

Patent Attorneys and Their Education in Japan

Dr. Shoichi Okuyama
Okuyama & Sasajima, Tokyo, Japan

March 2018
In Kuala Lumpur

What I want to say today

- History and current situation in Japan
- It is important to have a sound **patent attorney system**
 - Patent attorney qualification supports the patent system
 - Patent office and attorney work in tandem
 - Helpful for the development of **local** industries and research
- For maintaining a sound patent attorney system
 - High level examination and **continuing education** are important
 - **Ethics** education is also important

Beginning, more than 130 years ago

- **First substantive** patent act in 1885
 - By **Mr. Korekiyo Takahashi**
 - 425 patent applications in 1885
 - First trademark act in 1884 also by **Mr. Takahashi**
- **Mr. Takahashi** traveled to the U.S. and Europe to study patent systems for one year
 - November 1885 through November 1886
 - He was impressed by a US patent attorney
- First “**patent attorneys**” in Japan appeared in 1890
 - *Tokkyo Daigen Sha* (literally “Patent Attorney Co.”) opened two offices in Tokyo
 - Former examiners at the suggestion of **Mr. Takahashi**

So Mr. **Takahashi**, around 1985-90, -

- Created patent system and trademark system in Japan
- Created copyright system
- Created the Patent Office for examination
- Built a building for the Patent Office
- and
- **Created patent attorney profession**
- Sowed seed for special patent account for JPO fees

- He moved on to become Finance Minister three times, Prime Minister, and then FM for fourth-sixth times
- He was assassinated by soldiers in 1936

First Patent Attorney System (1899)

- First **regulations** on the registration of patent attorneys appeared in **1899**
 - Took effect on July 1, 1899
- **Patent Act in 1909** stipulates that **only** patent attorneys have power of representation before the Patent Office
- “Japan Patent Attorneys **Association**” (JPAA) was established in 1915 – 103 years ago
- First Patent Attorney **Act** was promulgated in 1921
 - The number of registered patent attorneys reached 1,350 in 1921
 - 39,064 patent and utility model applications, and 36,809 trade mark applications filed in 1921.

JPAA

- JPAA was established in **1915** in Tokyo
 - 9 branch offices including one in Tokyo
- **All** patent attorneys **have to** belong to JPAA
 - Compulsory membership
 - Monthly fee is JPY15,000 or about US\$140
- The budget is about US\$ 20 million
- JPAA has staff of 90 including 27 part timers

What Patent Attorneys Can Do?

- Patent Attorney Act stipulates what we can do:
 - Articles 4 through 6bis:
 - Representation before the Japan Patent Office for fees (exclusive)
 - Opinions, customs procedures, ADR
 - Representation before the IP High Court for appeals from decisions of Appeal Department of JPO
 - Assistant to lawyers in infringement litigation
 - Representation **with a lawyer** before **infringement courts** for specific types of litigation with **additional qualification**

