

JAPAN PATENT ATTORNEYS ASSOCIATION
3-4-2, Kasumigaseki Chiyoda-ku, Tokyo 100-0013, JAPAN
Telephone: + 81-3-3581-1211 / Facsimile: +81-3-3581-9188
<http://www.jpaa.or.jp>

Mr. Francis Gurry
Director General of World Intellectual Property Organization,
34, chemin des Colombettes
CH-1211 Geneva 20, Switzerland

September 28, 2020

Subject: Invitation to the rescheduled thirteenth session of the Patent Cooperation Treaty (PCT) Working Group

Dear Mr. Gurry,

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 reschedule the meeting in order to move forward the discussion on various important issues. Therefore, we deeply regret that the delegates of JPAA are unable to attend the meeting this time in-person or online. The JPAA is very much looking forward to seeing the world overcome COVID-19 and attending in-person the next session of the PCT Working Group in 2021.

In the meantime, the JPAA appreciates 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/13/2 Rev. — Meeting of International Authorities Under the PCT: Report of the Twenty- Seventh Session

The Working Group is invited to note the Summary by the Chair of the twenty-seventh session of the Meeting of International Authorities under the PCT (document PCT/MIA/27/16). Among various topics, the JPAA as a user of the PCT system especially notes the topic entitled “Appointment as an International Searching and Preliminary



Examining Authority (ISA/IPEA) and Declaration by Receiving Offices as Competent ISA/IPEA.”

The JPAA would like to express some concerns about the proposal introduced by the Indian Patent Office, which sought to offer more free choice to applicants — a choice for the applicant to freely select an International Searching and Preliminary Examining Authority (ISA/IPEA) regardless of the receiving Office. Firstly, there may be the issue of forum shopping unless the quality of search and examination of all the ISA/IPEA is standardized. Some applicants might be willing to select an ISA/IPEA that features high quality search and examination and provides valuable information for determining whether or not the international application should enter into the national phase of a particular country. Other applicants, however, might be inclined to select an ISA/IPEA that has insufficient search and a tendency to inadvertently acknowledge the patentability of an invention. This might cause a serious problem to the third party and ultimately result in the loss of trust in the PCT system. Secondly, there may be an issue of quality and workload, as already pointed out in the document. The applicant will be put in a difficult position if the quality of ISR/IPRP is poor or the dispatch of ISR/IPRP is delayed due to heavy workload on the overly selected ISA/IPER. We appreciate that some effective frameworks for quality control among ISAs, e.g. those discussed in the document PCT/WG/13/5, would be needed in order to realize free choice for the ISA/IPEA by the applicant. Thirdly, there may be an issue of national security clearance. Several countries impose a duty on their nationals or residents to file an application for patent in their country first, and to subsequently obtain national security clearance from the authorities for filing the application in a foreign country. Failure to comply with such provisions is treated as a criminal offense. The PCT system might be unnecessarily complicated if one tries to solve this problem.

PCT/WG/13/4 Rev. — Review of the Supplementary International Search System

The Working Group is invited to: (i) comment on the issues related to supplementary international search raised in this document; and (ii) consider the draft recommendations to the Assembly, set out in paragraphs 21 and 22. The JPAA in an observer capacity would like to comment on the issues related to supplementary international search raised in the document.

Obviously, the vast majority of the applicants who do not utilize the supplementary international search would not be affected by the decision. In the meantime, it is also clear that supplementary international search was, is, and will be needed by certain applicants even though the number of requests for supplementary international search is relatively small compared to the number of international applications *per se*. The development of the ePCT system should not leave those applicants behind merely because of the IT development-related costs. Such costs can be significantly reduced in the future with the advancement of IT. Thus, it would be sensible if the actual users of the supplemental international search are consulted with in order to hear their opinions. Practically, the JPAA would like to support the first option to maintain supplementary international search and review the system again, especially in view of the evaluation of PCT Collaborative Search and Examination (CS&E) Pilot Project.



PCT/WG/13/5 Rev. — 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 are re-cited or disregarded at the 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 its validity, especially when the examiners of the Office are less experienced.

PCT/WG/13/8 — Sequence Listings – Implementation of WIPO Standard ST.26

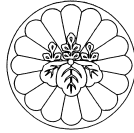
The Working Group is invited to comment on the proposed amendments to the Regulations set out in the Annex to this document.

The JPAA as a creator and user of sequence listing files would like to support the proposed amendments to the Regulations. We consider that the WIPO Standard ST.26 and the proposed amendments are user-friendly. We also note that the use of XML will greatly facilitate the utilization of the sequence information by the general public. As the date of transition from ST.25 to ST.26 is rapidly approaching, we would greatly appreciate it if the task force continuously provides detailed information.

PCT/WG/13/10 — Strengthening PCT Safeguards in Case of General Disruption

The document is submitted by the European Patent Office, France, Switzerland and the United Kingdom. The safeguards in case of general disruption are of great concern for the JPAA as a user of the PCT system.

The JPAA would like to support the proposal by the European Patent Office to amend the PCT Regulations by introducing a new rule, Rule 82*quater*.3, which would explicitly allow an Office to extend PCT time limits in the case of extraordinary circumstances for a defined period. We also support the proposal to amend Rule 82*quater*.1 by including a new paragraph, (d), giving the possibility for Offices to waive the requirement to submit evidence.



Such remedies initiated by Offices would be very helpful in the case of general disruption. In the meantime, we would like to note that the proposal would be even more user-friendly if the new rule, Rule 82^{quater}.3(a), does not include the passage “*in particular where the national law applicable by that Office or Authority provides, in respect of national applications, for a comparable extension of time limits.*”

[End of our comments on the meeting documents]

We hope that this proves useful for the future development of the PCT system.

Thank you for the opportunity to comment on the meeting documents.

Sincerely,

Yoshihiro SHIMIZU
President, JPAA