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PROPOSALS TO ENHANCE QUALITY AND EFFICIENCY OF THE PCT ROUTE

Document prepared by Japan

INTRODUCTION

1. Since the adoption and launch of PCT in the 1970's, the use of PCT has remarkably expanded in light of volume, users, and member states, so that PCT is becoming recognized as main route to seek global patent portfolio. In order to respond to the highest ever expectations and demands for PCT, Japan thinks that the efforts to improve PCT should be doubled and tackled in an organized manner. In this context, Japan appreciates the initiatives by the Director General of WIPO to set up a roadmap for the PCT reform ("Roadmap") where aims are indicated with timelines. Japan would like to take a positive part in this exercise and is therefore submitting proposals for PCT reform in this paper which we believe will deserve to be incorporated in the Roadmap.

ESTABLISHMENT OF ISR/WOISA AFTER THE INTERNATIONAL PUBLICATION AND INTRODUCTION OF THE SYSTEM FOR FILING OF THIRD PARTY OBSERVATIONS¹

2. Japan proposes the establishment of ISR/WOISA after the international publication and introduction of the system for filing of third party observation. The purpose of the proposal is to establish ISR/WOISA of maximum quality.

3. This proposal provides the optimum benefits for users and offices as follows:

(a) complete search can be provided in the first instance. It enables ISR/WOISA to cover all “secret prior art,” which is on high demand from users.² Under this proposal, the applicant can also respond to negative “secret prior art” at one time.

(b) The ISAs do not have to conduct “top-up” search on “secret prior art” at a later stage, which will save the cost and time that examiners spend reading, analyzing and searching.

(c) The information submitted by third party, who monitors the content of international applications when published, can be reflected in the ISR/WOISA³.

(d) All applicants can receive the reports which cover all “secret prior art”.

¹ The system for filing of third party observations is also proposed in the Roadmap (MIA/16/9, Annex I to Appendix I, paragraph 7) and in the EPO proposals (MIA/16/11, paragraph 22).

² The exemplary statistics in the table below shows that “secret prior art” cannot be considered negligible in examination. The table lists some technical fields where the rate of First Actions (“FAs”) with “secret prior art” rejection over all FAs citing publicly available documents or “secret prior art” (“rate of secret prior art”) exceeds 25%. The FA here was subjected to both national applications with JPO and national phase applications with JPO as DO. Furthermore, according to the statistics based on JPO database, the whole rate of “secret prior art” across all the technical fields is about 6.5%; and the technical fields where the rate of FAs with “secret prior art rejection” exceeds 10% cover a wide variety of fields ranging among the areas of Optics, Chemicals, Electricity, Machinery, etc. Therefore, it is clearly important to search not only publicly available documents but also “secret prior art”.

Technical Fields (example)	Rate of secret prior art
MRAM or Spin Memory Techniques	39.0% (172)
Secondary Cells (other Accumulators)	31.6% (1348)
Electroluminescent Light Sources	27.9% (1542)
Photoresist Materials	27.4% (2419)
Battery Electrode and Active Substance	27.3% (2599)
Luminescent Composition	26.9% (1143)
...	...

The parenthesis signifies the number of all FAs citing publicly available documents or “secret prior art”. (Source: JPO database)

³ For those who would like to submit information after checking the ISR, there are still occasions to be reflected; e.g., IPE or national phase.

