

Patent Cooperation Treaty (PCT) Committee for Technical Cooperation

**Thirtieth Session
Geneva, May 8 to 12, 2017**

EXTENSION OF APPOINTMENT OF THE JAPAN PATENT OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. All of the existing International Authorities were appointed by the PCT Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of this Committee (see PCT Articles 16(3)(e) and 32(3)). Information concerning this process and the role of the Committee is set out in document PCT/CTC/30/INF/1.
2. On March 8, 2017, the Japan Patent Office submitted its application to extend its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. This application is reproduced in the Annex to this document.
3. *The Committee is invited to give its advice on this matter.*

[Annex follows]

APPLICATION OF THE JAPAN PATENT OFFICE FOR EXTENSION OF APPOINTMENT
AS AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

1 – GENERAL

Name of Office: Japan Patent Office

Session of the Assembly at which reappointment is to be sought: 49th.

Expected date at which operation as ISA/IPEA could commence: January 1, 2018

Official to be contacted: Mr. Tatsuo Takeshige, Director, Multilateral Policy Office,
International Policy Division

Statement of motivation:

Ever since its accession to the PCT and appointment as an ISA/IPEA at the same time in 1978, the Japan Patent Office (JPO) is the only competent ISA/IPEA which is capable of carrying out international searches and international preliminary examinations in the Japanese language. In addition, in 2001, the JPO started conducting international searches in English. Currently, the Office acts as a competent ISA/IPEA for international applications by Japanese residents or nationals as well as those filed from other 11 member states.

While conducting international searches and international preliminary examinations on a large number of PCT applications, the JPO has been able to process them in a timely manner. Users who have taken the JPO's user-satisfaction surveys have consistently given high ratings to the quality of the JPO's ISRs and other work products.

Furthermore, in line with the fact that enhancing the quality of work products in the PCT international phase has become one of the key issues that needs to be addressed, the JPO has been actively working on measures for improvement in this regard.

As for its internal practice, for example, the JPO released its "Handbook for PCT International Search and Preliminary Examination" in 2015 in order for its examiners to conduct more streamlined international searches and international preliminary examinations as well as to improve transparency of its operations for its users.

With respect to its relations with other countries, the JPO continued participating in various cooperative activities, not only under the auspices of WIPO but also with other IP offices under the bilateral and plurilateral frameworks, including the IP5. For those recently appointed as such, the JPO shared its experiences in its effort to properly function as ISA/IPEA.

Based on the reasons stated above, the JPO is filing its application to be reappointed as an ISA/IPEA. Under the expectation that the JPO will be again appointed as a competent ISA/IPEA, the JPO sincerely looks forward to contributing to the further development of the PCT system, as it has to date.

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

Rules 36.1(i) and 63.1(i): *The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.*

Employees qualified to carry out search and examination:

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)	Breakdown of qualifications
Mechanical	662	12.7	Minimum qualifications are: (1) to pass the Examination for Comprehensive Service (for graduates of university/graduate schools) administered by National Personnel Authority, or (2) to hold bachelor's degree (or higher) in technical subjects and have a total of more than 4 years of professional experience in R&D activities or in the field of intellectual property in the private sector or universities.
Electrical/electronic	595	12.6	
Chemistry	266	11.8	
Biotech	179	11.0	
<i>Total</i>	1,702	12.2	

Training Programs

➤ Course training (for newly recruited examiners)

Successful completion of the examiner training course is mandatory to become a qualified patent examiner under the Japanese patent regulations.

An officer recruited by the JPO is required to attend two training courses and pass a series of examinations. Total hours of two courses are about 250 hours. Lecturers for this training program include university professors, patent attorneys and experienced examiners. The training curriculum comprises understanding the international regulations and related rules including the Patent Cooperation Treaty and PCT International Search and Preliminary Guidelines and practices of international search and preliminary examination.

➤ OJT by supervising examiners (for assistant examiners)

An officer recruited by the JPO conducts on-the-job training as an assistant examiner under the guidance of his/her supervising examiner for 2 to 4 years, depending on his/her prior experience.

