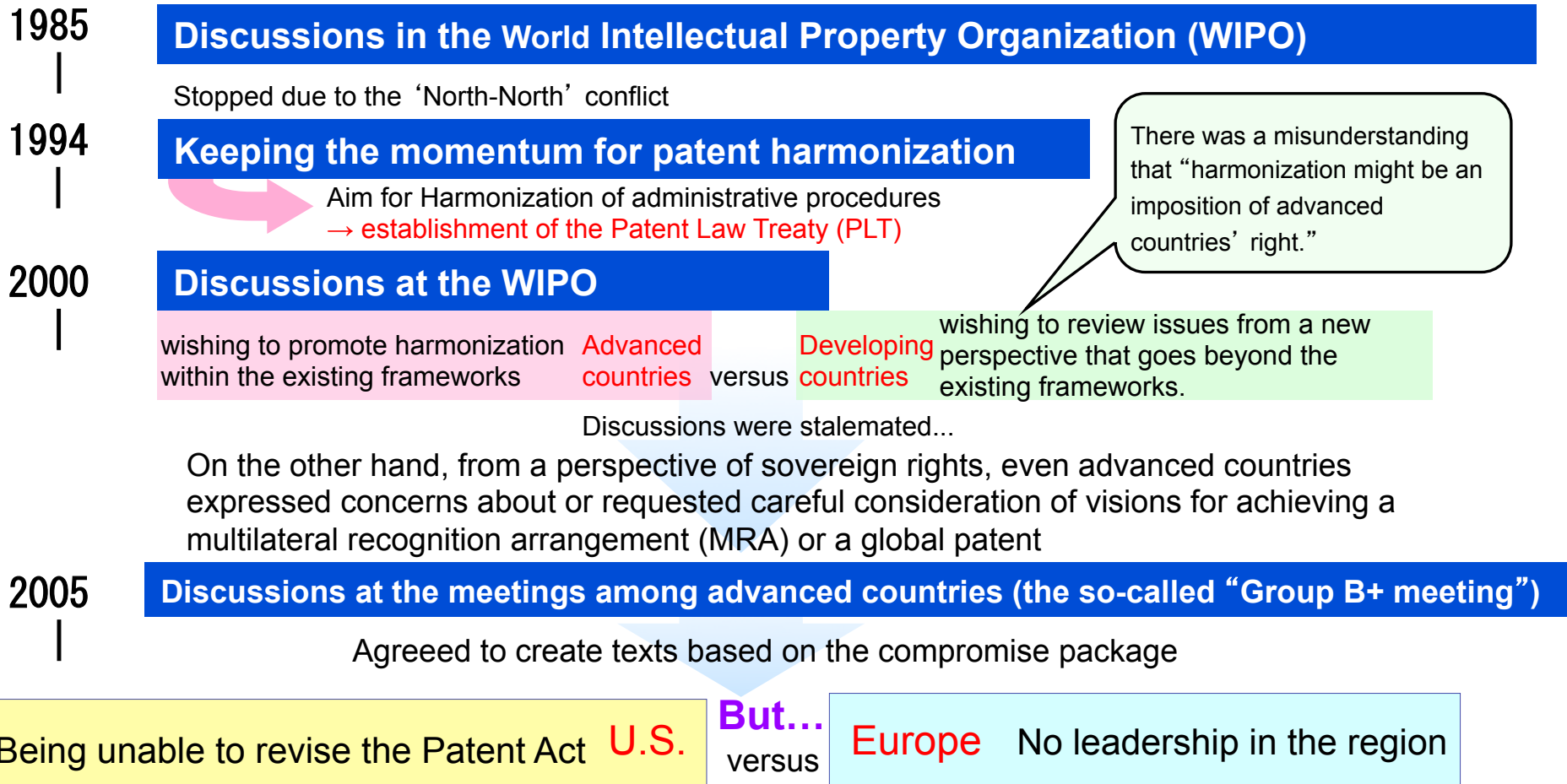
## *AIA includes...*

- ✓ Change from “First to Invent”  
to “First to File (First Inventor to File)”
  - ✓ Definition of Prior Art (No geographical limitation)
  - ✓ Removal of “*Hilmer Doctrine*”
  - ✓ Expansion of Prior User Right
  - ✓ Post Grant Review & Inter Partes Review
  - ✓ Third Party Submission
  - ✓ Prohibition of Revenue Diversion
  - ✓ Fee Setting Authority
  - 
  - 
  -
- Momentum for Patent Harmonization*
- Flexibility for USPTO*

