

## Patent Cooperation Treaty (PCT) Working Group

### Fourteenth Session

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#### **JPAA's comments on the fourteenth session of the Patent Cooperation Treaty (PCT) Working Group**

The Japan Patent Attorney Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has more than 11,600 members practicing intellectual property law in Japan. Its members practice in all areas of intellectual property law, including patent, design and trademark law, as well as copyright and unfair competition.

The JPAA greatly appreciates the efforts and dedication of the Secretariats to organize the meeting in order to move forward the discussion on various important issues. In the meantime, the JPAA is also grateful for this opportunity to submit comments on the meeting documents uploaded on the WIPO website. We would be happy to answer any questions regarding our comments below.

#### *PCT/WG/14/10 — Formal Integration of the Patent Prosecution Highway into the PCT*

The Working Group has discussed this issue on an ongoing basis since it was jointly proposed by the UK and the US in 2012. Some member countries that initially dissented from the proposal have changed their views as a result of their active participation in the PPH (Patent Prosecution Highway). Document PCT/WG/14/10 presents proposed amendments to the PCT Regulations and Administrative Instructions in order to formally incorporate the PPH into the PCT System. The Japan Patent Office (JPO) commenced the PCT-PPH pilot program on January 29, 2010, for the use of international phase work products of PCT applications in national procedures. Under this program, accelerated examination can be requested, using a written opinion prepared by certain International Searching Authorities (WO/ISA), a written opinion prepared by certain International Preliminary Examining Authorities (WO/IPEA) or an international preliminary examination report (IPER) prepared by certain International Preliminary Examining Authorities.

<[https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/pct\\_products.html](https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/pct_products.html)>

The JPAA agrees with this proposal because it would be beneficial if expedited examination can be requested upon entering the national phases in multiple PCT member countries, as in the case of accelerated examination under the PCT-PPH program. Furthermore, since Offices need to be convinced that quality patents would be granted, it is important to provide them with an option not to participate in the PPH under Rule

52bis.1(b) and Rule 78bis.1(b). To ensure that more member countries will consider participation in the PPH, the JPAA agrees with the option prescribed in proposed 52bis.1(b): "(b) If, on [...], paragraph (a) is not compatible with the national law applied by the designated Office, the paragraph shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette."

PCT/WG/14/11 and PCT/WG/14/2 — Strengthening PCT Safeguards in case of General Disruption

The safeguards in case of general disruption is of great concern for the JPAA as a user of the PCT system. The JPAA appreciates constructive discussions on this issue among the member countries at PCT/WG/13.

The JPAA agrees with the amendment to include "epidemic" as an additional example of a situation of force majeure under Rule 82quater.1(a). This amendment does not mean that "epidemic" is not included in the scope of situations of force majeure currently provided in Rule 82quater.1(a).

The JPAA agrees with the proposed amendment to add Rule 82quater.1(d), which provides that: "The need for evidence may be waived by the Office, Authority or the International Bureau." The proposed new Rule 82quater.1(d) further provides that: "the interested party must submit a statement that the failure to meet the time limit was due to e.g., epidemic." The JPAA considers it desirable to make this provision consistent with Rule 82quater.1(b), in terms of the deadline for filing the statement, with a view to keeping a balance between the need to give relief to the interested party and the need to prevent unexpected detriment to a third party.

The document PCT/WG/14/11 states that the main practical advantage of proposed new Rule 82quater.3 is that parties would not be required to file requests or submit evidence. The JPAA considers it desirable from the perspective of user-friendliness to allow an extension without requiring any requests or evidence.

At PCT/WG/13, the US delegation expressed to the effect as follows. It is necessary to provide appropriate relief to applicants wherever possible, but an Office's waiver of any requirement for the submission of "evidence" was not a waiver of the fact that an applicant must have been affected by an event. Any applicant not affected by an event must continue to meet the time limits of the Treaty. In order to request relief, an applicant must submit evidence or a statement that the applicant has been affected by an event. It is unreasonable to make those not affected by an event eligible for relief. On the other hand, USPTO announced an extension of certain patent and trademark-related timing deadlines under the Coronavirus Aid, Relief, and Economic Security Act (CARES Act). Under the CARES Act, due dates between March 27 and April 30, 2020, were extended 30 days from the initial due dates, provided that the filing was accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak as

defined in the Act. Thus, the United States requires an applicant to make a statement that the applicant has been affected by an event in order to receive relief under its national law, the CARES Act, but it does not further require the submission of evidence.

