

**Meeting of US Patent Bar/JPO Liaison Council, October 15, 2007**

# **Patent Harmonization**

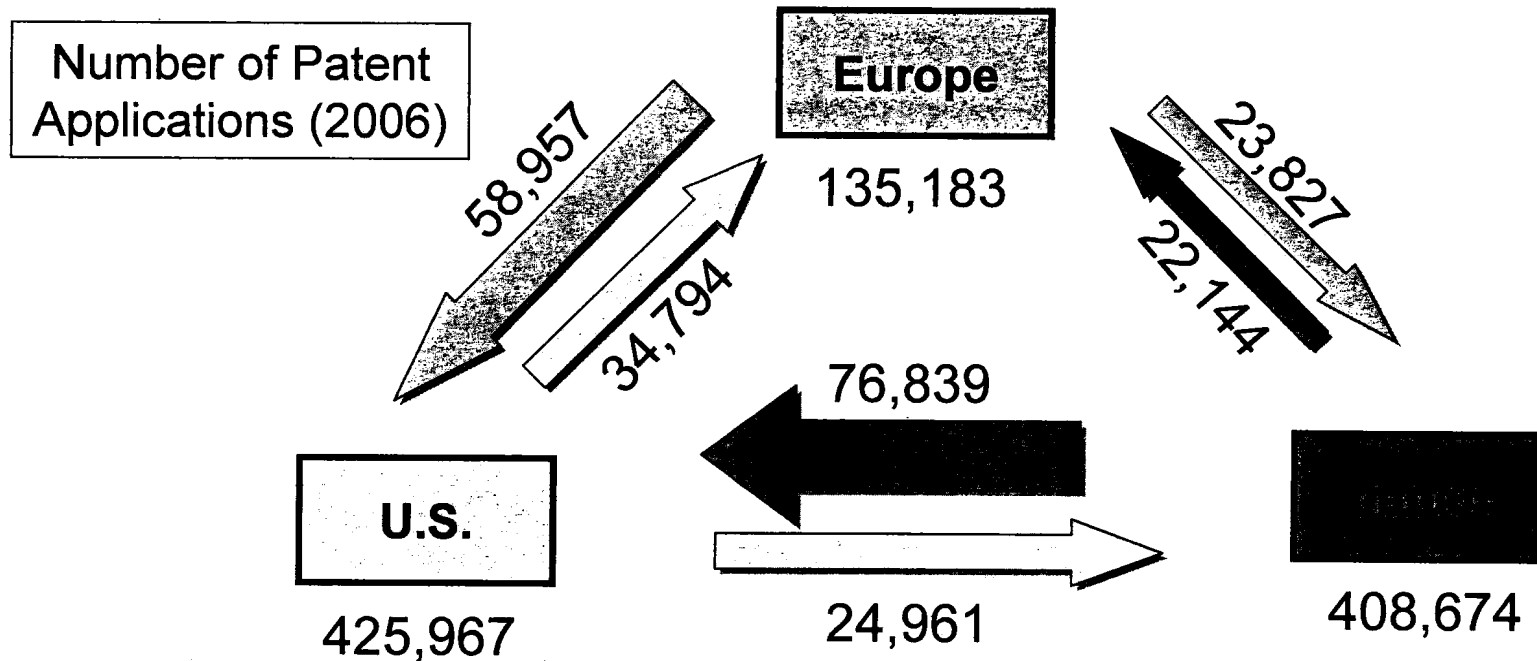
***Progress and Points under Discussion***

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Deputy Commissioner  
Japan Patent Office**

# Patent Activities in the Trilateral Region

- Globalized economy leads to strong need for patent protection abroad
- Total number of patent applications filed with Trilateral Offices: 970,000
- Duplicate applications filed with the Trilateral Offices: 240,000

- (1) Harmonization: Higher predictability regarding obtaining patents abroad
- (2) Mutual utilization of examination results: Burden of applicant reduced



# Progress of Patent Harmonization

**1985: Initial discussion of patent harmonization at WIPO**



**(1) 1991: Failure - U.S. refused to shift to “First-to-File” from “First-to-Invent”**



**(2) 2004: Failure - Blocked by developing countries at WIPO**



**(3) After 2005: Developed countries’ focused efforts on major issues\***

\* “Novelty,” “Inventive Step,” “First-to-File rule,” “Grace Period,” etc.



