
Trilateral Office and User Meeting

November 15, 2012

Kyoto, Japan



Study on Grace Period
- Revision of patent law in Japan -

Japan Patent Office

< Expansion of scope of GP >

Before revision

“List-type” scope

Problems of the previous system

“List type” scope couldn’t cover all user’s needs.

<Examples>

Internet ; covered

TV ; *not covered*

Designated academic societies; covered

Non-designated academic societies; *not covered*

After revision

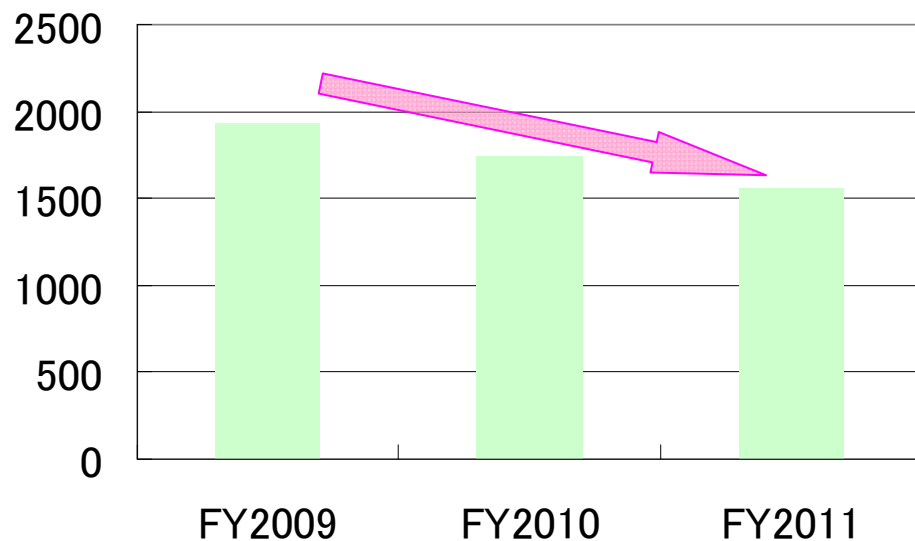
- ✓ Enhancing Friendliness
- ✓ Facilitating Industry-Accademia collaborations

“Comprehensive” scope

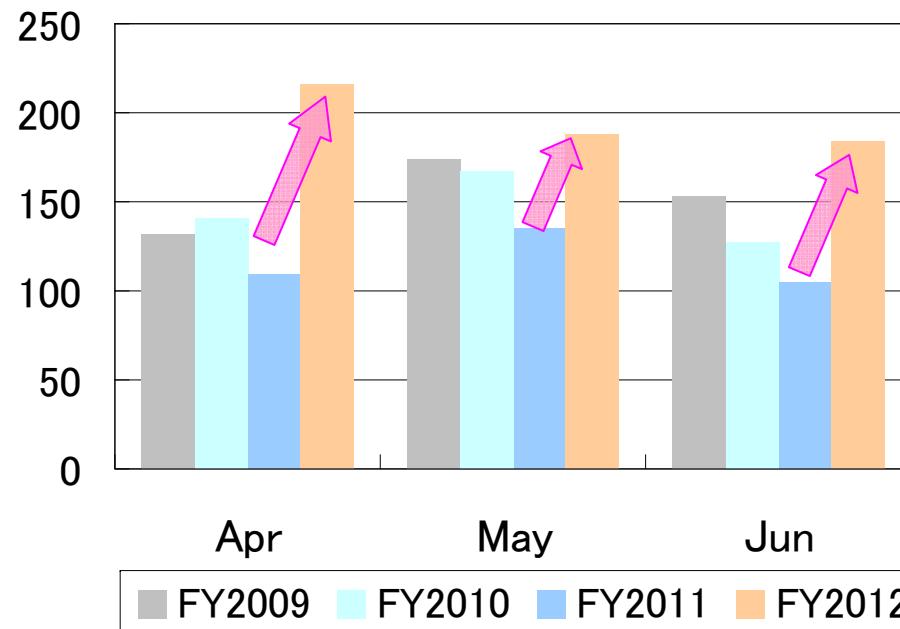
(Revision came into effect on April 1, 2012.)