- ✓ **Discussion on Patent Law Harmonization**
- ✓ **Flexibility of Patent Office**

# Discussions on Patent Harmonization in the Past

- Discussions on harmonization became mired in confusion because **developing countries strongly objected** to harmonization.
- Even discussions on harmonization among advanced countries were not concluded and the discussions substantially stopped in October 2008.

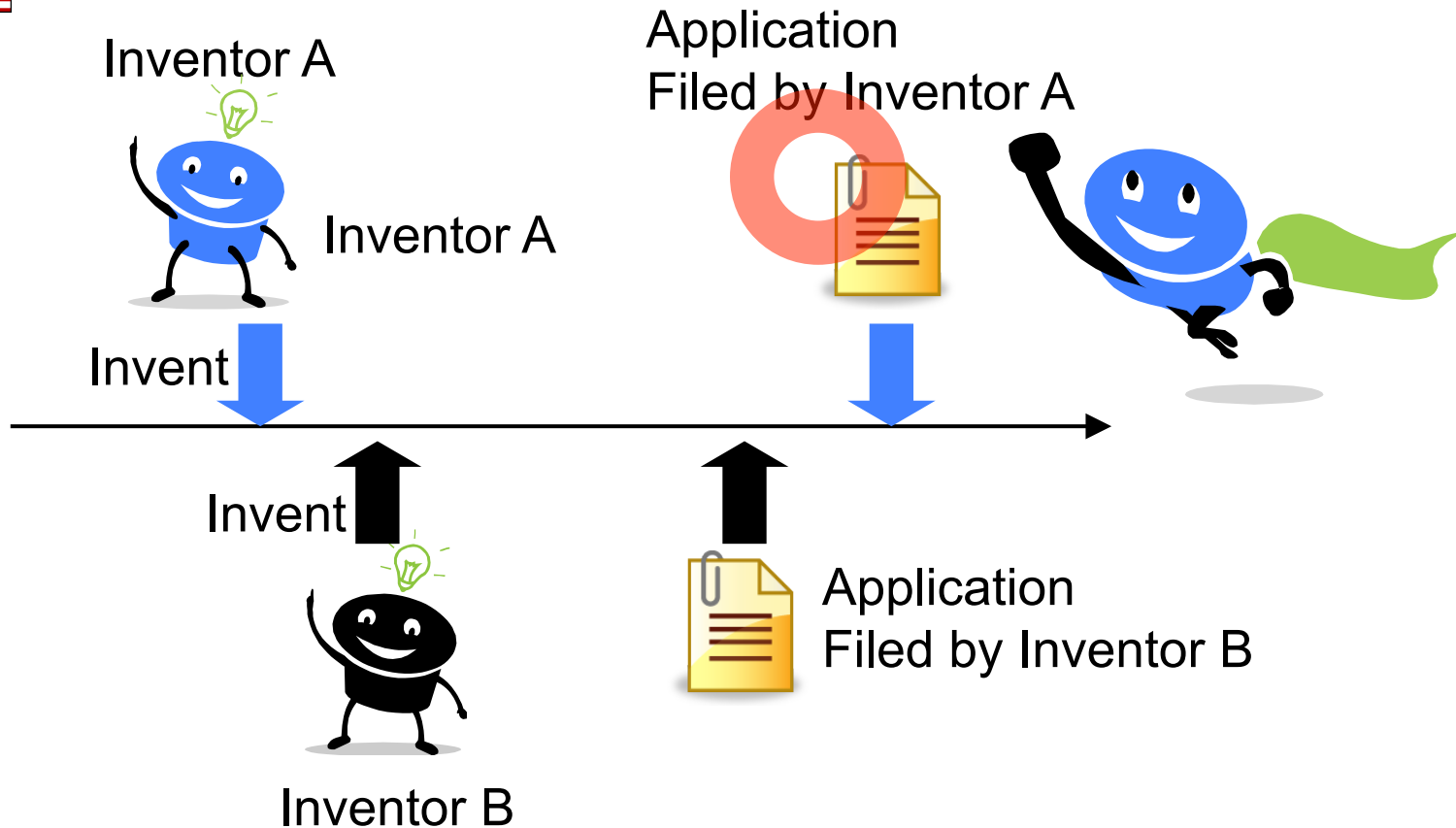


There was a misunderstanding that "harmonization might be an imposition of advanced countries' right."

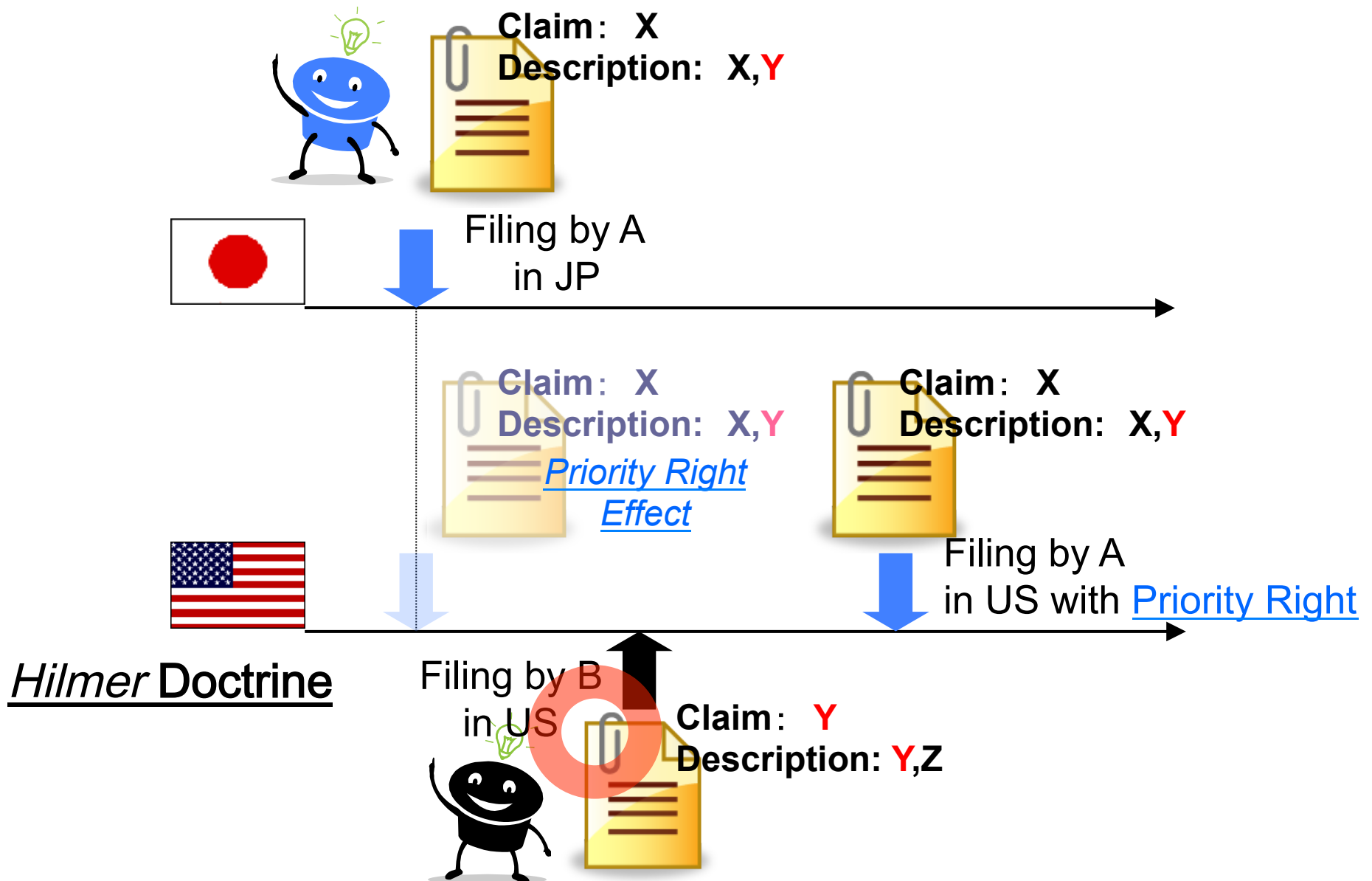
**October 2008 Discussions among the developed countries have stopped.**

