

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

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PCT KAIZEN¹ (FROM PARTIAL TO TOTAL OPTIMIZATION)

Proposals by Japan

BACKGROUND

1. In the past, we, the International Bureau (IB), Contracting States and International Authorities (Authorities) have worked together to make the PCT a better framework through PCT Reform and various revisions. As a result of these efforts, the PCT system has expanded in size, seeing an increase in the number of applications being filed under the PCT, an increase in the number of applications being filed by emerging countries, and an increase in players involved with the PCT system based on the increased number of Contracting States and Authorities. The PCT is now indisputably established as a global infrastructure for applicants to file their patent applications worldwide.
2. However, despite such efforts, there are still signs that “the PCT does not lead to reducing work load, as designed, through eliminating duplicated procedures for both applicants and IP offices” or that predictability of patent acquisition for applicants (and third parties) is not sufficiently ensured. This is based on the fact that work products of the international phase are not being thoroughly and efficiently utilized in the national phase. Therefore, the benefits² of the PCT system, which were anticipated at the time it was established, are not being fully achieved.

¹ The word “Kaizen” refers to a Japanese business philosophy of continuous improvement of working practices, personal efficiency, etc. (source: Oxford English Dictionary).

² “[T]hat a resolution of the difficulties attendant upon duplications in filings and examination would result in more economical, quicker, and more effective protection for inventions throughout the world thus benefiting inventors, the general public and Governments” (see BIRPI document CEP/II/12, paragraph 46).

3. There are various causes for this present condition, and they can be analyzed in many ways. In addition, there are various opinions about them. In this respect, the JPO considers the following to be the primary cause: emphasis has been placed on only “partial optimization”. In other words, emphasis has been placed on optimizing each “element and function”³ constituting the PCT system without full consciousness of “total optimization” of the whole system⁴, which is designed to optimize the efficiency and productivity of the entire system by looking at it as one big process and coordinating each “element and function”. That is, in general terms, no matter how many times “partial optimizations” are carried out, they will not result in “total optimization”.
4. Pursuing both “partial optimization” and “total optimization” is actually a corporate management approach that is taken for granted at companies. However, we may have given very little consideration as to “managing” the PCT system, even though it is made up of complicated elements and also serves as a standardized function as one big business process. In other words, with the PCT system “maturing”, we need to be aware of this fact even stronger.

BASIC CONCEPT OF “PCT KAIZEN”

5. Using this awareness, the JPO would like to propose advancing the discussion on improving the PCT from the perspective that the IB, Contracting States and Authorities look at the PCT system as a whole while being strongly aware of the need for managing the PCT system. We need to consider how to skillfully coordinate each “element and function” so as to maximize the benefits expected of the PCT system.
6. That is, the basic concept of “PCT Kaizen”, which the JPO is proposing in this document, is to maximize the benefits expected of the PCT system based on the idea of “total optimization”. In this regard, the IB, Contracting States and Authorities should make efforts and cooperate to continuously improve the system from the point of view of their respective roles as “business managers, employees and customers”, and furthermore, work to improve the environment designed for that purpose.
7. The JPO would like to emphasize the need to continue promoting “Kaizen” as a successful business administrative means when taking the basic concept into account, and ensure that the “Plan-Do-Check-Act” (PDCA) cycle continues to move smoothly. In particular, it is of utmost importance that “Check” and “Act” serve as effective functions in promoting “Kaizen”.

ESSENCE OF PROPOSALS

8. Annex I expresses the concept of reviewing the “Higher quality international search reports (ISRs)” approach. Based on these perspectives, the JPO regards this as the most significant element in maximizing the benefits of the PCT system. The JPO considers the “Higher quality ISRs” approach as the main driving force enabling “Kaizen” to become a reality. For that purpose, the JPO proposes three specific items for advancing further consideration and

³ “Element and function” refers to the multiple elements and functions involved in the PCT system such as the process of accepting applications, the function of certifying the international filing date, the action of conducting international searches, the work-products themselves such as ISRs, and the 30-month time limit for entering the national phase.

⁴ For example, when considering processes involved with “establishing ISRs by the due date”, there is the perspective of considering all the multiple elements and functions involved with establishing ISRs and thinking about what to do in order to achieve maximum results from the various processes. This not only means speeding up searches by ISAs but also includes a whole series of processes such as the sending of search copies to ISAs from receiving Offices.

implementation in this document: “(1) Improving quality of search/examination at the international phase”; “(2) Promoting linkage between the international phase and the national phase”; and “(3) Refining Collaborative Search and Examination”.

9. In addition, the basic material for making decisions for managing and analyzing the PCT system is necessary to promote “Kaizen”. That is to say, it is essential to continuously collect and analyze information. Therefore, the JPO proposes “(4) Increasing basic information designed for analyzing and improving the PCT process” so as to develop a mechanism for collecting and analyzing information for that purpose.

10. To ensure that the PDCA cycle continues to cycle globally as designed within in the network of all IP offices and the IB, and not only at individual IP offices, it is vital that we develop a mechanism for sharing information for that purpose, and that mechanism is IT infrastructure. Therefore, in order to enable information to be shared through networks and other means, the JPO proposes “(5) Creating an IT infrastructure that is conducive to “PCT Kaizen” (Development of the Global Dossier)”.

