

TOPIC

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A Revision to the Examination Guidelines for "Novelty and Inventive Step" of an Invention Having a Limitation by Use

On June 21, 2006, the Japan Patent Office announced a Revision to the Examination Guidelines for "Novelty and Inventive Step" regarding a way of thinking about an invention having claim statements defining a product by its use as well as a way of thinking about a use invention. The Revised Examination Guidelines were announced for the purpose of clarifying the Examination Guideline for Novelty and Inventive Step, and is applied to those applications which are to be examined on the same date or later.

The Revised Examination Guidelines relates to Chapter 1.5.2 "Methods of Constructing Particular Types of Claim Statements" of Part II "Novelty and Inventive Step" of the "Examination Guidelines for Patent and Utility Model". In accordance with the diversification of manners of expressing an invention and the development of technologies, it has been pointed out that the above concrete method is not necessarily clear. In response to these suggestions, a Draft Revision was prepared. Also in consideration of opinions made in the Public Comment Procedure carried out in April, a Final Revision was prepared.

The Revised Examination Guidelines have the following four points (a) to (d):

(a) It is made clear that, in finding an invention having a limitation by use, there are two cases as follows: (i) a case in which the limitation by use should be construed in such a manner that the limitation by use means a structure or the like particularly suitable for the use; and (ii) a case in which the invention having the limitation by use should be construed as a so-called use invention.

(b) It is made clear that, in general, a use invention is construed as an invention based on (i) the discovery of an unknown attribute of a product and (ii) the suitability of the product for a new use due to the attribute.

(c) Expressions pointed out to be ambiguous, such as the description of "a product that is to be used solely for the use purpose" and the description of "an insecticidal compound Z", are made clear, and it is also made clear that the expressions are examined by way of the method mentioned above in Point (a).

(d) Examples of an invention having a limitation by use are enriched.

Reconsideration of the Intellectual Cluster Creation Project

A project initiated by the Ministry of Education, Science and Culture is facing an uphill battle. A goal of the project was to create an internationally viable revolutionary technology by following the U.S. Silicon Valley, in which worldwide IT (Information Technology) ventures are launched. However, only one international patent has been obtained in the first five years. Since the project spends ¥10 billion from the national treasury every year, the Ministry of Finance requires a strict project evaluation to be carried out from the perspective of international competition.

The project is the "Intellectual Cluster Creation Project" initiated in the fiscal year of 2002, and 18 regions in Japan receive an annual subsidy of ¥500 million each. The Ministry of Finance investigated the results achieved by 11 regions whose subsidization is put to an end in this fiscal year. The region which made the largest number of domestic applications made 155 domestic applications, and 83 domestic applications were made on average. However, only 14 international applications were made on average, and only one of them was granted a patent. This has raised questions about international competitiveness.

In response to the pointing out of the Ministry of Finance, the Ministry of Education, Science and Technology argues that "a revolutionary technology is not created overnight, and a period of time between patent application and patent grant is long".

According to the Japan Patent Office, a period of time between patent application and patent grant is 32 months on average in Japan, 28 months on average in the United States, and 41 months on average in Europe.

Representative Counters for Small and Medium-sized Enterprises Set Up throughout Japan

The Ministry of Economy, Trade and Industry and the Small and Medium Enterprise Agency have announced that representative counters for small and medium-sized enterprises are set up at 3000 places in the Societies of Commerce and Industry and the Chamber of Commerce and Industry throughout Japan and that the representative counters starts on July 3 to assist small and medium-sized enterprises in consultation on intellectual property.

As the representative counters, counters provided in the Societies of Commerce and Industry and the Chamber of Commerce and Industry are used. At a representative counter, a management counselor provides a small or medium-sized enterprise with a consultation on intellectual property, and then introduces the small or medium-sized enterprises to an appropriate public assistance organization, patent attorney, or attorney. The representative counters deal with a wide range of intellectual property right issues such as (i) a task of obtaining, protecting, and utilizing an intellectual property right (patent, utility model, design, and trademark), (ii) prevention of misappropriation of trade secrets and technologies, and (iii) a transactional problem.

Examples of the organizations represented by the representative counters include: the Patent Office of the Bureau of Economy, Trade and Industry; the National Center for Industrial Property Information and Training; Japan External Trade Organization; Japan Institute of Invention and Innovation; Japan Patent Attorneys Association; and Japan Federation of Bar Associations.



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Please Contact us if You have any Comments or Require any Information.

Please acknowledge that the purpose of our column is to provide general information on the field of intellectual property, and that the description here does not represent our legal opinion on a specific theme.

HARAKENZO World Patent & Trademark Osaka Head Office

ADDRESS: DAIWA MINAMIMORIMACHI BLDG.
2-6, 2-CHOME-KITA, TENJINBASHI,
KITA-KU, OSAKA 530-0041, JAPAN

CABLE: KENZOPAT OSAKA

E-MAIL: kenzopat@mars.dti.ne.jp

WEBSITE: <http://www.harakenzo.com>

TELEPHONE: +81-6-6351-4384 (Key Number)
+81-6-6351-4397 / +81-6-6351-4374
+81-6-6351-4630 / +81-6-6351-4670

FACSIMILE: (GII, GIII)
+81-6-6351-5664 (Key Number)
+81-6-6351-2682 / +81-6-6351-5611
(GIV)
+81-6-6355-0986



HARAKENZO World Patent & Trademark Tokyo Office

ADDRESS: WORLD TRADE CENTER BLDG. 12F
2-4-1, HAMAMATSU-CHO, MINATO-KU,
TOKYO 105-6112, JAPAN

E-MAIL: hara-tyk@muse.dti.ne.jp

WEBSITE: <http://www.harakenzo.com>

TELEPHONE: +81-3-3433-5810 (Key Number)
+81-3-3433-5811
+81-3-3433-5812

FACSIMILE: +81-3-3433-5281

