

# **From Invention To Patent**

**Protecting New and Innovative Ideas  
for Launching New Products  
and  
Exploiting Patent Information for Business Development  
( WIPO Sub-Regional Workshop )**

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APIC, JIII**

## **1. History of IP in JAPAN**

**Before and After  
establishing of patent system**

## 1. Before Establishing of Patent System

Before 1885



**Mr. Tokimune Gaun**



**“gara” weaving loom**

Mr. Gaun invented a uniquely Japanese-style weaving machine. But another manufacturers copied the machine and enjoyed the profit. Due to absence of patent system, Mr. Gaun was struck by poverty.

## 2. Start Up of Japanese IP System

**1873 : Gara weaving loom developed  
(Mr. Tokimune Gaun)**

**1885 : Patent Monopoly Act enacted**

**1890 : A wooden manual weaving loom granted  
patent protection (Mr. Sakichi Toyoda)**

**1904 : Industrial Property Right Association  
( now JIII) founded**

**1905 : Utility Model Law enacted**

### 3. The Most Famous Inventors in JAPAN



**Mr. Sakichi Toyoda**

(1867-1930)



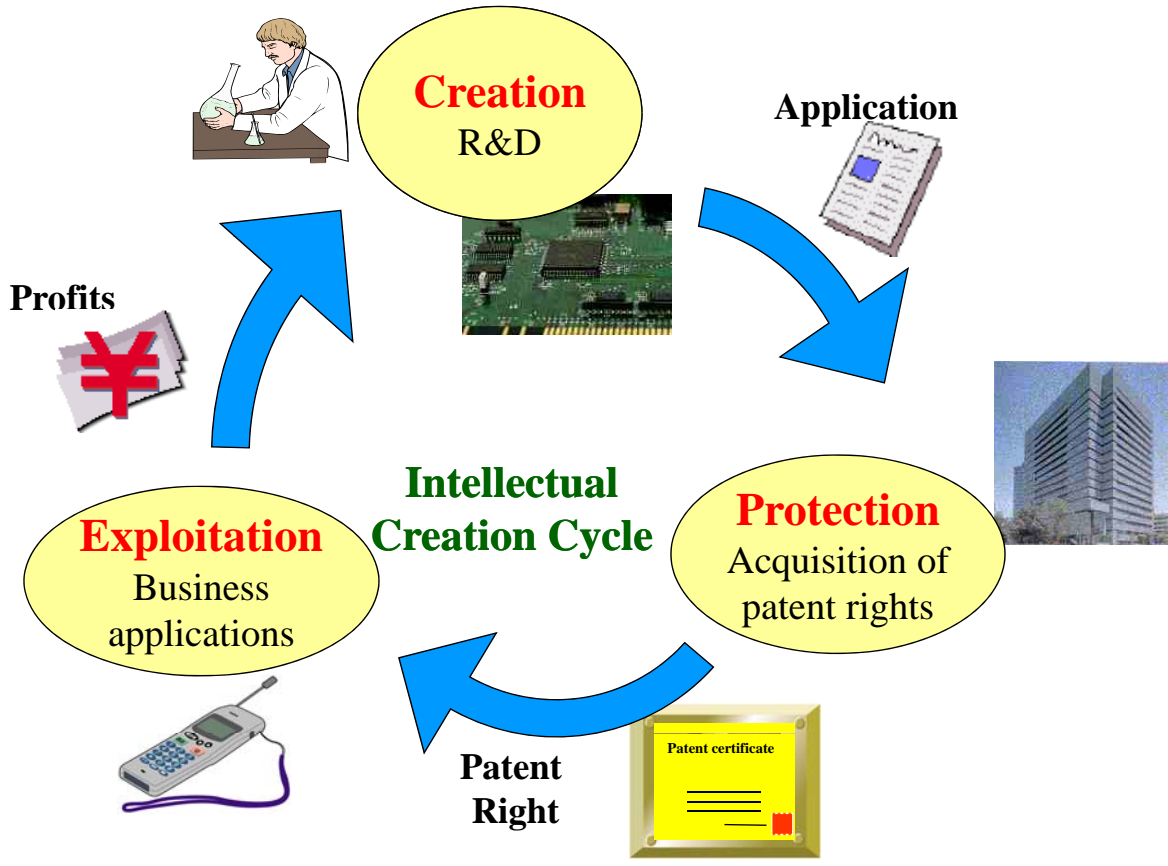
**Mr. Masaru Ibuka**

(1908-1997)

