

Measures taken by each Office that are beneficial to users

IP5 Industry Consultation Group Meeting

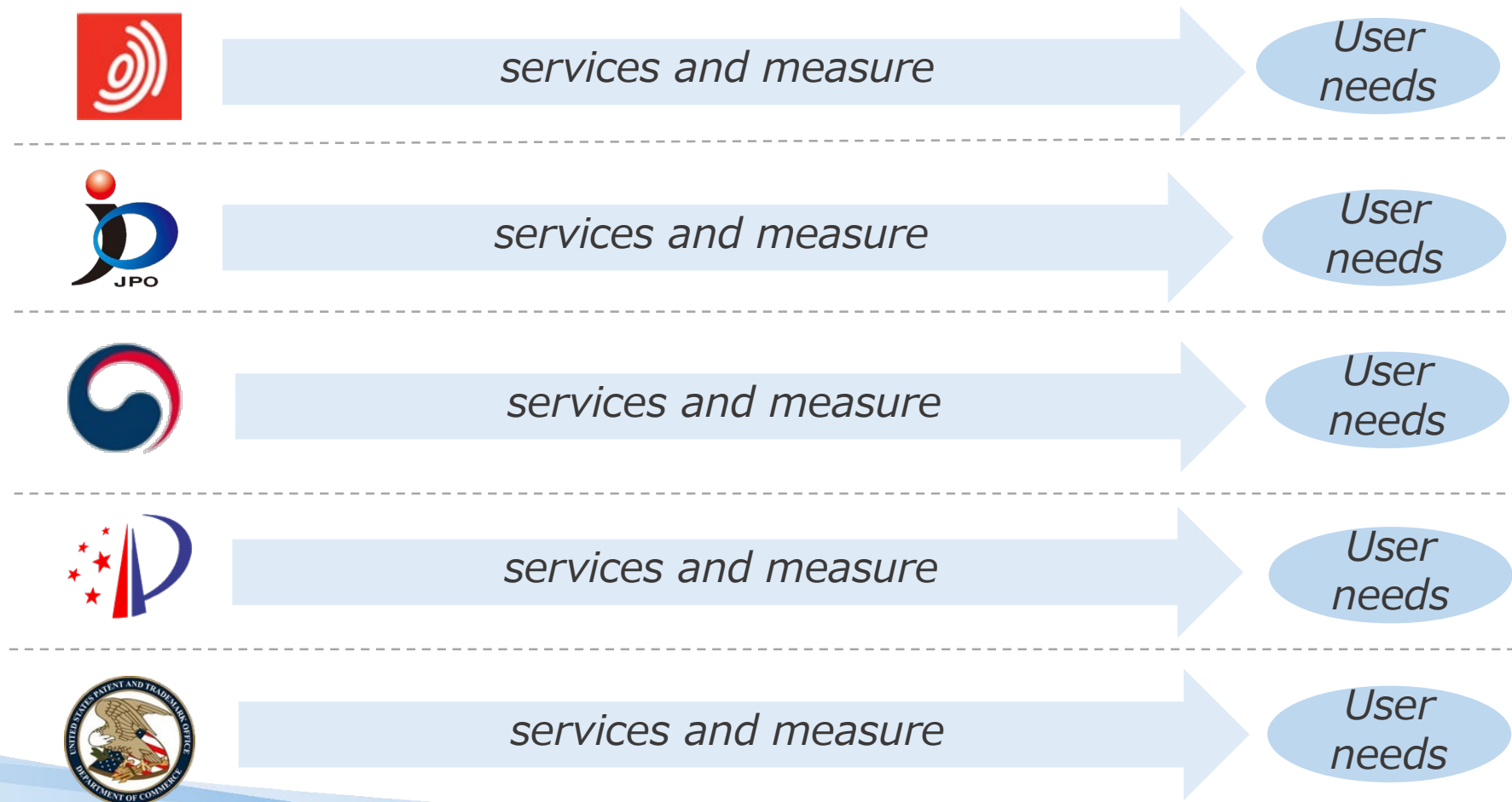
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Japan Patent Office



