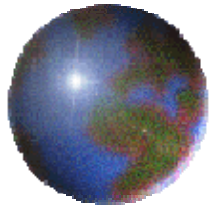




*AIPLA/FICPI Colloquium – June 17-18, 2010
- THE PATENT OFFICE BACKLOG CRISIS -*

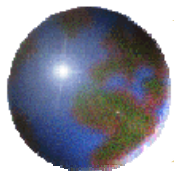


June 17, D1

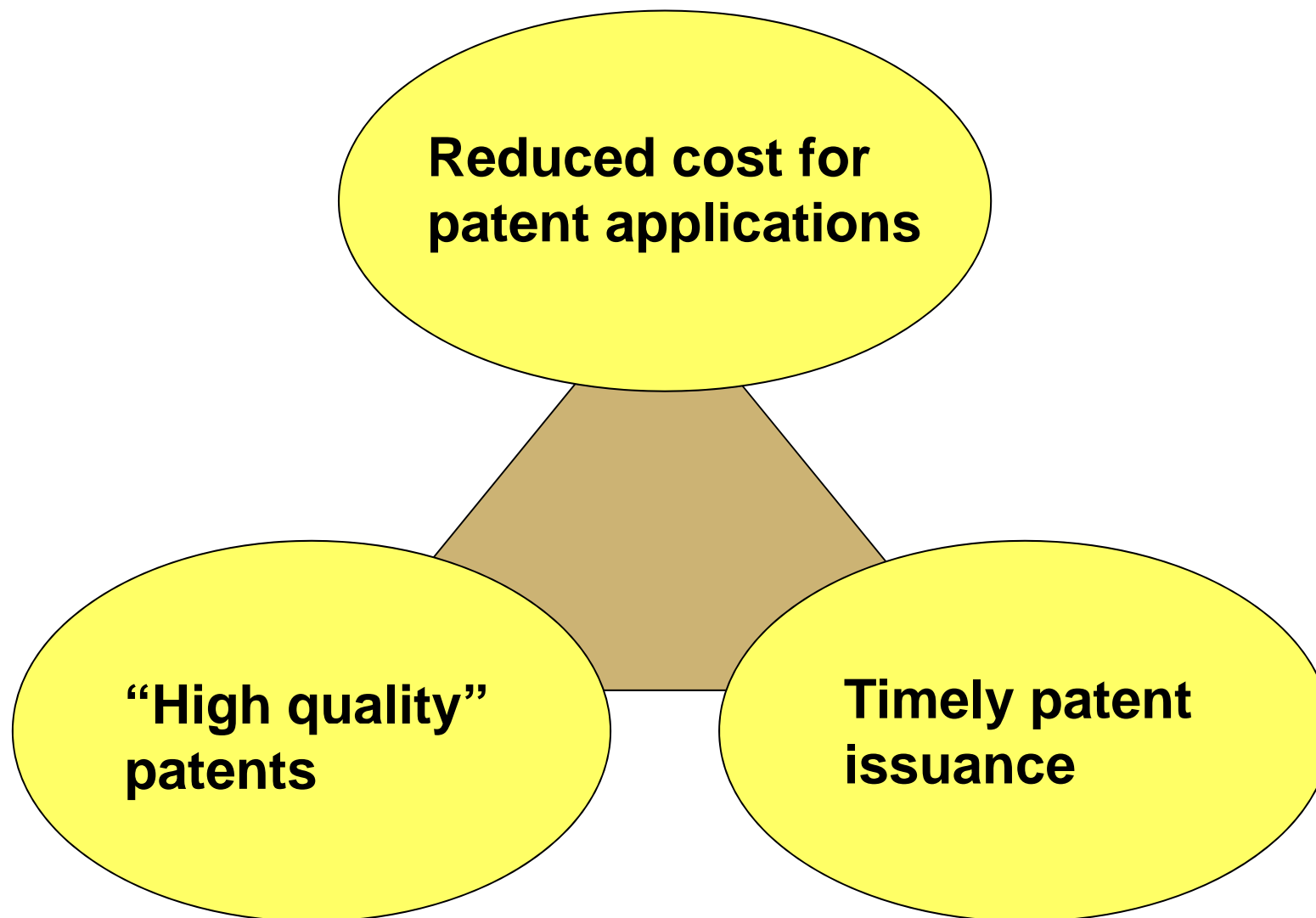
*Interrelationship with Other Issues
-- Quality*

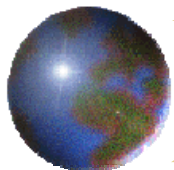


*Takeshi Ueno
Vice President
Japan Intellectual Property Association*



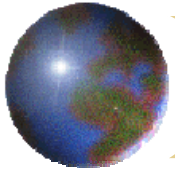
What Users Want:



