

Patent attorneys
Specialists on intellectual properties

Nagoya University

Academic Research & Industry-Academia-Government Collaboration

Intellectual Property & Technology Transfer Group

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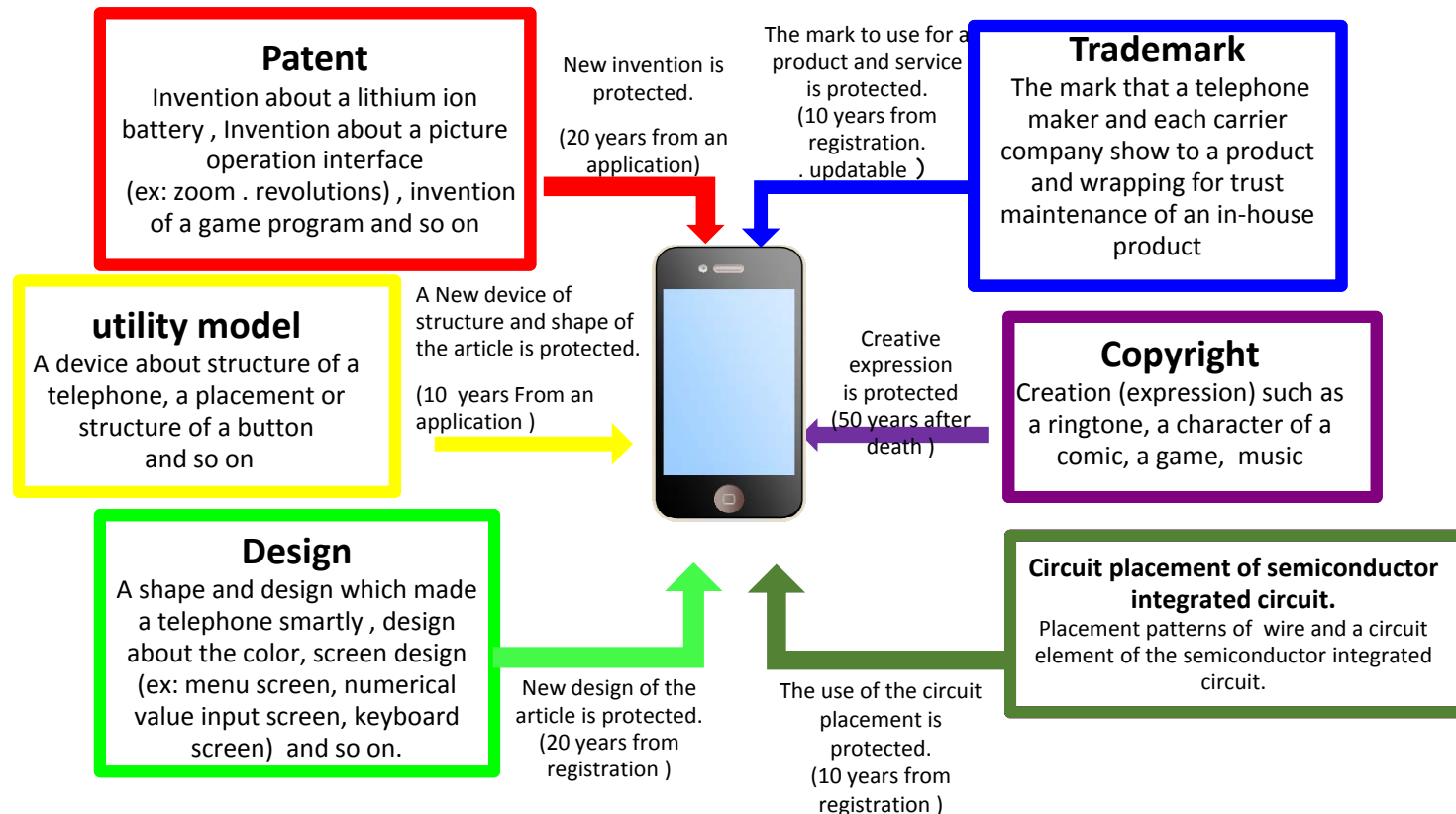
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What is a patent attorney?