PROPOSALS

(1) IMPROVING QUALITY OF SEARCH/EXAMINATION AT THE INTERNATIONAL PHASE

11. Discrepancies between results of the international phase with those of the national phase are believed to occur because of various factors. These discrepancies are expected to be solved by implementing specific measures designed to deal with each of the factors. In particular, when the discrepancies might be attributable to the searches/examinations being conducted in the international phase, the JPO believes that the quality of search/examination can be improved by providing feedback both on search/examination results of designated Offices (DOs) and on the analysis of these results to examiners. Therefore, recognizing the importance of developing the following two frameworks, the JPO proposes that cooperation among ISAs begin first as a starting point for advancing them:

- framework under which ISAs analyze and utilize feedback on WOISAs/ISRs from DOs that conducted First Actions;
- framework under which the results of analysis conducted by ISAs are shared with the DOs, as well as with other offices when appropriate.

12. In developing the above-mentioned two frameworks, it is expected that a more effective framework can be efficiently built when ISAs cooperate and share their expertise with each other. As a result, it is expected that (i) quality of search/examination will be improved through providing feedback to examiners, as well as (ii) progress on measures for resolving the problems will be accelerated through sharing individual issues on search/examination identified by analyzing the factors that cause the discrepancies. It will also be possible to operate the PDCA cycle for continuous quality improvement of search/examination at the international phase.

13. A detailed explanation of this proposal is attached as Annex II “Utilization and Analysis of Feedback on WOISAs/ISRs and Sharing of Analysis Results”.

2) PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

14. Measures for strengthening the linkage between the international phase and the national phase such as enhancing utilization of work products at the international phase in the national phase is vital for improving predictability of patent acquisition for the users and eliminating unnecessary duplication of work by Authorities and DOs. While each IP office has already implemented measures to strengthen the linkage under their current legal frameworks, the JPO proposes the following measures to further strengthen the linkage from the viewpoint of the ISA and the DO.

(A) Sharing and Analyzing Measures by the ISA

15. The measures to be taken by the ISA are (i) utilizing relevant examination results of national applications for basic priority applications etc., and (ii) preparing work products that will be easily utilized at the subsequent national phase.

16. With regard to the former, in the PCT Regulations there is a Rule called "Taking into Account Results of Earlier Search⁵". This Rule requires the ISAs to take the results of earlier searches into account at the international phase upon the request of applicants. Therefore, widely sharing and analyzing the present state of measures being taken at ISAs to promote the linkage between the international phase and the national phase, such as how this Rule is applied in practice at each ISA, would be beneficial in ensuring that the PDCA Cycle continues to function under the concept of PCT Kaizen.

17. As for the latter, although it is needless to restate the importance of measures that are being taken in terms of formal aspects such as making the wording of work products (WOISAs/ISRs) easily understandable for DOs/applicants and in terms of substantial aspects such as achieving higher quality prior art searches, it is also beneficial to widely share and analyze the present state of measures (self-improvement) being taken by each ISA with other IP offices. For instance, measures for providing easily understandable wordings would facilitate other IP offices in understanding the work products. However, there is a limit in terms of the degree of self-improvement measures alone, making it essential to listen to opinions of those who take the ISRs into consideration.

18. Therefore, the JPO proposes that ISAs share and analyze these measures to consider best practices as well as share the knowledge obtained not only with ISAs but also with various IP offices.

(B) Sharing and Analyzing Measures by the DO

19. The measures to be taken by the DO are (i) to voluntarily utilize the work products of the international phase as much as possible and (ii) to promote the users' voluntary actions in accordance with the search/examination results of the international phase.

⁵ Regulations under the PCT provide that where the applicant has requested the ISA to take into account the results of an earlier search and the search was carried out by the same ISA, or by the same Office as that which is acting as the ISA, the ISA shall, to the extent possible, take those results into account in carrying out the international search (Rule 41.1) and where the ISA takes into account the results of an earlier search in carrying out the international search, the Authority shall refund the search fee paid in connection with the international application to the extent under the conditions provided for in the agreement under Article 16(3)(b) (Rule 16.3).

20. With regard to the former, as the DO also functions as an Authority, it is important for such DO to actively utilize its own work products at the international phase, applying such work in the national phase, which is also referred to in PCT/WG/3/2 and PCT/WG/4/3. The European Patent Office (EPO), for example, requires an applicant to respond to negative opinions made by EPO in the international phase at the time of entering the national phase. Furthermore, it is important to fully utilize the work products established by other Authorities at the national phase. At the JPO, guidelines are formulated not only for utilizing its own prior art search/examination results but also for utilizing other Authorities' results to encourage the utilization of work products of the international phase.

21. As for the latter, there are measures such as giving incentives to applicants to make informal comments to WOISAs and/or to make amendments at the international phase. In particular, from the perspective of encouraging amendments at the international phase so as to enable applicants to obtain rights at an early stage, measures can be considered for increasing the number of IP offices participating in the PCT-PPH and integrating the PPH into the PCT. The PCT-PPH is a framework enabling applications, which were determined as patentable at the international phase, to undergo accelerated examinations at the national phase through simplified procedures. It has the effect of increasing the grant rate⁶, accelerating examinations, and reducing costs in obtaining rights for the users.