# Unique Systems removed by AIA

## Fist to Invention



# Unique Systems removed by AIA





*AIA removed some of controversial issues...*

*such as First to Inventor, Hilmer doctrine...*



**Discussion on Patent Harmonization among Developed Countries has been Restarted**



Remaining Issues:

Grace Period, Prior User Right  
18-month Publication without opt out,  
Conflicting Application etc...

“Best Practices” for  
Innovation or  
Economic Development

*In the Future*

**Discussion on Patent Harmonization In WIPO including developing countries**

Materials for understanding  
importance of IP

Expectation  
For Economic Analysis

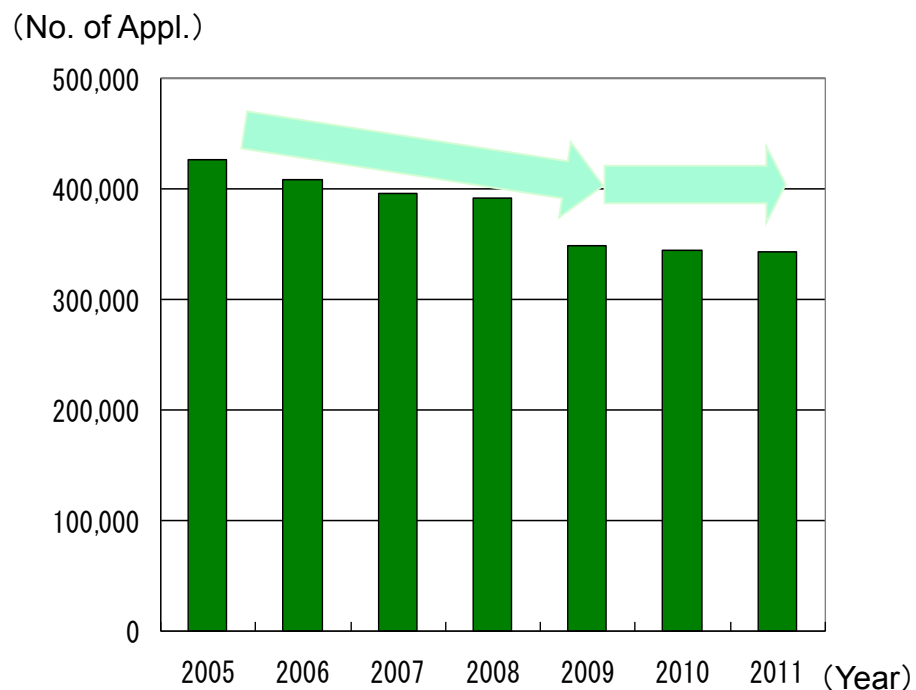
- ✓ Discussion on Patent Law Harmonization
- ✓ Flexibility of Patent Office

