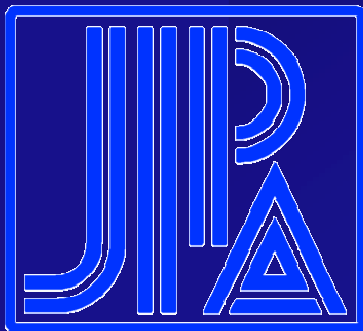


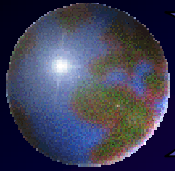
Topic4
Effective Use of the PCT System:
User's Perspective

May 16, 2012



Daisuke Nagano
Vice-Chairperson of International Committee #2
Japan Intellectual Property Association

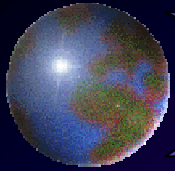
Creating IP Vision for the World



Contents

- 1. Introduction*
- 2. Trend of JP users' behavior as to PCT utilization*
- 3. Advantageous points in PCT system*
- 4. Limitations(?) in current PCT practice*
- 5. Expectations for PCT and emerging countries in the future*



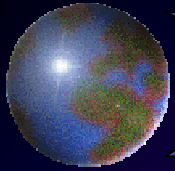


1. Introduction



-世界から期待され、世界をリードするHPA-
Creating IP Vision for the World

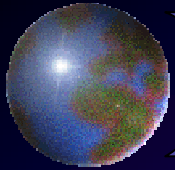




What is “JIPA?”

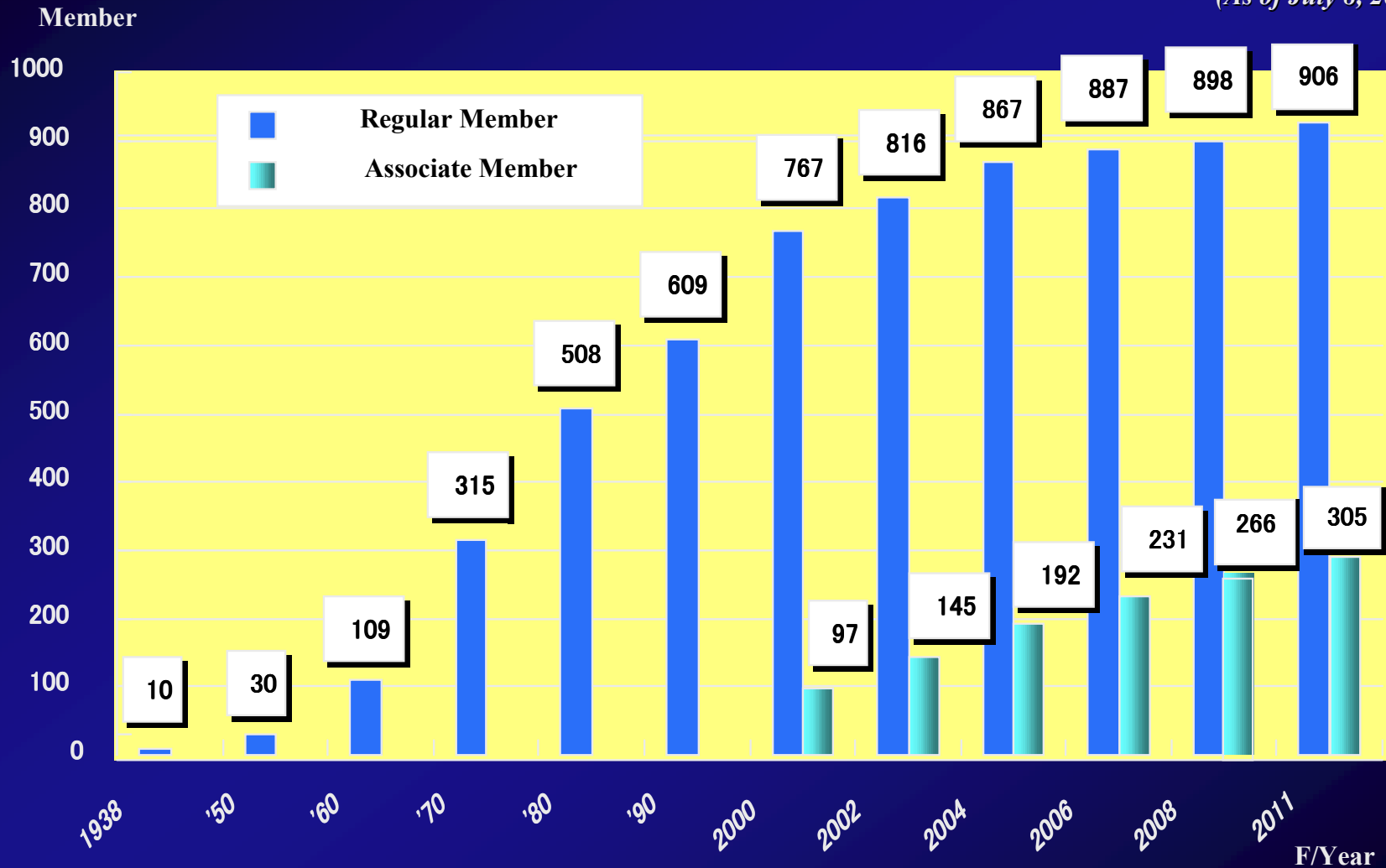
JIPA (Japan Intellectual Property Association) is
Nongovernment,
Nonprofit and
Largest intellectual property rights (IPRs)
users’ organization in the world





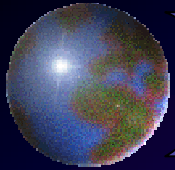
Transition of JIPA Membership

(As of July 8, 2011)

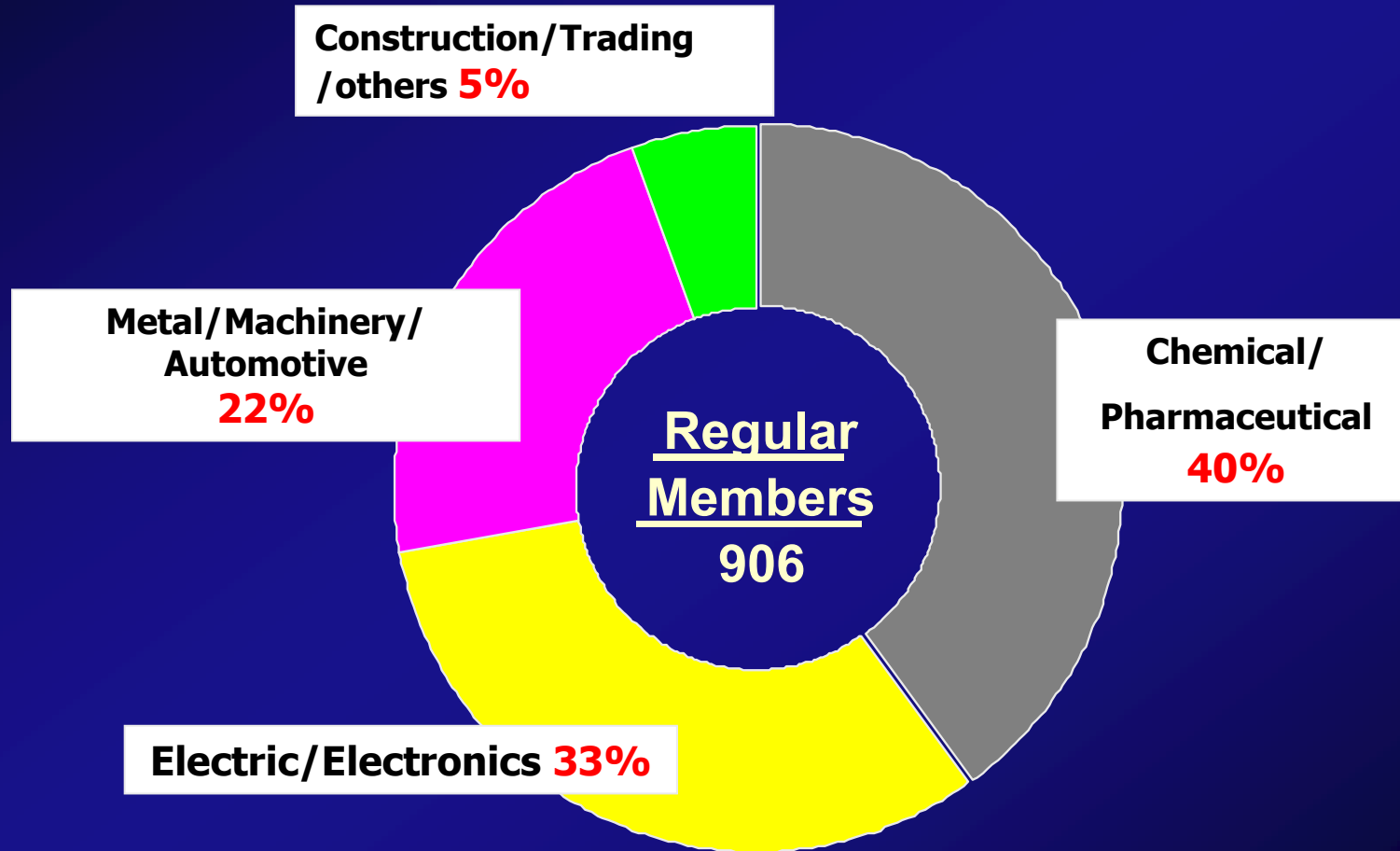


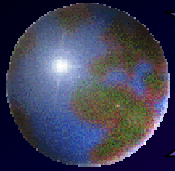
-世界から期待され、世界をリードするIPA-
Creating IP Vision for the World





Composition of JIPA Regular Members





Main Activities of JIPA

1. Policy & Strategy Project & Special Committee Activities

(4 Projects & 3 Committees)

- ☞ Strategic Studies and Researches on Offer of IP Policy

2. Standing Committee Activities

(20 Committees, 701 Members -'10)

- ☞ Professional Studies and Researches → Feed-back to JIPA Members
- ☞ Offering JIPA's Opinions and Suggestions to Outside Communities.

3. Training Activities

(78 Regular Courses, 12 Extraordinary Courses, 2 Overseas Courses, IP Leader Course, Strategic Staff Course & Junior Expert Course, Total: 13,002 Trainees -'09)

- ☞ IP Education / Training to Employees of JIPA Members.

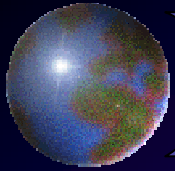
4. Publication

- ☞ Monthly Bulletin (3,850 Circulation), Investigation & Study Reports

5. Others

- ☞ Communication/Coordination with various IP Related Institutions and **Organizations.**



