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WORLD PATENT & TRADEMARK  
PATENT LAW FIRM

JAPAN

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### The JPO collaborates with Germany to expedite the Patent examination Prosecution. 特許庁ドイツと特許審査迅速化

On October 19, 2007, the presidents of the Japan Patent Office and the German patent and Trademark Office agreed to start the Patent Prosecution Highway program from March 2008 in which the standardizing of the procedures as well as sharing the information for examinations is promoted and the examinations of patent applications from the partner country are accelerated. When the patent technology which has been granted in the home country is applied, the applications will be examined early with simple procedures, resulting in early obtaining the examination report.

In the new program, when a company files an application for the patent granted in the home country, the patent office of the home country will provide the partner office with the prior art search and the search report. This allows the partner office to examine the application preferentially and to issue the examination report earlier. At the moment, Japan is negotiating with Australian, Canadian, and European Patent Office for introducing the same program.

Regarding U.S., Korea, and U.K., the "Patent Prosecution Highway program" has already been applied to.

日本とドイツの特許庁長官は2007年10月19日、手続きの共通化や審査資料の共有を進め、相手国企業から出願された特許を迅速に審査する「特許審査ハイウェイ制度」を2008年3月から始めることで合意した。自国で取得済みの特許技術を相手国で出願する場合、簡易な手続きで早期に審査を受けられるようになり、審査結果までの期間が短くなる。

新制度では企業などが自国で持つ特許を相手国で出願した場合、自国の特許当局が先行技術調査や審査結果を相手国に提供することによって、相手国当局は優先的に審査し、早期の判定をすることが可能となる。日本は現在、オーストラリア・カナダ・欧州連合などの特許当局とも同制度の導入に向けた交渉を進めている。

また、米国・韓国・英国については、既に「特許審査ハイウェイ制度」を適用している。

## Japanese government about to sign a treaty against imitation, while China stays out

模倣品防止条約、日本政府締結へ 中国は不参加

In order to sign with other developed countries a treaty that could put an end to the damage caused by imitation goods and pirated edition, the Japanese government will participate in a conference in Geneva before the end of the year. In a statement dated October 23, 2007, the Ministry of Foreign Affairs and the Ministry of Economy, Trade and Industry expressed their common will to join over thirty countries, including European countries and the USA, in the conclusion of an international treaty preventing the circulation of fake brand goods and pirated edition. However, since China, who is increasingly criticized for its attitude towards the protection of intellectual rights, will not take part in the conference, the policy will be to urge the Chinese government to join in so as to ensure the future efficiency of the treaty.

Participating countries in the conference include for the time being Japan, the USA, the European Union, Swiss, New Zealand, Mexico, South Korea and Canada. These countries hope to sign what is being temporarily called the "Treaty against the diffusion of imitation goods and pirated edition".

Measures such as the prohibition of import and export of such goods, as well as their confiscation at custom, are being considered in the treaty framework. The protection of intellectual property depends on rules set by the World Trade Organization, but since regulation is left to the discretion of the authorities in each country, their enforcement, reflecting conflicts of interests between developed countries and developing countries, is often minimum.

政府は模倣品や海賊版による被害を防ぐための条約を先進国と結ぶため、年内にジュネーブで協議を始める。外務・経済産業両省は、日米欧など30カ国以上が、ブランド品などの模倣品・海賊版の流通を防止するための国際条約を締結することで合意したことを2007年10月23日発表した。ただ、知的財産権保護をめぐる各国からの風当たりが強まっている中国は加わらないが、将来的には条約の実効性を高めるために参加を促す方針である。

締結を目指すのは「模倣品・海賊版拡散防止条約(仮称)」で、当初は日本・米国・欧州連合(EU)・スイス・ニュージーランド・メキシコ・韓国・カナダが協議に加わる。

構想では、模倣品の輸出入の禁止や、税関での模倣品の没収などが検討される。知財保護をめぐるっては、世界貿易機関(WTO)のルールがあるが、先進国と途上国の利害対立を反映して、取り締まりなどは各国当局に委ねられている等、最低限の基準にとどまっている。

## The USPTO published Examination Guidelines for determining obviousness. 米特許商標庁自明性判断基準のガイドラインを公表(USPTO)

On October 10, 2007, U.S. Patent and Trademark Office (USPTO) published examination guidelines to support examiners to determine obviousness in light of the KSR decision. Mr. John Doll, Commissioner for patents, noted that the patent examiner would continue to consider the following points:

- 1, the scope and content of the prior art,
- 2, the differences between the claimed invention and the prior art,
- 3, the level of person with ordinary skill in the art, and
- 4, objective evidence relevant to obviousness.

