

**Standing Committee on Patents**  
**Questionnaire on the Publication of Patent Applications**

**Questions**

Groups are invited to answer the following questions under their national laws:

**I. Analysis of current law and case law**

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

(Answer)

Article 64 of the Patent Act provides for publication of patent applications. The main points are:

- (1) A patent application shall be laid open after expiry of one year and six months from its date of the filing.
- (2) The laying open of a patent application shall be effected by stating the following in the patent gazette: information on the applicant, information on the inventor, a description, a scope of claims, drawings, and an abstract.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

(Answer)

Yes. Publication of patent applications occurs automatically after expiry of one year and six months from its date of the filing.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

(Answer)

If priority is claimed (including priority under the Paris Convention and domestic priority) based on an earlier application, an application will be made public after expiry of one year and six months from the earliest priority date.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

(Answer)

Yes. If it is still possible to cancel the issuance of the patent gazette when an applicant withdraws its application, the withdrawal can prevent the application from being published.

5. What parts of a pending patent application are published?

(Answer)

Information on the applicant, information on the inventor, a description, a scope of claims, drawings, and an abstract.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

(Answer)

Yes. A published pending patent application gives rise to a right to claim compensation. If, after the laying open of a patent application, the applicant has given a warning with documents stating the content of the invention described in the patent application, he/she may claim compensation (equivalent to a reasonable royalty) against a person who has worked the invention in business for a period between the warning and the registration of patent right. However, if an amendment is made to claims, after the warning, to cover a product and/or a process that was not covered by the preceding claims, it will be necessary to give a warning again. In this case, the applicant may claim a reasonable royalty for a period between the second warning and the registration.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

(Answer)

No. A patent application does not give rise to any special right if it is unpublished. It does not give rise to any right if it is withdrawn without being made public.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

(Answer)

Yes. Early publication is provided for in Articles 64-2 and 64-3 of the Patent Act.

The main requirements for early publication are:

- (1) The patent application has not been laid open yet (Article 64-2 (1)(i)).
- (2) A priority certificate has been submitted if priority is claimed under the Paris Convention (Article 64-2 (1)(ii)).
- (3) A translation of the documents has been submitted if the patent application is written in a foreign language (Article 64-2 (1)(iii)).
- (4) A prescribed written request to the Commissioner of the Patent Office is submitted (Article 64-3).

Early publication of "Application A" gives rise to the rights or protection (mentioned in Answer to Question 6 above) earlier for itself. As an effect on another application that was filed *before* expiry of 18 months from the filing of Application A but *after* the early publication of Application A (hereinafter this another application is referred to as "Application B"), Application A becomes citable as publicly known prior art when Application B is examined. In other words, when examining Application B that was filed during the said period, the examiner may decide whether Application A published earlier in the gazette serves as a basis for the lack of inventive step. However, if Application A is published after expiry of 18 months from its filing, the publication of Application A in the gazette does not serve as publicly known prior art, but it is only citable in the context of "enlarged novelty." In this context, any inventions disclosed in the gazette could serve as a basis for the lack of novelty of Application B, when appropriate. Application A (citable in the context of enlarged novelty) disclosed in the gazette cannot serve as a basis for the lack of inventive step of Application B. Incidentally, the grounds for the lack of novelty in Japan are publicly known prior art, enlarged novelty, and "prior invention." Differently from enlarged novelty, a

prior invention can serve as a basis for the lack of novelty only when it is contained in a claim of the prior application.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

(Answer)

No. As a general rule, non-publication is not possible. However, patent applications relating to defense matters filed under the JP-US bilateral agreement remain secret until cancellation of secrecy order.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

(Answer)

It is said, as a guide, that a patent application will not be published if it becomes lapsed, abandoned or withdrawn within one year and four months from its date of filing. This non-publication occurs automatically. Therefore, if the application is lapsed, abandoned or withdrawn before this point in time, no procedure is needed as a request for non-publication. However, since it is difficult for the Patent Office to handle its internal process for non-publication on a strict schedule, a patent application will not be published only if the said process is carried out without delay. "One year and four months" is not specified in the Patent Act, but it is based on practices at the JPO. It is said that the issuance of a gazette can be cancelled if a request for withdrawal is received by the JPO before expiry of "one year and four months," from the filing of the application considering the timing of starting of preparation for its issuance. Even so, it is possible that the gazette will be issued depending on the progress of preparation for the publication of individual applications.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

(Answer)

In relation to this question, a divisional application and a domestic priority application are available in Japan. A divisional application is laid open after expiry of one year and six months from the filing of its original application. However, if a divisional application is filed after expiry of one year and six months from the filing of its original application, this divisional application will be laid open immediately after being filed. A domestic priority application is laid open after expiry of one year and six months from the earliest priority date.

