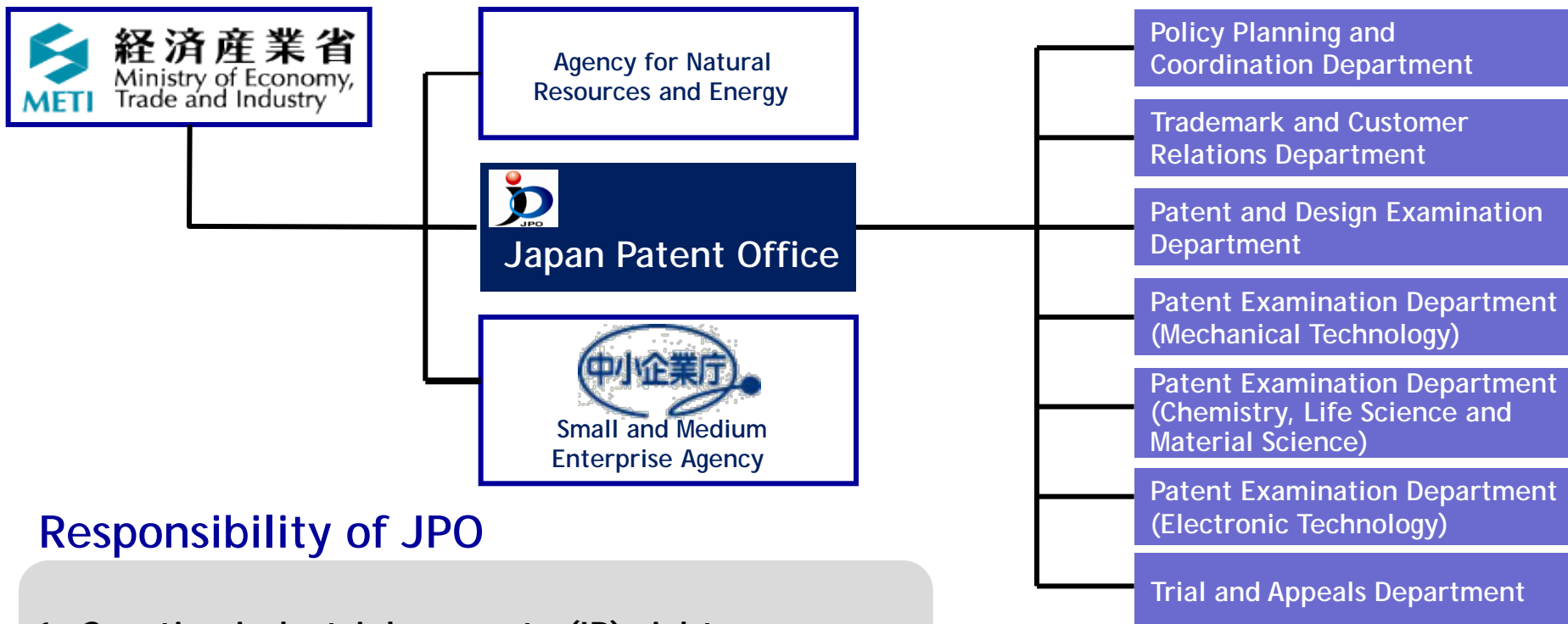


Outline of Patent Attorney Act and Its History of Revisions for Further Improving the Quality of Patent Attorneys in Japan

October 27, 2014
Shinichiro Hara
International Cooperation Division
Japan Patent Office

1. Overview of Japan Patent Office
2. Japanese Patent Attorney System
3. Recent Amendments to Further Improve the Quality of Patent Attorney Services

1. Overview of Japan Patent Office



Responsibility of JPO

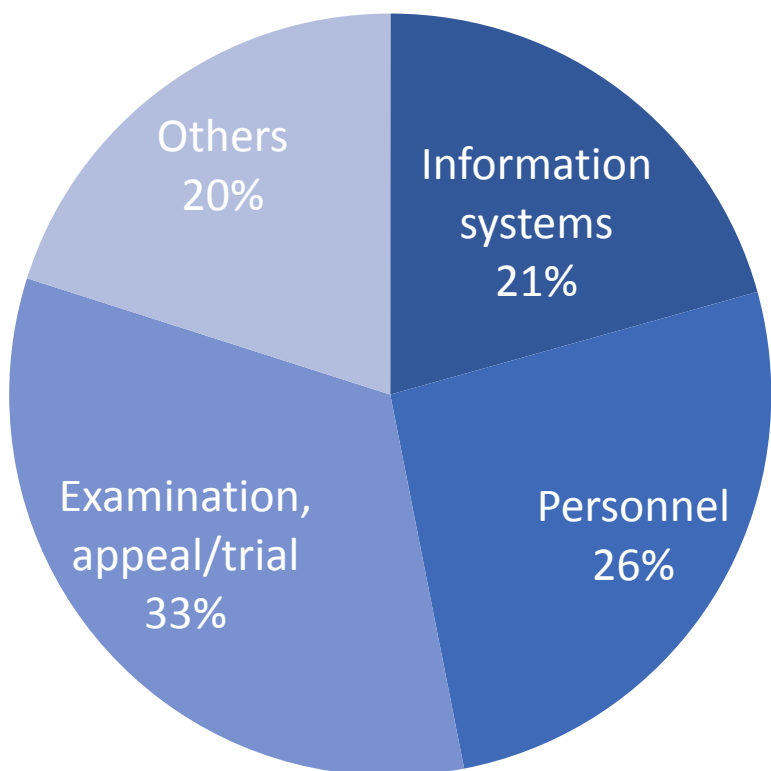
1. Granting industrial property (IP) rights
2. Drafting laws & regulations on IP
3. Promoting international harmonization and assistance to developing countries
4. Reviewing the IP rights system
5. Supporting SMEs and universities
6. Improving information services on IP



