

## PRELIMINARY PROGRAM

10:00            **Welcome address** - Lennart Karlström, President FICPI Sweden

10:05            **Introduction to topics and speakers** - Jan Modin, Moderator

### 10:10 – 11:15 JAPANESE PROSECUTION PRACTICE, PART 1

**Claim Drafting** - Mr. Yoshikazu Tani, Senior partner of Tani & Abe, Tokyo

Patent claim drafting is a fundamental task for patent professionals. Before drafting claims, we must realize the importance of pre-filing preparations and proactive use of the 18 months after filing. Understanding and identifying the invention is a key to drafting claims in a strategic manner. Also, a thorough search of prior art is essential to evaluate the invention we have identified. You should also consider a multi claim system and the complicated new practices of unity of invention. Simultaneously, we should check that the claims are well supported by the disclosure and the various embodiments of the invention. Functional claims and distributed transaction claims are discussed. Finally, examples of actual and interesting patented claims are introduced.

**Novelty and Inventive Step** – Ms. Kay Konishi, Managing partner of NICHIEI  
Patent and Trademark Attorneys P.C., Tokyo

Handling prior art based rejection is a core part of patent prosecution. In particular, novelty determination becomes an issue when an application claims an invention with numerical limitation or use limitation in Japan. To know the difference between the inventive-step practice in Japan and the problem-solution approach in Europe is crucial when presenting persuasive arguments against non-inventive-step type rejections, with which applicants are frequently confronted. This session will guide European practitioners into practices on novelty including the prior art effect of earlier filed applications (“fictive state of art”), and inventive-step in Japan.

### 11.15 – 11.25 SHORT BREAK

### 11:25 – 12:30 JAPANESE PROSECUTION PRACTICE, PART 2

**Amendments and Divisionals** - Yoshikazu Tani

Amendments practice is fundamental when a patent professional prosecutes a patent application. An amendment must not introduce new matter. So, what does “new matter” mean? The grand panel decision by the IP High Court changed and established new “new matter” practices. Another complicated amendment practice is unity of invention. In order to avoid a so-called “shift amendment”, proper claim drafting is critical. Examples will lead you to better understand the Japanese concept of unity of invention. Divisional applications are very important from a practical point of view. After allowance, a divisional can be filed but after a final rejection, one must be careful to avoid pitfalls of a “first final” situation. Practical tips for practitioners will be discussed.

**Further Procedural Aspects and Utility Model Practice** - Kay Konishi

This session will focus on “dos and don’ts” to keep in mind from a perspective of European practitioners upon filing/national entry and during prosecution in Japan. The session will also touch on other procedural requirements, and will further address Utility Model practice as an alternative and/or a supplement to patent protection.

**12.30 – 13.30 LUNCH**

**13.30 – 14.20 SWEDISH INDUSTRY PERSPECTIVE**

**Prosecuting patent applications in Japan**

Filip von Friesendorff, Group Patent Manager, Alfa Laval Corporate AB

**Challenges when prosecuting JP patent applications**

Tommy Vikholm, IP Counsel, Akzo Nobel AB

**Predictability of possible IP rights in Japan** – Filip von Friesendorff

**Strategy for safeguarding IP rights in Japan** – Tommy Vikholm

**14.20 – 14.40 COFFEE BREAK**

**14.40 - 15.30 ENFORCEMENT OF JAPANESE PATENTS**

**Patent Litigation in Japan** – Yoshikazu Tani

The fundamentals of the court system in Japan is briefly introduced together with statistics on the patent infringement litigation cases. Various features of the current patent infringement court proceedings are presented. Then, the doctrine of equivalents is discussed, especially in connection with the recent IP High Court decision of the “hollow golf club head” decision on June 29, 2009. Validity issues can be reviewed by an infringement court. Tips of functional claims and joint tort issues are discussed. Then, very important recent developments or pro-patent trends in the patent infringement court are introduced. A revised Patent Law to be effective from April 2012 is explained. The new law facilitates enforcement of patent, licensing practice, and joint inventorship. Also, the conditions for accepting a grace period will be relaxed. The Japanese ADR system is discussed, especially MedAb (Mediation followed by Arbitration) by Japan IP Arbitration Center since 1998 and “Fuki Benrishi” (patent attorney admitted to practice before a patent infringement court) since 2004.

**Enforcement issues and Recent Landmark Cases in Japan** – Kay Konishi

The JPO provides an invalidation trial available for validity challenge for possible or accused infringer, and a correction trial available for reinforcement of patent for patentee. To know various measures available both for the JPO and the Court for dispute resolution for both parties is of great importance to adequately enforce a patent in Japan. This session will address how to offense or defense in patent dispute, and further briefly touch on recent landmark cases rendered by the IP High Court that are must-know ones for European practitioners.

**15.30 – 16.00 PANEL DISCUSSION ON JP PATENT PRACTICE**

A panel with the four speakers will discuss the various topics dealt with at the seminar, including questions raised by those attending the seminar.

**16.00 END OF SEMINAR**