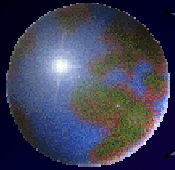


*“What is present state of PCT and
JP users ?”*

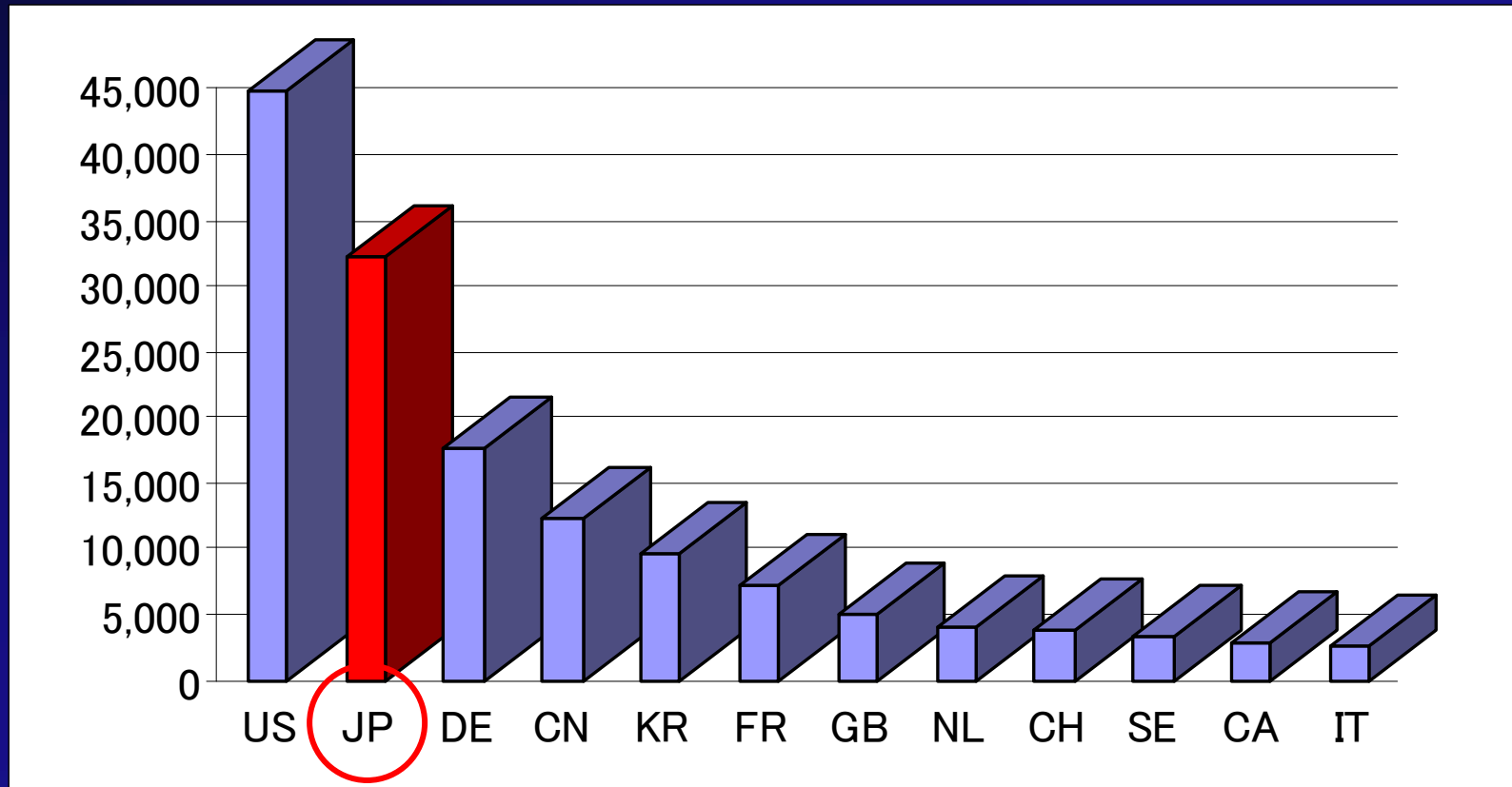


-世界から期待され、世界をリードするJIPA-
Creating IP Vision for the World



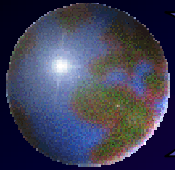


Number of PCT Filings by Country of Origin in 2010

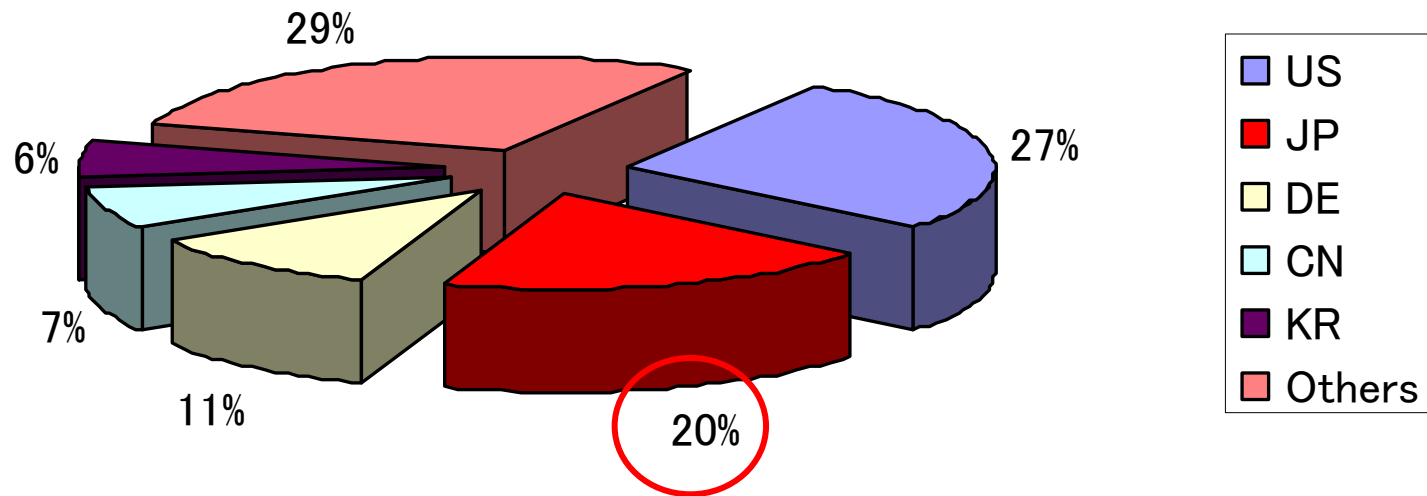


Source : WIPO



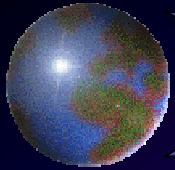


Distribution of PCT application by country of origin

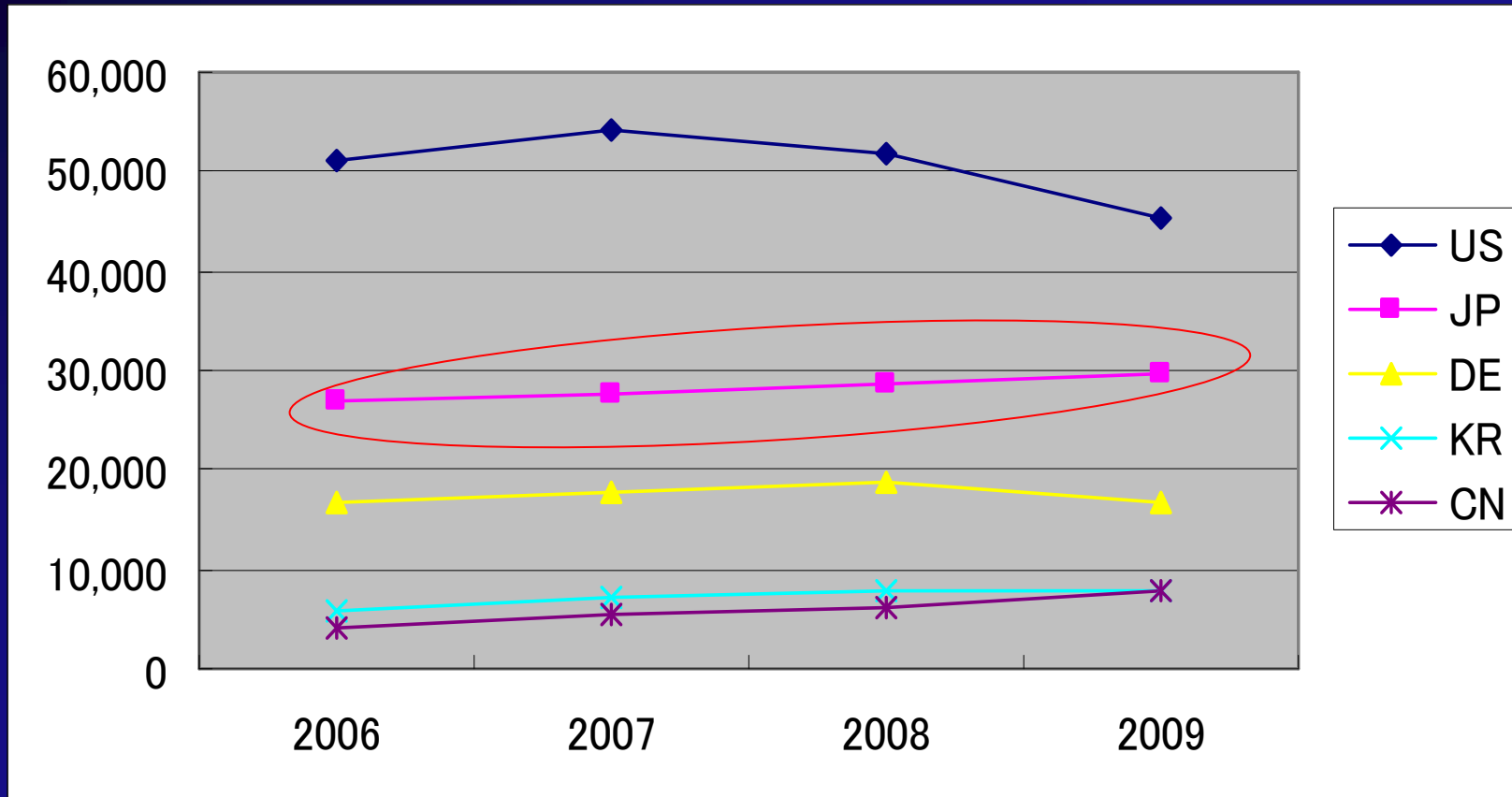


Source : WIPO



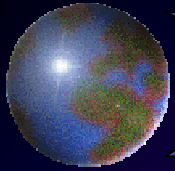


Distribution of PCT application by country of origin



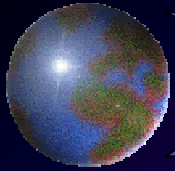
Source : WIPO





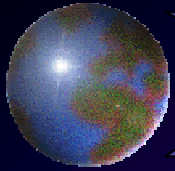
2. Trend of JP users' behavior as to PCT utilization





*“What do JP users actually consider
on PCT utilization ?”*

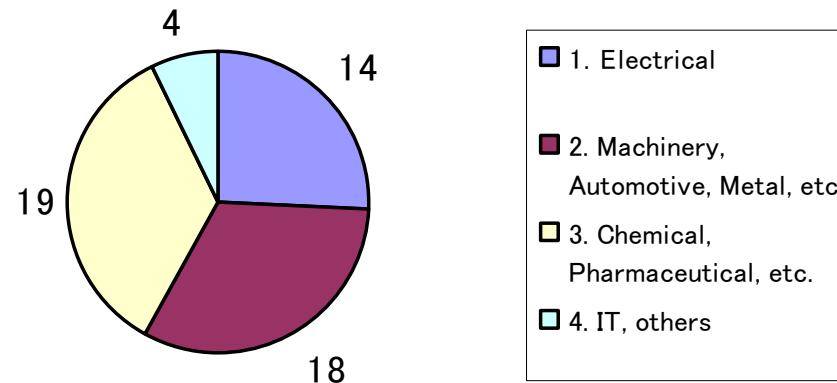


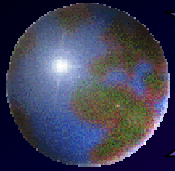


Questionnaire Survey as to utilization of PCT (2011)

- Purpose of the survey:
 - ✓ To know how JIPA member companies use PCT
- # of companies which answered: **55 companies**

Industry types (2011)



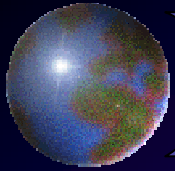


Questions to member companies (Category 1)

As to patent obtaining activity,

- ❖ *Rate of foreign patent filings*
- ❖ *Rate of using PCT in the foreign patent filings*
- ❖ *Reasons for using PCT*
- ❖ *Reasons for NOT using PCT*



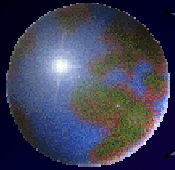


Questions to member companies (Category 2)

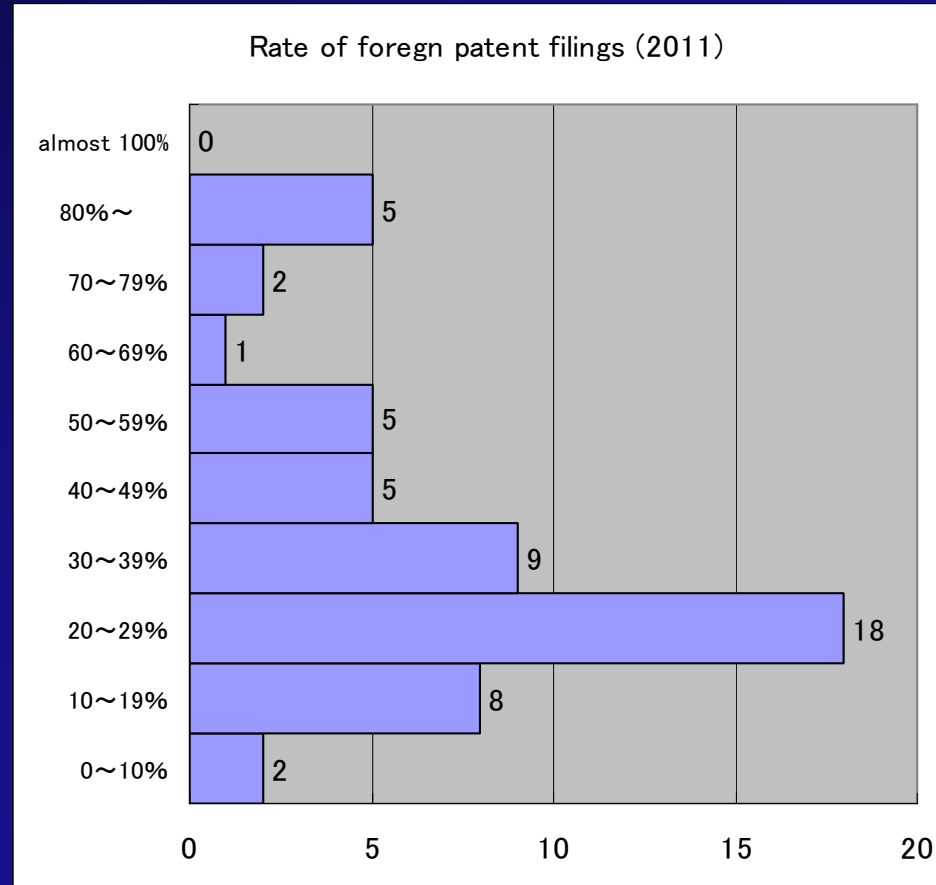
As to patent obtaining activity in emerging countries,

- *Major route for filing patent applications:
- Paris or PCT?*
- *Reasons for using PCT*
- *Reasons for NOT using PCT*
- *ISR and national examination in emerging countries*