State qualification career as a specialist
who treats the intellectual properties of
a patent, a utility model, a design and a trademark

The kind of intellectual property right in smart phones



Reference: "A curriculum for intellectual property rights system lectures for students of science and technology and its material for lectures " (the Patent Office)

The kind of intellectual property right in smart phones

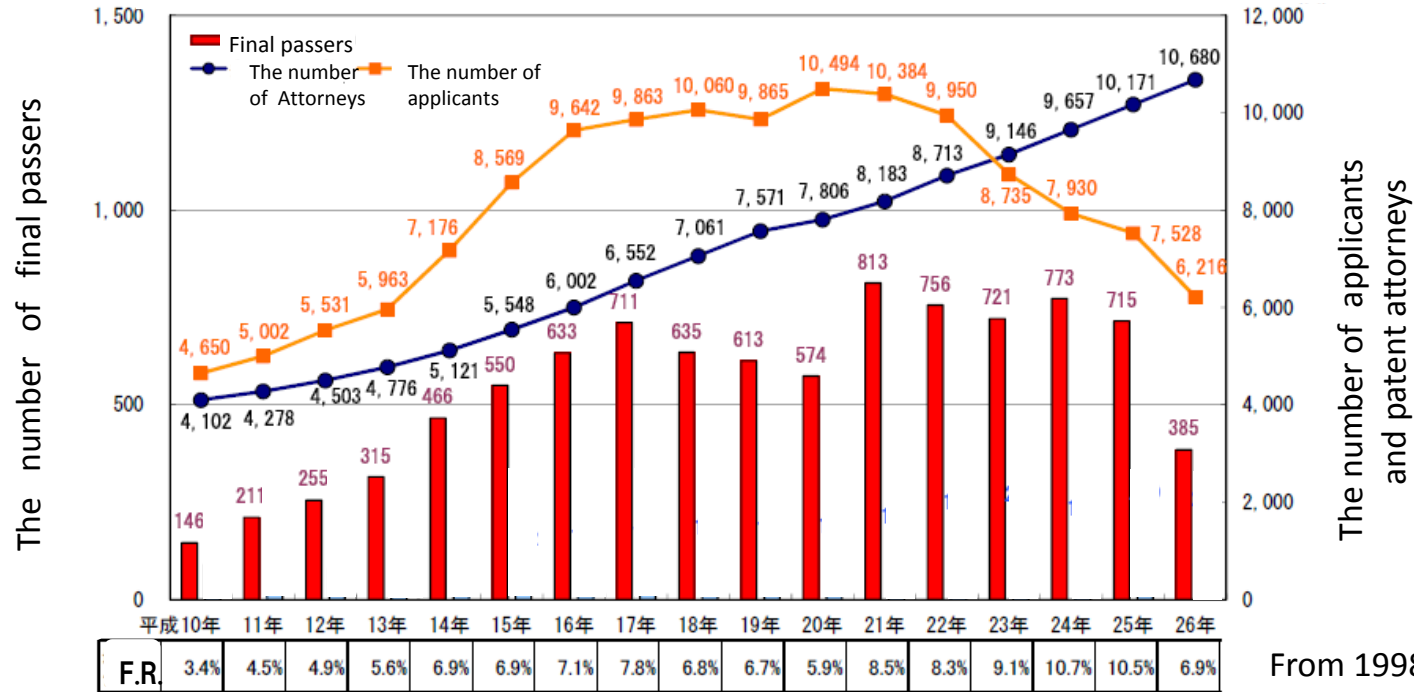
intellectual property right	detail
➤ patent	<p>It is given to a so-called invention. There are three types of invention, “thing”, “method”, and “the production method of things”. It is necessary to be ahead of a conventional technique and available in industry.</p> <p>When a patent right is set, the exclusive right is accepted about the invention. The unauthorized use of the invention by the third party is removed because it is a strong right.</p> <p>ex: the blue light emitting diode.</p>
➤ utility model	<p>In the utility model right, "a device" is targeted for protection. The invention step of the utility model is not as high as the invention. In addition, it relates to the shape, the structure and the combination of things, and "the method" cannot be applied unlike a patent right.</p> <p>ex: the form of the tissue case which is easy to pick up paper.</p>
➤ design	<p>The novel design of the article is targeted for protection. Industrial use and originality are required. In addition, a design and the color tied to a shape are targeted for protection.</p> <p>ex: the shape of the great PC in design.</p>
➤ trademark	<p>The name or the mark that are attached to distinguish one's product and service from others are targeted for protection.</p> <p>ex: Windows, Microsoft Office. and “Nagoya University” are registered as a trademark.</p>