Budget

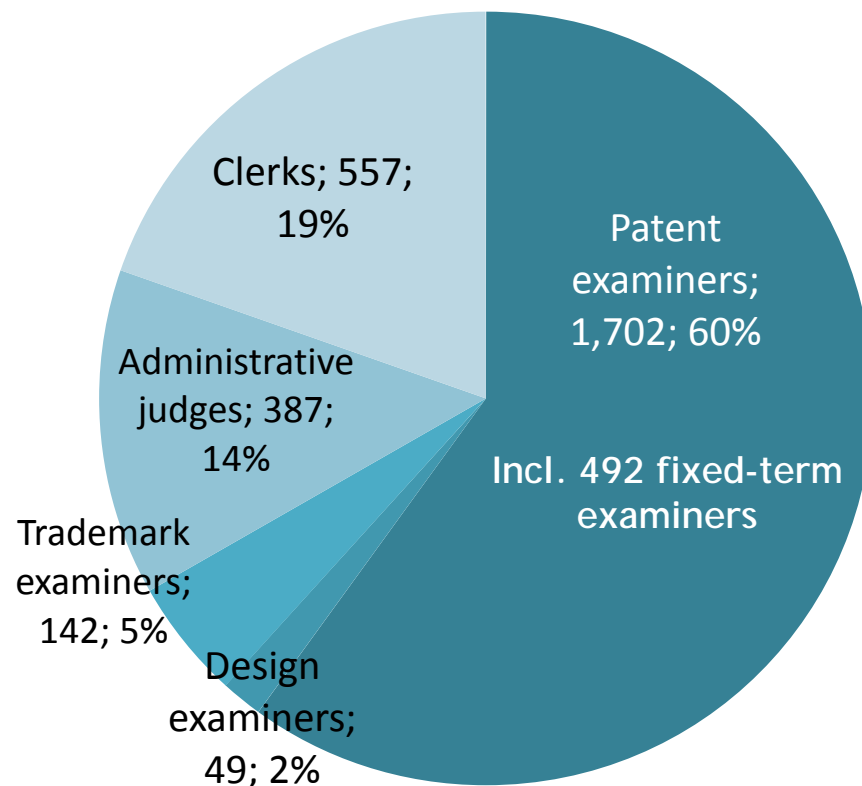
FY 2014 expenditure budget
126 billion yen (US\$ 1.26 billion)

*1 dollar ≒ 100 yen



Personnel

Total: 2,837 employees (FY2014)



2. Japanese Patent Attorney System

- In Japan, legal service is one of the strictly regulated areas of business
- Lawyers, as well as patent attorneys, can work as agents for conducting procedures before the JPO

Lawyers = Legal Service*

E.g.: Litigation in general , consultation on domestic/foreign laws

Tax Accountants
Conducting taxation
procedures

...
...