**Sep. 2006: Agreement on “compromise package” to draft treaty**

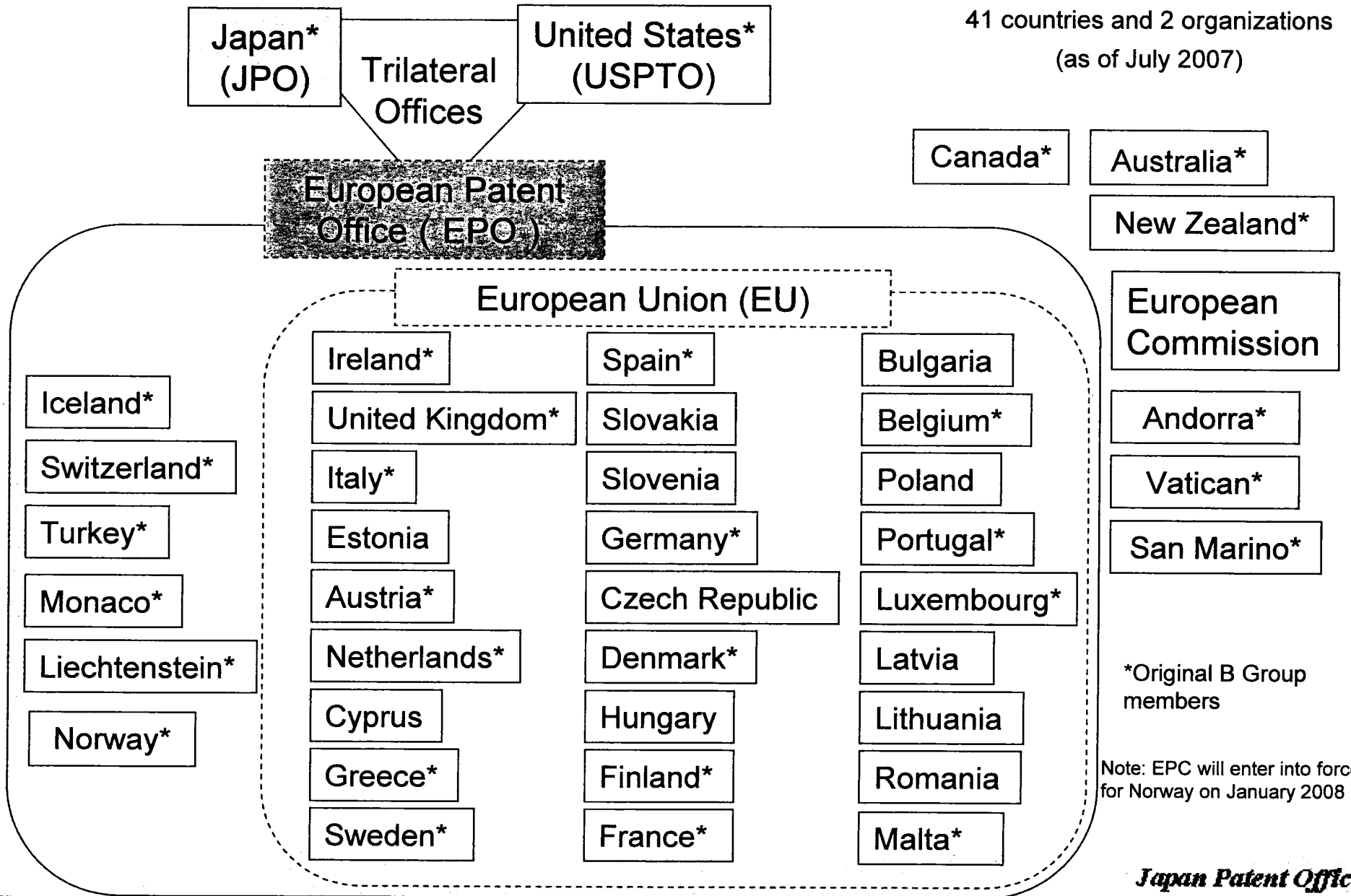
**Nov. 2006, Jul. 2007 & Sep. 2007: Continued discussion to reach final agreement**

***U.S.: Shift to First-to-File in return for expanded Grace Period by JP & EU***

***Some European countries reluctant to expand Grace Period***

# B+ Meeting Member Countries / Organizations

41 countries and 2 organizations  
(as of July 2007)



# Points under Discussion

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## 9 items included in Chair's Report

**First to file**

**Elimination of the Hilmer doctrine**

**12-month grace period with no formal declaration**

**Third party rights, optional or partially optional**

**Definition of the prior art**

**The abstract does not form part of the whole contents**

**Grace period covers published patent applications only if publication is erroneous**

**PCT applications apply as secret prior art as of the PCT filing or priority date**

**Inventive step methodology is not included in the Articles**

## 6 items to be discussed

**Legal certainty for third parties under the proposed grace period**

**18 months publication**

**harmonization of secret prior art**

**mandatory third party rights**

**mandatory anti-self collision**

**subject matter eligibility**

***Thank you***