



JAPAN PATENT ATTORNEYS ASSOCIATION

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February 28, 2013

Mr. Claus Matthes
Director
PCT Business Development Division
World Intellectual Property Organization

Re: JPAA's Comments on the Circular 1364, dated December 20, 2012, concerning the proposals for further improvement of the PCT system which had originally been presented at the fifth session of the PCT Working Group

Dear Mr. Matthes:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 9,600 patent attorneys practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including copyright and unfair competition as well as patent, trademark and design laws. Many are capable of representing clients in infringement lawsuits. The JPAA would like to submit comments on the proposals.

The following is our comments for the proposals by the United Kingdom and the United States of America (document PCT/WG/5/18, entitled "PCT20/20") and the proposals by the European Patent Office (document PCT/WG/5/18, entitled "Proposals for Further improvement of PCT Services and Products").

I. Our comments with respect to the "PCT20/20"

(i) Regarding the Proposal (A) SELF-SERVICE CHANGES (92BIS/PRIORITY CLAIMS)

Comments:

We agree to this proposal that the applicant, after verification of their identity, could make correction of priority claims and changes to persons, names and addresses under Rule 92*bis*.

(ii) Regarding the Proposal (B) LIMITED CHAPTER I AMENDMENTS

Comments:

We agree to permitting limited claim amendments as indicated in this proposal

(iii) Regarding the Proposal (C) SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS



Comments:

We disagree to this proposal, because it would substantively allow to one of joint applicants to withdraw an international application without agreement of the other joint applicants.

Further, this proposal is contradictory to our domestic law. In Japanese Patent Act, procedures for withdrawal of a patent application filed by joint applicants must be made by all the joint applicants (Article 14). As an exception, when the joint applicants have appointed one of them as a representative for both/all of them and have notified the Japan Patent Office accordingly, the representative can perform withdrawal of the patent application on his/her own. However, such a representative is rarely notified the Patent Office.

(iv) Regarding the Proposal (D) STANDARIZING FEE RESUCTIONS FOR NATIONAL STAGE APPLICATIONS

Comments:

We agree to this proposal.

(v) Regarding the Proposal (E) INTERNATIONAL SMALL/MICRO ENTITY REDUCTION

Comments:

We found this proposal favorable in view of services to our clients. However, we believe that further discussions is necessary to realize this proposal. For example, it is difficult to decide definition of “small and micro entity” as stated in this proposal. In addition, it is necessary to have discussions with respect to proving a method and conditions of small and micro entity in order to reduce load of applicants and each of states.

(vi) Regarding the Proposal (F) INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTION ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE INTEGRATED NATIONAL SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS

Comments:

We agree to this proposal. We think it is valid way to shorten examination period.

(vii) Regarding the Proposal (G) MANDATORY RECORDATION OF SEARCH STRATEGY

Comments:

We agree to this proposal.

(viii) Regarding the Proposal (H) COLLABORATIVE SEARCHING (2 + OFFICES),



ELIMINATE SUPPLEMENTARY INTERNATIONAL SEARCH

Comments:

We agree to this proposal. We think that it is preferred that applicants of an international application may select one or more member states (e.g. designated state(s) in this application) requiring cooperation for examination.

(ix) Regarding the Proposal (I) MANDATORY TOP-UP SEARCHES

Comments:

We agree to this proposal. However, at present, there are not many applicants who desire use of the international preliminary examination. We do not know whether or not this proposal can result in the increase of the PCT users.

(x) Regarding the Proposal (J) DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM INTO THE PCT

Comments:

We agree to this proposal.

(xi) Regarding the Proposal (K) FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT, FAST TRACK OF NATIONAL PHASE APPLICATIONS, IMPROVE REUSE OF PCT WORK AT THE NATIONAL PHASE

Comments:

We agree to this proposal. We think that this scheme will contribute to reduce load of applicants desiring early grant of patent and load of examination.

(xii) Regarding the Proposal (L) MAKING THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY AVAILABLE TO THE PUBLIC AFTER INTERNATIONAL PUBLICATION

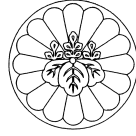
Comments:

We disagree to this proposal, because it has high probability of violation to PCT Rule 44^{ter} (Confidential Nature of Written Opinion, Report, Translation and Observations). We are concerned that an applicant may suffer unforeseen disadvantages if a secret condition of a Written Opinion is dissolved within the international phase during which the applicant may not file his/her argument to the Written Opinion even though its content is not correct.

II. Our comments with respect to the “ Proposals for Further improvement of PCT Services and Products”

Comments:

We agree to these proposals from the EPO.



Best Regards,

Shoichi Okuyama
Shoichi Okuyama
President
Japan Patent Attorneys Association