## **II. Policy considerations and proposals for improvements to your current system**

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

(Answer)

No. We do not think there is any demand for a restriction on automatic publication, seemingly due to the reason below:

If a requirement were established for automatic publication by a particular deadline, and as a result, some or many applications were not laid open, then there would be an adverse situation where a certain application is not laid open for a much longer period of time and then a patent is issued abruptly. Before the introduction of the system for unexamined patent publication, competitors and third parties used to fear unexpected loss or damage caused by such a patent, so called a "submarine patent." When looking at any single case, it turns out that a submarine patent would only be advantageous to one person, who is the applicant, while it would be disadvantageous to so many people as said above. You can also make an analysis on any single person, i.e. which party he/she is more likely to become: generally speaking, a person more frequently becomes a competitor or a third party than the applicant of a certain application. Even if there were several submarine patents, any single person would still be more likely to be the former than the latter. In view of such an imbalance between the advantage and disadvantage of this situation, it is hardly possible that a restriction on automatic publication will be supported by a majority.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

(Answer)

Yes. There should be such a right to meet applicants' demand for earlier publication. The consequence of early publication is already explained in our answer to Question 8 above.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

(Answer)

No. Only those applications the applicant wants to publish early should be published early.

15. Should there be a right for the patentee to withdraw the application before publication?

(Answer)

Yes. Under the current system, the applicant can withdraw an application any time, both before and after its publication. This right should be maintained in the future.

If an application, once filed, cannot be stopped at all from being published, the applicant may suffer a serious disadvantage under this system. To address such a problem, the patent law or the patent office should clearly specify a period in which an application will (or can) be published even if request for its withdrawal prior to the publication is made. With this information in place, an applicant will be able to file a request for withdrawal of his/her application during a period by which its publication will be avoided without fail.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and

b. with respect to third party patent applications?

(Answer)

Question 15 is about the withdrawal of an application before its publication. Therefore, with respect to the withdrawn application, the consequence is that this particular application will not be published in the future. Then, we will discuss the consequence with respect to the other applications. According to the prevailing theory, under the patent system, an exclusive right is granted in compensation for the publication of an invention. As part of the benefit from such publication, it is expected that the patented invention will be made available in society and will be conducive to promotion of R&D. Therefore, the effects consequent to non-publication should be as little as possible. Based on this perspective, with respect to the patentee's own subsequent patent applications and third party patent applications, it should be stated "the application shall be deemed never to have been filed."

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

(Answer)

No. This is not realistic. If initial assessment of the validity of the patent were automatically provided to all applications, an additional burden to be borne by the Office would be enormous and such burden of assessment would be highly likely to cause delay in the essential process of examination. Thus, it does not seem viable at the present, anyway.

However, shortly after the filing of an application (i.e. if it is early enough), the applicant can file a request for Accelerated Examination and get its results (determination of the validity of the patent) before the he/she is required to decide whether to withdraw.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

a. the patent office to provide the results of its initial assessment?;

- b. the applicant to decide whether to withdraw the application?; and
- c. the application to be published?

(Answer)

- a. No time limit should be established.
- b. We think that an act of deciding whether to withdraw the application includes the indication of his/her intention at the Office based on this decision. From the applicant viewpoint, the closer the time limit is to the date of publication, the better. However, in the light of the actual condition of the publication system in Japan, we think it should not be later than the expiry of 16 months from the filing. For information on the actual condition in Japan and a related opinion, see our answer to Question 10 and the latter part of our answer to Question 15 above.
- c. 18 months from the filing.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

- a. on the initiative of the patentee;
- b. on the initiative of the patent office; or
- c. on the initiative of third parties (such as other governmental agencies)?

(Answer)

According to our understanding, this question asks whether an application should be prevented from being automatically published based on a request or decision by **a**, **b**, or **c** above. However, if some exceptions to publication are allowed, many people will suffer a disadvantage of non-publication (see our answer to Question 12). Also, it is difficult to establish clear-cut criteria for a decision on publication / non-publication. Therefore, all applications should be published in a single uniform way, with the exception of an application related to defense secrets filed under an international agreement with a country that has a secret patent system, and a part of an application that contravenes public order and morality.

We see no problem with these two (a defense secret and an offense against public order) when used as criteria for a decision on non-publication. When a



secret patent application filed, the Office can decide on its non-publication from a formal aspect, i.e. whether it is designated as a secret patent application in the foreign country of the other side under an international agreement with that country. With regard to a part of an application that contravenes public order and morality, we do not think there is any counter-argument to the principle of non-publication, nor is there likely to be any problem with practices adopted when deciding on non-publication.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

(Answer)

We answered No to Question 19.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

(Answer)

No. We see no reason for the adoption of different rules.

22. What proposals would you make to improve your current system?

(Answer)

There should be a clear time limit by which the applicant can withdraw his/her patent application without it being published.