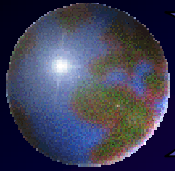


Rate of foreign patent filings

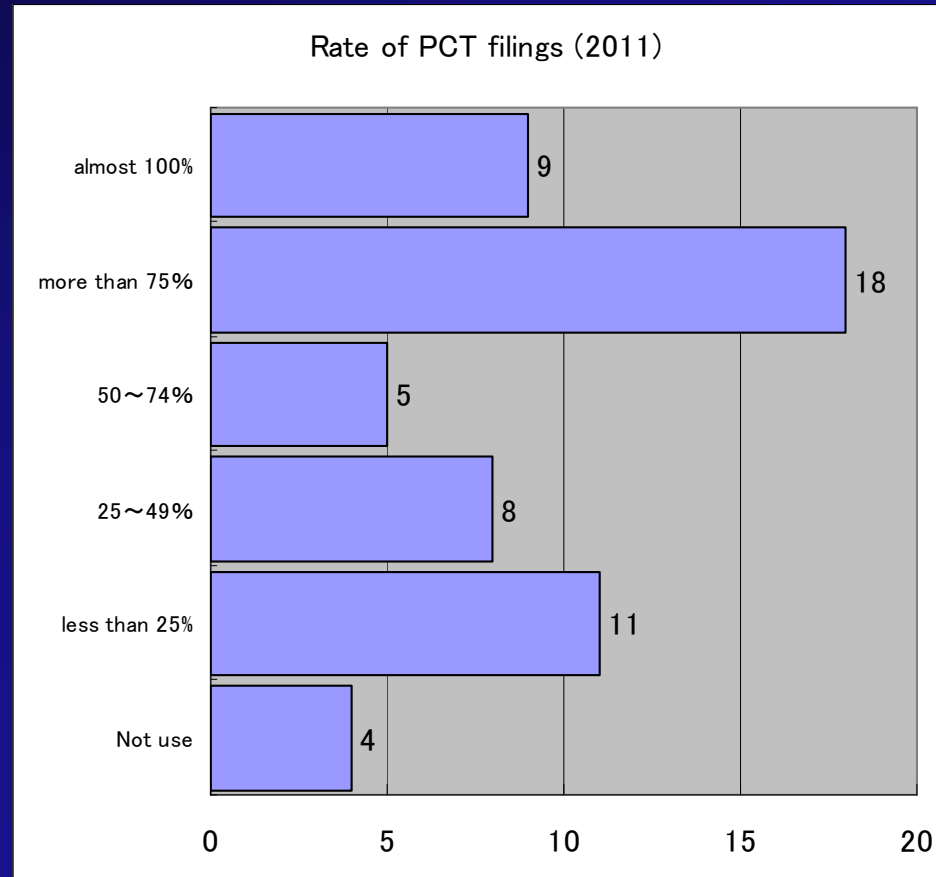


There are many companies filing foreign patent applications for 20-40% of the original inventions.



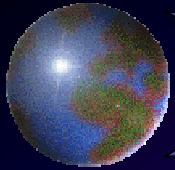


Rate of using PCT in the foreign patent filings

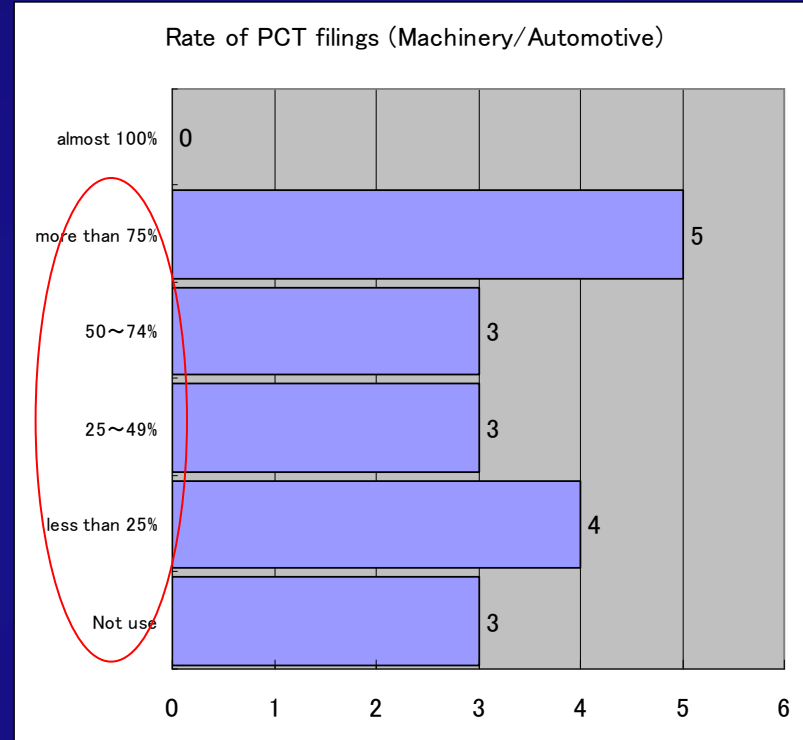
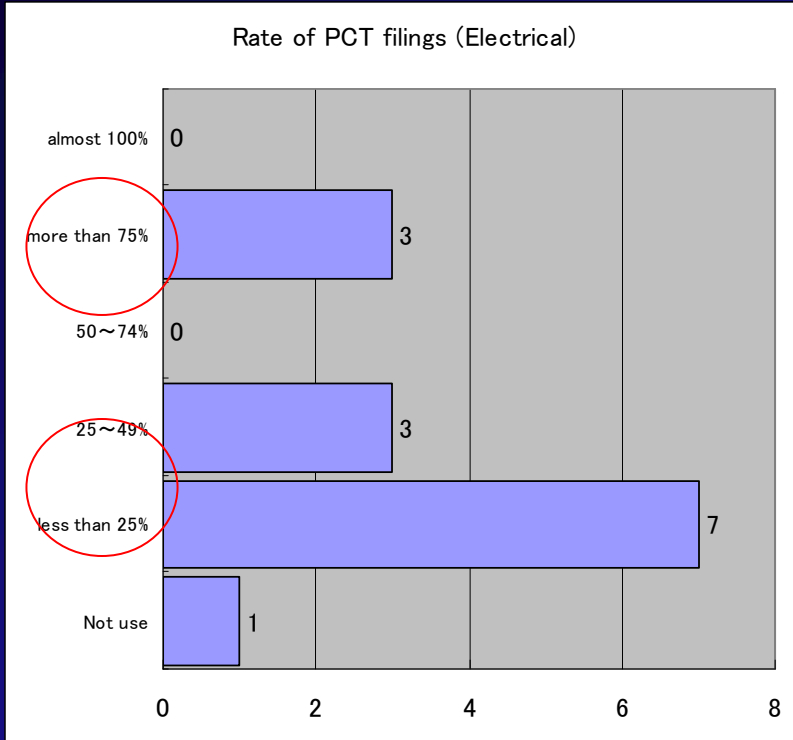


There is a wide range of variety in use of PCT.





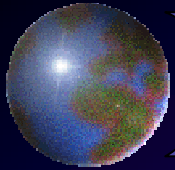
Rate of using PCT (Electrical, Machinery/Automotive)



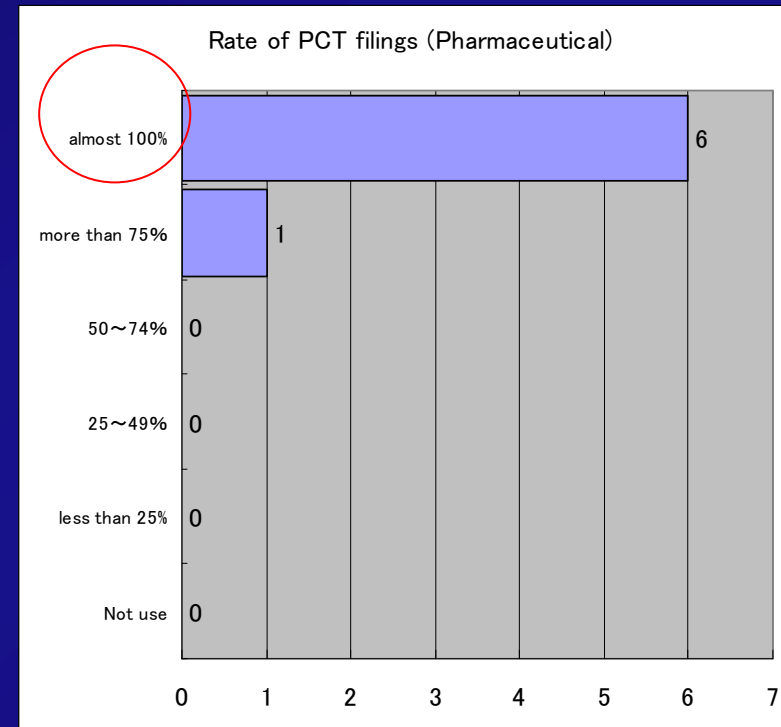
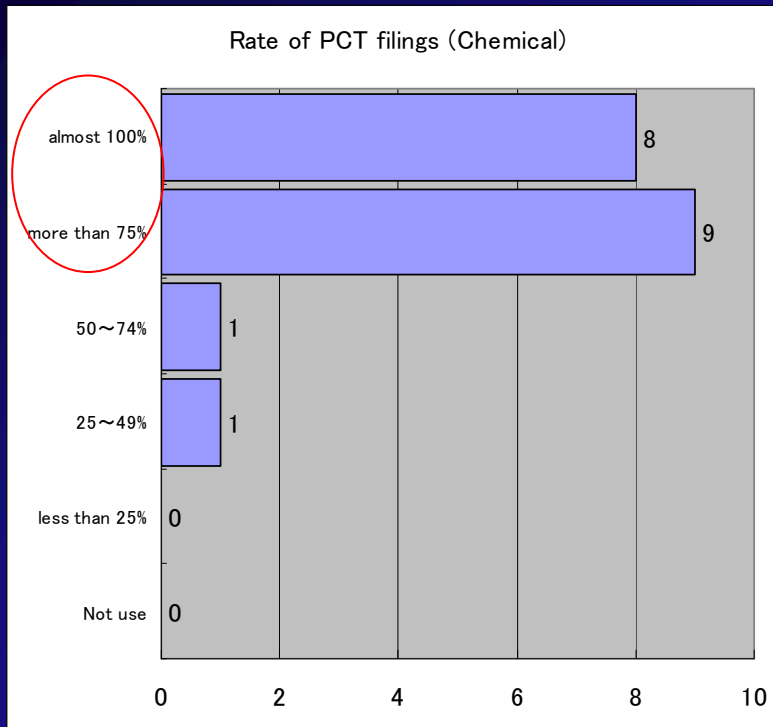
Electrical:
"Bipolarization"

Machinery/Automotive:
"Wide range of variety"



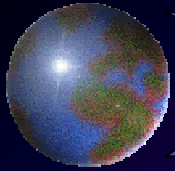


Rate of using PCT (Chemical, Pharmaceutical)



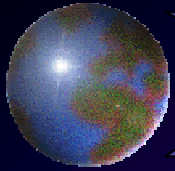
Chemical, Pharmaceutical :
”Major route for obtaining patents”





3. Advantageous points in PCT utilization



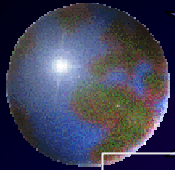


“Why do JP users often use PCT?”



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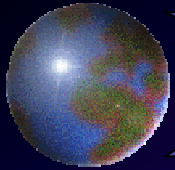




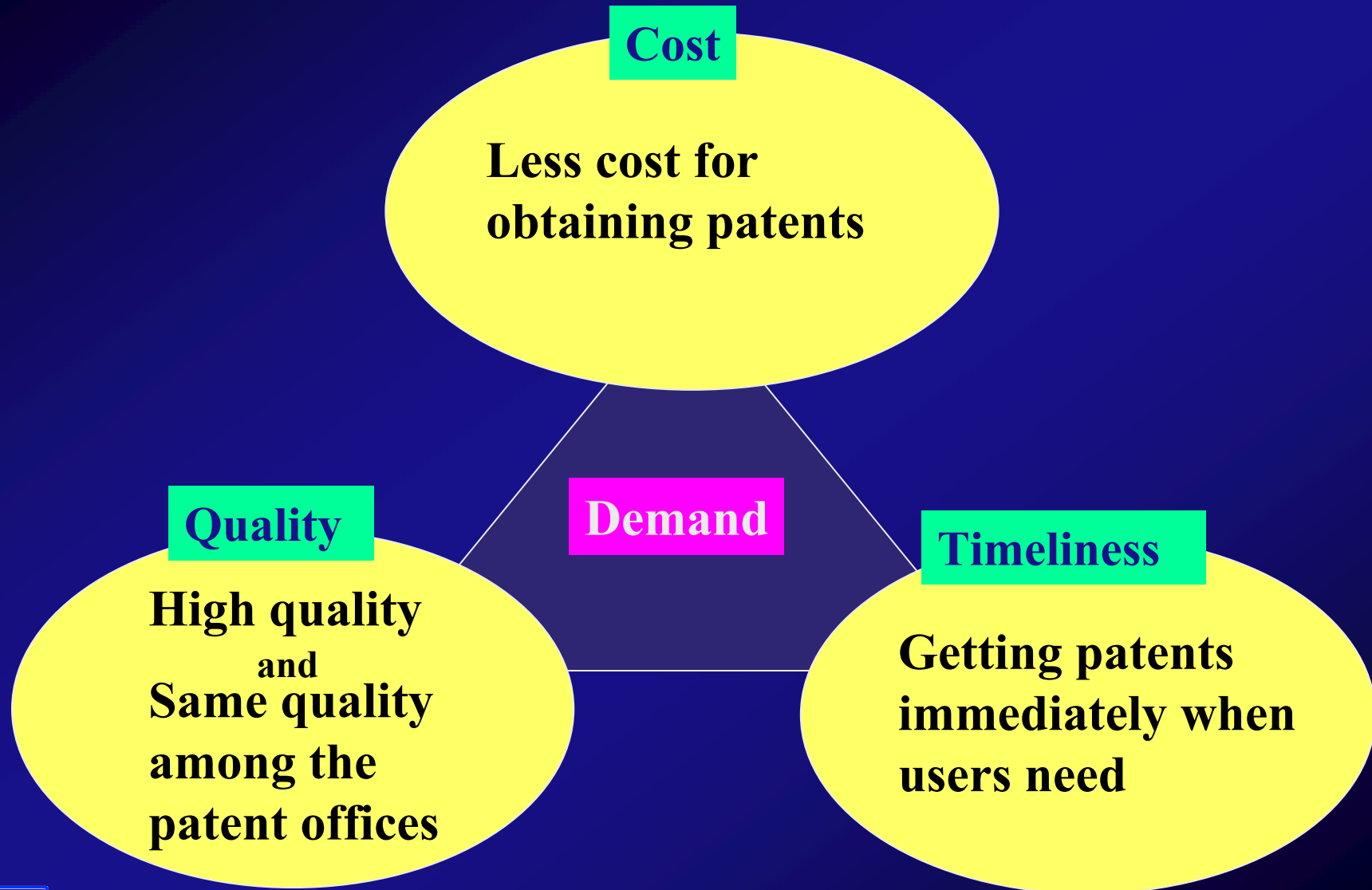
(Textbook tells us) PCT system has the following features:

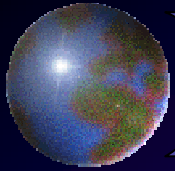
- By filing "one" application with "one" receiving office, the PCT application is treated as "national application" filed on the international filing date in each member country.
- User can file the PCT application with his/her familiar language required by the receiving office.
- User can get "International Search Report" and (optionally) get "International Preliminary Report on Patentability" to predict patentability in each designating office.
- User can amend claims and specification during international phase, if necessary.
- Before the expiration date of 30 months from the priority date, user has to enter the national phase including submission of necessary translation and fee.
- -----





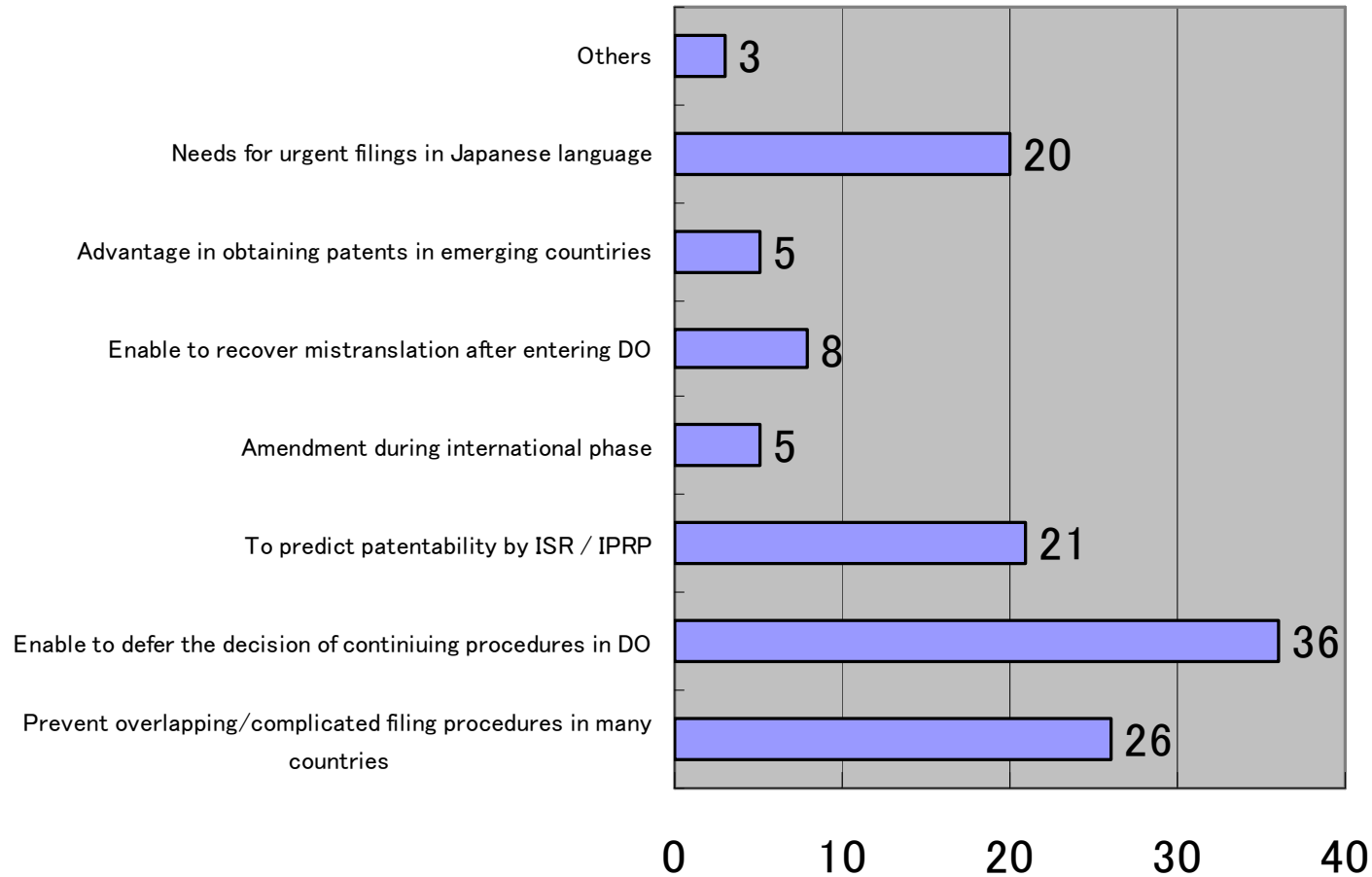
Basic demands of JP users for obtaining foreign patents

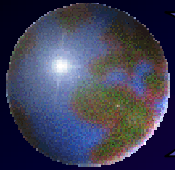




Why do JP users use PCT?

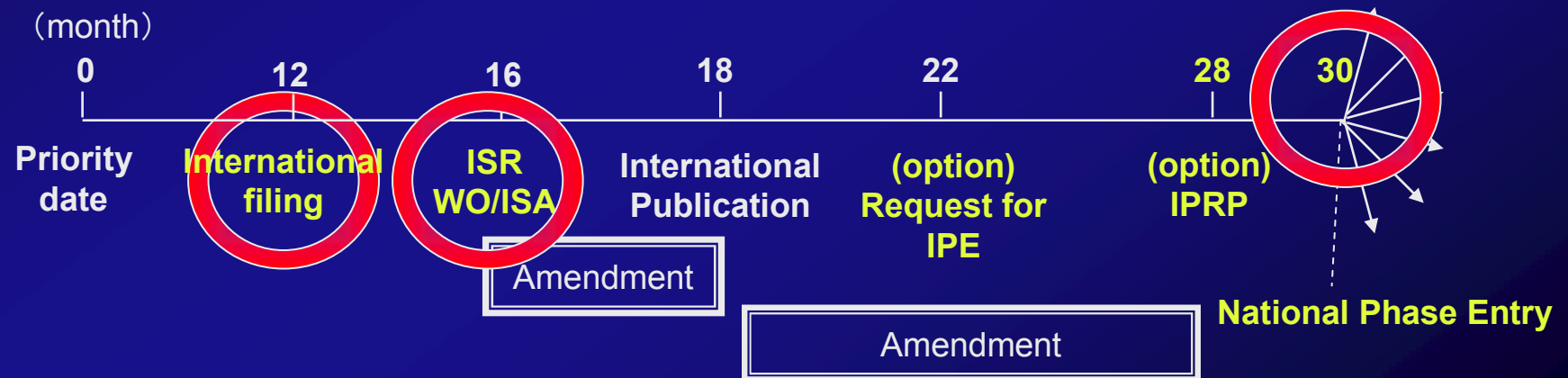
Reasons for using PCT (2011)

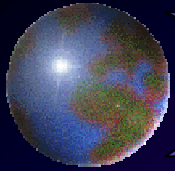




Major 3 reasons for using PCT from the survey

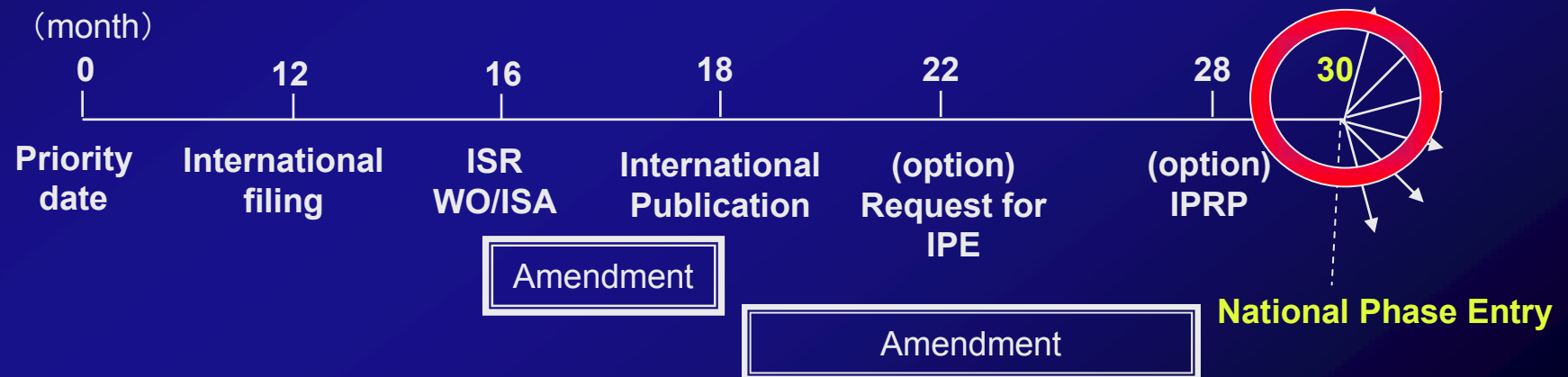
1. Term before entering National Phase (30 months)
2. Simplification of Filing Procedure
3. International Search Report (and IPRP)

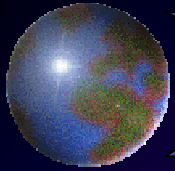




Major 3 reasons for using PCT from the survey

1. Term before entering National Phase (30 months)
2. Simplification of Filing Procedure
3. International Search Report (and IPRP)





1. Term before entering National Phase (30 months)

- Assessing the value of invention

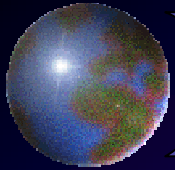
- ✓ Business strategy / R&D strategy

- Under “first to file” system, users can adjust their strategies in response to the changing situation after filing.

- ✓ Patentability

- Users ascertain it based on ISR (WO/ISA) & IPRP(Ⅱ)

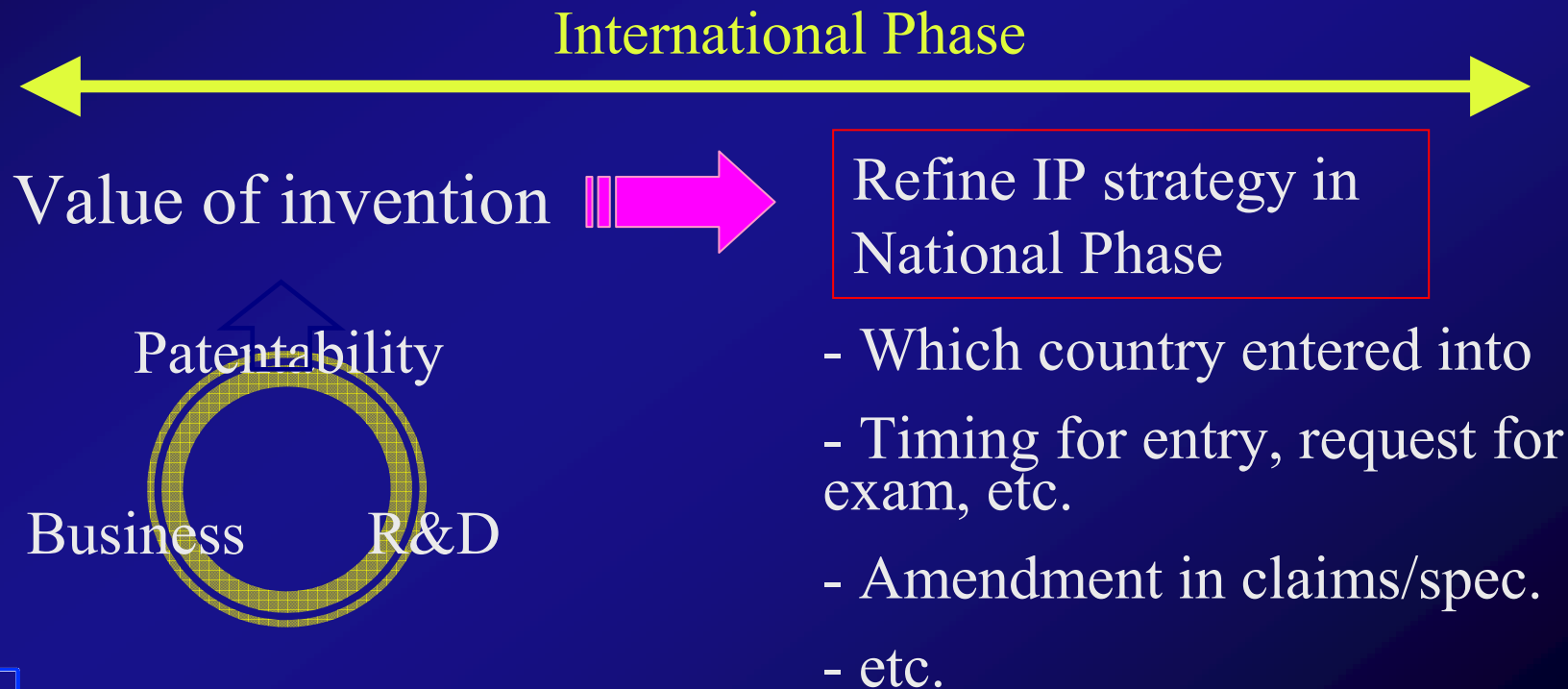


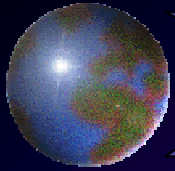


1. Term before entering National Phase (30 months)

● Assessing the value of invention (cont.)