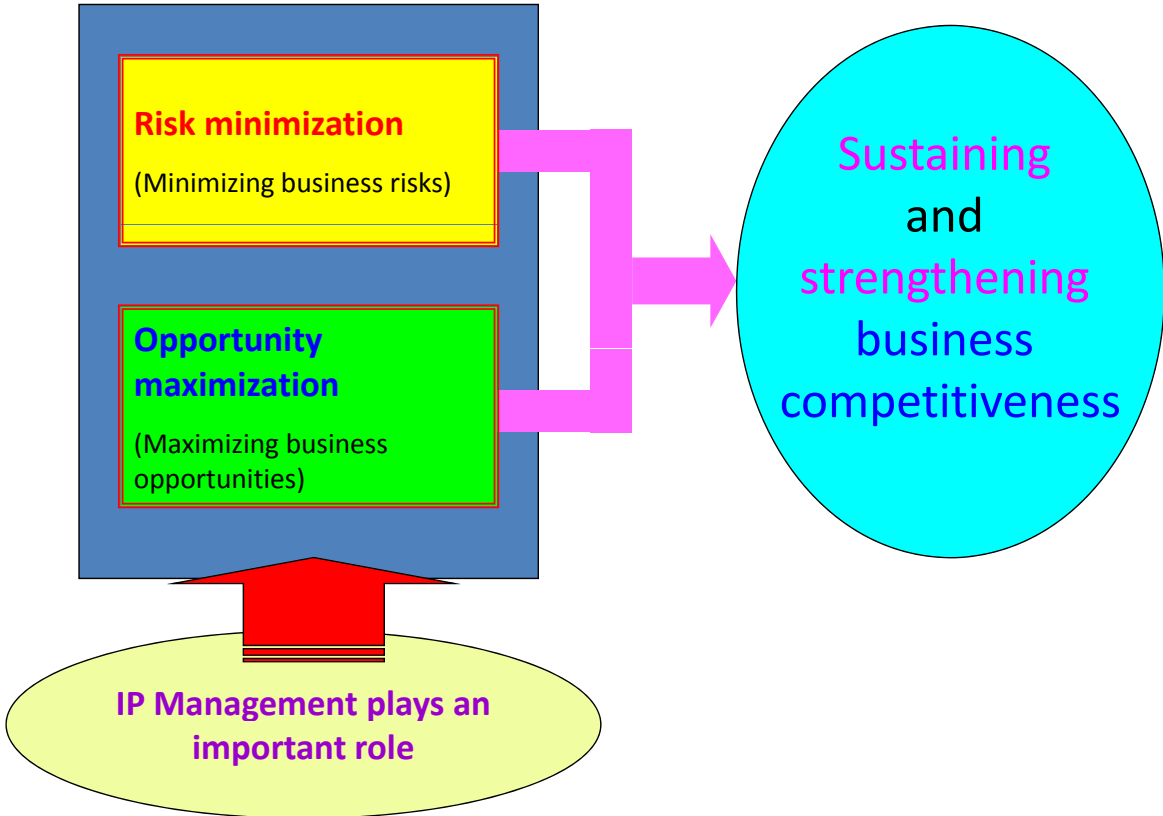
## 2. IP Management

Arrival of Global Competition Age

# 4. Intellectual Creation Cycle



# 5. Intellectual Property (IP) Management is now the Cornerstone for Business Management.



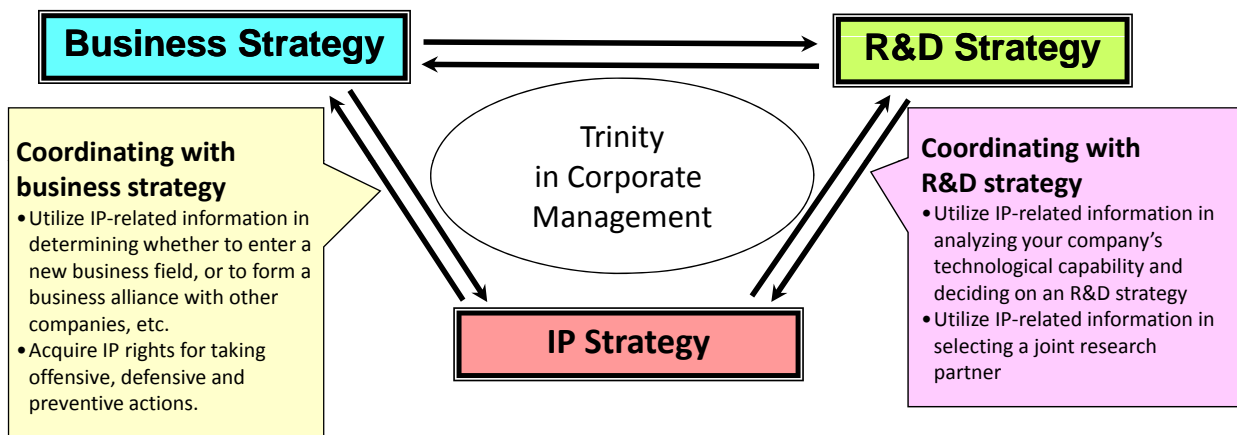
## **6. Possible Business Risks Caused by Improper IP Management**