According to the guidelines, when examiners make obviousness rejection, rationale to conclude obviousness should be still provided. In examining each case in view of obviousness, there are used also the old guidelines for determining obviousness, as has been conventionally used in the U.S. Court of Appeal for the Federal Circuit (CAFC). That is, when the so-called "teaching, suggestion, and motivation test" (TSM-test) specifies the prior art, the claimed invention will be deemed to be obvious.

Whereas the guidelines noted that it is not obligatory to conduct the TSM-test. Even if the TSM-test is not applicable to the claims being considered, there could be some cases that the invention is obvious. The guidelines hereby avoid contradictory between the KSR decision and itself.

KSR判決を受け、米特許商標庁(USPTO)は、2007年10月10日、審査官による自明性判断を支援するための審査ガイドラインを公表した。特許局長のジョン・ドール氏によれば、特許審査官は引き続き、①先行技術の範囲と内容、②請求項に係る発明と先行技術の差異、③当該技術における当業者の水準、および④自明性に関する客観的証拠を考慮するということである。

同ガイドラインによれば、特許審査官が自明性拒絶を行う際、今後も自明性を結論付ける根拠を示す必要がある。なお、該自明性には米国連邦巡回控訴裁判所(CAFC)で従来から用いられている自明性判断基準も含まれている。すなわち「教示、示唆、動機付けテスト」(TSM テスト)で先行技術が特定された場合、その請求項に係る発明は自明であるという論理である。

しかし一方で、ガイドラインは、自明性拒絶にTSMテストは必須ではなく、たとえ問題の請求項にTSMテストが適用できない場合でも、自明性が認められる場合があると示している。これにより、KSR判決との矛盾を回避している。

## U.S. District Court issued a preliminary injunction enjoining the USPTO from implementing the new rule. 米連邦地裁、USPTOの新ルールに仮差し止め命令

U.S. District Court of Virginia issued a preliminary injunction enjoining the United State patent and Trademark Office (USPTO) from implementing the new rule regarding patent examination. A major pharmaceutical company GlaxoSmithKline in United Kingdom had filed a complaint against the USPTO, seeking to enjoin from implementing the new rule.

The disputed new rule would limit the number of amendments for filed application as well as the number of claims of a single invention. Aiming to improve quality and efficiency of the patent examinations, the USPTO promulgated the new rule on August 2007 and would enforce on November 1, 2007. Based on the preliminary injunction, the USPTO announced that the new rule would not go into effect on November 1, 2007.



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米バージニア州の連邦地裁は、米特許商標庁(USPTO)の特許審査に関する新規則の施行を仮差し止めする判決を下した。英製薬大手グラクソ・スミスクライン(GlaxoSmithKline)がUSPTOを相手取り、新規則の施行の差し止めを提訴していた。

争点となった新規則は、既存の出願に対する修正回数と、発明1件あたりの請求項数に制限を設けるといものである。特許審査の質と効率の向上を目的として、USPTOが2007年8月に公布し、同年11月1日から施行する予定であった。

これに伴い、USPTOは、同規則の施行を11月1日には行なわないことを発表した。



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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

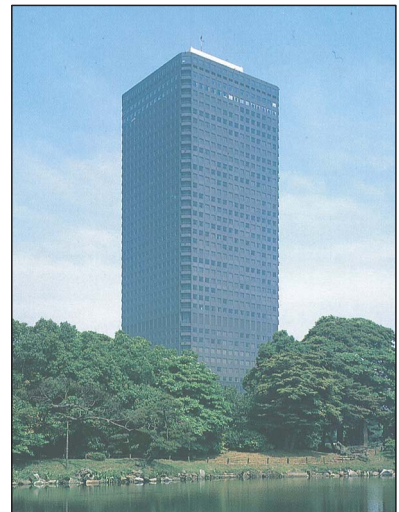
ADDRESS: WORLD TRADE CENTER BLDG. 21F  
2-4-1, HAMAMATSU-CHO, MINATO-KU,  
TOKYO 105-6121, JAPAN

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 (Key Number)  
+81-3-3433-5286



For extension of business, we moved our Tokyo Office from the 12th floor to the 21st floor of the World Trade Center Building on August 1, 2007. There are no changes in the phone number, the facsimile number, and the like.

弊所東京事務所は、業務拡張のため2007年8月1日に、同ビル内の12階から21階に移転しました。  
なお、電話番号、FAX番号等に変更はありません。