22. Some of these measures have already been implemented and have produced certain effects while others are still at the proposal stage and require further scrutiny. Therefore, the JPO proposes sharing and analyzing knowledge gained from these measures, as well as heightening discussions on each proposal.

(3) REFINING THE COLLABORATIVE SEARCH AND EXAMINATION

23. The JPO has insisted that since ISRs should be established by each ISA in a responsible way as a basic principal, it is important for this purpose to improve the capacity of individual ISAs. On the other hand, although contrary to this principal, it is true that the Collaborative Search and Examination for which a pilot project has been started has the possibility of achieving higher quality ISRs. In addition, cooperation among examiners at various ISAs makes it possible for them to share search/examination methods of other ISAs. This will lead to improving the individual capacity of each ISA, which is expected to play a role in implementing the global PDCA cycle.

24. Aside from having the advantages of achieving higher quality prior art searches at the international phase and reducing the work load at the national phase, there is a certain amount of user needs involved in Collaborative Search and Examination. On the other hand, in terms of actually providing Collaborative Search and Examination as an option under the PCT system, there are concerns about some practical disadvantages such as increased work loads (including translating) and the costs to both the users and Authorities at the international phase. Furthermore, discussions will be necessary in light of observing the due date for establishing ISRs.

25. It is needless to say that while evaluating the above-mentioned advantages and disadvantages based on actual results of pilot projects, providing the Contracting States with information for considering (i) whether the present Collaborative Search and Examination is appropriate as an option to be provided under the PCT system, and (ii) if it is not appropriate due to some cause, whether it is possible to eliminate the cause so as to refine the system and make it further suitable, would occupy an important role of the pilot project.

⁶ The final grant rate for PCT-PPH applications received by the JPO was 94.9% (compared to 65% for normal applications; the rate is for applications examined from July 2011 to June 2012.)

26. Therefore, the JPO looks forward to a follow-up evaluation that plays a major role in analyzing the balance between the various costs needed for Collaborative Search and Examination practices with the advantages that the searches offer, focusing on the disadvantages involved with Collaborative Search and Examination practices such as increased work loads and costs to both users and Authorities. In conducting the follow-up evaluation, the JPO believes that it is necessary to conduct it from the perspective of making an empirical analysis as to the effect that reducing work load has on the national phase.

27. The JPO welcomes discussions for the purpose of exploring the potential of Collaborative Search and Examination practices, and refining them.

(4) INCREASING BASIC INFORMATION DESIGNED FOR ANALYZING AND IMPROVING THE PCT PROCESS

28. Under the concept of "PCT Kaizen", continuity is the main focus for improving the PCT system. To this end, we will need to conduct a business-like analysis of PCT operations based on various items of information available to us; and conduct it as if we were analyzing the PCT using a corporate management approach. In carrying out a business analysis on the PCT, especially in terms of finding ways to ensure its smooth operations, we must uniformly grasp the basic information that will enable us to see the current circumstances of PCT operations.

29. The basic information available on the PCT system consists mainly of static information on bibliographic data pertaining to international applications per se which, for example, can be found by referring to the PATENTSCOPE. Such information has not been collected with the idea of continuously improving the PCT system. As a result, in collecting information, attention has not been directed at information that can analyze the flow of processing applications, e.g. how effectively/ineffectively an international application was processed, how long a specific process took, etc.

30. For instance, information on the status of applications entered in the national phase is information that is used the most by users of the patent system. This information enables them to see the fate of international applications. Nonetheless, the amount of such information accumulated is still insufficient as it stands now. The perspective of "PCT Kaizen" goes beyond that. Such information is extremely important for following up and analyzing the international application process, and reusing the international phase products in the national phase.

31. In light of the above facts, the JPO proposes the following:

(A) Collecting and increasing the basic information for analyzing the PCT process

32. It is a matter of course to add to the existing information, but the JPO proposes to collect additional information to quantitatively analyze the current status of the PCT. Furthermore, by combining the additional information with the existing information, and processing them to give added value, they become the PCT's "Basic Intelligence", a new set of value-added information. The PCT Basic Intelligence will be indispensable in managing PCT Kaizen, so that PCT operations become a series of processes, not individual actions, emphasizing the importance of the variety of intelligence (processed information) such as the timeliness of PCT procedures.

33. For instance, when various dates involving international applications are compiled as individual items of information listing only the dates in which the documents were received (as it is now), this is nothing more than a collection of information on the step-by-step progress. By combining them with several other dates or adding new information from new perspectives and

processing all of these, they become the basis to calculate the substantial processing period. By doing so, PCT Kaizen becomes possible⁷ through analyzing the processes that cause delays. Information on the completion date of a process is insufficient as an item of information because such information does nothing to help improve any delay in operations leading up to that date of completion. "Kaizen" starts when more dates and information are collected and organized, so that this information becomes PCT intelligence. This could be the time it takes to send documents, any detailed results of processes by IP offices, whether there were replies from applicants who were late in carrying out procedures, etc.