1. Risk of disputes over IP
2. Risk of counterfeit goods
3. Risk of overlapping R&D
4. Risk of standardization
5. Risk of know-how leak

## **7. Expanding Business Opportunities Through Proper IP Management**

1. Build a barrier to hamper others from entering your business field
2. Contribute to R&D strategy
3. Effects are expected through the use of other companies' technology
4. Generate income by licensing/assigning your rights
5. Gain advantage in relation to standardization through the use of IP
6. Enhance corporate value

## 8. Integrated IP Strategy (Trinity Strategy)



### Establishing IP strategy in line with business strategy and R&D strategy

- Determine whether to apply for a patent right or to keep as a trade secret
- Shift from quantity-oriented to quality-oriented management by selecting patents to be obtained and focusing on them
- Conduct prior art search at the same time as conducting R&D activities, patent application, and request for examination
- Survey moves by other companies by creating a patent map
- Use rights effectively (exclusive right ownership, licensing, countermeasures for counterfeit goods, etc.)

## 3. Strategic Patenting

### IP Protection

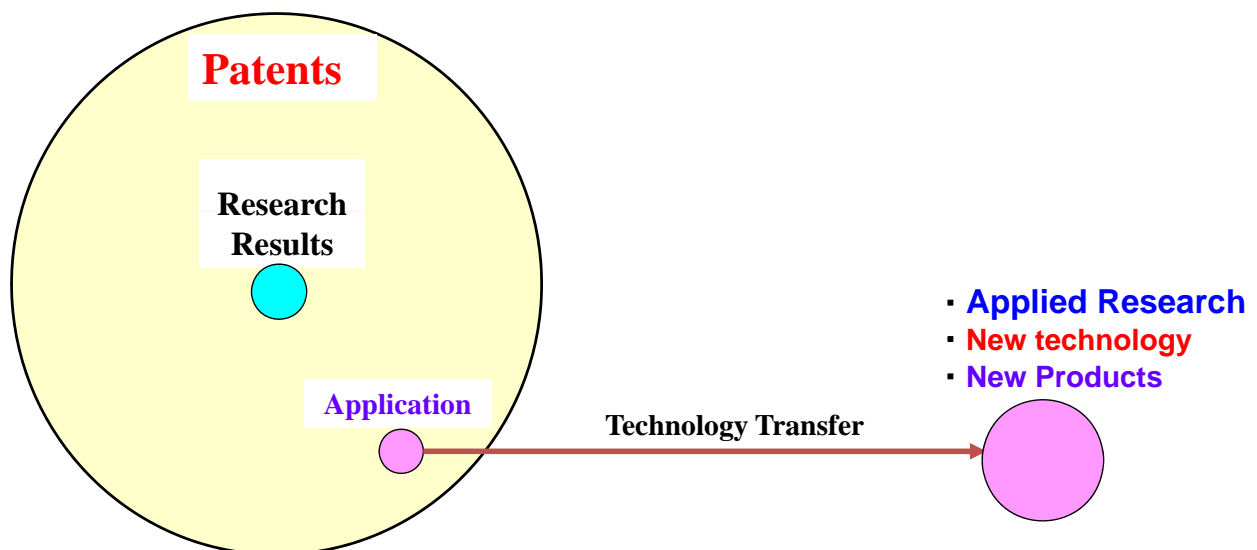
## 9. Three Challenges in Promoting Innovation (Three Steps)

**Step 1. IP Creation**  
(Encouraging co-creation)

**Step 2. IP Protection**  
(Strategic patenting)

**Step 3. IP Practical Use**  
(Application for business/  
technological transfer)

## 10. Relations between Technology and Patent



## 11. Strategic Patenting of R&D results

- When producing a new research result (IP), have a **business model** in mind.
- Make an appropriate decision as to whether to seek a patent right or to keep the know-how as a trade secret. (proper **ex-ante evaluation** is required)
- **Create a patent portfolio:**
  - Patents covering a wide range of areas
  - If necessary, take further action (e.g., improved patents, application patents, international patents)