# Changes in Number of Applications

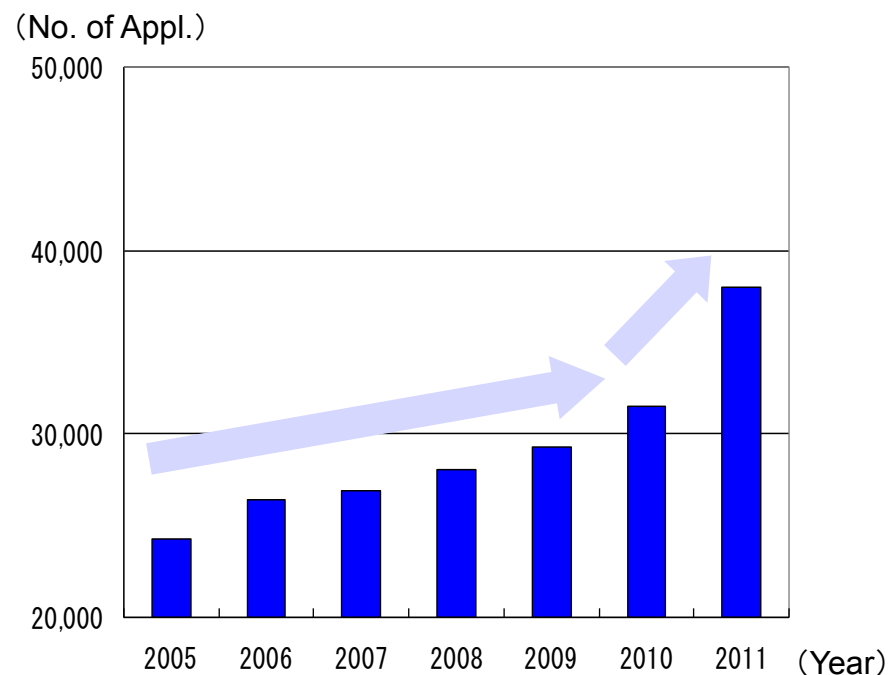
- Although the number of patent applications filed with JPO is slightly decreasing or flat, the number of PCT applications received by JPO is greatly increasing.
- The number of PCT applications in 2011 increased 20% year-on-year.