In the meantime, proposed Rule 82quater.3(a) requires that a general disruption caused by an event affects the operations at the said Office, [...] thereby interfering with the ability of parties to perform actions before that Office, [...]. However, as the purpose of introducing new Rule 82quater.3(a) is to “provide” additional “safeguards protecting applicants' rights, including the restoration of the priority right, the excuse of delays or the extension of time limits under various circumstances”, JPAA believes that such safeguards should be provided regardless of the status of the operations at the Office as long as the ability of parties to perform actions before that Office is hindered. In fact, if the operations at the Office are affected, it is likely that the Office would be closed and Rule 80.5(i) be invoked.

The new Rule 82quater.3(c) provides that an extension granted in the international phase does not affect the procedures at the designated or elected Office. The JPAA considers that if the time limit for the entry into the national phase falls upon the period extended in the international phase, this must not interfere with the prompt grant of rights at the designated Office.

PCT/WG/14/12 — International Search Report Feedback Pilot

The Working Group is invited to: (i) note the contents of the current document; and (ii) comment on whether they see the development of a feedback service as beneficial to the PCT System.

The discrepancy between the ISR and the national phase examination is of great concern for the JPAA as a user of the PCT system. We understand that the creation of a feedback system would be very beneficial to the PCT system. We also understand that the feedback will be useful for the applicant as well if a national examiner should provide reasons as to why he or she had to find further prior art documents or had recategorized some citations found by the ISA. In this regard, we consider that the ISR feedback form provided as Annex I is carefully devised. It might be informative if statistics are available based on the feedback, e.g., what percentage of the prior art documents cited in the ISR is re-cited or disregarded in a national stage. In the meantime, we recognize that there may be some drawbacks. The national phase examination at an Office in a country might be influenced by the review regardless of the validity of the review, especially when the examiners of the Office are less experienced.

PCT/WG/14/14 — PCT Online Services & PCT/WG/14/2 — XML Search Reports and Written Opinions & PCT/WG/14/8 — Processing International Applications in Full-Text Format

According to Document PCT/WG/14/14, since the start of the COVID-19 pandemic, the International Bureau has suspended the transmission of documents on paper to applicants and Offices and encouraged the use of the ePCT and other means that do not rely on

postal services. Since before the pandemic, the International Bureau had requested that information from designated Offices and international search documents be delivered electronically. It has also been promoting the use of the eSEARCHCOPY and the use of the system that allows the transmission of application and other prosecution documents via the common server under its management. The electronic delivery of documents can not only resolve the problem of delay in postal delivery caused due to the pandemic but also enable the documents to be sent and received instantly, providing great convenience to PCT users. The electronic delivery of documents also serves for infection control as it can eliminate obstacles faced by teleworker and remote workers. In view of these benefits, the JPAA supports the initiatives carried out by Offices in connection with PCT Online Services.

In conjunction with this, it is desirable that documents to be electronically delivered should include machine-readable text data, instead of PDF files of scanned data. According to Document PCT/WG/14/2, nine Authorities delivered search reports and written opinions in XML format, and additional Authorities are expected to start doing so in the future. The use of XML format will facilitate machine translation to multiple languages and provision of links to cited documents. Some Authorities request that the International Bureau should provide technical support, such as an editing tool, and cooperation for training upon the implementation of search reports and written opinions in XML format. Most PCT applications filed from Japan are prepared in XML format, so it would be more convenient for users if XML format is used for search reports and written opinions. Therefore, the JPAA agrees with the implementation of search reports and written opinions in XML format.

Document PCT/WG/14/2 also concerns the XMLization of the PCT related documents. According to this document, to encourage more filing of full-text applications, the International Bureau will make its DOCX converter and full-text comparison tools available to all IP Offices through web services. If PCT international applications are filed in XML format, the application document data can be used as it is for subsequent procedures, such as international search and international publications, which is conducive to enhancing operational efficiency. The JPAA supports the initiative by the International Bureau to encourage the filing of PCT international applications in XML format.

#### *PCT/WG/14/16 — Certified Copies of Earlier International Applications*

It is proposed that record copies of international applications be used as the basis of certified copies in the case where the international application is used as the basis of a priority claim in a later application. The JPAA hopes that the proposal will be discussed constructively and realized for the convenience of applicants.