34. By further expanding the idea of PCT "Basic Intelligence", information on how work products of the international phase are evaluated, fairly standard information used in commercial services, may be desirable in the future. When evaluation of PCT work products becomes well established through feedback from applicants, there will be high expectations for continuous improvement.

(B) Platform for collecting, accumulating and utilizing "Basic Intelligence"

35. In terms of improving the PCT system, the above-mentioned "Basic Intelligence" cannot be enriched by the IB alone or just by its IT technology. It is necessary to build a mechanism under which "Basic Intelligence" is routinely accumulated by involving Contracting States.

36. Thus, for collecting the "Basic Intelligence," the JPO would like to suggest a mechanism by which the IB, IP offices and applicants share and circulate intelligence, using the ePCT promoted by the IB as a hub. By utilizing the ePCT, it may become possible to manage and technically sort intelligence offered into it for the benefit of both applicants and IP offices. It is our understanding that PATENTSCOPE International Application Status Report (IASR) could be used as a platform for offering information and intelligence, if appropriate.

37. Furthermore, this new idea of "Basic Intelligence" can be considered as a perfect opportunity to take a second look at the current "PCT Applicant's Guide". The JPO would also like to take the opportunity to reanimate the Guide, as requested by users, by adding to existing information (information mainly related to the Offices and Authorities themselves) and adding information inherent to national procedures in DOs. Such information could include certificates that DOs request applicants to submit in their national procedures, outside the framework of the PCT system, and based on domestic laws of the Contracting States. Despite the fact that there has been such a great demand from applicants for such information, it has not been included in the Guide so far.

⁷ A specific example in which we consider new intelligence described below will be necessary to improve timeliness of issuing ISRs. At present, the date of issuance of ISRs is recorded in the PATENTSCOPE as mere information on recordation of dates. However, the date the competent ISA in question received a search copy from a receiving Office is not accumulated as information in the PATENTSCOPE as it stands now. To be more precise, there is a way to learn the date, since it is possible to refer to PCT/ISA/202 notification on the PATENTSCOPE and find the date of receipt of the search copy stated on the notification. In attempting to improve the present situation of due date adherence for issuing ISRs, it would be desirable to add the actual date of receipt of the search copy as information in addition to the date of issuance of ISRs. By processing the two dates, it becomes possible to obtain the intelligence of substantial processing period that makes it possible to find out actually how long it took for an ISA to issue an ISR. Furthermore, it is possible to envisage cases where the applicant took a long time to respond in communicating with the ISA which unexpectedly prolonged the processing period in that ISA. More amount of intelligence will be necessary for conducting deeper analysis. In this way, it will be important for PCT intelligence in the future to keep information as utilizable information and not as information to be found in the notifications. Moreover, by combining relative information and processing them, PCT "Basic Intelligence" for continuously improving the PCT system will be generated.

(5) CREATING AN IT INFRASTRUCTURE THAT IS CONDUCIVE TO “PCT KAIZEN”
(DEVELOPMENT OF THE GLOBAL DOSSIER)

38. To truly achieve “PCT Kaizen”, it is necessary to create an IT infrastructure that enables IP offices in the world (and in some cases also public users) to easily share application and examination information (dossier information), including prior art search results.

39. Therefore, the JPO proposes organic cooperation between the PCT System and the “Global Dossier” that the IP5 and WIPO are mainly starting to consider. The “Global Dossier” is a concept which will virtually integrate dossier information maintained by each IP office and provide various services in a unified manner.

40. It can be taken as an example of organic cooperation with the PCT system. For example, we can consider building a common user interface that enables dossier information at the international phase such as ISRs and at the subsequent national phase in various countries to be displayed on one portal site through a dossier access system that provides seamless and instant access to information based on using ePCT. As a result, the following effects can be expected:

- The instant sharing of examination information on WOISAs/ISRs by DOs enables several countries to make maximum, efficient use of work products of the international phase during their national phase, which in the short term reduces redundant work as well as decreases discrepancies in decisions reached at the international phases with those reached at the national phase. (Achievement of “(2) Promoting linkage between the international phase and the national phase”).
- Sharing of search/examination methods and expertise in other offices, in the long term, enables us to raise the quality of ISRs as well as discrepancies in quality of ISRs among ISAs. (Achievement of “(1) Improving quality of search/examination results at the international phase”).

41. Furthermore, if the dossier access system and the search system for PATENTSCOPE and such are linked together, it will become possible to interactively access patent gazettes and related dossier information. For example, it will be possible to view related dossier information from patent gazettes referred to in prior art searches, and get cited documents such as patent gazettes while referring to dossier information of other offices. This will eliminate the trouble of entering each document number, as in the past, to a minimum and facilitate acquiring useful information while conducting prior art searches. As a result, we can look forward to greater efficiency in the search process.

42. As stated above, the JPO proposes making simultaneous studies on both the PCT system and applicable infrastructure such as the Global Dossier, with the prospect of using the latter as the common infrastructure for achieving the global PDCA cycle.

FUTURE VISIONS

43. The JPO hopes that this proposal will not be limited to only what has been mentioned above. It further hopes that the above will be refined based on constructive discussions by Contracting States. The JPO also intends to continue contributing, as it has in the past, to international discussions for achieving the future vision of the PCT system, making it a truly attractive system for users all over the world.