➤ Technical training, Visits to businesses, Internships, Studying in domestic universities and overseas universities (for examiners)

Examiners are given opportunities to acquire the knowledge of cutting edge high level technologies, such as attending technological training, visiting businesses, internships, and studying in domestic universities and overseas universities.

➤ Language training (for examiners)

Opportunities to receive training on English and other foreign languages are also given to examiners according to need.

Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

Access to the minimum documentation for search purposes:

(√) Full access

Search systems:

The JPO possesses a substantial amount of documentation, covering both patent and non-patent literature. The JPO's examiners can utilize patent publications corresponding to minimum documentation through using internal search systems and commercial databases.

For non-patent literature, the JPO's examiners can utilize documents stored in the JPO and commercial databases. Thus, it is able to access non-patent literature corresponding to minimum documentation, making it possible to meet the requirements for searches on minimum documentation as an ISA.

➤ IT Hardware and Software that Support the Search and Examination Processes

Resources include a search system for effectively executing searches of prior art documents such as minimum documentation, and a drafting system for establishing ISRs or IPERs. These resources are extremely important for examiners to perform their task, and are periodically updated, and are upgraded upon their request when needed. Technical support is also extended to examiners so that the best operating conditions are continuously maintained.

The JPO makes use of its proprietary search system, which enables access to domestic/foreign patent literatures and non-patent literature. Furthermore, the JPO has contracted with approximately 40 external commercial database providers in order to conduct prior art searches. Retrieval styles that have been used in searches, and a document-set obtained based on the retrieval style, can automatically be recorded. This makes it possible for examiners to share their knowledge about searches with each other, which is useful in terms of quality audits.

The JPO has set up support functions that help examiners issue ISRs or IPERs, by using a drafting system. The support functions permit simultaneous drafting of necessary documents, automatically import bibliographic data to drafting documents, and check the report contents, for example. Moreover, this makes it possible to administer and approve procedures electronically for PCT applications.

A dual-display terminal is assigned to each examiner so as to facilitate screening of patent literature and non-patent literature with a larger-size display.

➤ Search Indexes for Searching Patent Literature

For efficient searching of Japanese patent literature, JPO maintains classification which is referred to as “File Index” (FI) and search index referred to as “F term”. FI is subdivision of IPC for Japanese patent literature. F term is search index in which multiple aspects are developed for each of approximately 2,600 technical groups based on FI. JPO’s examiners can combine full-text search with FI/F term in the prior art search. They can screen patent literature groups with using FI/F term. Therefore, JPO achieves efficient and highly accurate search through them. JPO’s examiners use not only IPC or full-text search but also ECLA, CPC, or USPC when searching foreign patent literature.

➤ Tools and Equipment for Non-patent Literature Search

IPOs need thorough search of both patent and non-patent literature.

Therefore the JPO stores useful non-patent literature in its internal database. The search system uniquely developed by the JPO provides seamless search between patent and non-patent literature.

The JPO improved its search environment for technical standards and draft version of technical standards submitted during the process of establishing the standards in recent years. JPO expanded the coverage of standard-related documents that can be stored in the internal database through the collaborative relationships with standards setting organizations (SSO).

➤ Search Indexes for Non-patent Literature

The JPO sets up search index referred to as “CS term” for efficient search of non-patent literature. It is similar to the above-mentioned F term. CS term is a computer software-specific search index in which multiple aspects are developed for each technical group.

Similarly to the F term used for patent literature, JPO’s examiner can combine full-text search with CS term. They can screen non patent literature groups with using CS term.

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

Language(s) in which national applications may be filed and processed:

Japanese*

* An applicant can submit the description, claims, drawings (where applicable) and abstract prepared in any other language, provided that he/she shall submit Japanese translations thereof within one year and four months from the filing date (or the earliest priority date).