- ✓ Users can also refine the strategies before entering National Phase



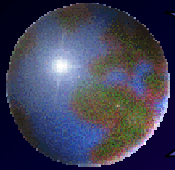


1. Term before entering National Phase (30 months)

● Preparation for translation

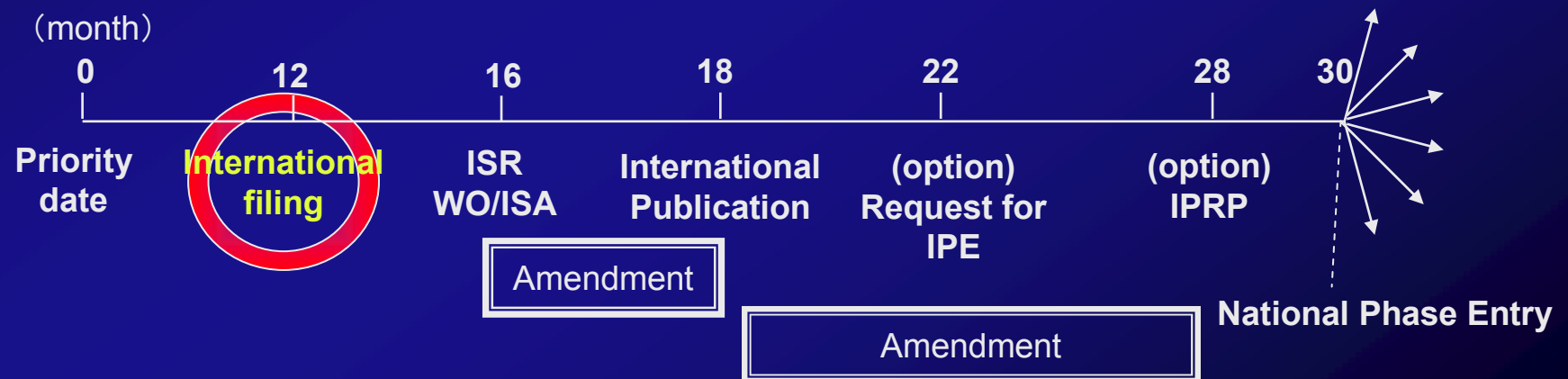
- ✓ Users have enough time to translate from Japanese to English or a third language (through English) in International Phase
- ✓ Users can save cost for translation, because they can select countries entered into based on the value of invention

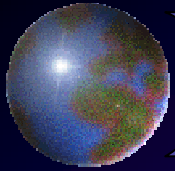




Major 3 reasons for using PCT from the survey

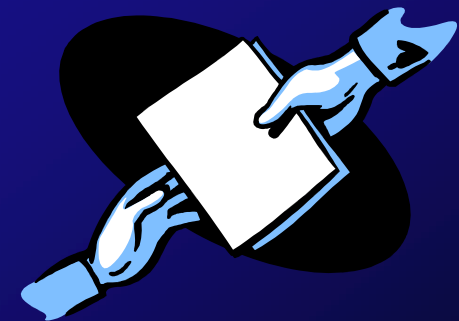
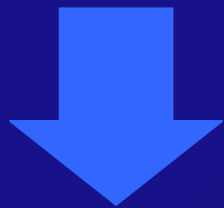
1. Term for entering National Phase (30 months)
2. Simplification of Filing Procedure
3. International Search Report (and IPRP)





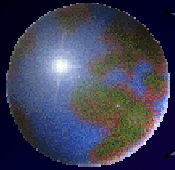
2. Simplification of Filing Procedure

- Easy to file PCT application
 - ✓ Simplification of filing procedure under “first to file”
 - One set of documents
 - One Receiving Office, One Formality Examination
 - One Language : Japanese



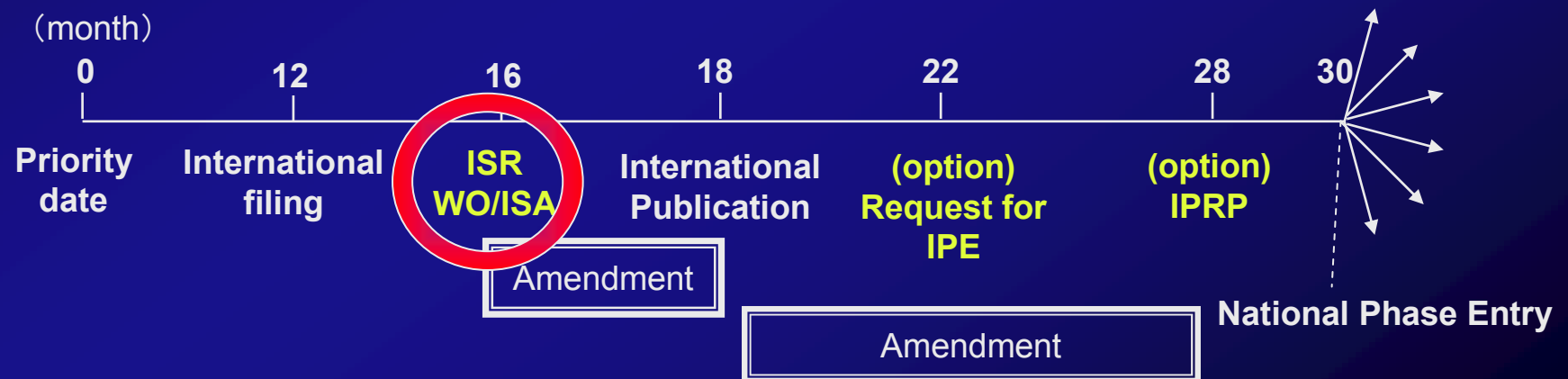
- ✓ PCT International Filing Date = National Filing Date
(§ 11(4))

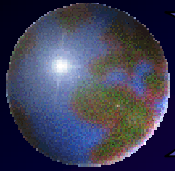




Major 3 reasons for using PCT from the survey

1. Term for entering National Phase (30 months)
2. Simplification of Filing Procedure
3. International Search Report (and IPRP)

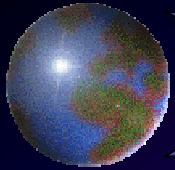




3. International Search Report (and IPRP)

“How effective is ISR (and IPRP) as predicting tool for Patentability in DO ?”





Prediction of patentability by ISR (from JIPA study in 2010)

ISR

特許出願書以外の資料で調査を行った分野に属するもの

日本国特許庁データベース	1992年-1998年
日本国特許庁データベース	1971-2003年
日本国特許庁データベース	1994-2003年
日本国特許庁データベース	1994-2003年

国際調査で利用した電子データベース (データベースの名称、調査に利用した期間)

CAJZD, [1994/04/01]

引用文献の カテゴリ	引用文献名	及び一部の発明が明瞭なときは、その明瞭化する箇所の表示	関連する 請求の範囲の番号
X	特 6-190144 A (エンター・カンパニー)		1-7
V	1994.07.12, 没落【0026】-【0030】、第7図		9-13
A	& US 525339 A, 第5欄, 第6-80行, 第7図		14, 15
Y	特 11-510891 A (エイアイ・アンド・エム・インコーポレイテッド)		9-13
	1999.09.14, 請求項1, 第1図		
	& WO 1997/04842 A1		

この発明は以下の条件が認められる。 [] の場合、上マニエーに数字を別紙を添付

* 引用文献のカテゴリ

「A」特許に関連のある文献ではなく、一般的技術水準を示すもの

「B」国際出願日前の公開または特許であるが、国際出願日以降に公表されたもの

「C」優先権主張を行使する文献又は他の文献の発行日若しくは他の特別な理由を確定するために引用する文献 (優先権を付す)

「D」口説による開示、使用、展示等に開示する文献

「E」国際出願日前で、同一発明の主張の基礎となる公開

「F」特許に必要とされた文献

「G」国際出願日又は優先権主張に公表された文献であって、出願上予備するものではなく、発明の原理又は理論の理解のために引用するもの

「H」特許に関連のある文献であって、当該文献のみで発明の新規性又は進歩性が認められるもの

「I」特許に関連のある文献であって、当該文献と他の1以上の文献との、当業者にとって自明である組合せによって進歩性が認められるもの

「J」特許に関連のある文献

国際調査を完了した日 2010.10.2005 国際調査機関の名称 特許庁調査官 (他国のある職員) 2E 8990

国際調査機関の名称及び住所 日本国特許庁 (JIPA) 東京都千代田区千代田4番2号 電話番号 100-8518

特許庁調査官 (他国のある職員) 2E 8990 電話番号 03-3681-1101 内線 3119

様式PCT/ISA/210 (第2ページ) (2005年4月)

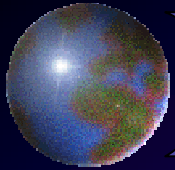
Same Claim

JPO
Notification
of Reasons
for Rejection

EPO
Examination
Report

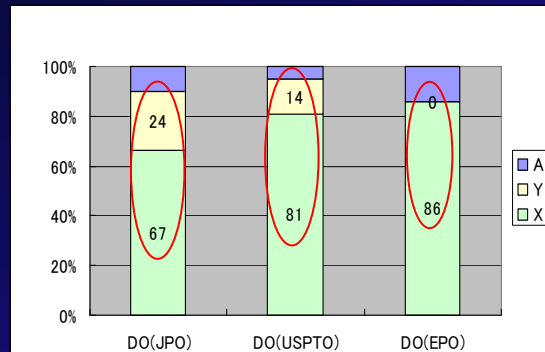
USPTO
Office
Action



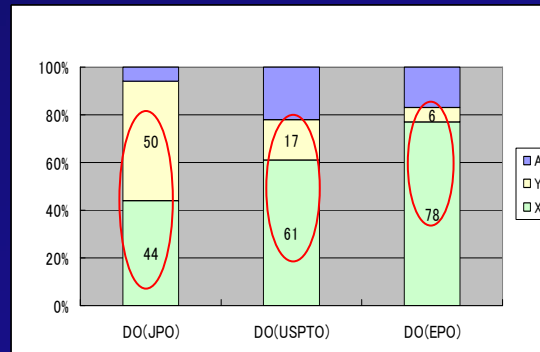


Prediction of patentability by ISR (Cont.)

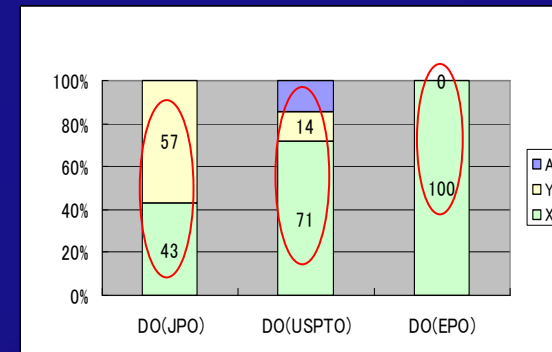
When the ISR indicated category "X"



ISR(JPO):X → JP, US, EP



ISR(EPO):X → JP, US, EP

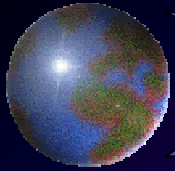


ISR(USPTO):X → JP, US, EP



When the ISR indicates category X, there is a high probability that each Designated Office will issue a rejection for lack of novelty and/or inventive step.