## 12. Which invention should be patented? (Ex-Ante Evaluation)

### 1. Technical evaluation

- Degree of completeness
- Market trend
- Originality

### 2. Economic evaluation

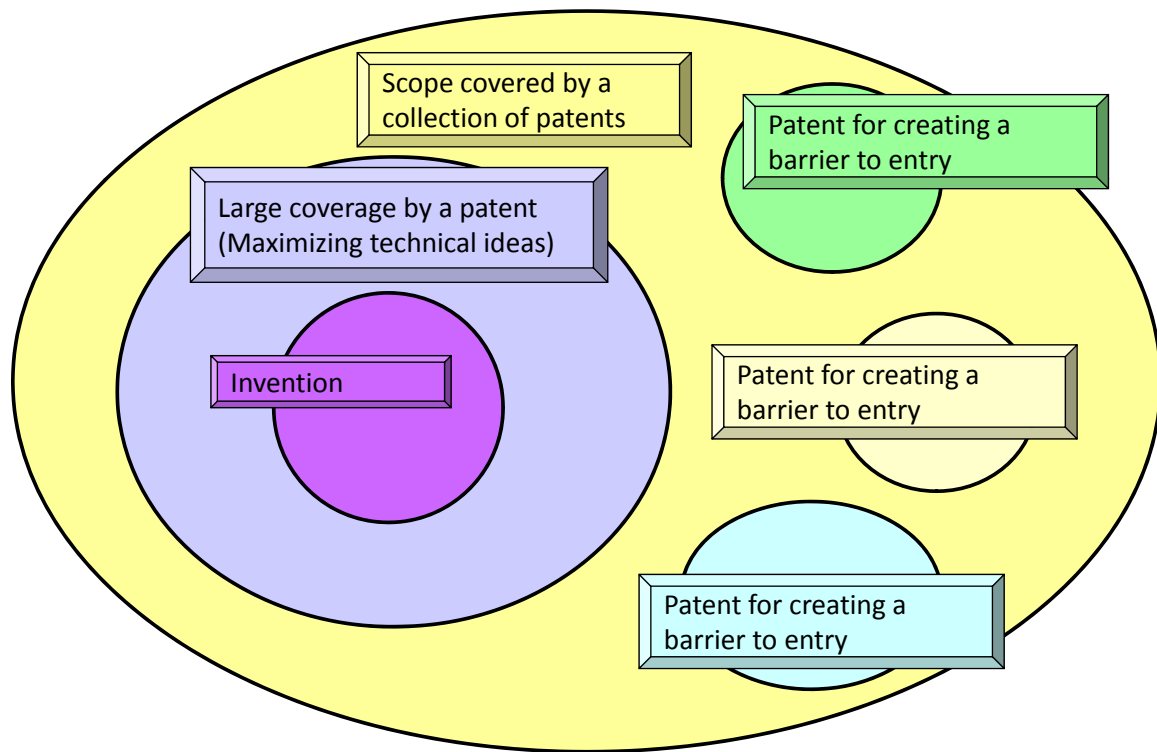
- Economic effects
- Life cycle

### 3. Evaluation of rights-related matters

- **Patentability**
- Degree of difficulty in avoiding



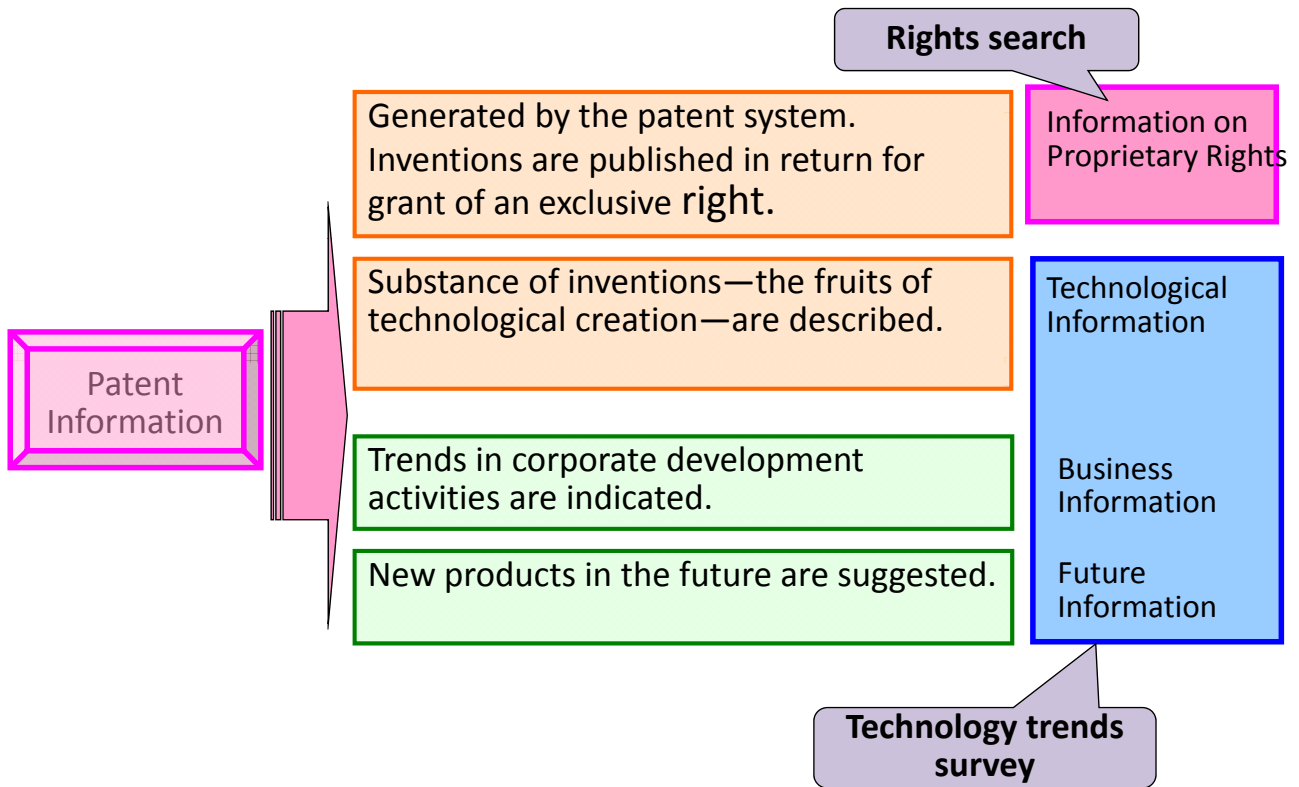
### 13. Patent Portfolio (Management of a collection of patents)