Reference: Japanese Patent Agents' Association HP

The work of the patent attorney

- Agent business about the procedure to the Patent Office about the applications such as a patent, design and a trademark
 - Consultation about the application strategies on a patent, design and a trademark
 - Agent business of the contract negotiation and conclusion such as licenses
 - The lawsuit agent on litigation that is prescribed in the Patent Law
- etc.

Yearly change of the number of people, applicant, passer of the patent attorney



From 1998 to 2014

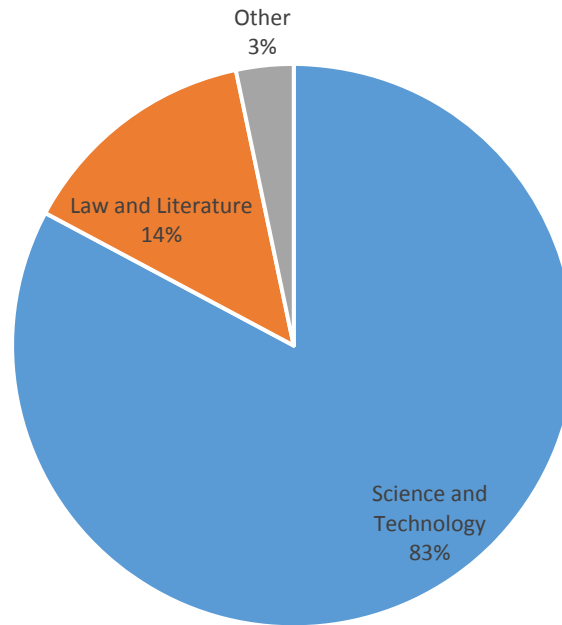
※F.R. shows the final pass rate.

Though the number of applicants has declined, the pass rate has remained between 6-10%, so it is very difficult to pass the examination. By the way, in the patent attorney examination of 2014, the number of applicants is 6,216, the number of passers is 385. The average age of successful candidates is 36.4 years old, and the youngest is 21 years old.

The number of times they take a exam is 3.86 in average.

Reference: the Patent Office HP

Successful candidates of Patent attorney examination : Breakdown of their field



Because a patent attorney handles many science field, more than 80% of patent attorneys had majored in science and engineering in their universities.

Reference: Career Garden HP

Overview of patent attorney examination

- To become a patent attorney, you have to pass the patent attorney exam that is annually carried out and need to register for patent lawyer. There is no limit for qualification for the exam.
- The period of application acceptance; the end of March - early April
- The short-answer type written test; May
 - the format of questions: 5 choices: mark sheet form (subjects; The Patent and Utility Model Law, The Design Law, The Trademarks Law, laws and regulations related to The Industrial Property Rights, The Copyright Law, The Unfair Competition Prevention Law)
- Written exam (essential subject); early July
 - (patent, utility model, design, trademark)
- Written exam (elective subject); the end of July (masters and doctors are exempt)
- Oral exam; the end of October
 - the format of questions: interview (patent, utility model, design, trademark)

※ Those who passed the short answer written type test will be able to take a essay test.