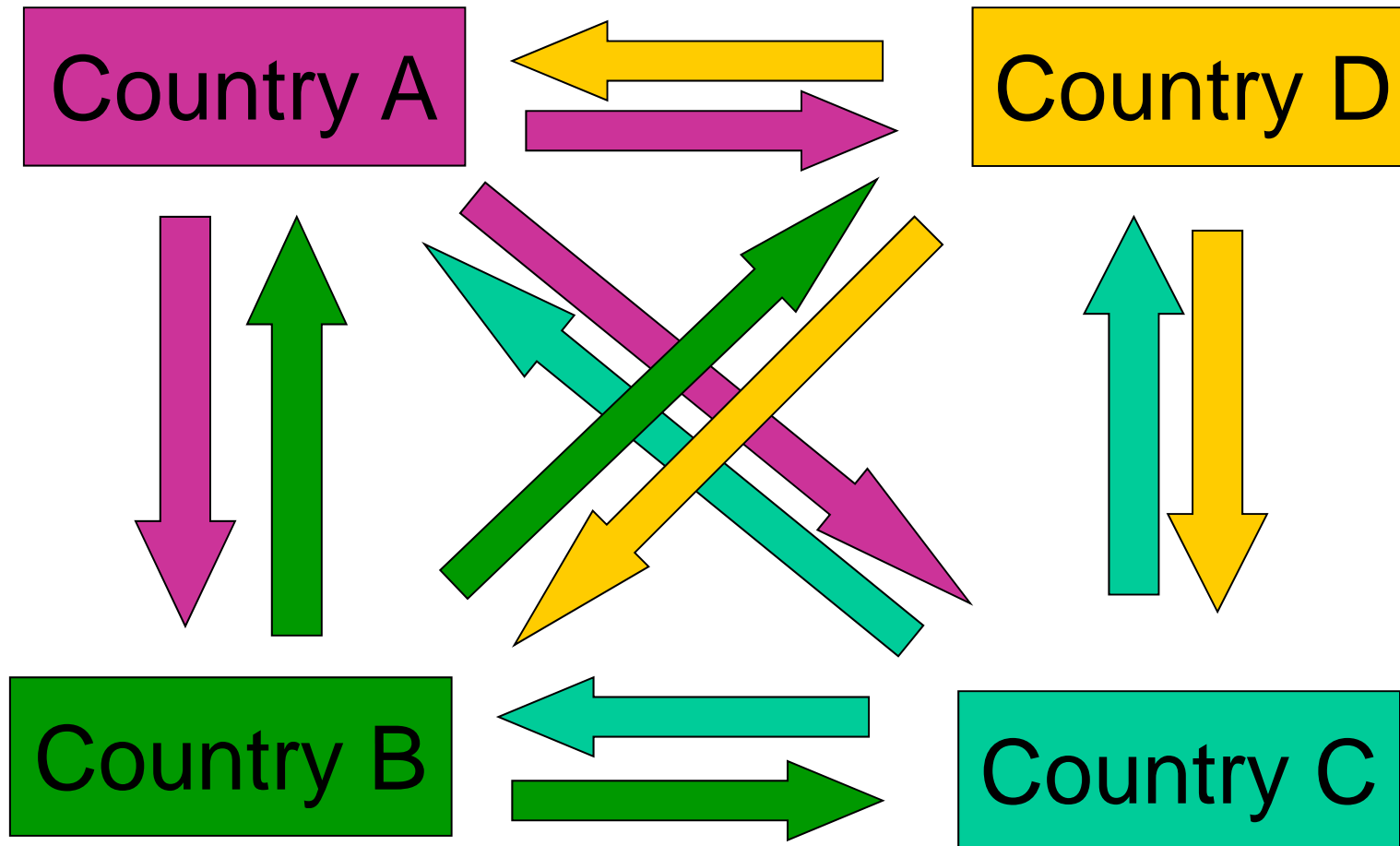


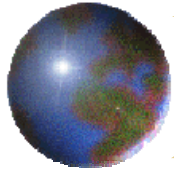
What is “Patent Quality” ?

- Applicants want high quality patents to be issued to secure their investments.
 - Patents with legal stability
 - Thorough and complete searches and examinations
 - Clear notice to the public, with proper claim scope
 - Patent quality is more important than the examination speed.
- Will the backlog negatively affect exam quality?
 - It may, if the time pressure is strong.
 - However, from our experience of accelerated examinations in Japan, the examinations quality between AEs and regular examinations appear to be the same.
 - AE is a mere change of the sequence of the applications in the queue. The same amount of time seems to be spent to examine one case.
- Worksharing and harmonization which remove inefficiencies and enhance patent quality are the key to addressing backlog issues.