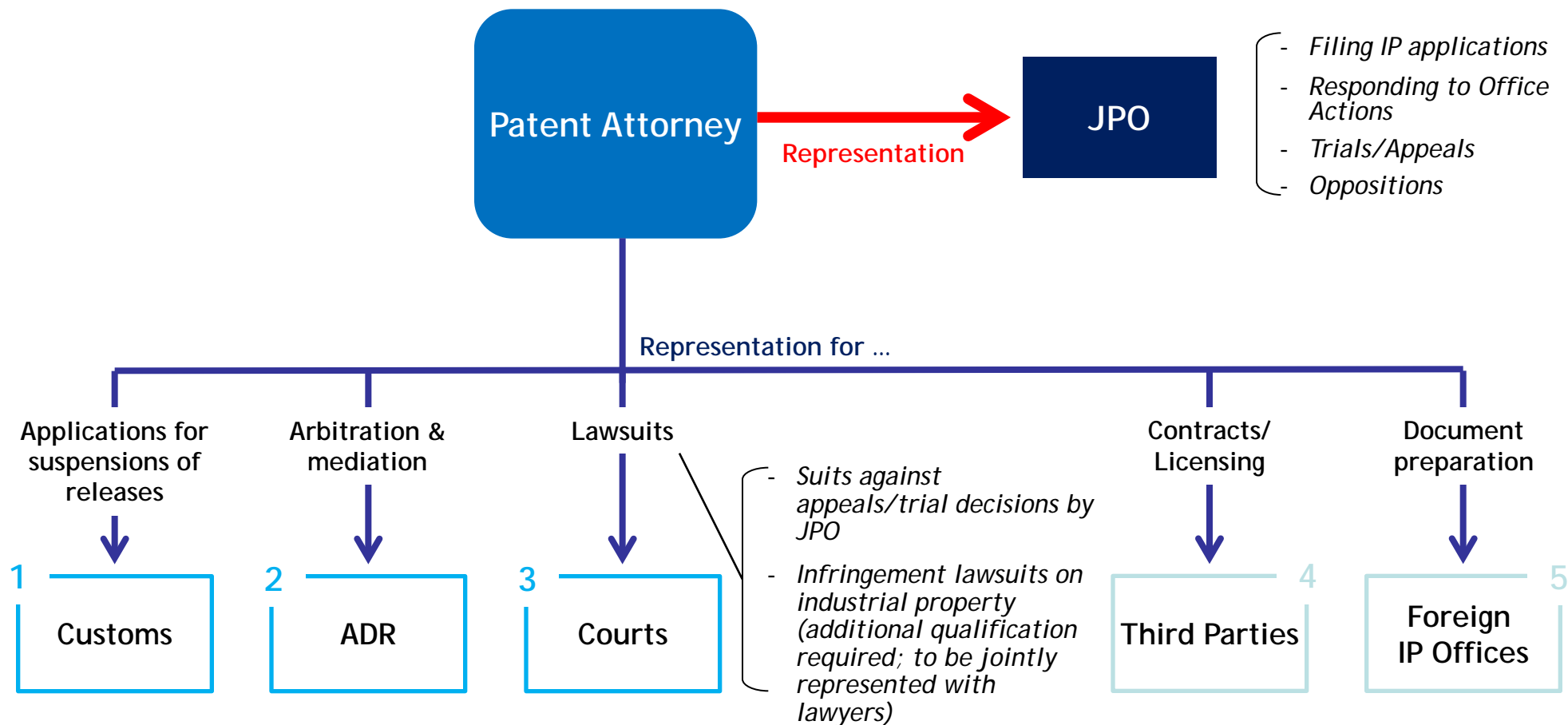
Judicial Scriveners
Registering
companies, land,
etc.

...
...

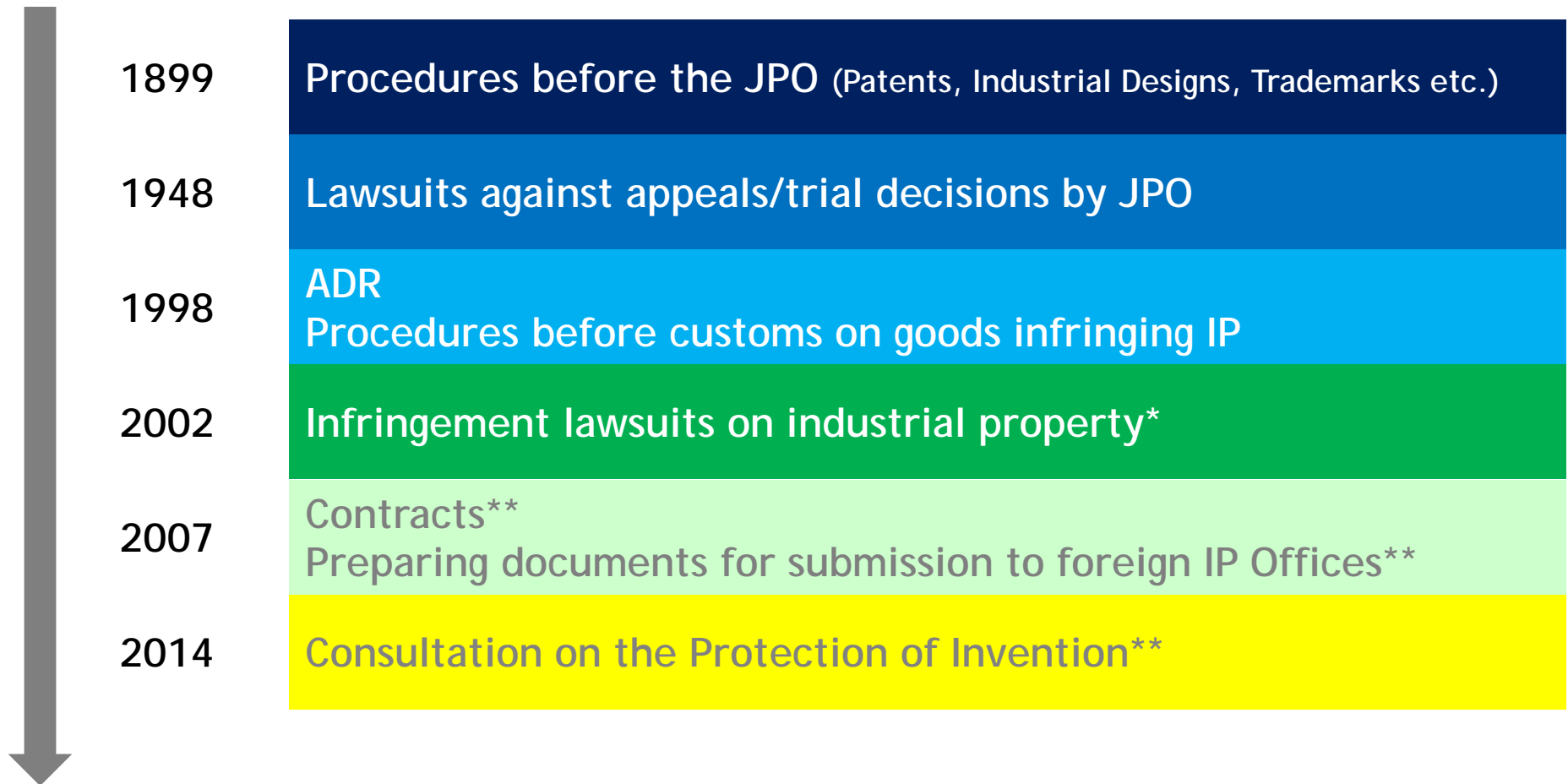
Patent Attorneys
Conducting
procedures before
the JPO