44. *The Meeting is invited to comment on the proposals set out in this document.*

[Annexes follow]

ANNEX I

PCT KAIZEN (ACHIEVING HIGHER QUALITY PRIOR ART SEARCHES)

I. RAPID GROWTH OF PATENT APPLICATIONS GLOBALLY AND THE ROLE OF THE PCT (PATENT COOPERATION TREATY) SYSTEM

1. With economic activities becoming more globalized, the need for acquiring intellectual property rights (IPRs) globally has been rising, and the number of patent applications worldwide has also been increasing. In particular, when an application claiming one invention is filed, examined, and patented in many countries, this causes redundancies in application and examination procedures in all the offices in the world, adding a greater workload to examinations at IP offices as well as increasing the burden on system users.

2. Under such circumstances, the PCT application system, namely a system under which international patent applications are filed and which is being used more widely through the years, has now become a major tool for applicants who are aiming to acquire patents globally. The PCT system is a framework to implement prior art searches, and it is anticipated that if the search results can be effectively used in examinations in the national phase in each country, the above-mentioned workload and burden will be eased, thus creating a more efficient and effective global patent application system.

II. CURRENT STATUS OF THE PCT SYSTEM**(1) NECESSITY FOR IMPROVING THE QUALITY OF PCT SEARCH RESULTS AND DETAILS OF DISCUSSIONS**

3. On the other hand, the prior art search results in the international phase under the PCT system have not been actively used in the national phase of each country. Accordingly, there is a certain criticism that, contrary to the above-mentioned expectation, workload requirements of both users and IP offices in the international phase have caused redundancies also in the national phase of each country. Also, in some cases under the PCT system, although users trusted decisions made in the international phase, the decision was overturned in the national phase. As a result of such cases, the reliability of the PCT system may be decreasing.

4. Based on these circumstances, discussions at various international forums such as the Trilateral Heads Meetings, the IP5 Heads Meetings, and at WIPO, have been conducted to improve the PCT system. As a result of these discussions, revisions to the PCT system, including the "creation of written opinions by International Searching Authorities," have been made in order to enhance the quality of the search results in the international phase. In this context, recent discussion on improving the PCT system has been promoted at the working level based on various types of specific proposals which were agreed at the PCT Working Group of WIPO in 2010.

(2) RESUMPTION OF DISCUSSIONS ON PCT IMPROVEMENT BY THE UK/US AND EPO PROPOSALS

5. After that, in 2012, UK/US, and EPO, suggested specific proposals to the PCT Working Group of WIPO in May for improving the PCT system. We offer many thanks to the dedicated efforts of these IP offices for setting the framework to enable fruitful discussions toward improving the PCT system to be resumed. We believe that now is the right time to discuss the direction toward improving the PCT system by imagining what an attractive PCT system should be like in the future.

III. WHAT SHOULD THE PCT BE LIKE IN THE FUTURE?

6. Based on the experience gained from discussions made at WIPO so far, JPO believes that we should create a flexible framework based on voluntary cooperation by each IP office.

7. On the other hand, the issue of achieving a higher level of quality in terms of PCT prior art searches is a theme which we should continue pursuing. Consequently, by having PCT search results accepted at the national phase in each country, the level of user satisfaction will be increased, and thus eventually the workload imposed on IP offices as well as on users will be reduced.

8. Accordingly, based on the perspective of users who use the system, and being aware of costs at all times, the future PCT should be aimed at increasing options that are truly attractive for users and which meet their diversified needs reflecting their awareness of costs.

9. In searching for a flexible framework based on the voluntary cooperation of each IP office, we firmly believe that pursuing high quality prior art searches for the PCT and working to include options that meet the various needs of users, such as being cost sensitive, will certainly result in the efficient reduction of the workload imposed on both the users and the IP offices. In addition, it will work toward establishing a truly effective global patent application system.

10. While it is possible to consider several specific measures, we consider the following to be the three most important pillars.

PILLAR (1): SELF IMPROVEMENT ACTIVITIES TOWARD GAINING THE ABILITY TO ENABLE INDEPENDENT ISA TO CONDUCT HIGH-QUALITY INTERNATIONAL SEARCHES

11. In order to make the PCT system more attractive to users, it is especially important to improve the quality of search results at the international phase. For this purpose, as the JPO has been maintaining so far, it is at the heart of the PCT system that a single ISA/IPEA should be enabled to heighten its capability of searching multilingual prior art documents in order to improve the quality of international search results and to make the system more attractive and trustworthy. Furthermore, conducting international searches by using individual ISAs under this principle may be a very reasonable solution for many users who want to fully enjoy, at minimum cost, the advantages of the system such as languages and grace periods for translation.

12. One essential measure is to have each ISA/IPEA continue conducting self-improvement activities according to each situation in terms of various issues such as: (i) facilitating a system that can store, translate, and search multilingual documents; (ii) introducing training programs and quality-assurance mechanisms to improve the ability of examiners to search; and (iii) fostering the institutions that can conduct prior art searches.