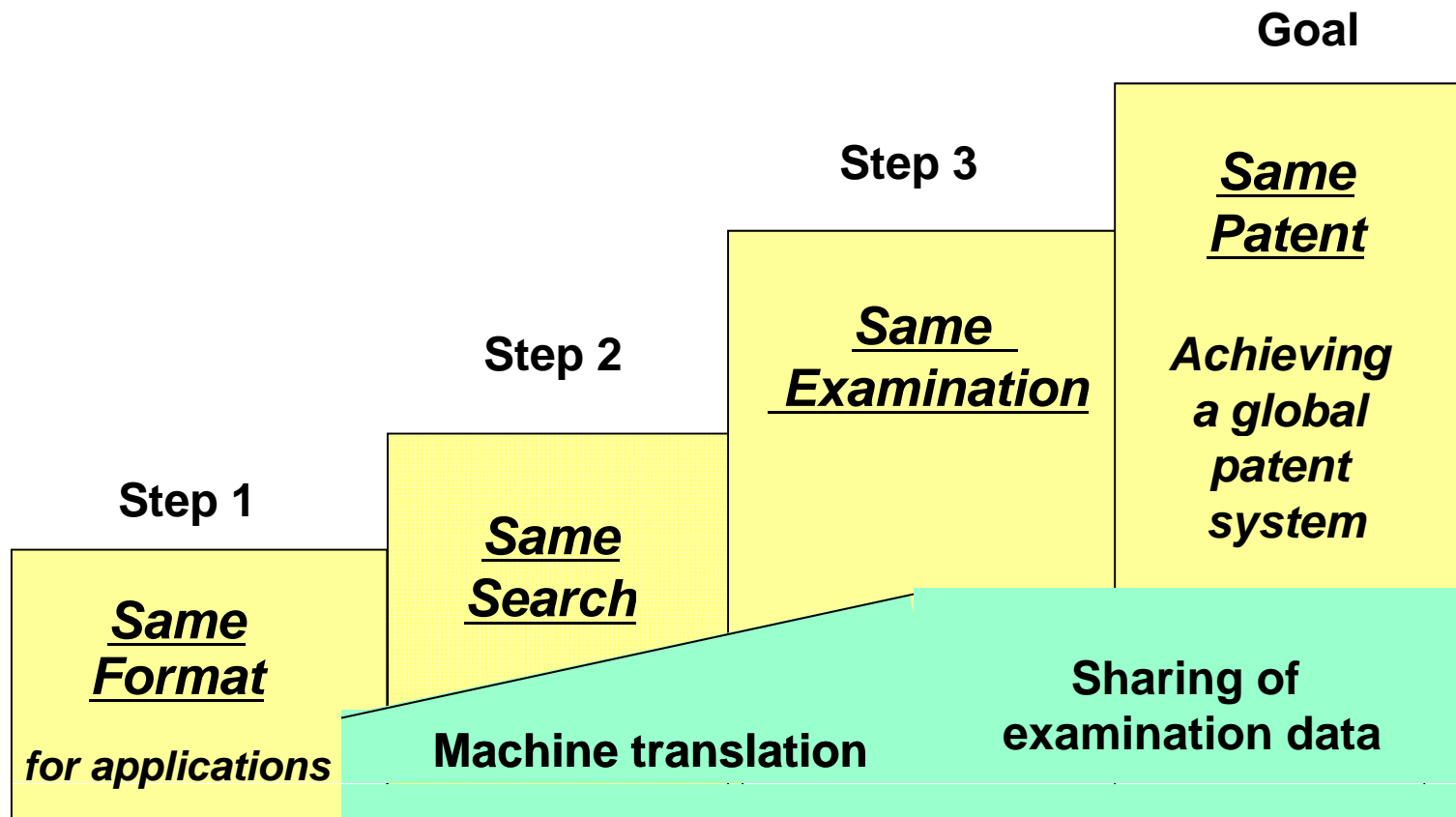
Duplicate applications among patent offices

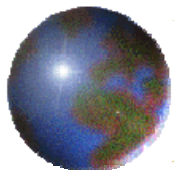




4 “Same” Achievements

***Issue high quality patents globally
at low costs and burdens.***





To enhance quality and productivity

● Harmonization and Worksharing

■ Common Documentation

- Common Application Format (CAF)
- Common Citation Document (CCD)

■ PCT

■ Patent Prosecution Highway

- Expedited exam, Higher issuance ratio, Fewer office actions

● Quality of prior art searches

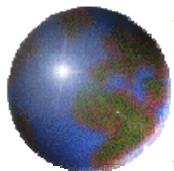
■ Improving the quality of PCT international searches