*Note: No person other than an attorney may, for the purpose of obtaining compensation, engage in the business of providing legal advice or representation, ..., or providing other legal services in connection with any lawsuits, non-contentious cases, or objections, ... etc., or other general legal services, or acting as an intermediary in such matters; provided, however, that the foregoing shall not apply if otherwise specified in this Act or other laws. (Attorney Act, § 72)

- The primary business of the patent attorney as a representative is to conduct procedures before the Japanese Patent Office, for patents, utility models, designs & trademarks



- Patent attorneys' scope of business has gradually been expanded



Note: * Additional qualification necessary; to be represented jointly with lawyer (attorney at law).
** Anybody can conduct these services; patent attorneys can do so under their professional responsibilities.

- Japanese patent attorneys can be certified in several ways

1. Any of the following enables persons to be certified as patent attorneys:

(1) Pass the National Examination for Patent Attorney

(2) Certified as Lawyer (Attorney at Law)

(3) 7 years experience as examiner/appeal examiner at JPO

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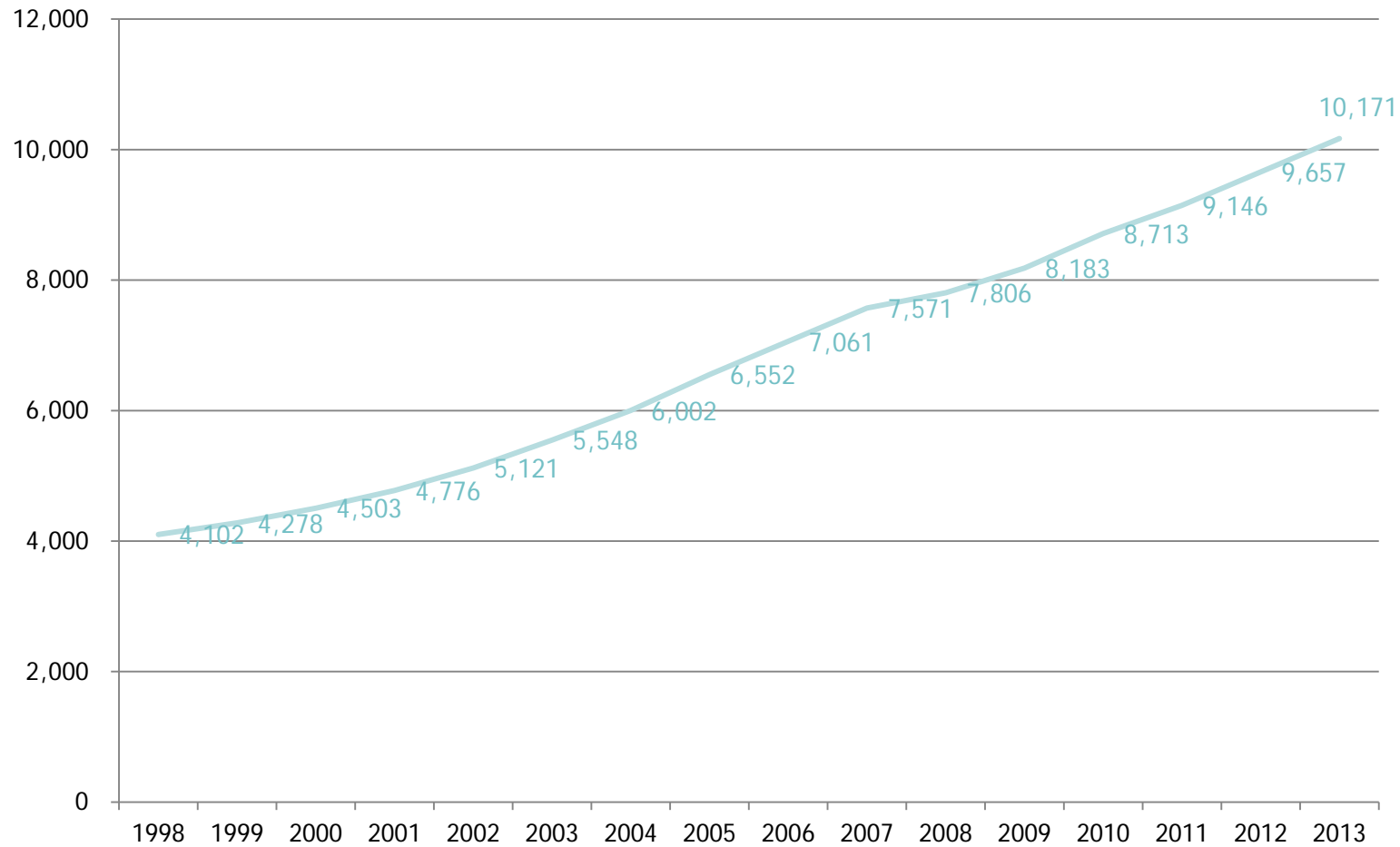
2. Practical Training (conducted by JPAA) - added under the 2007 amendment