The number of requests for Grace Period increased by about 70% after the revision of patent law.

Number of Applications requesting GP from FY 2009 to FY 2011



Number of Applications requesting GP in April – June



The number of requests for Grace Period by SME increased by about 4 times.

Breakdown in Number of Applications Requesting GP between Apr – Jun of 2011 and 2012 [Type of Applicant]


	Apr - June of 2011		Apr - June of 2012	
University/Public Research Institute	88	25.2%	106	18.0%
Joint Applicant(including University/Public Research Institute)	89	25.5%	100	17.0%
SME	34	9.7%	130	22.1%
Large Company	90	25.8%	169	28.7%
Joint Applicant(not-including University/Public Research Institute)	24	6.9%	54	9.2%
Other	24	6.9%	29	4.9%
Total	349	-	588	-


Note: A red arrow points from the SME value of 34 in 2011 to 130 in 2012, with the text "4 times" written below it.

Statistical Survey - 3

Breakdown in Number of Applications Requesting GP
between Apr – Jun of 2011 and 2012
[Type of Disclosure & Type of Applicant]

	University / Public Research Institute		Joint Applicants (including University / Public Research Institute)		SME		Large Company	
	2011	2012	2011	2012	2011	2012	2011	2012
Printed Publication	10	14	7	11	8	19	30	29
Internet	6	14	5	14	1	18	14	48
TV/Radio	-	2	-	0	-	1	-	0
Academic Meeting (including disclosure though collection of papers for such meeting)	69	67	73	69	15	15	41	51
Other Meeting	-	0	-	0	-	5	-	7
Exhibition/Fair	2	7	2	5	6	34	2	22
Test	0	0	1	0	2	3	1	0
Sale	-	0	-	0	-	21	-	8
Other Working of Invention	-	0	-	1	-	8	-	2
No Data Entry	1	2	1	0	2	6	2	2
Total	88	106	89	100	34	130	90	169