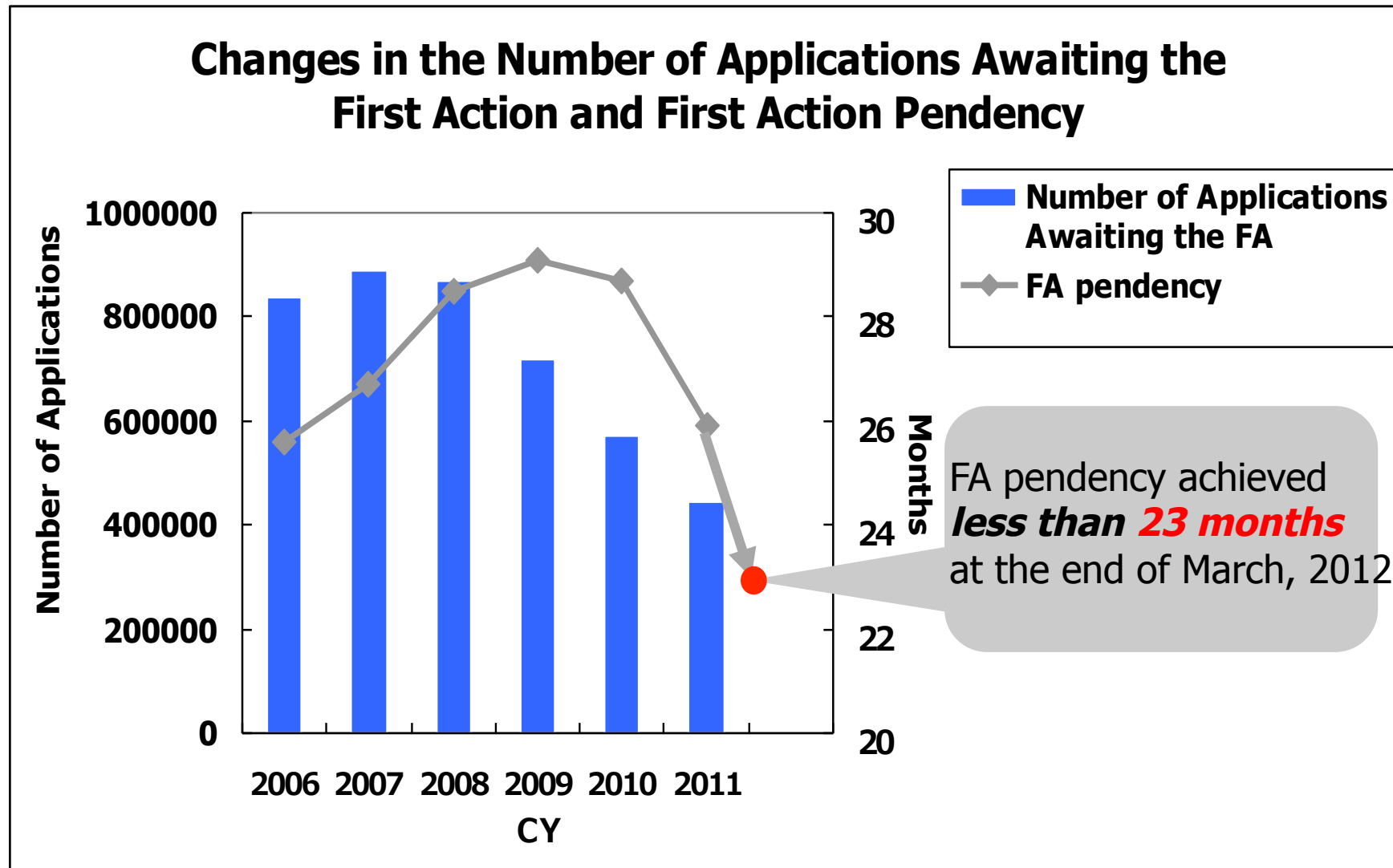
## Changes in the Number of Patent Applications/PCT Applications Filed in Japan