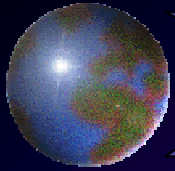


3. International Search Report (and IPRP)

- Saving cost and Reducing workload for corresponding OA in national phase

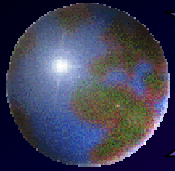
- ✓ ISR is an effective tool to find/eliminate claims lacking novelty before processing in each countries.
- ✓ Quit entering into national phase with unpatentable claims could eliminate wasting time and money.
- ✓ Possibly, amendments can be useful in international phase (§ 19, § 34)





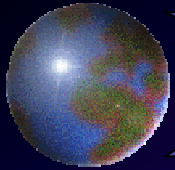
4. Limitations(?) in current PCT practice





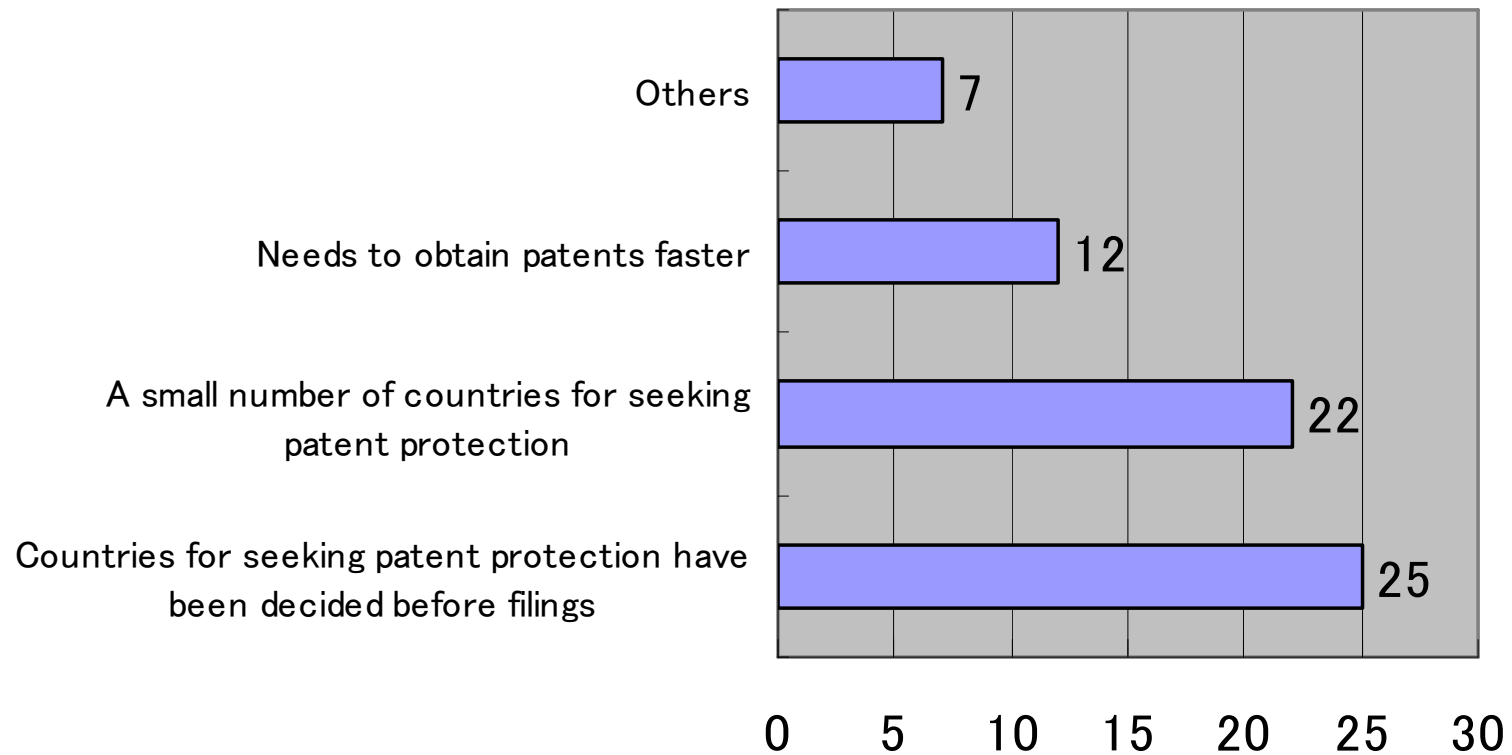
“PCT seems to be an ideal vehicle for users to seek patents in many foreign countries in view of the system, but ...”

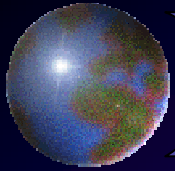




Why do JP users not use PCT?

Reasons for NOT using PCT (2011)



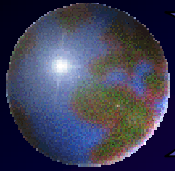


Limitations of PCT system (1)

- Cost

- ✓ It costs extra More than 1,000 USD in Official Fee compared to “Paris Convention Route”
- ✓ Furthermore it costs Attorneys Fee in International Phase
- ✓ Number of countries seems to be one of the keys(?)
- ✓ It is hard to evaluate the cost advantage in using PCT that much depends on various factors



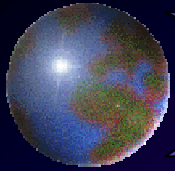


Limitations of PCT system (2)

- **Timeliness**

- ✓ It takes extra time before starting examination in DOs because of procedures in international phase.
- ✓ Even after entering into DOs earlier, it sometimes takes extra time for taking different process from normal national applications.





Limitations of PCT system (3)

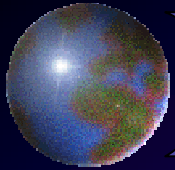
- ISR (IPRP) indicating category “A”

- ✓ New prior arts found in national phase examination
(Caused by the difference of Search and Examination process among ISAs and Dos)

- ✓ Users never know how each DO utilize ISR in its examination process.

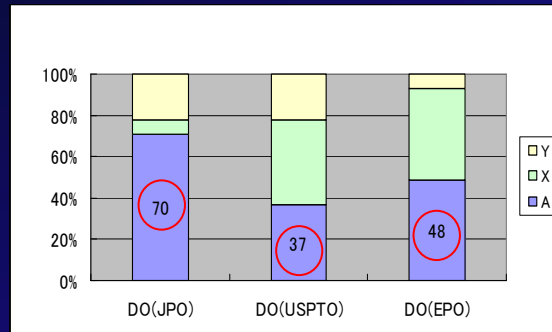
(Some applicants think the product of ISA or IPEA is not always helpful for them)



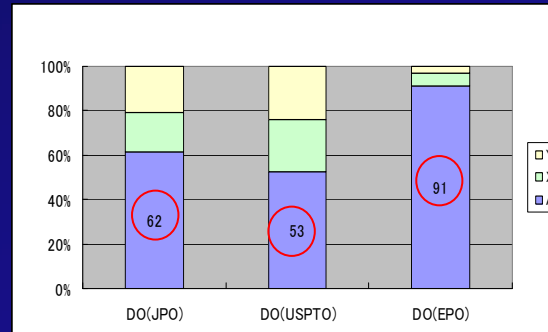


Limitations of PCT system (from JIPA study in 2010)

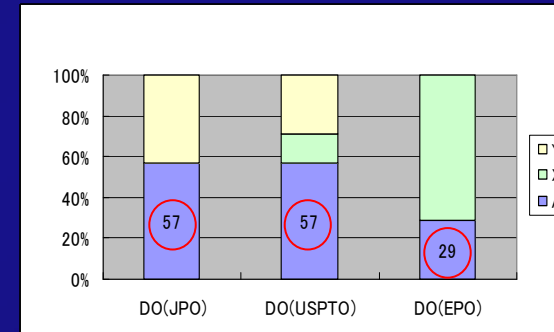
When the ISR indicated category “A”



ISR(JPO):A→JP,US,EP



ISR(EPO):A→JP,US,EP



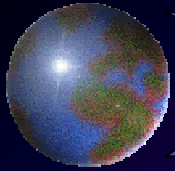
ISR(USPTO):A→JP,US,EP



When the ISR indicates category A, it does not always mean that those claims will be patentable in the National Phase examination.

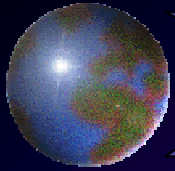
(Remark: JPO showed the similar study and results in Japan this year.)





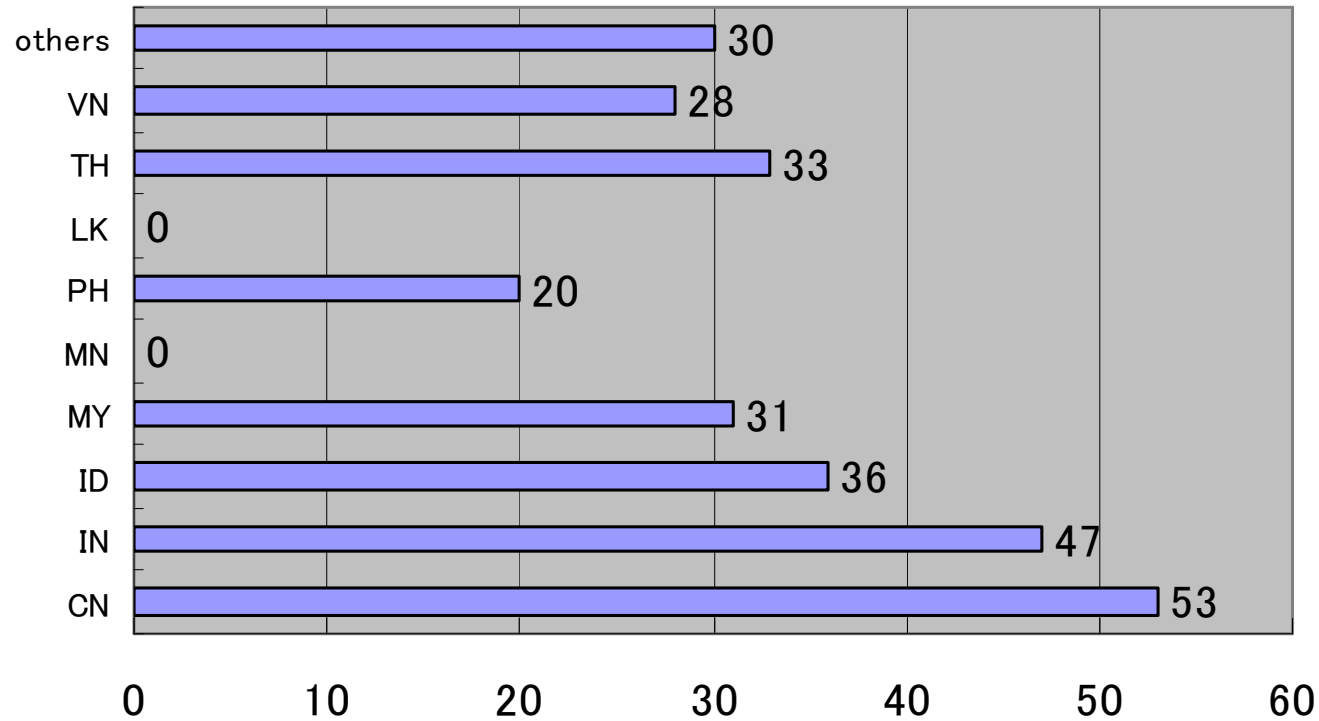
5. Expectations for PCT and emerging countries in the future





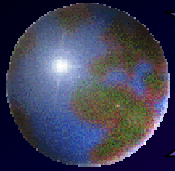
Patent filings in emerging countries by JP users

Countries JP users have ever filed except US, EP, KR



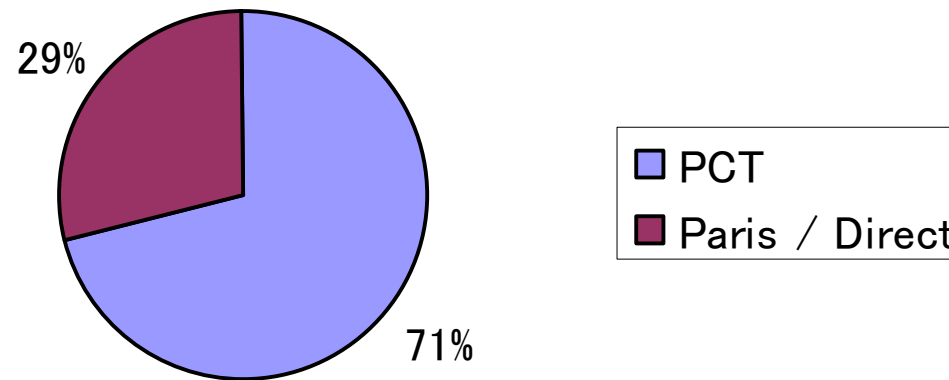
Obtaining patents in emerging countries is becoming more important for JP users





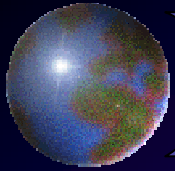
PCT use in emerging countries by JP users

Major route for filings in emerging countries



“PCT” is a major route for obtaining patents in emerging countries.