## 4. Exploitation of Patent Information

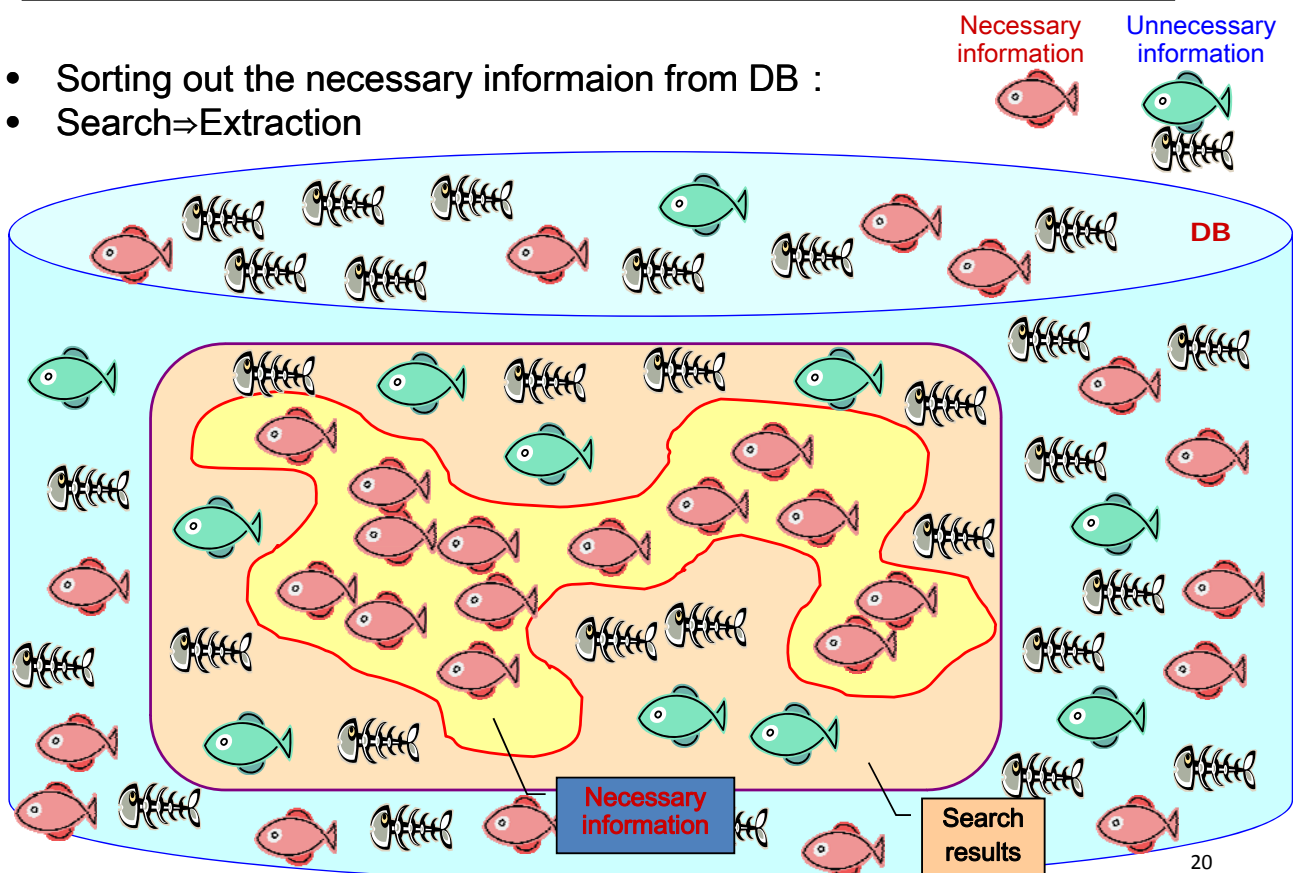
Prior Art Search and Patent map

# 14. Two aspects of patent information



# 15. What is information search?

- Sorting out the necessary information from DB :
- Search⇒Extraction

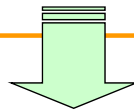


## 16. Japanese Patent Information Service

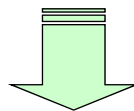
Top page of IPDL <http://www.ipdl.inpit.go.jp/>

## 17. Prior Art Search

Analysis of other companies' patents (prior art search) is indispensable in deciding which investments in technology the company should make.



Failing to analyze other companies' patents...



The worst scenario is --- that after your company made a large investment in development, it was discovered that the identical technology had already been developed by a rival company and patented.



Prior-art search, although requiring a significant amount of time and expense, is definitely worthwhile.

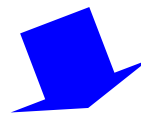
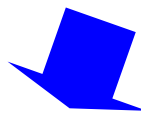
## 18. Prior Art Search



- \* R&D must contain novel elements.
- \* Analysis of other companies' patents is essential in making a decision regarding which investments in technology the company should make.



Prior art search



(It is worthwhile although costing time and money)

Offensive strategy

Defensive strategy

## 19. Use of a Prior Art Search --- Defensive Strategy

- (1) Improving prediction of risks related to company's investments in technology**
  - Investigate rival companies' R&D activities, business, and IP strategy
  - Conduct a preliminary review of business strategy and conduct strategic negotiations related to licensing
  - By doing so, the risk of infringing other companies' patents is reduced.
- (2) Enhancing protection against an action to invalidate a patent right**
  - Prepare effective patent documents based on a proper recognition of prior art
  - To respond to an offensive action to invalidate a patent right, make a legal and appropriate revision to the invention in question
  - Be prepared for a possible offensive action, enhancing the effects of protection as a patent holder
- (3) Improving efficiency and reducing costs**
  - R&D and inventions are properly evaluated in terms of their degree of advancement
  - R&D activities become more efficient by avoiding overlapping research
  - Costs for wasteful patent applications and requests for examinations are slashed

## 20. Use of a Prior Art Search --- Offensive Strategy

### (1) Improving appropriateness of R&D evaluation in terms of advancement and strategy

- Confirm the level of advancement
- Recognize your technology's strengths and how it differs from other companies' technology

### (2) Centralizing R&D and business strategies at the management level

- Compare advantages and disadvantages of each bundle of patents (collection of interrelated patents) that your company and other companies respectively hold
- Select strategies to concentrate on
- Strengthen strategy for business globalization