4. The current timing of establishment of the ISR/WOISA should be maintained as an option, for the benefit of an applicant who desires ISR/WOISA before the publication.
5. The Japan Patent Office presented this proposal at the 16th session of the Meeting of International Authorities (PCT/MIA) in Seoul. While some Authorities recognized the above merits, other Authorities expressed some concerns that: (i) it would be detrimental to the interests of third party who wants ISR as part of international publication; (ii) it would affect subsequent conduct (e.g., SIS or IPE) and risk final reports not being established before the end of the international phase; and (iii) normally, most of the relevant “secret prior art” cannot be made available through search database until after certain period of time (e.g., 24 months), which might be too late for ISR/WOISA (see PCT/MIA/16/15, paragraphs 21 to 25).
6. Regarding (i), it goes without saying that the time limit for issuance of ISR/WOISA should be prescribed in some way or another. It should be the earliest feasible time after international publication, taking into consideration factors like the period necessary to conduct search, and the burden of the third party monitoring the fate of the application.⁴
7. Regarding (ii), the time limit of ISR/WOISA should surely take into account (in addition to those in paragraph 6) the time schedule of the subsequent conduct so as to ensure that a final report meets the national phase entry deadline. Each Authority should be responsible for managing the time schedule of each conduct tightly so as not to delay the final report.
8. Regarding (iii), it is noteworthy that each Authority will be urged to store necessary publication data as quickly as possible to enable an international search to cover the maximum number of published documents possible. In addition to that, at least the member states whose patent documents are designated as PCT minimum documentation should be urged to exert the utmost effort to provide their published patent data to each other at the earliest time after the publication. IB will be expected to contribute to such data storage and exchange in terms of technical support or coordination as appropriate. These kinds of technical issues would better be dealt with in appropriate fora.
9. Considering that this proposal is crucial to enhancing the quality of ISR/WOISA which can now substantively be seen as international examination in the first instance, and is feasible to achieve under the current framework of PCT⁵, Japan would like the proposal to be incorporated into the Roadmap as one of the aims as follows.

Making International Examination More Complete, Relevant and Useful

Aim: To create the time limit of establishing the ISR/WOISA at the earliest feasible time after international publication, while maintaining the current timing as an option.

⁴ For example, 21 or 22 months from the priority date can be considered as the time limit for establishing the ISR/WOISA. (indicative only)

⁵ The time limit for ISR can be changed by the amendment of PCT Rule 42. Third party observation could be introduced by creating new a PCT rule at most.

POSSIBLE EXTENSION OF TIME LIMIT FOR INTERNATIONAL PRELIMINARY EXAMINATION AND NATIONAL PHASE ENTRY

10. While establishing ISR/WOISA after publication may not have a significant influence upon normal proceedings of IPE, it might be worth considering to extend the time limits of IPE proceedings, such as demand for IPE or the establishment of IPER and subsequent time limit (i.e., national phase entry), in case that it would be necessary to respond to legitimate demands to enrich IPE process.

11. Such a review of the timing of the international phase is also suggested by IB as a rounded package as follows (PCT/MIA/16/3 paragraph 17):

“Developing a Rounded Package

“17. Some of the matters which are discussed above could be most effective in the context of a major review of the timing of international search and preliminary examination to ensure that there was sufficient time for the work to be conducted effectively and that any particular piece of work is done at the best time. Amongst the matters to be considered will be the time limits for establishing the international search report, for making the demand for international preliminary examination, for establishing the preliminary examination reports and for entering the national phase.”

12. It should be noted, however, that change of the time limit of national phase entry, if any, should apply to every case to avoid the situation in which IPE is requested just to delay national phase entry (PCT/MIA/16/3 paragraph 18).

PARALLEL PROCESSING OF INTERNATIONAL APPLICATION AS ISA/IPEA AND EARLY NATIONAL ENTRY APPLICATION AS DO

13. The Roadmap contains the aim in “Compliance and Consistency” that international searches will not be repeated by ISA in the national phase as DO. This aim will presumably envisage the conventional situation where First Action (“FA”) as DO is not processed until 30 months period of the international phase. However, there should be another case in which international search is not repeated, that is, where an early national phase entry has been made upon the express request of the applicant⁶ so that the ISA, if nicely timed, establishes the FA as DO at the same or similar time as the ISR/WOISA is produced. Such parallel processing enhances efficiency and reduces duplicative workload of an office as ISA and DO to a large extent. For an applicant, he or she can obtain FA at an early stage while still remaining in the international phase. It also enables the applicant to respond to the ISR/WOISA and the FA at the same time, if the applicant so wishes, which have the same contents substantially, and thereby sharply reducing the burden on applicants to respond.

14. Japan believes that not only in the situation as envisaged in the Roadmap but also in the situation of early national entry upon express request by an applicant, international search should not be repeated, by encouraging parallel processing where applicable, which will enhance efficiency and confidence. Therefore, Japan would like to pursue the incorporation of the following aim into the Roadmap.

⁶ See PCT Art.23(2)

Compliance and Consistency

Aim: For International Search Authorities and International Preliminary Examination Authorities to conduct parallel processing of international application as ISA/IPEA and early national entry application as DO where applicable.

15. The Working Group is invited to consider the proposals contained in this document.

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