Those who passed the essay written test will be able to take a Oral examination.

Reference: the Patent Office HP

Method of study in order to pass the patent attorney examination

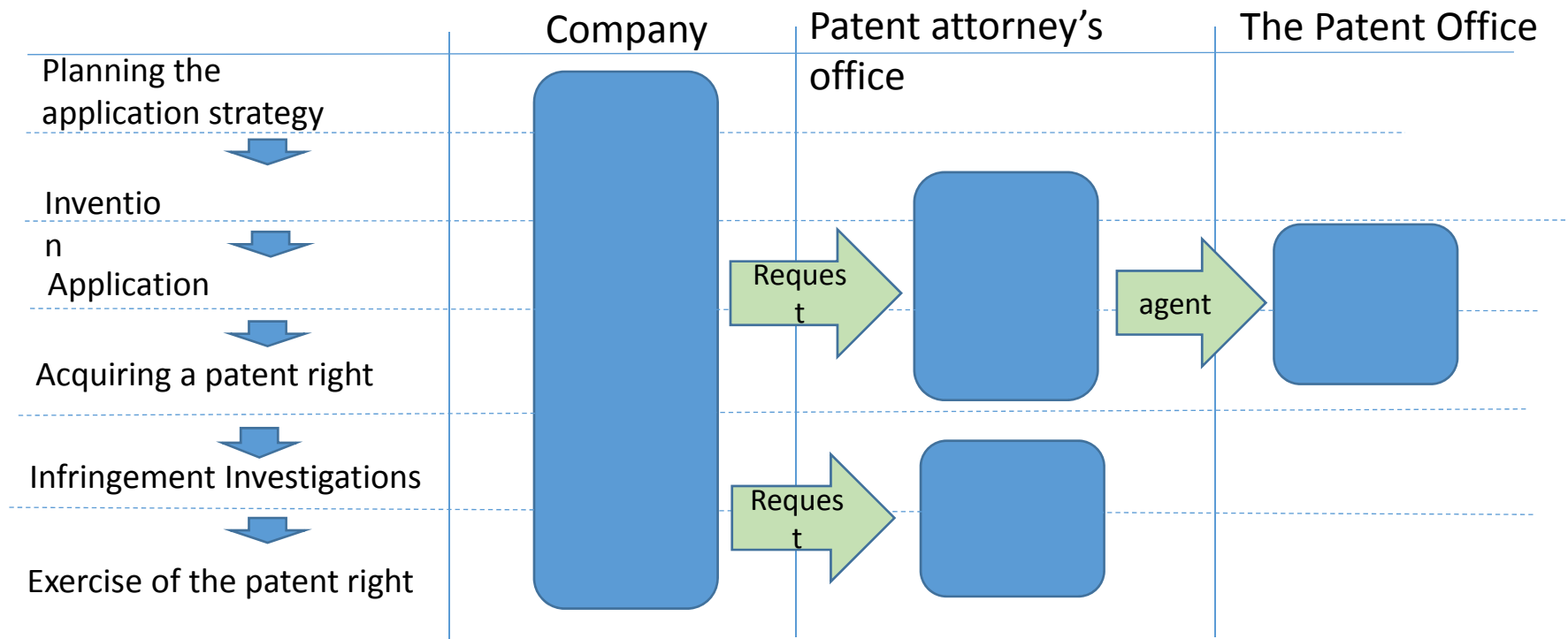
- Time spent in studying to pass; about 3000 hours
- Although studying on your own is not impossible, most of the applicants go to a prep school to pass because it is very difficult and takes a lot of time.
- (Examples of prep schools)
 - TOKYO LEGAL MIND K.K.
 - Yoyogi School
 - TAC Corporate
 - Yoshida seminar etc.