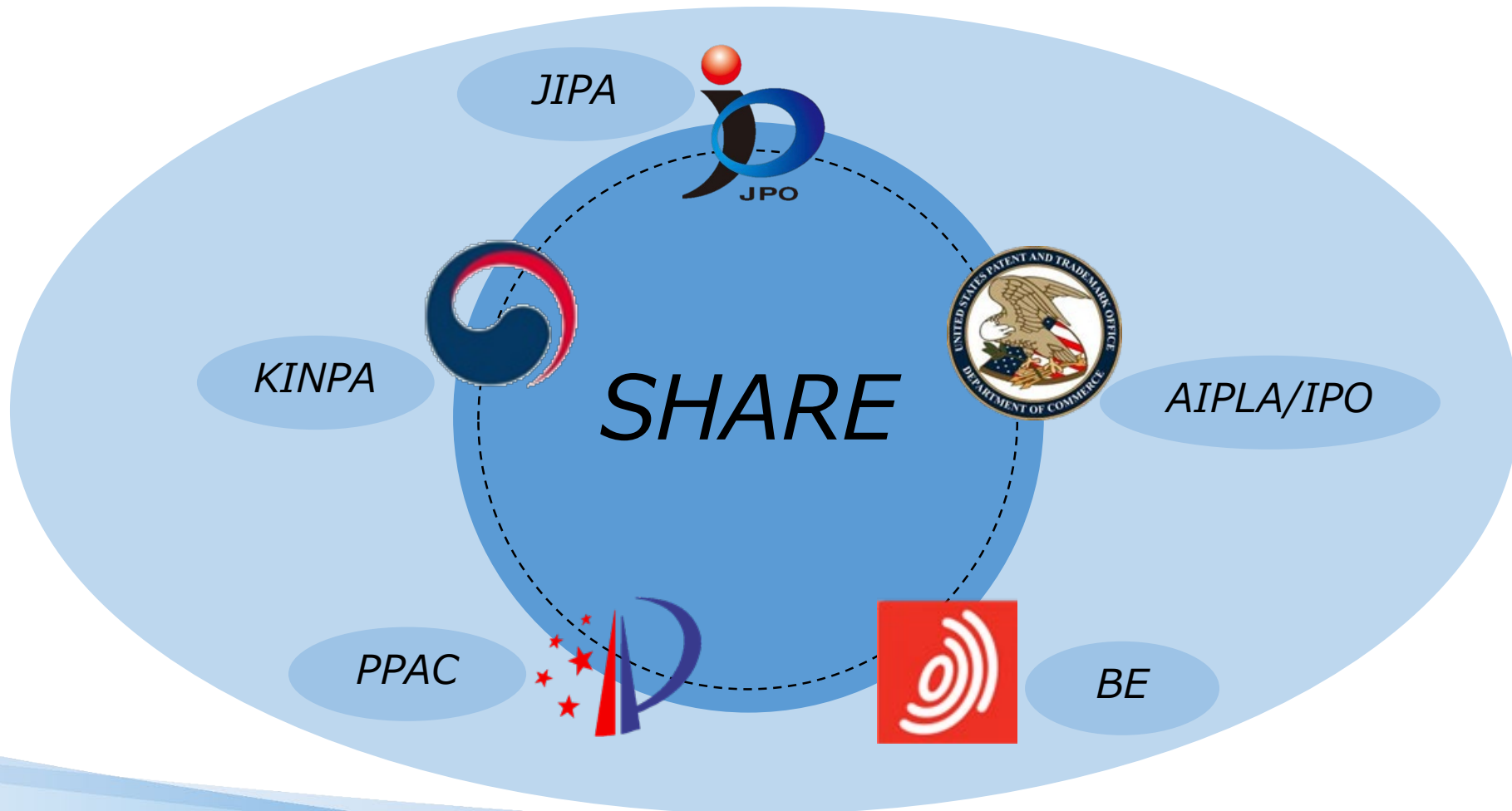
Background

Each office is working on its own measures to meet the user needs variously.
But **those measures are not fully shared among IP5.**



Background

Sharing beneficial measures of each office among IP5 will provides hints for each office to improve its service measures.