■ Search outsourcing

- Training, Vendor certification, Quality control, DBs, Openness, Feedback

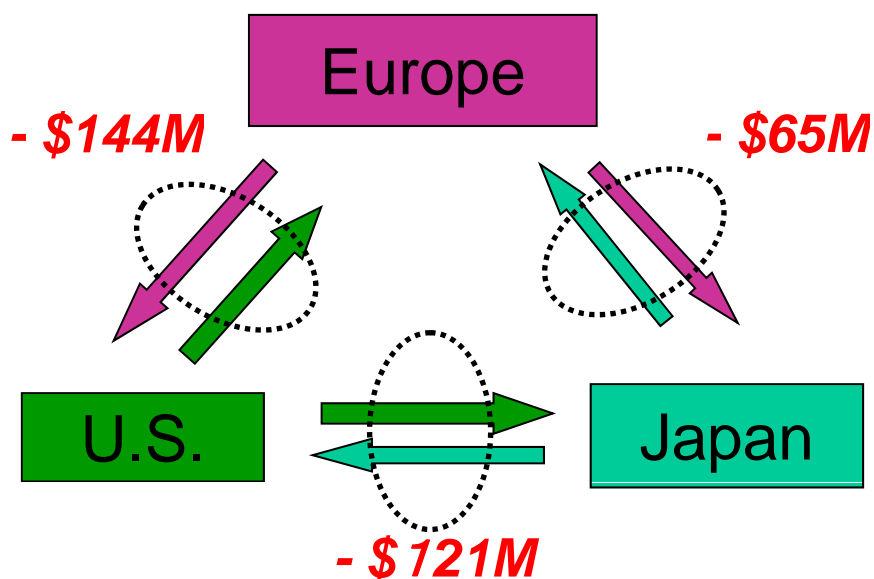
■ Public participation

- Protest
 - Higher rejection ratio in Japan
- Community Patent Review (Peer-to-Patent)
 - Pilots in US, JP, AU, KR



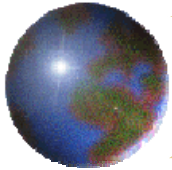
Common Application Format (CAF)

Estimated cost reduction for users



Costs for reformatting and revising specifications to seek patent protection for the same invention in multiple countries can not be ignored.

- **-\$330M/year** is expected to be saved among Trilateral Users from CAF.
- However, only a portion of 330M/year has been achieved from the already implemented CAF (Jan. 1st, 2009.)
- To enable users to enjoy the entire savings expected from CAF, further harmonization on several substantive issues (unity of inventions, reference numbers in the claims, etc.) will be needed.

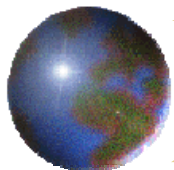


Common Citation Document (CCD)

- ⊕ CCD is a list of references used by patent offices (office actions), users (IDS), and the third party.
 - ▣ Applicants can use CCD form which they receive from one Patent Office to submit IDS to another Patent Office.
- ⊕ CCD can form a central repository of the prior art references.

CITATION DOCUMENT

Citation Document Type		Index	Application no.	
td ¹ disclosure at filing or IDS	td ² official search report	td ³ post-filing acknowledgement of prior art	Consecutive numbering of citation documents for the patent family	
A. CLASSIFICATION OF SUBJECT MATTER				
According to International Patent Classification (IPC) or to both national classification and IPC				
B. FIELDS SEARCHED				
Minimum Documentation Searched (Classification system followed by classification symbols)				
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched				
Electronic data base consulted during the search (name of data base and, where practical, search terms used)				
IDS only	Category ⁴	C. DOCUMENTS CONSIDERED TO BE RELEVANT		Relevant to claim No.
Examiner Initials ⁵		Citation of document, with indication, where appropriate of the relevant passages	Voluntary comments attached	



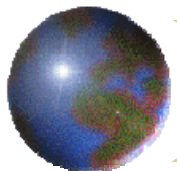
Patent Prosecution Highway (PPH)

- Office of Second Filing will trigger the accelerated examination based on the claims found allowable by the Office of First Filing (14 Patent Offices)
- PPH based on PCT with favorable ISR/IPER started in Jan. 2010
- This work sharing program for patent offices demonstrates significant merits also for users.

	US to JP	JP to US
Shorter time from 1 st OA to issuance	13.4 → 9.8 months	6.6 → 3.8 months
Higher issuance ratio	38.2% → 59.4%	44% → 90%
Fewer number of OAs up to issuance	1.25 → 1.09 OAs	3.4 → 1.7 OAs

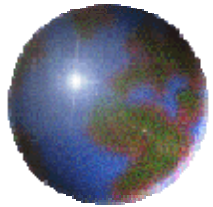
Data: Regular(Non-PPH) → PPH

Source: Presentation by JPO Deputy Commissioner Minami at JIPA Kantoh Session on 10/27/2009



Conclusions

- ✚ For users, backlog is backlog when a patent issues later than the desired timing.
- ✚ Patent quality is more important than the examination speed.
- ✚ Worksharing and harmonization are essential for solving the backlog and patent quality issue.



Thank you for your attention.