CONFERENCE
on
JAPANESE PATENT LAW AND PRACTICE
for
US CORPORATE PATENT COUNSEL
at the
JAPANESE PATENT OFFICE
FEBRUARY 13-16, 1984

Opening Remarks

Minasama ohaio gozaimasu!

Honorable Director General, Officials of the JPO.

We are so grateful for your most kind invitation and we appreciate so much the opportunity to be here in Tokyo on this Study Trip in order to learn, first and foremost, and, secondly, to exchange views.

Today, tomorrow, this whole week, you are, or if I may put it this way, we all are making history. This is an historic event! I don't recall that such a Conference ever took place anywhere. This Study Trip of ours augurs well for the future in terms of improved international understanding and cooperation and will go down in history as a significant milestone in this respect. Hence you are to be highly commended and applauded for your statesmanship and foresightedness in calling this Conference.

You have a great program in store for us, indeed. And incidentally because of this and because we are here primarily to learn and study, we had no particular suggestions for program

changes. It is your "show" and we want to be very attentive viewers and listeners and, of course, very good students.

We are very anxious indeed to learn more about the Japanese Patent Office, its administration and its challenges and the Japanese Patent System and Patent Practice.

It behooves us to be willing, nay eager, to learn more about Japanese Patent Law and Practice because, on the one hand, Japan is such an important country in terms of industrial might and R & D prowess and, on the other hand, it is such a distant land with such a different culture and difficult language - and very importantly - it behooves us to make an effort to learn more about your system because we are lagging sadly behind our Japanese colleagues and friends in terms of studying other patent systems.

It is a fact that Japanese patent officials and attorneys have worked much harder to understand other industrial property systems than foreign patent officials and attorneys have tried to understand the Japanese system. For example, at any one time there are literally dozens of junior Japanese attorneys with Washington law firms and in other cities and other countries for periods of half a year or longer to study Patent Law and Practice in the US and elsewhere in great depth and with great diligence. The reverse is not true - far from it!

May I also mention that this momentous program has materialized in record time and this is also to your everlasting credit. Only little over half a year has elapsed since you proposed this program to us on a "Seeing is believing" basis through the good offices of Mr. Hiraoka, the President of the Japanese Group of PIPA. I hope we can be forgiven for the speed and zeal with which we embraced this proposal as a great opportunity for dialog and maintenance of good international relations. We saw the great potential for good immediately in terms of present impact and future benefit.

Naturally, we felt PIPA was a very logical sponsor for this endeavor. PIPA is now recognized as an important international industrial property organization. It's goal is to aid information exchange between patent and trademark counsel in our two countries with respect to the promotion of rights and interest in industrial property. It focuses attention on patent, trademark, know-how and licensing matters in Japan and the United States. This focusing of expertise from two of the most important industrial countries on major problems in the industrial property field has been and continues to be helpful to both national and international industrial property rights system. One of the most important valuable results of PIPA has been the mutual respect and personal friendships developed between the Americans and Japanese working in the field of industrial property.

By the way, Mr, Jaharis, our Honorary Chairman at the Washington PIPA Congress, stated in his address that "the Delegates to this Congress bear a special responsibility to see that the industries of our two countries better understand the workings of the patent systems of both countries, so that the secrets of each are open to all, and so that all may benefit from the systems of both countries, in full keeping with the letter and spirit of the Paris Convention."

Your formal invitation with a date proposal, an outline of the program and guidelines for team selection arrived in September shortly after the initial contacts. This was followed by an oral confirmation in October at the PIPA Washington Congress.

As another brief aside I would like to say again, Mr. Wakasugi, that it was a great privilege and pleasure to have had you and other high-level JPO officials in attendance at our Washington Congress. You were most honored guests indeed and indeed most welcome. I would also like to express to you, Mr. Wakasugi, again our deep gratitude for your eloquent address at our Congress. In particular we appreciated you ringing "formal declaration" that the JPO would be " open and transparent" (except for confidential material) and "receptive to all direct and indirect contacts." This I also consider as a milestone.