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3. Registration on Japan Patent Attorneys Association (JPAA)'s Register

2. Japanese Patent Attorney System - Number of Patent Attorneys

- The number of patent attorneys has been steadily increasing



2. Japanese Patent Attorney System - International Comparison (as of 2012)

	US	UK	Germany	France	EPO	China	ROK	Japan
Number of Patent Attorneys/Agents ⁽¹⁾	42,033 ⁽²⁾	1,956	3,200	909	10,427	14,679	7,369	9,657
Number of Patents Filed	542,815	23,235	61,340	16,632	148,560	652,777	188,915	342,796
Approx. No. of patent applications per attorney/agent	12.9	11.9	19.2	18.3	14.2	44.5	25.6	35.5

(1) As of March 2012 for EPO; April 2012 for US; October 2012 for China & France; November 2012 for UK; End 2011 for Republic of Korea

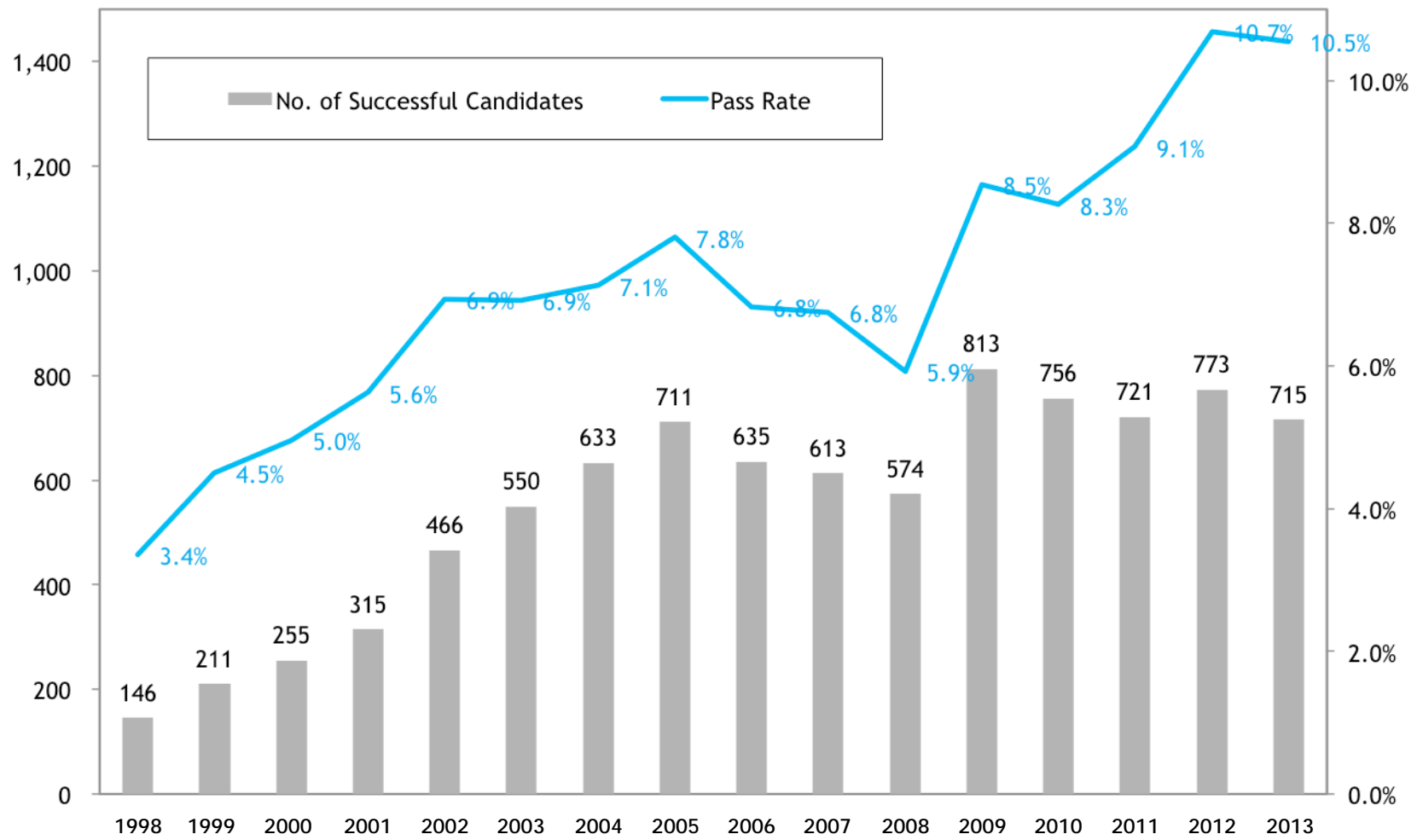
(2) includes patent attorneys & patent agents