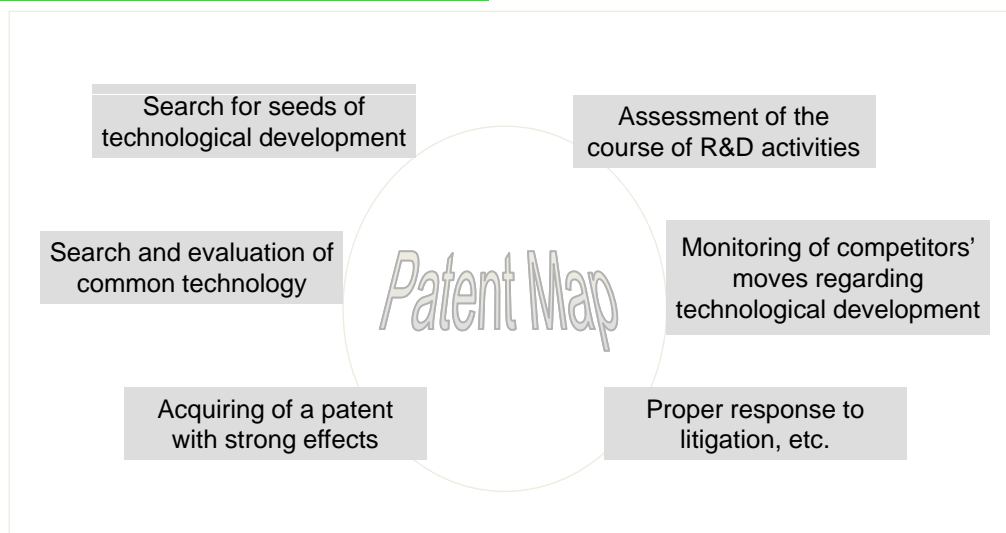
### (3) Beefing up patent strategy

- Make appropriate decision as to whether to apply for a patent right or to maintain the know-how as a trade secret
- Establish a proper strategy for overseas patent applications (Securing a first-mover advantage overseas)
- Prepare patent documents, which serve as a basis for a strong and stable patent right—thereby ensuring a clearer future regarding the acquisition of a patent and the scope that the right can cover
- Improve strategy for the use of rights (acquiring exclusive/monopolistic rights or licensing rights)

## 21. What is a Patent Map?

A patent map is a visualized presentation of patent information, analyzed according to the usage or aim in the form of charts, graphs, tables, etc.