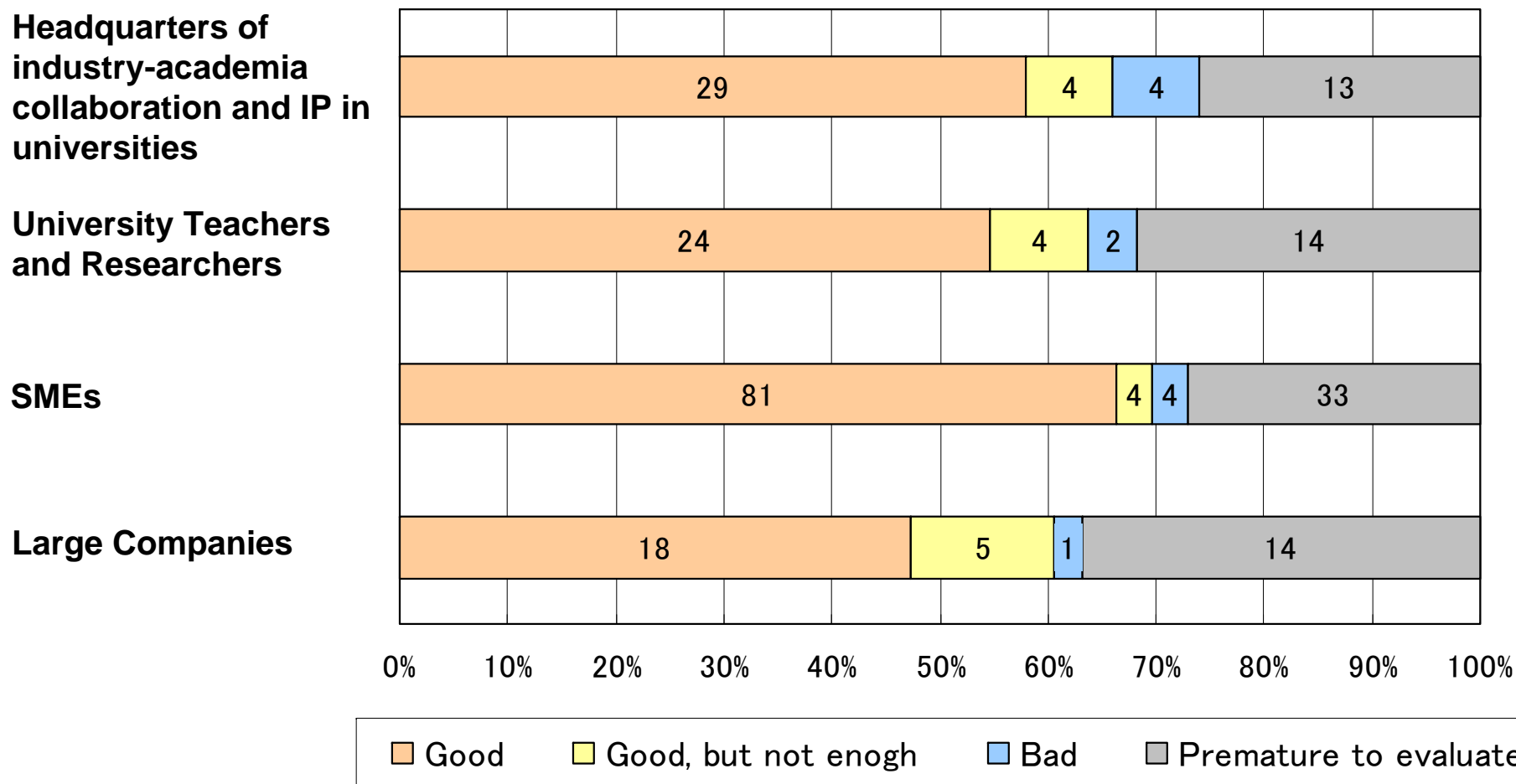
 Newly Added

 Expanded
(Abolition of Designation)

Questionnaire Survey - 1

Most respondents gave a favorable evaluation to expansion of scope of GP.

Evaluation of the 2011 revision of the Patent Law



Typical tendency in invoking Grace Periods

Universities : Frequently use

- Universities tend to make presentations before filing patent applications even though working hard to file patent applications before making presentations at academic conferences as far as possible

SMEs

- Only enterprises with sufficient fund and high awareness on the importance of patent rights might obtain patents rights before selling their inventions.
- Quite a lot of SMEs come to seek patents only after sales of their invented products have increased.

Large companies : Seldom use

- Large companies could not help but use GP as a relief measure when inventions were disclosed before filing due to miscommunications with patent firms and errors of deadline management .

Grace Period system saved different types of applicants.

Universities :

- “As to an invention related to method of dyeing at normal temperature for timbers, a notification for that has been made before the disclosure, but filing a patent application for that was not in time. Accordingly, we used the grace period system and obtained patent rights for that. Thanks to this patent, we successfully made a license agreement with business enterprises and gained the license income. “
- “We received a report from an inventor after a presentation of the invention had been made at academic conferences, and filed a patent application for that in Japan requesting the application of GP. Some enterprises showed interest in the presentation material and offered a request for a license agreement in Japan. We hastily made preparations to file patent applications abroad, but gave up the patent applications to some countries due to lack of GP.”

Grace Period system saved different types of applicants.

SMEs

- “One small company had sold its product without an intention of filing patent applications, but received high reputation for the product, and then, it reconsidered patent applications for it by using GP.”
- “One small company has conducted a joint-research with a public research and development institute, but the institute made presentations for the joint-research. Therefore, the company obtained patent rights for that by using GP. Currently, although it’s a very small scale, the company is manufacturing the products and selling them to trading companies.”

Large companies

- “After submitting an article on an invention on a catalyst for a fuel cell in an academic magazine, we found that patent application for the invention was not filed. We filed a patent application in a hurry and acquired a patent by using GP.”
- “Although we considered that there is no need to file an application at first, we filed the application in a hurry by using GP because there was a huge public reaction when presentation was made at an academic conference.”

Thank you!