Source: Institute of Intellectual Property, Tokyo

2. Japanese Patent Attorney System - Patent Attorney Examination

- Administered by the Council on Industrial Property (Secretariat: Japan Patent Office)
- Since around the end of 1990s, the number of successful candidates has generally been increasing

Patent Attorney Examination Number of Successful Candidates & Pass Rate



- The National Patent Attorney Examination is conducted to determine whether or not persons have the knowledge and ability needed to become patent attorneys”
- The Exam consists of the following 3 parts:

1. Multiple Choice

(1) to check if applicants have the *basic knowledge* required to perform a patent attorney’s business, and (2) to *narrow down the number of applicants eligible to take* the essay & interview examination



2. Essay

to check the applicants’ *comprehensive abilities* in terms of legal interpretation, comprehension, judgment, logical thinking, written communication, etc.



3. Interview

to check the applicants’ abilities in terms of *oral communication*, based on their ability tested in the Essay part

- Examination includes both legal and technological subjects
- Knowledge on *industrial property* laws is mandatory in all parts of the exam, but technological subjects are elective

1. Multiple Choice

Industrial Property* Laws

Treaties on
Industrial Property

Copyright & Unfair
Competition Laws



2. Essay

Industrial Property Laws

Legal or Technological Subjects
(*elective*)



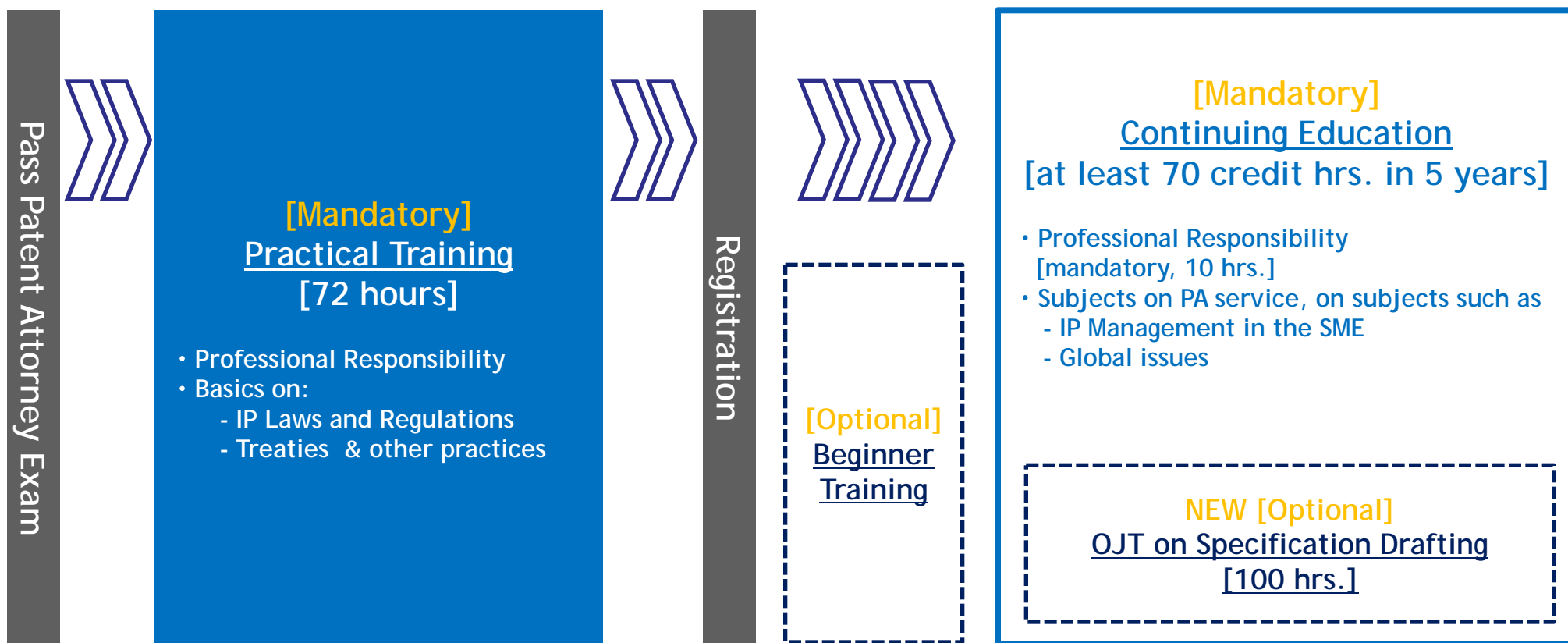
3. Interview

Industrial Property Laws

2. Japanese Patent Attorney System

- Training and Continuing Education

- The successful completion of “Practical Training” is a precondition to being registered as a patent attorney
- Patent attorneys not fulfilling the duty to enroll in continuing education are subject to disciplinary action by JPAA and Minister of Economy, Trade and Industry



3. Recent Amendments to Further Improve the Quality of Patent Attorney Services

- As a part of the Judicial System Reform, the scope of a patent attorney's services was expanded based on the 2002 amendment to include the representation of clients in infringement lawsuits involving industrial property. Also, quality assurance measures were added.