### Objectives of a patent map

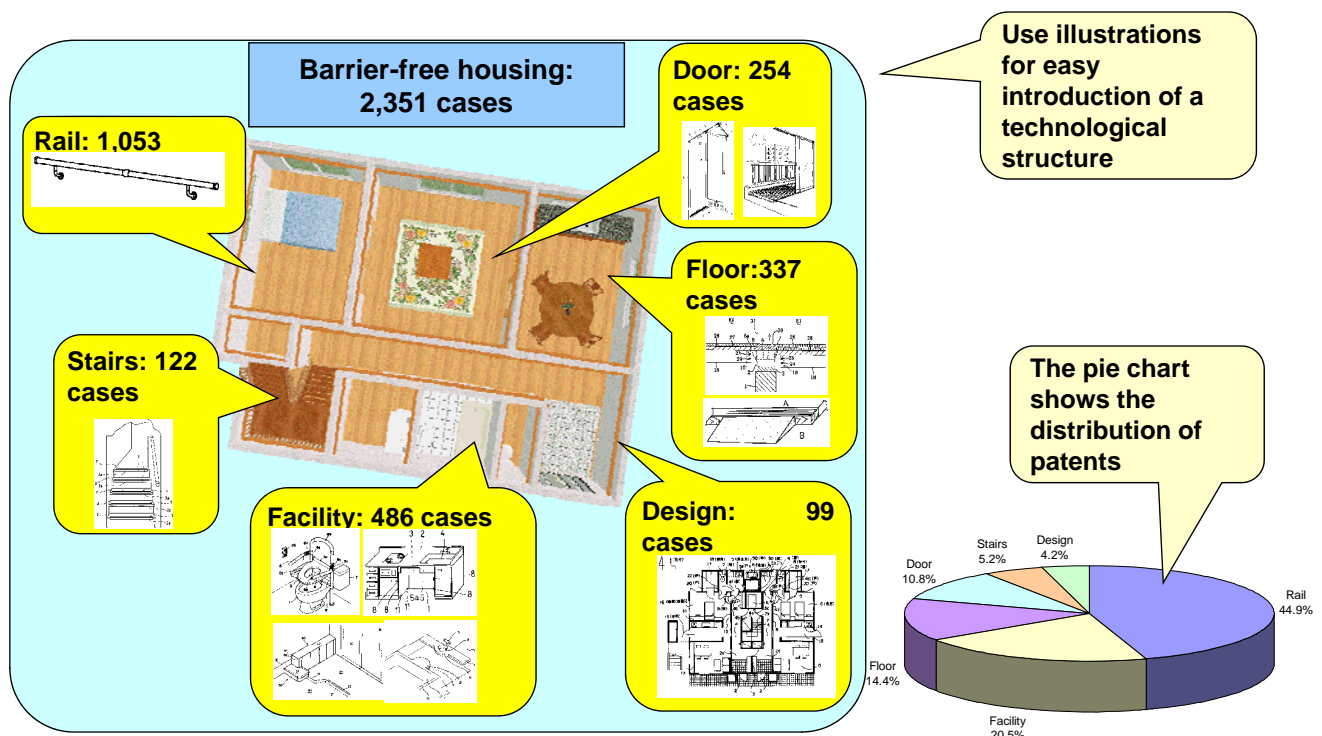


## 22. Use of a Patent Map

- Visualize respective technology-based positions and rights-based relationship of your company and others
- Regarding visualization, create a patent map by searching past patent papers
- Failure to create a proper patent map could lead to failure in establishing a bundle of patents.
  - **Prior art search is extremely important**
- Patents that cover wide areas (the scope of a right) are generally better regarded. However, it is important to examine the coverage of rights based on the data of patent maps.