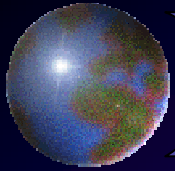


Question to JIPA member companies in the survey

Question (to JIPA member companies):

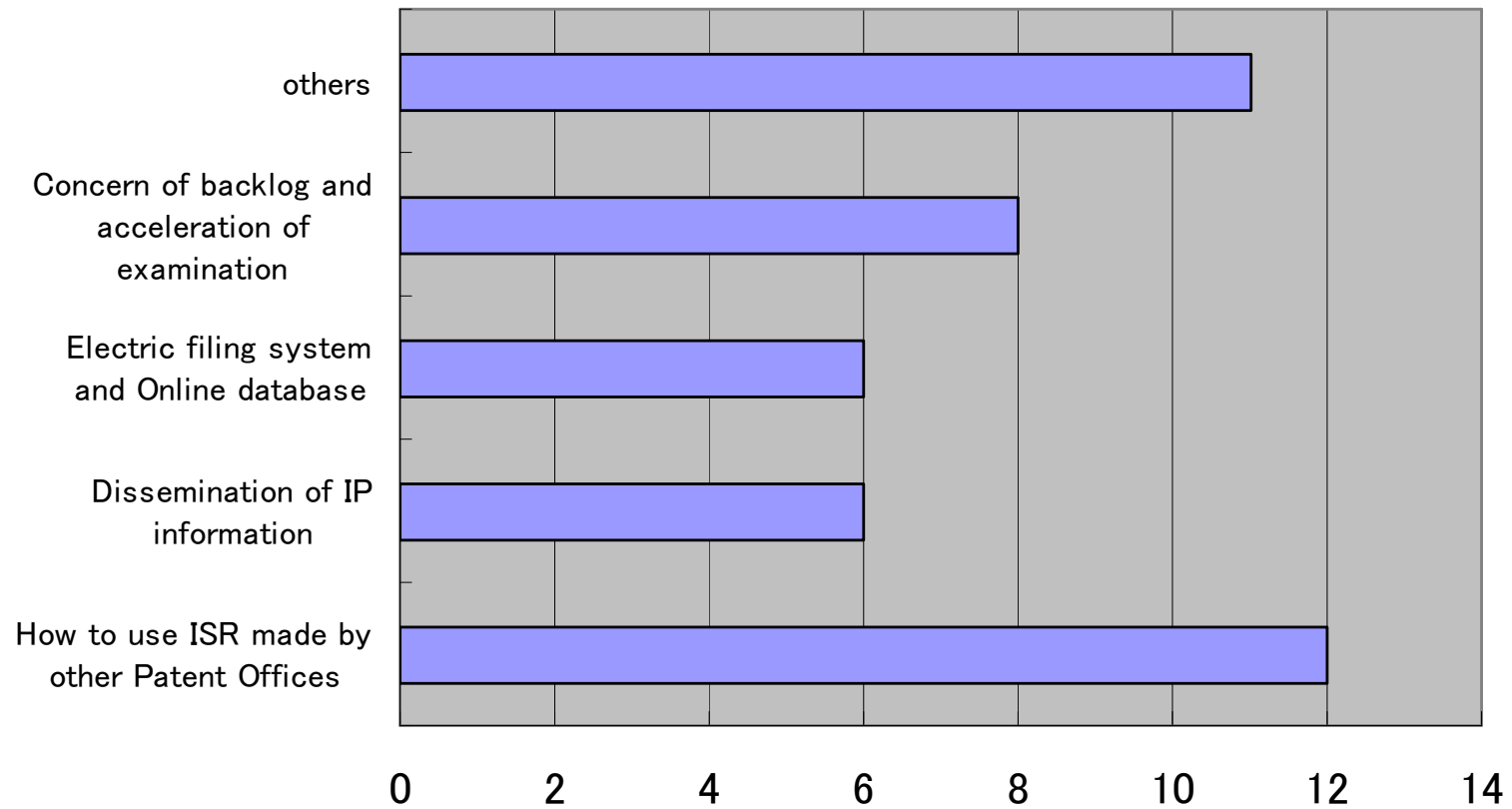
“Any requests or questions as to IP systems in emerging countries which attend this workshop meeting – China, India, Indonesia, Malaysia, Mongol, Philippine, Sri Lanka, Thailand, Vietnam?”

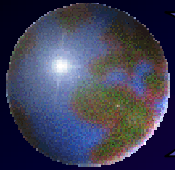




(Answers to the question in the previous page)

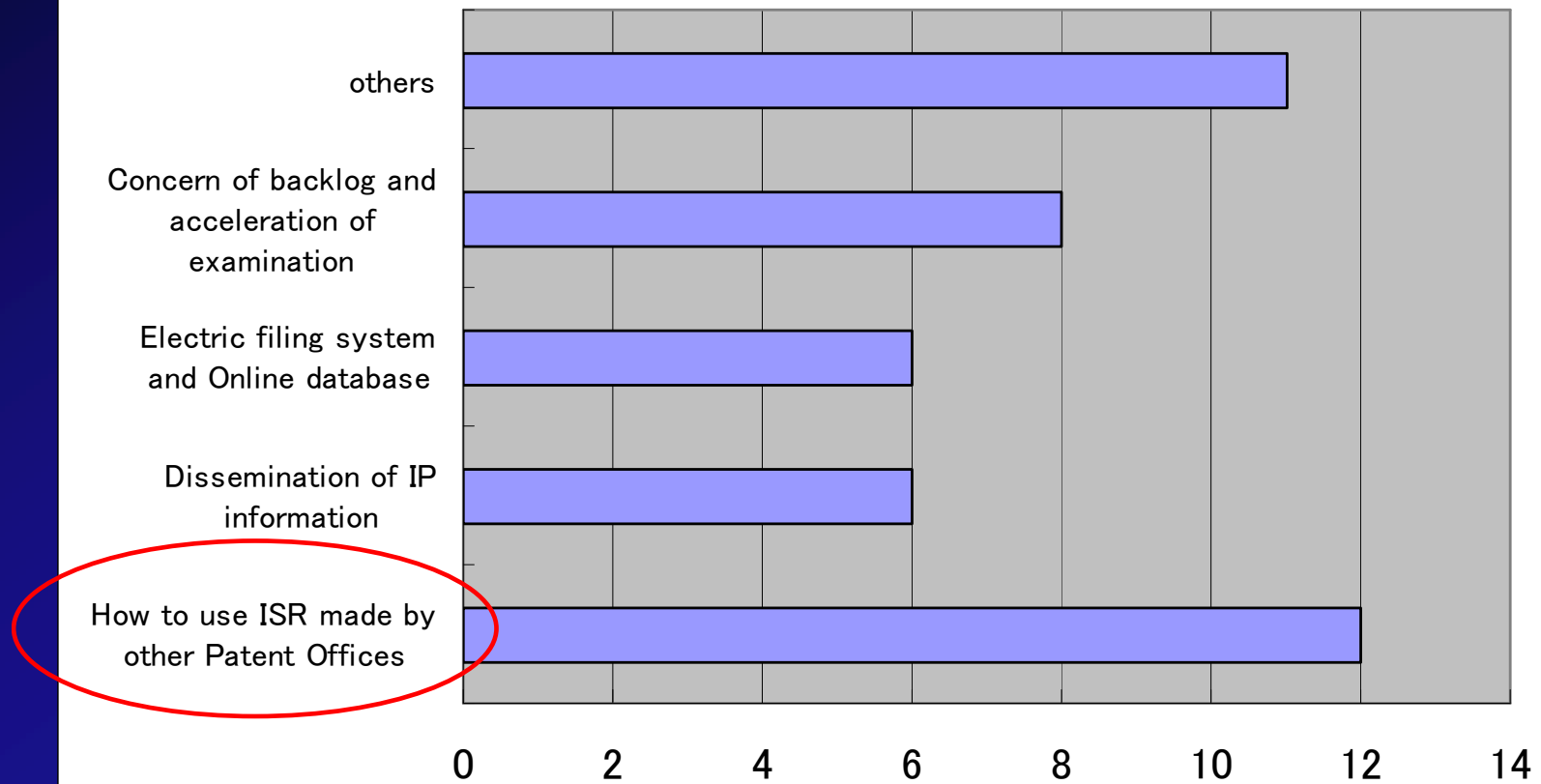
Requests/Questions as to IP systems in emerging countries

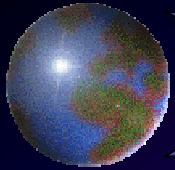




How to use ISR made by other patent offices

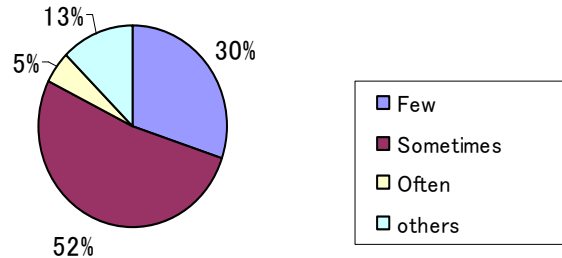
Requests/Questions as to IP systems in emerging countries



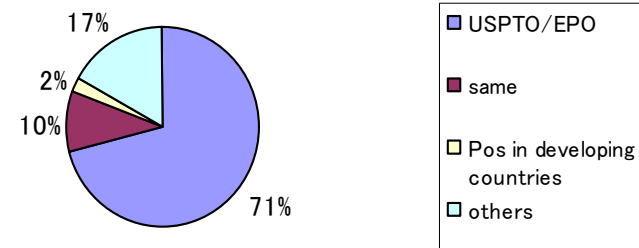


How to use ISR made by other patent offices

Did you receive different prior arts from them shown in ISR during national examination in emerging countries?



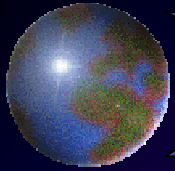
Which patent offices show more often such different prior arts, USPTO/EPO or POs in emerging countries?



JP users' big interest

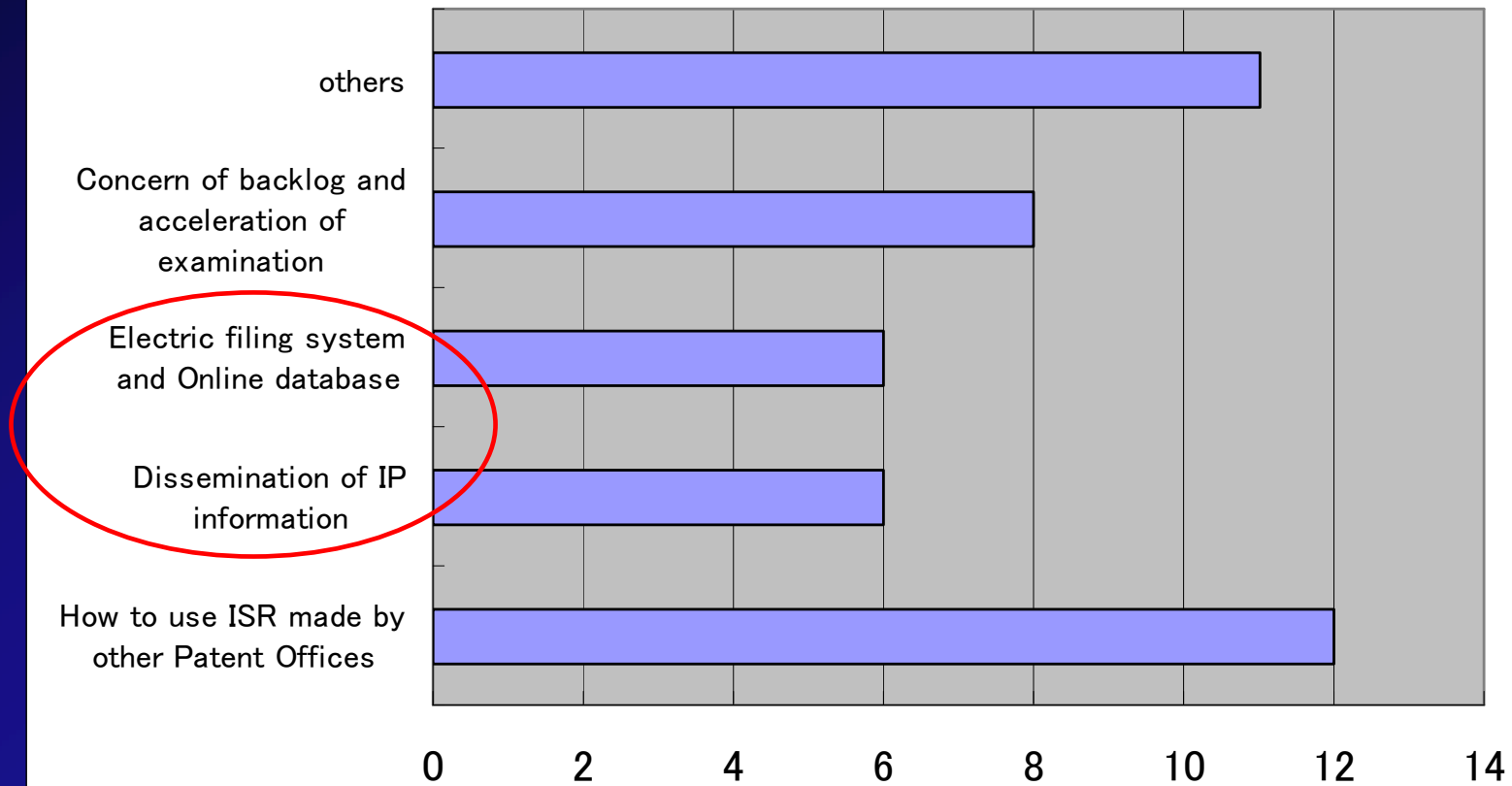
- How does each DO reflect ISR in the examination process?
- Any difference in dealing with ISR depending on which ISA made it?