13. At the same time, by sharing information worldwide on the current status of self improvement activities at each agency, thus by fostering common recognition on the quality level which should be aimed at by each of independent prior-art search agencies, it will be possible to create a flexible and organic PDCA cycle to cultivate the ability of both IP offices and ISAs to conduct prior art searches, and therefore enhance the quality of prior art searches worldwide.

14. Furthermore, it will be quite effective if such PDCA cycle is operated not only by individual ISAs but among a number of IP offices. For example, it will be effective to investigate the correlation between the prior art search results of the PCT international phase with those of the national phase and analyze the factors for any discrepancies. In addition, it will be important to share and utilize the results among a number of IP offices. This will contribute to the PCDA cycle being operated not only by individual ISAs but also IP offices worldwide, and thus achieve higher quality prior art searches.

PILLAR (2): HIGHER QUALITY PRIOR ART SEARCHES THROUGH MUTUALLY SHARING SEARCH RESULTS OF SEVERAL ISA

15. In addition to the necessity of each ISA continuing to take action as stated regarding Pillar (1) above, expanding the framework of the PCT system and presenting other options for providing higher quality searches for the international phase that meet user needs is also useful for enhancing the attractiveness and credibility of the PCT system.

16. One of the options is to adopt the measure of “sharing the search results at the international phase in a supplementary manner among ISAs.” This measure may be ideal for applicants who might consider it efficient in the end to acquire search results from several ISAs at the international phase, even at the expense of paying the costs and dealing with time/languages constraints at the international phase, in order for the results to equally influence the national phase.

17. This measure is further divided into (i) “a collaborative search and examination” system in which ISAs collaborate in real time to prepare a single ISR and (ii) “a supplementary international search (SIS)” system in which users ask for the preparation of additional ISRs as required. The former is still at the trial stage. And even though the latter has been adopted, it has not been used much. Both systems still have room for improvement. Taking into account that there is positive feedback on both systems from users, it is necessary to further refine and improve the efficiency of these frameworks to meet the cost-consciousness of the users.

18. Furthermore, one of the important results expected from these measures is a detailed analysis of what should be strengthened in order for an individual ISA to further improve the quality of conducting prior art searches by using the knowledge obtained by following the measures stated here. In addition, it is important to widely share the information with IP offices and to give feedback to the ISAs. This should lead to enhancing the capability of each office and ISA to conduct prior art searches, and also enable them to play a role in creating a flexible and organic PDCA cycle that promotes higher quality prior art searches worldwide.

PILLAR (3): HIGHER QUALITY PRIOR ART SEARCHES THROUGH MUTUALLY SHARING SEARCH RESULTS IN NATIONAL OFFICES

19. As mentioned before, there may be many users that give higher priority to the advantages they receive under the PCT system without being restrained by costs or time/language constraints at the international phase, and not requiring the search results of the international phase from several ISAs. For such users, developing a mechanism for “the timely sharing of search results of IP offices for the national phase” with each ISA and national offices making self improvements in the course of action stated regarding Pillar (1) is especially important.

20. As a platform for such a measure, it is imperative to build an IT infrastructure for sharing dossier information such as prior art search results at the IP offices. We would like to add that, to achieve this, the JPO together with the USPTO has initiated studies based on the framework of the IP5 Meeting in cooperation with WIPO in creating the “Global Dossier” concept. It continues to actively work on this concept.

21. Furthermore, WIPO is advancing studies on creating a mechanism for providing feedback when the DO finds documents other than those presented in the ISR to the ISA that prepared the ISR.

22. It is needless to say that these concepts and mechanisms will form the infrastructure for creating the above-mentioned PDCA cycle that promotes higher quality prior art searches on a global basis.

23. As indicated by these three pillars, the important theme in extending the possibilities of the PCT system is to pursue higher quality prior art searches for PCT applications under a flexible framework based on voluntary cooperation by each IP office and to refine these menus which suggest different courses of actions that meet users' various needs reflecting their cost-consciousness through discussions among the contracting states, and sublimate it into a user friendly and organic framework.

24. At a time when the role of individual IP offices will become increasingly significant, improving the prior art searching capacity of IP offices in the world and pursuing interests of users all over the world through such an approach is a role that the PCT system should play in aiming at establishing a truly efficient and effective global filing system.

IV. PCT SYSTEM THAT CONTINUES TO IMPROVE

25. Discussions on the improvement of the PCT system are not limited to the above. In the discussions, it also required to deal with user needs (such as their cost-consciousness) that will be increasingly diversified and to continue proposing new options while pursuing higher quality prior art document searches for PCT applications under a flexible framework. And, ultimately, discussions are required so as to provide a more efficient and effective global patent application system. JPO, as in the past, intends to continue to contribute to international discussions toward achieving a truly attractive PCT system for users worldwide.

[Annex II follows]

ANNEX II

UTILIZATION AND ANALYSIS OF FEEDBACK ON WOISA/ISR AND
SHARING OF ANALYSIS RESULTS**SUMMARY**

1. Recognizing the importance of developing the following two frameworks, the JPO proposes that cooperation among ISAs begin first as a starting point for advancing them as we aim to improve the quality of PCT work products and thereby make the PCT system an effective and efficient global patent application system:

- framework under which ISAs analyze and utilize feedback on WOISA/ISR from DOs that conducted First Actions;
- framework under which the results of analysis conducted by ISAs are shared with the DOs, as well as with other offices when appropriate.