  - **Blindly seeking patents in order to cover broad areas will result in acquiring many patents at risk of having grounds for invalidation**

## 23. Usage of a Patent Map (1)

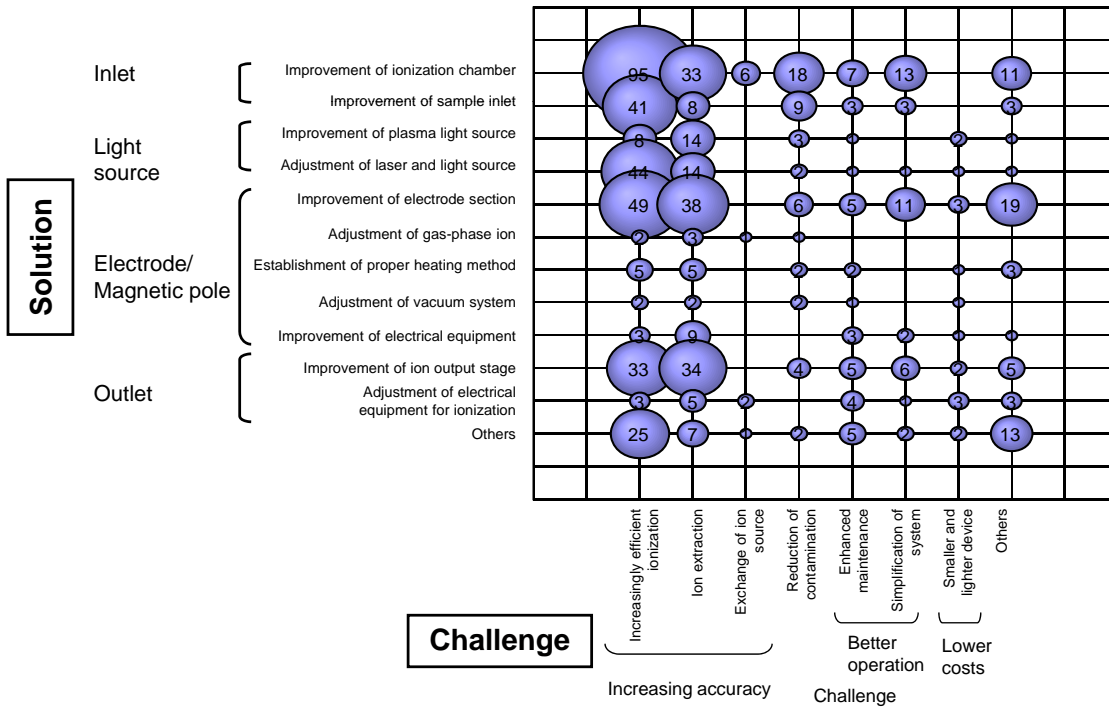
Overview the technologies in question



## 24. Usage of a Patent Map (2)

### Find a new solution

The distribution shows challenges in the ionizing process and solutions to them



# 4. Message to You

## To Become IP Expert

## 25. Message to youth who wants to become IP Expert

**(1) Live Positively and Affirmatively**

→ **Creativity**

**(2) Find your Value**

→ **Originality**

**(3) Draw your Dream**

→ **Vision**



**Thank you for your time.**