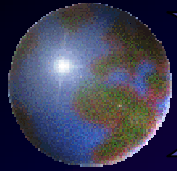




Dissemination of IP information / Electric filing

Requests/Questions as to IP systems in emerging countries

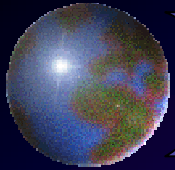




Dissemination of IP information / Electric filing

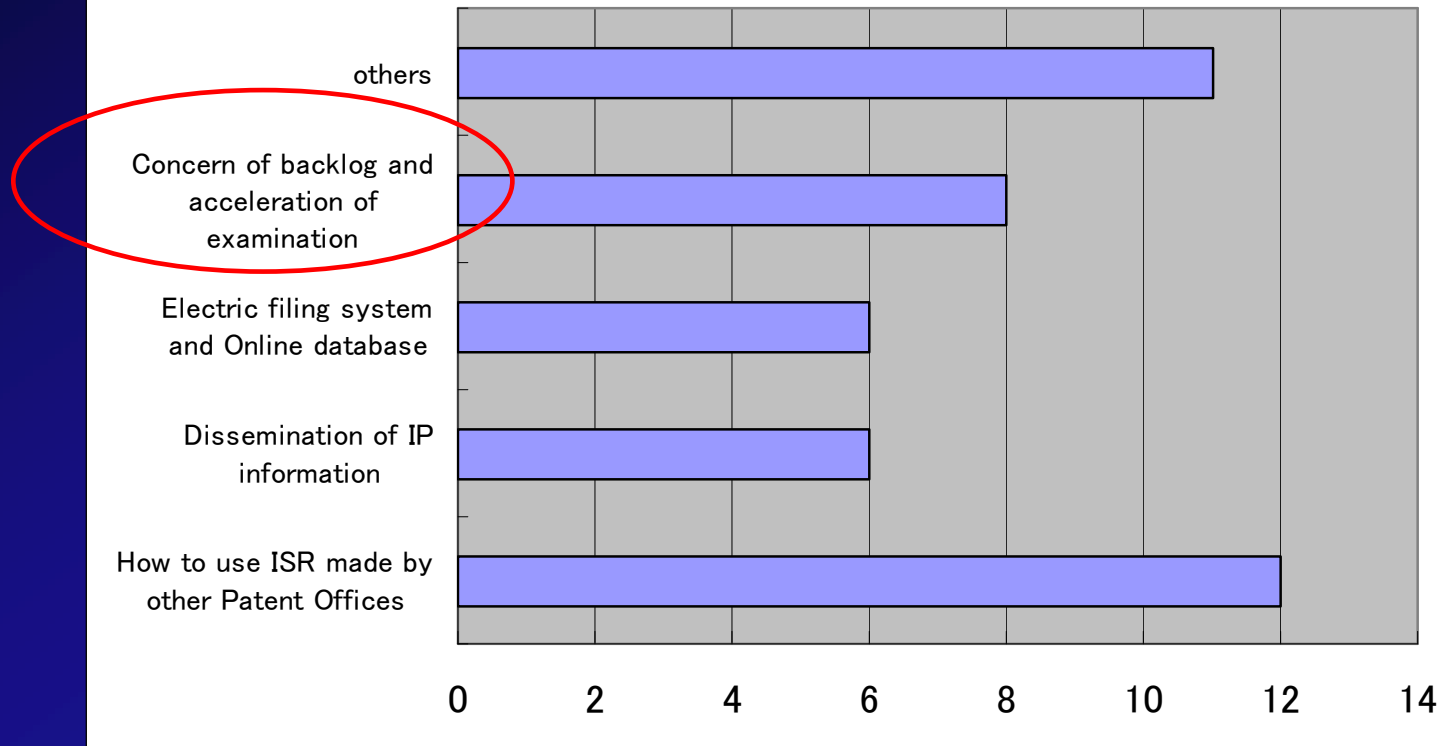
- Dissemination of IP information (preferably on the WEB)
 - ✓ National Patent Law, Rule, etc.
 - ✓ Statistics about the national application via PCT
 - ✓ Internal operation guideline for dealing with ISR made by other offices
- E-Filing (XML) and Online DB
 - ✓ Prosecution in National phase (after PCT filing in International phase)
 - ✓ Status information (*ex. PAIR, IPDL, PatentScope, etc*)





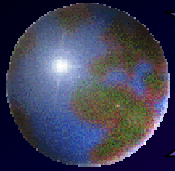
Concerns of backlog and acceleration of examination

Requests/Questions as to IP systems in emerging countries



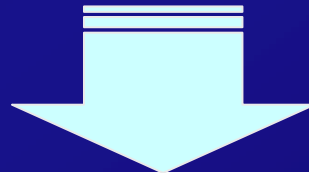
Some JP users have concerns about existing and future delay in examination





Concerns of backlog and acceleration of examination (cont)

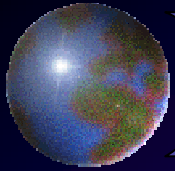
- More importance of business in emerging countries
- More demand for obtaining patents in the countries from “Foreign users”
- More patent applications to be examined in each of the countries



Increasing

Workload in the both of offices and users





Aim to reach the 'win-win' goal

- **Effective use of ISR is one possible solution**

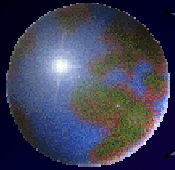
(for users:)

- ✓ More efficient patent obtaining with patentability assessment by ISR
→ Saving cost and more patents

(for offices:)

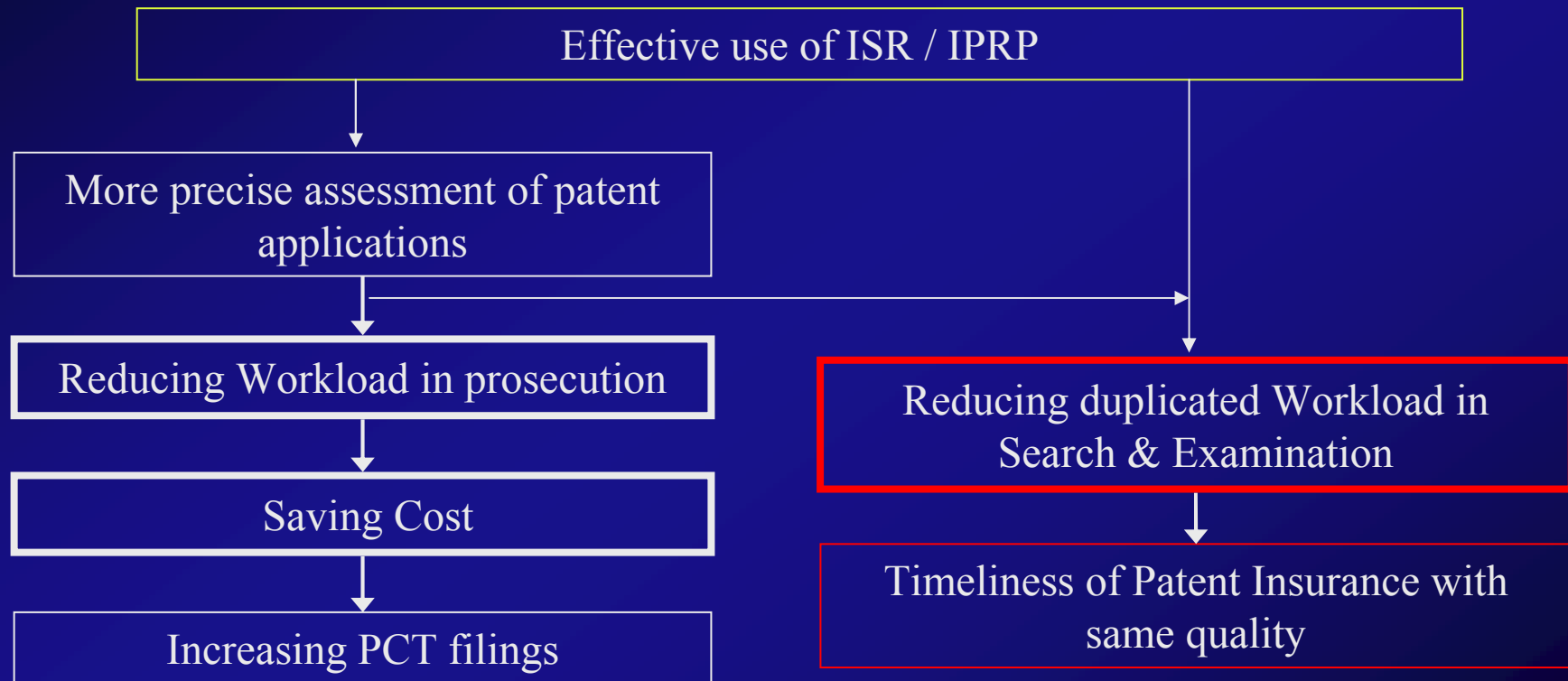
- ✓ More collaborate closely with other patent offices to keep quality
- ✓ More effective use of ISR and IPRP in National Phase
- ✓ Possibly expanding use of affirmative ISR as well as IPRP
→ Timely patent issuance with quality





Aim to reach the 'win-win' goal

- Effective use of ISR is one of the Keys to reach “win-win” goal for the both of users and patent offices

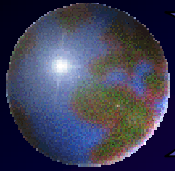


USER

Win-Win

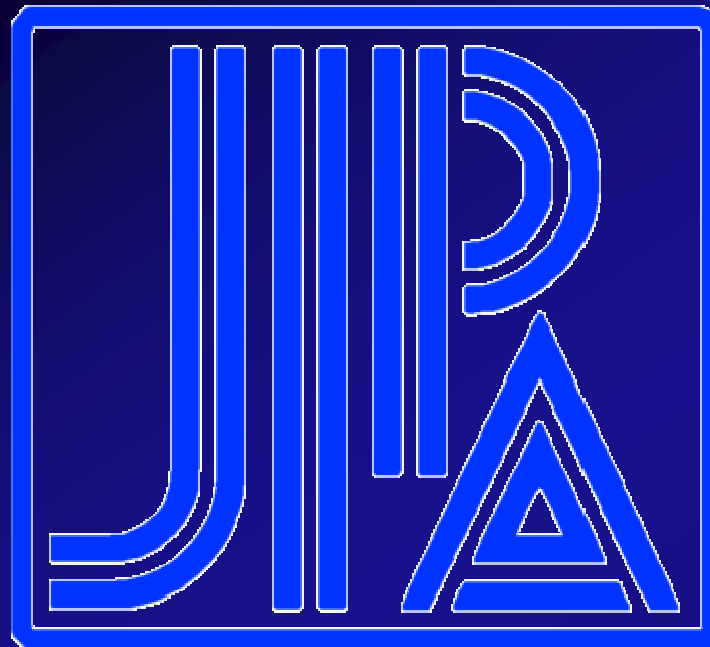
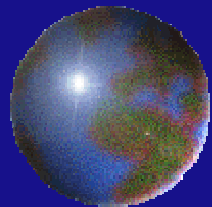
PO





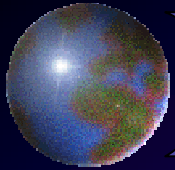
*“PCT has a possibility to reach
the 'win-win' goal for the both of users
and patent offices”*



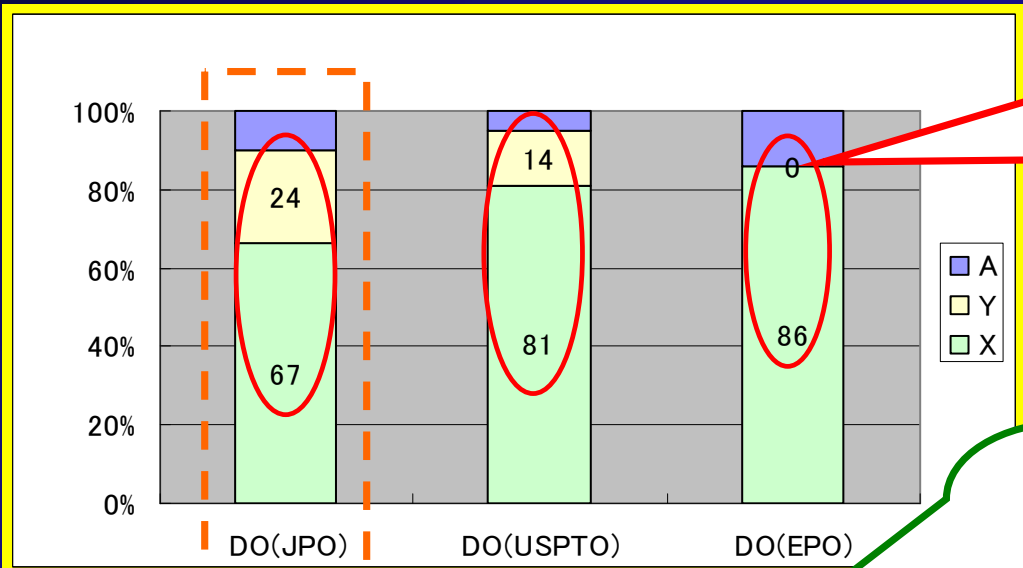


Creating IP Vision for the World

Thank you for your attention !



Appendix: What each figure in the graph means?



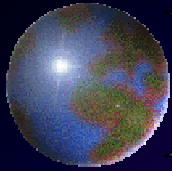
Percentage% of DO "X" vs. "Y" vs. "A" determinations

"ISR(JPO):X→JP,US,EP" indicates what kind of patentability determination (X,Y,A) was made in each Designated Office when ISR cited category "X" and JPO was the ISA

Relative proportion of DO(JPO) X, Y, or A patentability determinations when the ISR indicated category "X"

ISR(JPO):X→JP, US, EP





Several data regarding JP users shown in this presentation today are based on the results of studies and surveys conducted by JIPA through its committee activities in the past.