### Changes in the No. of Patent Applications



### Changes in the No. of PCT Applications

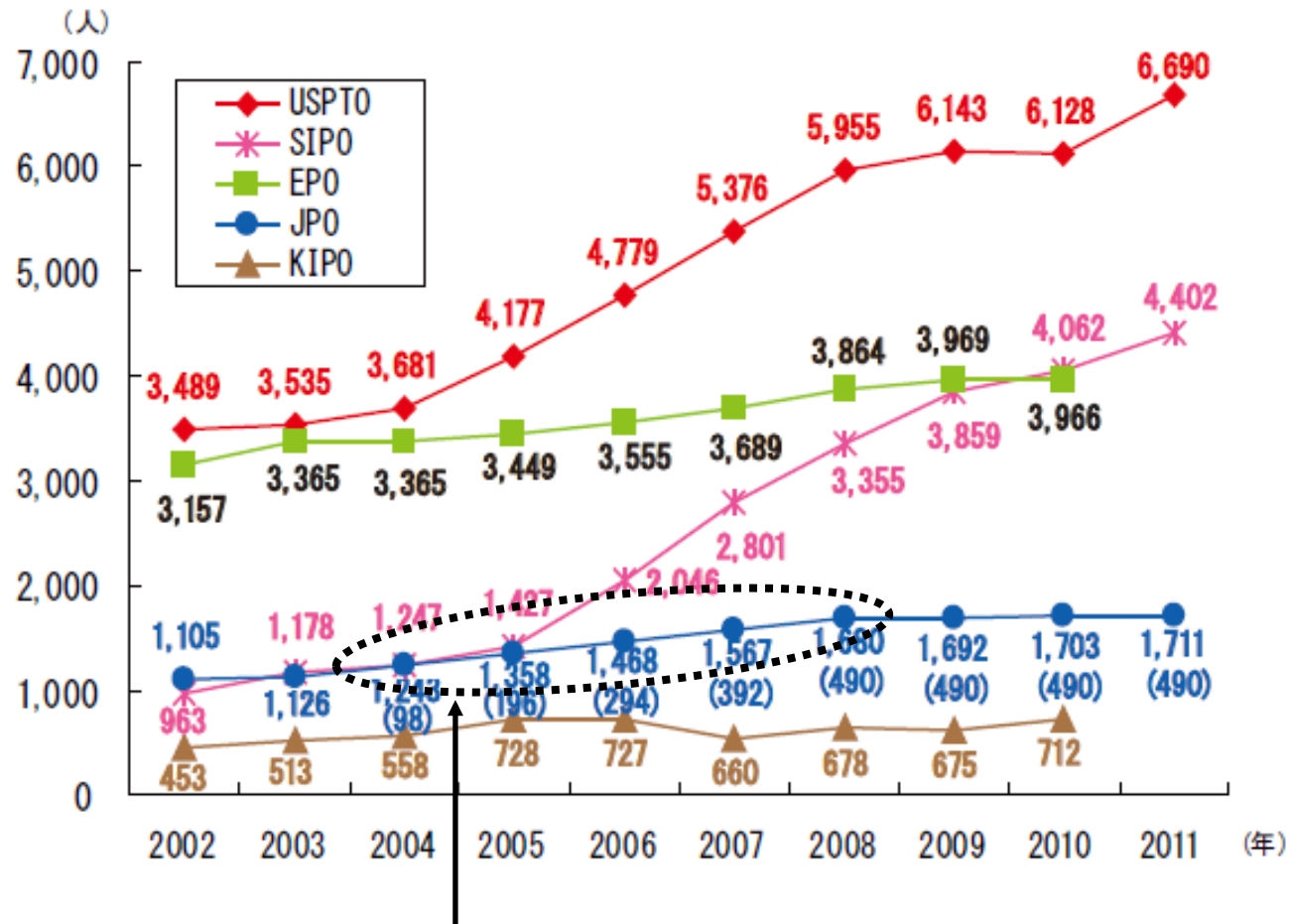




**Goal: Shorten FA pendency less than 11 month in 2013**

# Increase of the number of Patent Examiners

Changes in the Number of Patent Examiners



Hiring 100 Fixed-term Examiners every year  
Term: 5 year (with 1 more term → 10 years)

# Fee setting : Change in 2011 and 2012

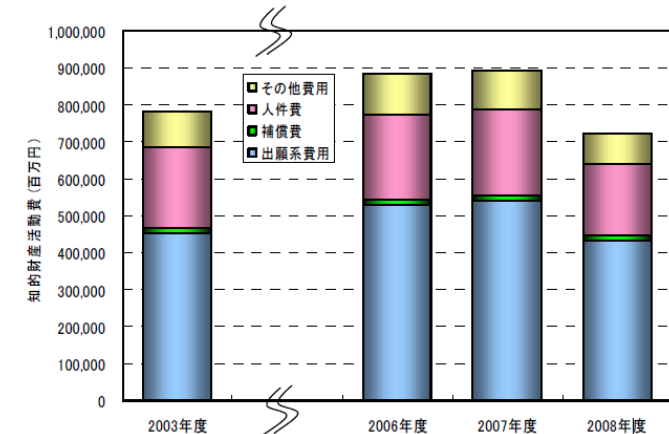
## Reduction of Examination Request Fees (August 2011)

200,000 YEN

→ 150,000 YEN (-25%) (Average Case)

Background:

Decline in IP-related investments  
by companies



## Expansion of Fee-Reduction for SME (April 2012)

SME not paying corporate tax

50% Reduction of

Examination Request Fee, Maintenance Fee for 1<sup>st</sup> to 3<sup>rd</sup> year



SME not paying corporate tax or SME less than 10 years old

50% Reduction of

Examination Request Fee, Maintenance Fee for 1<sup>st</sup> to 10<sup>th</sup> year

***Thank you!***