E.g.: 3-Year Deregulation Program (Cabinet Decision, March 2001)

"In order to appropriately meet the growing demand for legal service, necessary measures are to be taken, including, opening the door for non-lawyer professionals to represent clients in limited areas/lawsuits"



Expanded Scope of Business:
Representation* in
infringement lawsuits involving
industrial property



Quality Assurance Measures
-Training on civil procedure
practices (45 hrs.)
-Final evaluation exam

3. Recent Amendment to Further Improve the Quality of Patent Attorney Service 2007 Amendment

- In response to the growing need to strengthen the professional ability and responsibility of qualified professionals, new measures on quality assurance were implemented based on the 2007 amendment

A scandal involving some architects forging documents on earthquake resistance standards (November 2005 -)

Report on the Direction of Revision of Patent Attorney System
(Industrial Structure Council, January 2007)

“Taking into consideration the diversified needs for patent attorney services, as well as greater responsibilities of qualified professionals, training that ensures the ability of patent attorneys should be made obligatory”



Quality Assurance Measures
-Practical Training

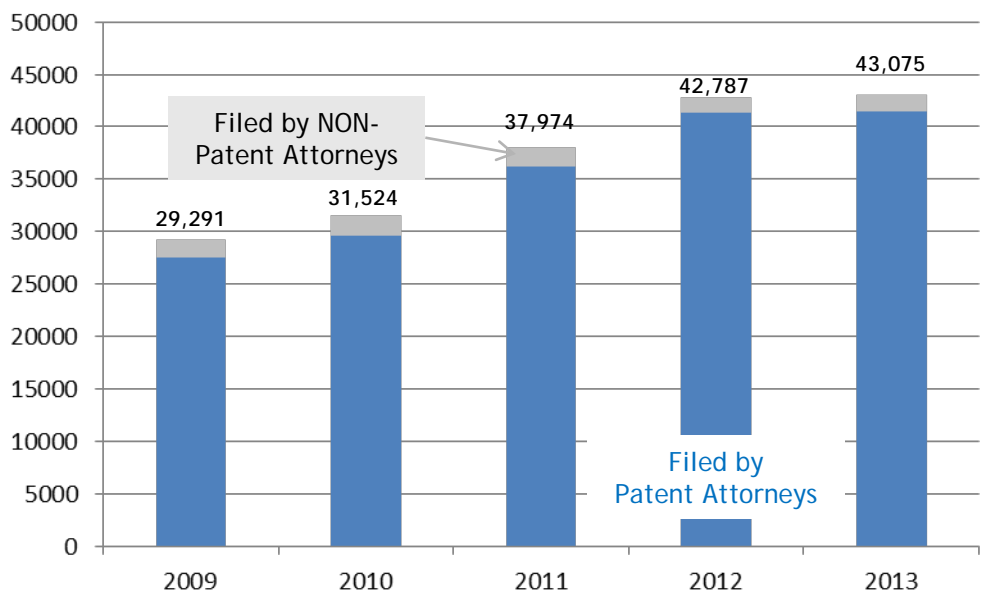
Precondition for Registering

Quality Assurance Measures
-Continuing Education (Training)

Non-Compliance Subject to Disciplinary Action

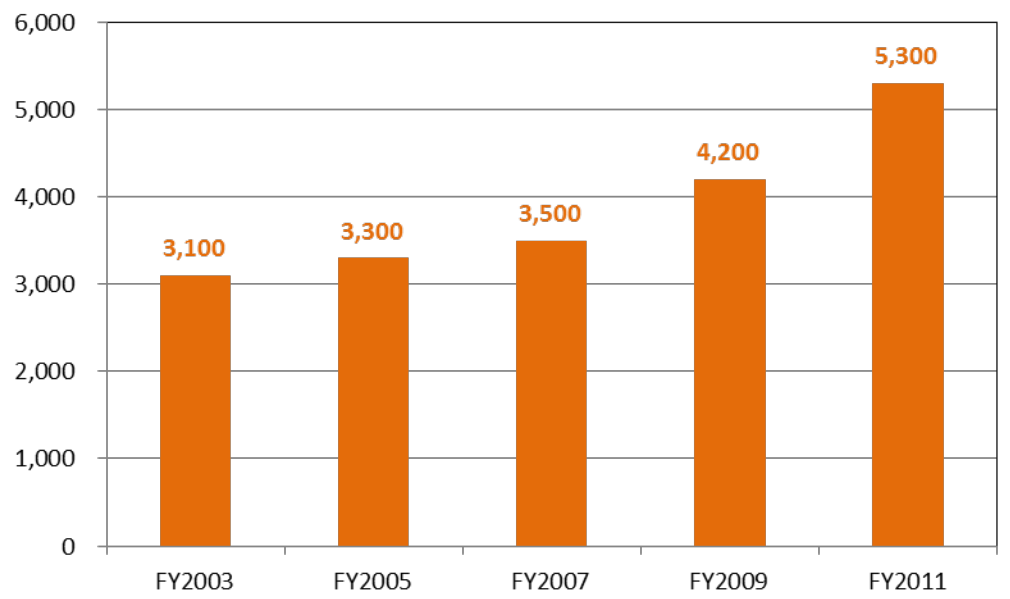
3. Recent Amendment to Further Improve the Quality of Patent Attorney Services 2014 Amendment - Background