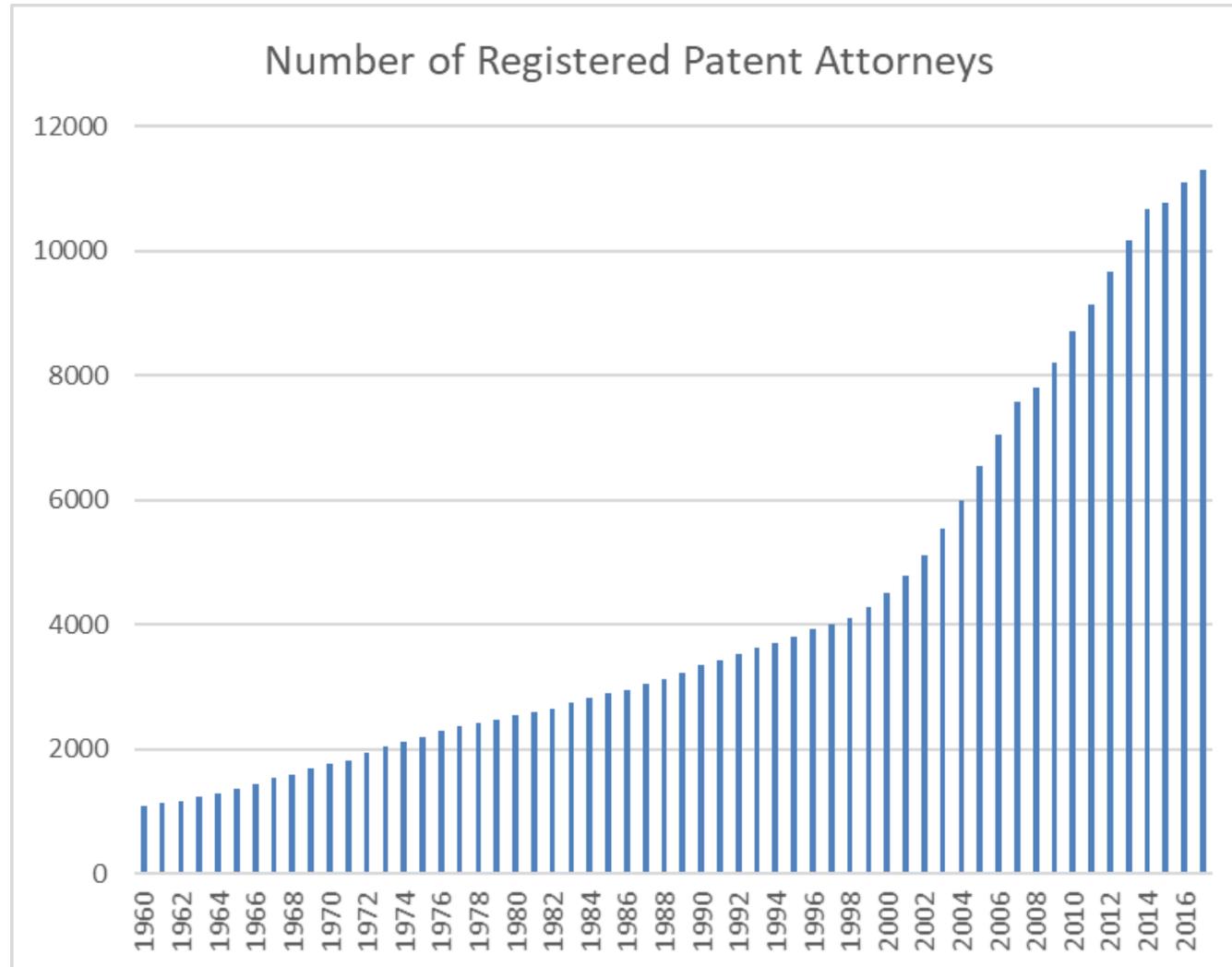
Representation before infringement courts

- Representation before infringement courts for specific types of litigation
 - Representation **together with an attorney at law**
 - Patent, UM, design, trademark, circuit layout, and certain types of unfair competition violations
- Qualification process
 - 45 hours of lectures and four drafting exercises
 - Three courses in Tokyo and one in Osaka
 - Lecturers are attorneys at law, judges and court clerks
 - Examination conducted by JPO
 - Drafting a complaint and a brief
 - Pass rate is about 45%
- More than **3300** patent attorneys have this qualification (as of Feb 2018)