1a. Measures taken by each office useful as procedural measures in examination procedures 1/5

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Accelerated patent examination		AIPLA
All Offices	Patent Prosecution Highway (PPH)	- It's been a useful tool historically. More user input could be helpful in trying to improve PPH in order to meet the current needs of users.	IPO
All Offices	Patent database	- Easily conduct patent searches. Easily review and get file wrappers.	JIPA
?	Accelerated examination procedures with no fees/less requirements	- Friendly to applicants	JIPA
?	Automatic annuity payment system	- Save the trouble of payments. No failure to make payments by mistake / oversight.	JIPA
?	Electronic services provided by offices	- However, some services do not offer electronic options, which greatly increases the burden of users. For example in some offices: <ul style="list-style-type: none"> · Paper patent certificates · Some communications via paper · If a priority is PCT application, ONLY Paper priority document can be submitted. - Therefore, Offices are highly expected to provide electronic services including certificates or any other communications.	PPAC

1a. Measures taken by each office useful as procedural measures in examination procedures 2/5

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
EPO	Translation system of gazettes into multiple languages	- Easily understand inventions.	JIPA
EPO	Auxiliary Request	- Speeds up examination process and increases chances of registration. - Allows applicant to file a Main Request as well as an Auxiliary Request to overcome issues raised by Examiner.	KINPA
EPO	PACE	- Effectively reduces time spent (50% or more) on Examination.	KINPA
JPO	Applicant identification number system	- No longer need to enter the applicant's address in application form because the address is linked to the applicant's identification number.	JIPA
JPO	Re-issuance of patent certificates	- In case of assignment of patent, some assignees requests assignor to provide the patent certificates as evidence. In such event, if the certificate is missing, the re-issuance is helpful.	JIPA
JPO	Issuance of patent certificates to all joint patent holders		JIPA

1a. Measures taken by each office useful as procedural measures in examination procedures 3/5

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
JPO	Inquiry of predicted period for starting patent examination (individual inquiry)	- Useful for third party observations	JIPA
JPO	Inquiry of predicted period for starting patent examination (list of predicted periods for starting patent examination)	- It would be more useful if the period were 2-3 months instead of 6 months.	JIPA
JPO	Apply for the interview on the website	- Interview request will be accepted without fail.	JIPA
JPO	Unified examination for business strategy	- It may be useful when technologies of a product are related to multiple fields. It makes it possible to acquire patent rights related to business strategy in a cross-field manner when they are needed. - High-quality examination will be conducted.	JIPA
JPO	Super Accelerated Examination	- Reduces the examination period from 14.1 months to 2.5 months (on average) from the date of examination request.	KINPA
KIPO	Inquiry of information on patent gazettes, etc. by QR code	- Smoothly acquire patent gazettes, etc.	JIPA
KIPO	Electronic patent certificate	- No longer need to keep paper patent certificates.	JIPA

1a. Measures taken by each office useful as procedural measures in examination procedures 4/5

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
KIPO	Amendment Review Request	<ul style="list-style-type: none"> - Allows applicant to discuss a proposed amendment through an Examiner interview prior to the filing of a response to an office action. - Allows the applicant to submit a proposed amendment before conducting the Examiner interview to provide the Examiner with time for review and preparation of the applicant's submission. - Useful for applicant to understand and analyze Examiner's opinion on the proposed amendment. 	KINPA
KIPO	Provisional Application	<ul style="list-style-type: none"> - Allows applicant to claim earlier priority dates for their inventions. 	KINPA
CNIPA	Multiple examination procedurals (Accelerated, Normal, Deferred)	<ul style="list-style-type: none"> - It can better meet the user's needs. 	PPAC
USPTO	Pre-Appeal Brief Conference pilot program	<ul style="list-style-type: none"> - These conferences save time and expense by helping to focus issues. 	AIPLA
USPTO	After Final Consideration Pilot (AFCP) 2.0	<ul style="list-style-type: none"> - It has proven to be a useful tool to reach agreement with Examiners. - It has resulted in efficiencies and lowered costs. 	IPO
USPTO	Request for Continued Examination (RCE)	<ul style="list-style-type: none"> - Allows applicants an opportunity to overcome rejections even after the Final Rejection. - Provides applicants effective measures to protect their rights to Inventions. - Provides applicants certain degree of freedom to change scope of their claimed invention. 	KINPA

