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Japan, U.S., and EU Agreed to Establish New Convention, Aiming Unification to First-to-File System

Forty-one countries, including Japan, U.S., European Union Countries, and EPO member countries held an unofficial chief examiner meeting on September 24, 2006 in Geneva. In the meeting, they reached an agreement to draw up a new convention. This new convention unifies the current patent approval principles to a "first-to-file system", which gives a right to obtain a patent to a person who first files an application.

The U.S. has been the only one country using a "first-to-invent system", which protects right of a person who made an invention. However, the U.S. agreed to abandon the first-to-invent system. When a new convention is established, a patent examination will be prosecuted more smoothly across the world and a patent will be available internationally.

In the meeting, they reached agreement on the unification to the first-to-file system and the following matters.

- Fundamental criteria for judging whether an invention can be granted a patent are defined in the new convention.
- One year is given as a grace period for preparation from the date of publication of an invention to a filing date.
- The first filing date is acknowledged by the member countries of the convention, no matter where the first filing is made in the member countries.

A draft of the convention will be established before a chief examiner meeting scheduled for this November in Japan, and details of the convention will be negotiated. The convention will be adopted as early as next year.

Some of Japanese and European enterprises have persistently shown disputes regarding the fact that only the U.S. uses the different system. Even in the U.S., there have been increasing demands for converting the first-to-invent system to the first-to-file system which requires less cost for applying and maintaining a patent application.

Drug Patent Online Market Set Up

The Osaka chamber of commerce and industry (OCCI) set up a Drug Patent Online Market for the first time in Japan. This is established aiming to make patents more available, especially patents related to: drug seeds (drug candidate substances); fundamental techniques (techniques for producing drugs); and reagents and diagnostic drugs.

Items to be registered in the market (purchase items) are techniques related to patents including: (i) drug seeds whose development has been stopped by drug companies, (ii) drug seeds whose property rights are possessed by universities, research centers, venture companies, and the like, and (iii) target proteins that are the causes of diseases, (iv) fundamental techniques, and (v) the like.

Technical information of the purchase items is classified into: primary information which is available to anyone; and detailed information which can be viewed by only the members of the market (e.g. domestic and foreign drug companies). The members can also request an order (i.e., register a selling item). Such a request is received and matched with a purchase item by the administrative office.

The website of this market is operated by the OCCI. Further, the market is supported by: CIMIC Co., Ltd. performing consulting services such as clinical tests; Sojitz Corporation performing coordinate services such as matching the items; Mitsubishi UFJ Trust and Banking Corporation performing licensing services such as reducing burdens on licensing procedure, and trusting intellectual properties; and Osaka Institute of Technology giving advices on market operations.

The website posts information such as "patent information disclosed assuming its use by other companies", and "patent information specific to drugs". In the website, selling items will be posted for free until the end of March 2008.

URL: <http://www.drugtech-patent.jp/j/>

KIPO Enlarged the Range of Subjects of Preferential Examination

In Korea, amendments to the Korean patent regulations related to subjects of preferential examination (which is equivalent to the accelerated examination in Japan) and a notification related to this were announced and put into force on October 1, 2006.

With the amendments, the range of the subjects of the preferential examination covers a patent application that was first filed in the JPO and then filed in the KIPO. Further, the amendments enable an application to be examined earlier than other normal applications when documents including: (1) the result of a search made by the JPO and other patent offices; (2) copies of reference(s) cited in the search; and (3) comparison(s) between an invention of the subject application and invention(s) disclosed in the reference(s) are filed with the KIPO.

The amendments have been requested by the JPO in order to (i) enable Korean users of the JPO to widely use the preferential examination and (ii) implement the Patent Prosecution Highway between the KIPO and the JPO, which aims to reduce burdens on prosecution of an application that is filed in either Japan or Korea and that seeks prompt examination in the other country.

Further, after the Patent Prosecution Highway between the KIPO and the JPO is implemented in the first half of the year 2007, a Korean patent application that discloses the substantially same invention as the one first filed in the JPO and granted a patent will not be required to file the above document (3) (i.e., comparison(s) between the subject application and cited reference(s)) when (i) a translation of claims that are granted a patent by the JPO and (ii) a translation of a notification related to the examination are submitted to the KIPO.



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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.

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