According to the current practice, "if an application has been withdrawn, waived or dismissed, or if a decision of refusal has become final and binding before the publication of the patent application or before the registration of the utility model, then the gazette containing this application will not be issued in principle, except where the issuance of the gazette cannot be cancelled because its preparation has already started, or where a request for the publication is filed." Therefore, the time limit is generally 16 months from the date of filing, but there is no guarantee that publication of an application will be avoided without fail even when, for example, the application is withdrawn within 16 months from the date of filing.

### III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

(Answer)

A system for providing such information seems desirable from applicants' perspective. However, if the "examination or search by patent offices" in this question is performed automatically for every application before its publication, it is feared that an additional burden to be borne by the Office will be enormous and such burden of assessment is highly likely to cause delay in the essential process of examination. Therefore, it is necessary for each country or region to address such a possible problem, if any, before introducing the new system, which will be beneficial to applicants. If search results are automatically provided by the Patent Office, we think the additional burden to the Patent Office will not be so heavy, even if it is made to all applications, as it would be if examination results are provided to all applications. Anyway, it is preferable that such new system be introduced without a problem of delay in the process of examination.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

(Answer)

No. We do not think there is any demand for a restriction on automatic publication, seemingly due to the reason below:

If a requirement were established for automatic publication by a particular deadline, and as a result, some or many applications were not laid open, then

there would be an adverse situation where a certain application is not laid open for a much longer period of time and then a patent is issued abruptly. Before the introduction of the system for unexamined patent publication, competitors and third parties used to fear unexpected loss or damage caused by such a patent, so called a "submarine patent." When looking at any single case, it turns out that a submarine patent would only be advantageous to one person, who is the applicant, while it would be disadvantageous to so many people as said above. You can also make an analysis on any single person, i.e. which party he/she is more likely to become: Generally speaking, a person more frequently becomes a competitor or a third party than the applicant of a certain application. Even if there were several submarine patents, any single person would still be more likely to be the former than the latter. In view of such an imbalance between the advantage and disadvantage of this situation, it is hardly possible that a restriction on automatic publication will be supported by a majority.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

(Answer)

We think it is generally permissible for the Patent Office to suppress publication on the grounds of being contrary to public order and morality. In this case, a definition or practical interpretation of "what is contrary to public order and morality" should be given in accordance with social norms in each country. Matters related to national security may affect fundamental policies in each country and should be decided based on the territorial principle, through thorough discussions between each country/region and its people.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

(Answer)

We think 18 months is widely accepted as a period from the filing or priority date to the publication date and it is appropriate.

In other words, there does not seem to be a compelling opinion that 18 months is generally an inconvenient period. Also, according to the report, *Comments from AIPPI on the Objectives and Principles of the B+ Sub-Group dated 27 May 2015*, 18 months is supported by an overwhelming majority. To Question 3 (Table 2.5) "Should all applications be published after a period of 18 months?" on page 47, over 80% of the respondents answer yes in all of the seven countries/regions surveyed. Over 10% answer no to this question only in two countries (Japan and the US). On page 51, there is a question to be answered by applicants and third parties, "Is a period of 18 months reasonable?" The percentages of applicants who answer yes to this question in the seven countries/regions are: a little under 75 % in one, 100% in one, and 80% to 90% in five. Compared to the applicants, more third parties think that 18 months is too long. However, 18 months is supported by more than half of the third-party respondents (60% to 100%) in six countries/regions, and slightly less than half of the respondents (49.3%) think that 18 months is reasonable only in one country.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

(Answer)

We think, as discussed above, the 18 month publication period is widely accepted. We disapprove of an extension of this period, because a longer period could pose a risk (though only to a slight degree) of a delay in the examination process and a submarine patent, which made it necessary to introduce the system for unexamined patent publication.

It is indispensable that a period between the filing or priority date and the publication date be the same in all countries and regions. In other words, there should not be a difference in the length of time during which applications are prevented from being published. Even if only one country or region adopts a shorter period, e.g. 17 months from the filing or priority date, one month of non-publication (between the end of 17th month and the end of 18th month) will have no meaning in the rest of the world. Since there is currently a unified period of 18 months from the filing or priority date, every country should promise not to adopt a different period.

However, the countries have no problem adopting a procedure for early publication based on a request from the applicant.

## Procedure

It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI ([StandingCommittees@aippi.org](mailto:StandingCommittees@aippi.org)) by 3 August 2016.

For inquiries, please contact either of the following members of the Standing Committee on Patents.

### **Tim Iserief**

NautaDutilh N.V.  
Strawinskylaan 1999  
1077XV Amsterdam  
The Netherlands  
T +31 20 7171 460  
F +31 20 7171 335

E: [tim.iserief@nautadutilh.com](mailto:tim.iserief@nautadutilh.com)

### **Andrew Meunier**

Meunier Carlin & Curfman LLC  
999 Peachtree Street NE, Suite 1300  
Atlanta, GA 30309  
United States of America  
T + 1 404 645 7700  
F + 1 404 645 7707

E: [dmeunier@mcciplaw.com](mailto:dmeunier@mcciplaw.com)