

## Collective Examination System for IP Portfolios

In April 2013, the Japan Patent Office (JPO) instituted a new system, hereinafter referred to as "Collective Examination" with the intention of simultaneously conducting examinations of multiple applications regardless of whether the applications are a mixture of patent applications, design applications, utility model applications, and/or trademark applications.

Under Collective Examination, a team of JPO examiners is assigned to examine applications which could potentially cover a wide range of fields, projects, and/or products for applicants and businesses wishing to create more encompassing IP portfolios. This would be useful at a time when a mixture of patent applications along with design applications, utility model applications, and/or trademark applications is necessary, particularly in the case when IP protection is necessary for the launching of a start-up or the introduction of a new project or product.

Prior to October 1, 2014, the Collective Examination System required hearings and interviews be held in order to understand the details of the business project or product and the relationship among the various previously unexamined applications by the same applicant.

On October 1, 2014, new less-stringent requirements for requesting a Collective Examination were introduced by the JPO.

Now, one Collective Examination may be requested for a group of applications by different applicants, even if examinations have already commenced for some of the applications. If the applications are clearly recognized as belonging to the same business, or product, or the same research and development project, an application(s) currently under examination is (are) permitted in the group of applications submitted for Collective Examination.

It is anticipated that these various applications will

be used for the development of business projects, specifically, the development of international business projects.

At the very least, one of the applications among the group of applications must be either

1) a "working-related application", in which the applicant has already worked the invention (or plans to work the invention within 2 (two) years of the date on which the Collective Examination is requested); or

2) an application which has been filed not only at the JPO, but also an IP office in another country. Please note that PCT applications are not permitted in the group of applications if the PCT application is in the international phase.

In addition, additional applications can be included, substituted, replaced, etc., after requesting the Collective Examination.

#### To Request a Collective Examination

Before filing a request for Collective Examination, please understand that the maximum number of applications which can be grouped together for a Collective Examination is generally restricted to 20 (twenty).

1) A single applicant (in the case when there are multiple applicants) requests the Collective Examination.

2) The request contains a description of the business project or product and how the project or product and the various applications are related.

3) The JPO informs the applicant of whether the request is to be permitted. If deemed to be allowable, a coordinator at the JPO will arrange interviews or hearings to be conducted and a team of JPO examiners will be designated to perform the Collective Examination.

According to the Japan Patent Office, in 2016, 36 separate filings were made requesting examination under the Collective Examination System. These filings encompassed 360 patent applications as well as trademark and design applications.