As far as this great program of yours itself is concerned, we are of course very happy about the substantive sessions on Patent Administration in Japan - Present and Future, the Japanese Patent System (in comparison to the US) and Japanese Patent Practice (including a presentation by the Engineer General and a Trademark session) and we look forward to the tour and visits of the JPO, the JIII, and JAPATIC.

What we also greatly welcome is the possibility of interviews with Examiners and Appeal Examiners on Friday or Wednesday for those who can't do it on Friday. We all should avail ourselves of this great opportunity to practice what we learned.

The Working Session and Luncheon with the Patent Attorneys Association of Japan and the Receptions with other Bar and Industry Groups will surely be most interesting and enjoyable.

After all this, we'll deserve an impressive diploma, provided we don't have to pass the kind of examination "benrishis" have to take!

However, we are also greatly pleased to see that there will be opportunities provided during the working sessions for us to discuss and probe those particular aspects of the Japanese Patent Law and Practice with which US practitioners have difficulty and for which special help and understanding is needed.

I myself will switch hats from PIPA President and JPO tour coordinator to chemical practitioner, from time to time and especially in the Case Studies session on Tuesday afternoon and will have questions and comments, for example, about the incomplete invention/change of gist practice. Personally, I have great difficulty comprehending the legal and technical reasons and the statutory and decisional bases behind rejections in this area, especially since no other country, apart from Russia, appears to have the stringent requirements that Japan has.

Before I say another word, however, I'd like to state categorically that no one in our delegation seriously believes that the JPO is not totally fair and objective and without bias in dealing with its applicants, whether they be domestic or foreign.

Culture and language barrier and the fact that we are entirely dependent on Japense associates with attendant communication and translation problems, contribute to the impression that life may be easier for Japanese applicants. Provisions of local law which differ markedly from what is typical in other countries are soon familiar to domestic applicants but likely to trip up foreign applicants for some time.

Sometimes foreigners feel harshly treated in the US if, e.g., later-filed applications of US origin issue earlier than

applications of foreign origin on the same inventions.

I have had a particular abiding interest and sensitivity in the question of different treatment inasmuch as a) I bridge European and US cultures having lived on both continents and b) work in the US for a European company.

Some of you may recall that I gave a talk at the 9th International PIPA Congress in Nagoya in October 1978 entitled "That Discriminatory US Patent Law!" (Published in the Proceedings and at 61 JPOS 95, 1979). In that talk I initially quoted very critical statements made by Japanese, German and British commentators about the US Patent Law. Then I went on to show how some provisions of the US Patent Law considered discriminatory could be neutralized and how in fact, other provisions harbored advantages for foreigners which Americans did not have. Incidentally, I also stated in that talk that US interference practice and Section 104 of the Patent Code were "much too anachronistic and uncommon to be defended." Mr. Jaharis also strongly endorsed a "First-to-File" System for the US as those of you who heard his address in Washington may recall.

During this Conference and especially in the Keynote Address Thursday afternoon the term "harmonization" will be used and heard. While I have no intention to anticipate Mr. Kalikow's

remarks, I would like to recognize that Japan has come a very long way in a very short time. Not too long ago - until 1871 - invention, manufacture and sale of new products was still prohibited under an ordinance of 1721 vintage. Since then Japan has synthesised a modern and distinctly Japanese Patent System accompanied by harmonization with European and American Patent Systems and adherence to international treaties. I understand a movement is presently underway in Japan to further revise its Patent Law. Thus, an opportunity may arise again for further harmonization and internationalization and perhaps liberalization.

Before I conclude my remarks this morning, I would like to bring you greetings from the US Commissioner of Patents and Trademarks, Mr. Mossinghoff. Even though the USPTO, after considerable discussion and consultation with the JPO, chose not to participate directly in this Program, Mr. Mossighoff is very much interested in this Program and I shall come back to this in my Closing Remarks. Naturally, in addition to sending regards, he also sends best wishes for a productive and fruitful program.

In closing I would like to express my genuine belief and my supreme confidence that Mr. Wakasugi's aims in calling this Conference will come to fruition and that improved understanding and cooperation will ensue from your presentations and our discussions and dialogs this week. We can and will make this Conference a positive accomplishment and a significant milestone!

Goseicho arigato gozaimashita!

Karl F. Jorda