✂ In addition to schools,
there is also a course to learn using the Web or DVDs at home.

Workplace to be active of attorney

- Patent attorney's office
 - Independent practice
 - Law office (Infringement litigation and licensing agreement)
 - Intellectual property departments in the companies
(Acquiring the rights of intellectual property about new product development)
 - Universities and Technology Licensing Organization
(Supporting the use of intellectual property, which is the results of research, from the professional standpoint)
 - Patent Office
(fixed-term system; research experience for more than four years, and Japan nationality are required)
- etc.

Flow from planning the application strategy to making use of the right



Jobs at the patent attorney's offices

Part 1 :In charge of domestic patent application

- The flow of domestic patent applications
 - Request of the patent application and consultation about it →Hearing
 - (Patentability search) → Making application document → Application to the Patent Office → (Deal with the office action) →Acquisition of the patent rights
- In the "hearing", the attorney is given an explanation of the invention from the inventor, and understand the essence of the invention technology.
- When “Making the application document”, the attorney properly makes document(the specification and drawings) about the invention.
- In the “deal with the office action”, in case the office action is notified by the Patent Office after the application, the attorney consider and deal with it to be able to establish the right properly.
- Others, the attorney conducts a series of business on acquisition of patent rights.

Jobs at the patent attorney's offices

Part 2 :In charge of foreign patent application

- The flow of foreign patent applications
 - Request of the foreign patent application → Confirming the content of the domestic patent application → Making the English (or the corresponding foreign language) application documents tailored to the practices of each country → Application to the Patent Office in each countries through a local representative → (Deal with the office action) → acquisition of the patent rights
- In order to protect the invention of domestic patent application in the world, applying for a patent in foreign countries.
- After understanding the technology of domestic application ,applying for a patent in accordance with practice (law) of each country in English (or other foreign languages).
- In the “deal with the office action”, in case the office action is notified by each foreign Patent Office after the application, the attorney consider and deal with it to be able to establish the right properly, and instruct the local representative in English.

Jobs at the companies

Part 1 :Patent application/Acquisition of patent rights

- The difference from the patent attorney's office
 - The investigation into prior arts of intellectual property in the business areas in charge
 - Planning the application strategy based on the business strategy of development department
 - Prior art research for an invention that is proposed from the development department
 - The judgment whether the patent can be applied or not, based on the findings and the consistency in strategy
 - Request the patent attorney's office to apply for a patent
 - Analyzing the competitors' products, and modifying the scope so as to cover the product

Jobs at the companies

Part 2 :Response to disputes on intellectual property

- Infringement Investigation of patent rights
 - Whether competitors' products use the company's own patents
 - Whether our company's product use the competitors' patents
- Exercise of authority of the company's own patents against competitors
 - To send a warning
 - Negotiation about license ⇒ Infringement litigation on patent rights
- Response to the exercise of authority by competitors
 - Response to the warning letter
 - Negotiation about license ⇒ Infringement litigation on patent rights

The importance of US patent

High litigation expenses between global companies.
There is also a long battle which mobilizes both overall abilities.

The main battlefield is the litigation against a US patent in the US court.

- There are litigations between non-US companies against the United States Patent.
- Unique court system
 - : discovery (Advance disclosure of evidence documents)
 - : deposition (Summons by the other party lawyer)
- Jury system
 - : It is important that Logic can be understood by the amateurs.
- Expensive litigation costs : several million in US dollars a year depending on the circumstances.

Appeals of Attorneys

- You can make use of expertise that has been cultivated up to now.
- In other words , attorneys can advice as an expert for the consultation of the invention from inventors, and also can develop the invention technically.
- It is exactly the creative work.
- It is possible to come into contact with the innovative invention first, so technical intellectual curiosity is satisfied.
- It relies on the ability of patent attorneys whether the patent rights can be acquired. So, this job is worth doing.
- You can take advantage of the language skills, too.

*Thank you for your
attention!*