The proposal submitted by the JPO does not force any ISA to develop the two frameworks, but simply suggests that ISAs willing to develop such will consider doing so voluntarily.

2. In addition, the JPO proposes that Offices cooperate in taking measures, which include existing projects and new proposals for improvements, to deal with points identified for improvement in the analysis. Doing so would enable continuous improvements of the PCT system to be made.

3. In working toward developing these frameworks and ensuring the continuous improvement of the PCT system, the JPO is confident that both the feedback and the analysis will prove to be useful, based on the results of Phase 3⁸ of the Trilateral Collaborative Study on Metrics, which the EPO and the JPO will begin from 2013. This Phase 3 will be positioned as Step 1 in developing the frameworks, in that it will attempt to determine the degree of discrepancies between the international phase and the national phase first actions at the EPO and JPO and seek to identify some of the underlying reasons for the discrepancies.

I. BACKGROUND

4. Nowadays issues dealing with improving the PCT are actively being discussed on a global scale. Under this current circumstance, projects aiming for improvement are earnestly being advanced in international cooperative activities by the Trilateral Cooperation and IP5. One of these projects is the “Trilateral Collaborative Study on Metrics”⁹. This study was started in 2010 and has been led by the EPO. In November 2012, it was agreed for the EPO and the JPO to start Phase 3 of the study. Phase 3 is a collaborative study on reviewing files for which there

⁸ Phase 3 of the Study will involve a more detailed collaborative review of a sample of files selected during Phase 2, for which there is significant discrepancy (an extreme example would be grant by Office A and refusal by Office B). The selected files will be reviewed to establish root causes and related frequencies. For example

- different legal requirements; or different practices;
- classification;
- documentation;
- translation and other language issues;
- differing interpretation of claims between examiners.

⁹ Please see paragraphs 9-14 of report of PCT/MIA/19/14.

are discrepancies between work products (WOISAs/ISRs) at the PCT international phase and examination results of First Action in the national phase¹⁰. Some offices expressed considerable interest in Phase 3 at the previous PCT MIA in 2012.

5. Discrepancies between results of the PCT international phase with those of the national phase are believed to occur because of various factors. These discrepancies are expected to be solved by taking specific measures to deal with each of the factors, so that the quality of ISRs and reusability of ISRs would be improved. In this regard, the JPO recognizes that Phase 3 and similar detailed analysis are useful to improve the PCT system.

II. SUMMARY RESULT OF DETAILED ANALYSIS OF THE DISCREPANCY CONDUCTED BY THE JPO

6. In light of the usefulness of the detailed analysis, the JPO conducted an analysis by randomly extracting files in which decisions made in the international phase by the JPO and national phase by other offices differed. The JPO then conducted a detailed analysis of the causes for the discrepancies. This analysis differs from that to be conducted in Phase 3, since this analysis was not conducted jointly with another office, but conducted solely by the JPO. Even though the JPO's analysis was small scale, the JPO confirmed the following cases, identifying the detailed causes of discrepancy for each file.

- (a) Cases in which search/examination results by the DO were appropriate
- (b) Cases in which search/examination results by the DO were deemed to be not necessarily appropriate
- (c) Cases in which XY citations in the JP-ISR were not used by the DO for First Actions due to language issues
 - (c-1) The citations were Japanese patent literatures with no foreign family
 - (c-2) The citations were Japanese, non-patent literatures
- (d) Cases in which neither the ISA nor the DO were deemed to be at fault
 - (d-1) Differences in laws or office practices
 - (d-2) Differences in interpretations of claimed inventions

7. In the case of (a) and (b) above, the JPO believes that the quality of search and examination results by ISAs and DOs would improve if appropriate measures were taken, such as giving feedback of results of analysis to examiners.

¹⁰ Moreover, as a first step, the two offices have been considering using structured data as a means to identify differences in outcomes between the international and national phases at the technical field level. Subsequently, areas of particular interest will be the subject of efforts aimed at explaining discrepancies in more detail.

8. In addition, it is important to deal with language issues seen in the case of (c) in order to enhance the usability of ISRs. The JPO thinks that issues seen such as in the cases of (c-1) can be dealt with by (1) increasing the accuracy of machine translation, (2) describing reference points in documents for which no translations are provided, and (3) making the descriptions in WOISAs and ISRs easily understandable. Since these measures are closely related to the “Revision of WIPO Standard ST.14¹¹” or “Standardized Clauses”¹², the JPO would like the other Offices to give feedback as to how the problems identified in the JPO’s analysis can be solved.

9. Furthermore, based on current operations dealing with non-patent literatures including the case of (c-2), titles of Japanese non-patent literatures cited in ISRs are partially translated into English while the remaining parts are merely transcribed into the Roman alphabet, as shown below:

(Example)

Network-jo Kobunshi Nano Fiber no Keisei to Gas Bunri Zairyo eno Oyo
(Underlined words are transcriptions to Roman alphabet)

Based on the translation described above, the JPO is not sure if examiners in other Offices can easily identify or obtain Japanese non-patent literatures. Based on this, the JPO would like to ask comments about this from the other Offices using JP-ISRs. The JPO hopes that we can all consider various problems such as how ISRs should be translated or how to make non-patent literatures easier for examiners to use.