Trends surrounding JP patent attorneys

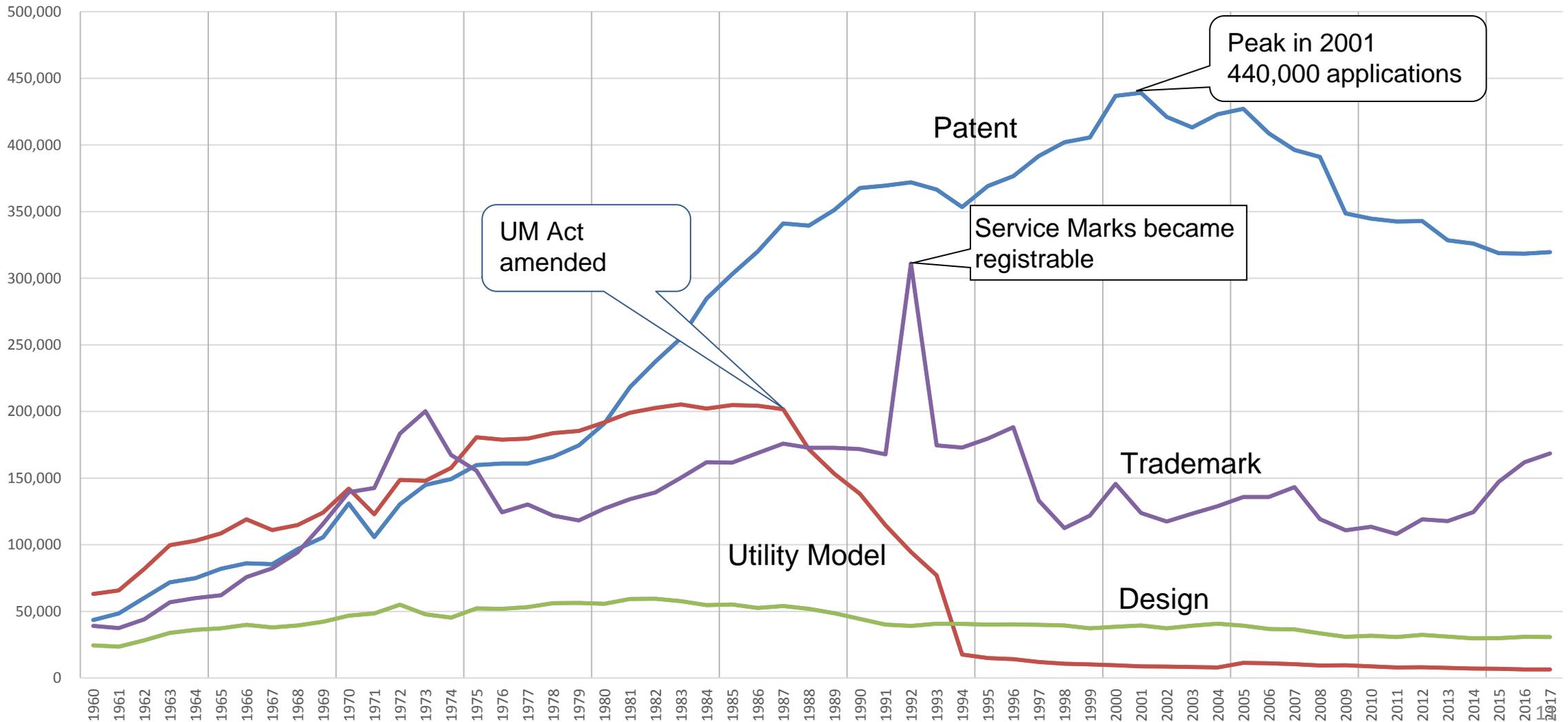
- Increasing number of patent attorneys
 - More than 11,000 patent attorneys in Japan
- Dwindling domestic filings
- Increasing foreign filings by Japanese companies

We have 11,000 patent attorneys in Japan



Filings in Japan – Pat, UM, Design, TM

Annual filings in Japan - Patent, UM, Design + TM



Education is JPAA's top priority!!

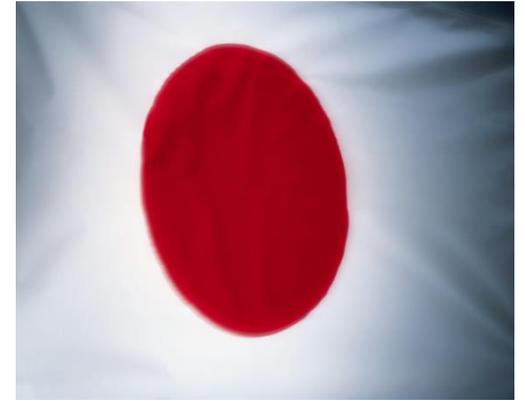
- “Educational Institute” of JPAA
 - 110 attorney members (volunteers) + administrative staff of 10 or so
 - More than 400 classes per year
 - About 250 e-learning programs
- Branch offices (9) are active providers as well
- Education budget - Expenditure - **4 million US dollars in total**
 - E-learning and many lectures are free of charge to members
 - A bit less than US\$380 per attorney
 - Fees may be required for a number of courses
 - Fee income is about 1.0 million US dollars

Types of Educational Programs

- **Pre-registration courses** for those who passed bar exam.
 - 72 hours – e-learning + live lectures + assignments
- CLE courses
 - Mandatory **70 hours over 5 years (including 10 hours for ethics)**
 - Live lectures + e-learning
 - Compulsory classes corresponding to important developments such as law amendments – every attorney is required to take them
- Courses for **infringement litigation qualification**
 - 45 hours live lectures in preparation for exam
- Courses conducted by JPAA **branch offices** (9 branches)
- JPAA-certified CLE courses by **outside** organizations

Thank you

okuyama@quon-ip.jp



Thank you