Other languages in which large numbers of examiners are proficient:

English

English is one of the subjects in the Examination for Comprehensive Service. The JPO regards English ability as an essential element when recruiting staff. Moreover, assistant examiners have a chance to receive specified English language training before they are promoted to examiners. Examiners can also participate in training courses to learn other foreign languages such as French, German, Korean, Chinese, etc.

Services available to assist search or understanding of prior art in other languages:

Machine translation system is available for every examiner.

2.2 – QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search.

The Quality Report submitted by the Japan Patent Office in December 2016 can be found at: <http://www.wipo.int/pct/en/quality/authorities.html>

2.3 – EXCHANGES OF INFORMATION AND SUGGESTIONS CONCERNING GOOD PRACTICE WITH OTHER INTERNATIONAL AUTHORITIES

The JPO is committed to constant improvement in quality for itself and within the PCT system as a whole. To this end, it not only conducts internal quality reviews, but works actively with other International Authorities and Offices to exchange information and good practice and to try out potential new ways of achieving improved results. Some examples are as follows.

(i) *Japan-US Pilot Program for Conducting Collaborative Searches and Examinations*

Pilot program for conducting collaborative Searches and Examinations (CS&E) at the JPO and the United States Patent and Trademark Office (USPTO) is a program in which examiners at the JPO and the USPTO conduct their own prior art searches for inventions described in patent applications that were filed in both Japan and the U.S. Then, the examiners of the two Offices share their search results and opinions, and send the first examination results to each other at the same time. This cooperative initiative was launched in August 2015, for the purpose of enhancing the predictability of patent grants in terms of conducting examinations and acquiring rights for inventions filed in both Japan and the U.S. This is also aiming to enable applicants to obtain stronger and more stable patent rights earlier in both Japan and the U.S. As of January 2017, 45 patent applications have been filed under this program.

(ii) *PCT Collaborative Search and Examination Pilot Program among IP5 Offices*

In the PCT Collaborative Search and Examination pilot program among the world's five largest IP offices, namely, the IP offices of China, Japan, Republic of Korea, the United States and the European Patent Office (the IP5), a main IP office in charge makes judgment on the patentability of a single international application being filed under the PCT, in collaboration with sub IP offices. Then, the offices prepare a single international search report and send it to the applicant. In June 2016, at the IP5 Heads Meeting, the Heads agreed on the basic direction to launch the pilot program among the IP5 Offices. Now, the working-level staff are discussing the details of the operating procedures, aiming to launch the pilot program in June 2017 at the earliest.

(iii) *“International Examiner Conferences”*

“International Examiner Conferences” are frameworks in which examiners from various countries meet face-to-face, exchange frank opinions, and discuss examination practices. The conferences have been done mainly (1) to promote effective work sharing in terms of patent examinations based on mutual understanding of prior art searches and examination practices; (2) to harmonize patent examination practices at a high level of quality; and (3) to harmonize patent classifications. From April 2000 to January 2017, the JPO conducted international examiner conferences for short-term and medium to long-term periods with a total of 29 IP offices and organizations.

(iv) *Cooperative Initiatives on Patent Examinations for Emerging Countries*

(a) Singapore

The JPO has been conducting cooperative activities to enhance the capabilities of patent examiners working at the Intellectual Property Office of Singapore (IPOS), which started functioning as an ISA/IPEA under the PCT in 2015. The activities include sending a JPO's senior examiner from December 2014 for a long-term period, for the purpose of building IPOS's capacities in patent examination, including IPOS's operations under the PCT.

(b) India

The JPO has been supporting the Controller General of Patents, Designs and Trade Marks (CGPDTM) of India, which started functioning as an ISA/IPEA in 2013. From fiscal year 2013, the JPO sent several examiners to the CGPDTM to help its operations under the PCT. In addition, in November 2016, under the framework of the Japan Funds-in-Trust at the WIPO, the JPO held a workshop to enhance the search and examination capabilities of patent examiners at the CGPDTM as an ISA/IPEA. This was done as part of the CGPDTM's training program designed for its newly hired examiners.

[End of Annex and of document]