10. The above is the summary of the results of the JPO’s analysis. By having DOs and Other IP Offices (when appropriate) share these kinds of analysis results, they can obtain analysis results that have different viewpoints from their own i.e., obtain many viewpoints from the various ISAs. The JPO believes that such sharing of analysis results is beneficial in the following aspects:

- improving search and examination quality at each office based on utilizing analysis results conducted by ISAs;
- enhancing usability of ISRs and efficiency of search and examination through deepening mutual understanding among ISAs and other Offices;
- cooperating on developing measures together so as to deal with issues by mutually understanding the underlying causes of discrepancies.

III. PROPOSALS

(1) DEVELOPING FRAMEWORK UNDER WHICH ISA ANALYZE AND UTILIZE FEEDBACK ON WOISA/ISR FROM DO THAT CONDUCTED FIRST ACTIONS

11. As mentioned above, the JPO recognizes that it is beneficial for ISAs to utilize the analysis results dealing with the causes of discrepancies between the international phase and national phase, in order to improve the quality of ISRs.

12. Therefore, the JPO proposes that the ISAs first begin work to advance the development of the framework for analyzing and utilizing feedback on WOISAs/ISRs from DOs that conducted First Actions.

¹¹ PCT/MIA/19/11,CWS/2/6

¹² PCT/MIA/19/2

13. In order to establish the frameworks, it is necessary to obtain search and examination results of DOs or feedback from DOs. This would be done by utilizing related tools and infrastructures such as the Quality Feedback System, Common Citation Document (CCD) and dossier systems. The JPO is of the opinion that Authorities need to be actively involved in the development of such systems, aiming to have the systems utilized for conducting analysis in an efficient manner.

(2) DEVELOPING FRAMEWORK UNDER WHICH THE RESULTS OF ANALYSIS CONDUCTED BY ISAS ARE SHARED WITH THE DOS, AND OTHER OFFICES

14. As described in Paragraphs 7 and 10, there are some cases in which it is useful to DOs and other offices to be provided analysis results conducted by ISAs. For example, there are some cases under (a) and (b) in which discrepancy was due to problems related to substantial search and examination details/practices at the ISAs or DOs in how they conducted searches or how they determined patentability. The JPO is of the opinion that the causes for these discrepancies should be dealt with over a long-term perspective, while the sharing among the Offices of details on the actual results obtained through analysis will lead to speeding up the development of measures for resolving problems, based on a unified understanding.

15. Also, the JPO believes that some ongoing projects should be advanced after each ISA fully understands the details of the actual problems and work together for the advancement. As a result, this would lead to reaching a more beneficial outcome. The JPO is of the opinion that “Standardized Clauses” and improving the formality of PCT work products (WOISA/ISR) are examples of the projects mentioned above.

16. Therefore, in considering the development of the framework that enable analysis results by ISAs to be shared among DOs and other Offices when needed, the JPO proposes that the development of such the framework should be advanced among ISAs cooperating together, working in line with (1). In the JPO’s view, it is meaningful for individual ISAs to continuously cooperate to resolve the issues identified in the analyses as to the causes of discrepancy under this framework. Doing so will make the PCT system more effective and attractive for all stakeholders.

17. Moreover, the JPO considers obtaining feedback not only from DOs but also from users as one more PDCA cycle. Feedback from users can be obtained from user surveys and other means. Therefore, the JPO also hopes to be able to discuss how the results of user surveys can be shared and utilized among ISAs.

IV. STEPS FOR DEVELOPING THE FRAMEWORKS

18. The JPO’s analysis shown in section II was solely conducted by the JPO and the results were not provided to other offices (DOs), even though they are meaningful to the JPO as an ISA. Nevertheless, there has been no discussion on the merits of sharing analysis results, and to the extent that sharing such results would enhance the convenience to stakeholders of the PCT system. The JPO expects that Phase 3, the Metrics Study that will be conducted by the EPO and the JPO collaboratively, will shed light as to the causes for discrepancy between the international and national phases. The results of the study will be shared between both offices. As a result, we expect that discussion on the above will be possible.

19. In this context, Phase 3 to be implemented by the EPO and the JPO can be seen as the first step in developing the frameworks. While cooperating together with the EPO in following the principle objectives of the Metrics Study, the JPO is confident that the EPO and the JPO will successfully find a useful information and outcome to consider in developing the frameworks.

20. Based on the above, the JPO will report various items of information and its experience in regard to developing the frameworks to all interested ISAs. In our view, Phase 3 should be advanced by taking the following items, which should be considered for developing the frameworks, into consideration.

- (a) Scheme for obtaining feedback on WOISAs/ISRs from DOs
- (b) Methodology for analyzing feedback information
- (c) Methodology for utilizing analysis results
- (d) Scheme for providing analysis results to DOs
- (e) Scheme for cooperating to eliminate causes of discrepancy

21. From 2014, the JPO hopes to review the meaning of the frameworks based on the report, considering a roadmap for developing both the frameworks themselves and their details with other offices.

[End of Annex II and of document]