PCT Applications from Japan



Source: JPO

Number of SME Consultations



Source: Tokyo Metropolitan SME Support Center

3. Recent Amendment to Improve the Quality of Patent Attorney Service 2014 Amendment - main revisions

The main points of the 2014 review are to leverage and enhance the capacity of PAs in assisting:

1. Japanese companies' IP activities worldwide
2. SMEs in managing their IP

Main Revisions

- Consultation services on how to protect inventions
- Send PAs overseas (JETRO Office) to assist Japanese business*

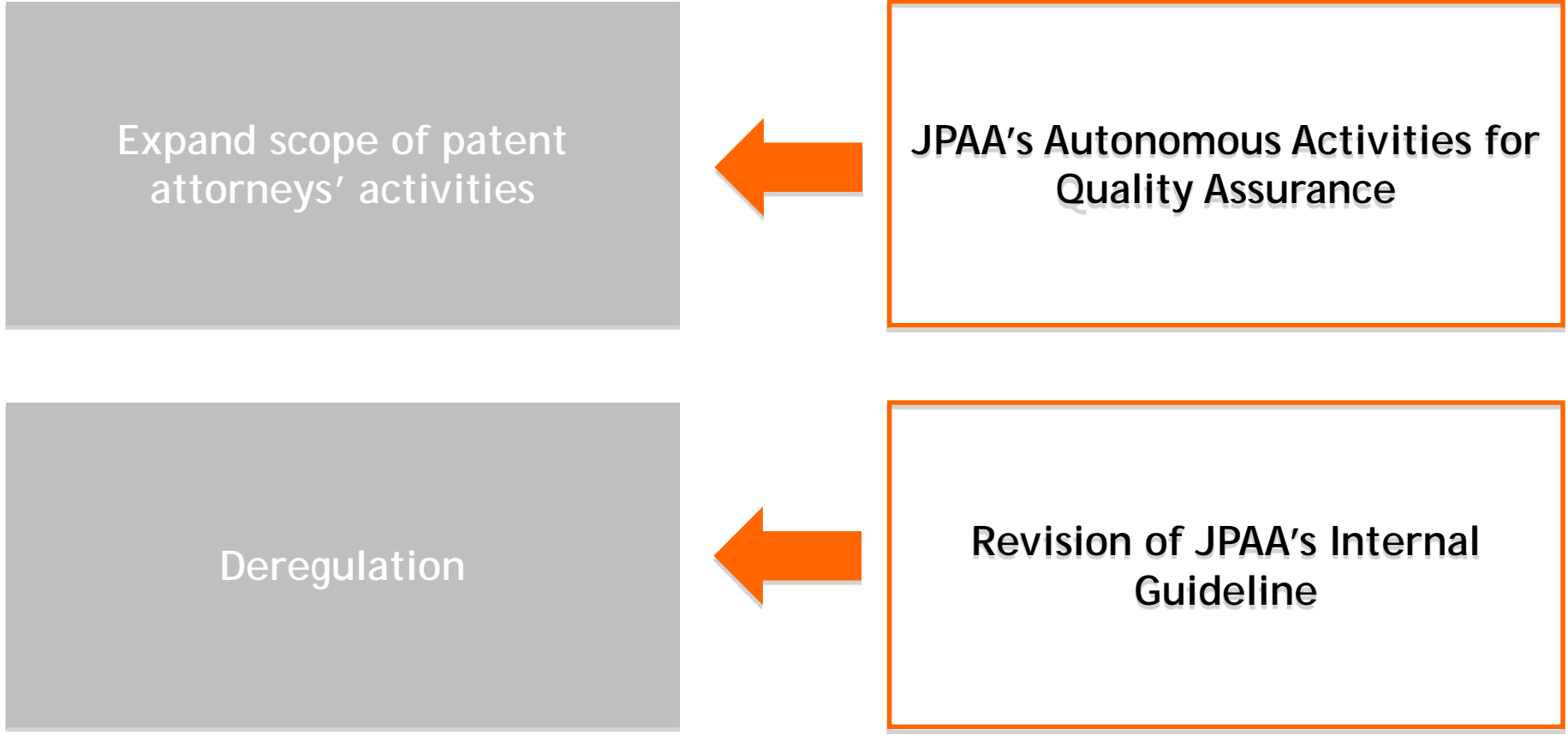
- Relaxed rule on conflict of interest

Main Revisions

- Continuing education
- Enhanced IP management in SMEs
- JPAA's Guideline on client-attorney privilege (ongoing)

- Revision of JPAA's Guideline on blocking the flow of information in offices





The activities & responsibilities of patent attorneys, the principal experts in assisting industries and businesses in the IP field, have been steadily expanding over the years

In the meantime, the level of their professional ability has been raised based on the *Patent Attorney Examination* and the *JPAA's activities*, such as *training*, in order to guarantee quality assurance

Thank you

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