1a. Measures taken by each office useful as procedural measures in examination procedures 5/5

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
USPTO	Continuation Application (CA) / Continuation-in-Part (CIP) Application	- Useful for speeding up the examination process for corresponding applications filed in participating intellectual property offices from around the world.	KINPA
USPTO	Terminal Disclaimer	- Useful tool for overcoming Double Patenting issues	KINPA
USPTO	Incorporation by Reference	- Effectively protects applicant rights to their inventions by utilizing prior-filed application details in the later filed related application in Office Action Responses.	KINPA
USPTO	Prioritized Patent Examination Program (Track One)	- Allows users to get a final disposition within about twelve months.	KINPA
USPTO	Patent Prosecution Highway (PPH)	- Useful for speeding up the examination process for corresponding applications filed in participating intellectual property offices from around the world.	KINPA
USPTO	Quick Path Information Disclosure Statement (QPIDS)	- Since it is a requirement in the USA to file an IDS, if it has been overlooked at the time of filing or during the process of examination, this tool can efficiently resolve such issue.	KINPA

1b. Efficient and effective communication/interaction in examination procedures 1/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Examiner interviews by Video Conference	<ul style="list-style-type: none"> - It allows participants to save travel time and costs, is desirable from an environmental point of view, and is very much needed in order to promote procedural efficiency, especially in times like the current pandemic. - IPO does not express a view regarding the general question of whether a party should be made to attend by ViCo if a party does not consent, as in person hearings or interviews may be preferred. - IPO has a concern about one party being ordered to attend a hearing by ViCo over its objection when in-person oral proceedings are planned. - Also, some IPO members have expressed that their organizations have security concerns with and/or do not permit the installation of certain ViCo platforms; - IPO suggests the Offices consider whether it is possible to provide an alternative platform when appropriate. Also, IPO believes that it is essential that the right of all parties to be heard does not get impaired or denied if and when technical difficulties arise. 	IPO
All Offices	Interviews with Examiner	<ul style="list-style-type: none"> - Promote mutual understanding between examiner and applicant (inventor) regarding the invention to seek patent. Smoothly acquire patent rights with less number of OA. 	JIPA
All Offices	Video Interviews	<ul style="list-style-type: none"> - Save transportation costs and time, especially useful for distant applicants. 	JIPA

1b. Efficient and effective communication/interaction in examination procedures 2/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Exchange of opinions with Patent Office	- Allow users to share their needs and to discuss patentability of the latest technology, etc.	JIPA
CNIPA & USPTO	Telephone Interviews	- They are very efficient and effective.	PPAC
CNIPA	Tele-Conference with Examiners	- Speeds up the process of examination by assisting Examiners on technical aspects of inventions. Useful for understanding Examiner's intentions.	KINPA
USPTO	Examiner interviews	- It's proven an effective but often underutilized tool for advancing prosecution and resolving misunderstandings over claim language and prior art. - In-person examiner interviews are often preferred to telephonic interviews when practical but are not now available due to Covid-19.	AIPLA
USPTO	After Final Consideration Pilot (AFCP) 2.0	- Useful for responding to the final Office Action. - Able to receive Examiner opinions on proposed amendments via Examiner interview.	KINPA
USPTO	Video/Tele-Conference with Examiners	- Effective communication tool between Examiner-Applicant/Inventor/Agent	KINPA

1c. Measures taken by each office beneficial in opposition, appeal or post-grant procedures 1/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Hearings by Video Conference	<ul style="list-style-type: none"> - It allows participants to save travel time and costs, is desirable from an environmental point of view, and is very much needed in order to promote procedural efficiency, especially in times like the current pandemic. - IPO does not express a view regarding the general question of whether a party should be made to attend by ViCo if a party does not consent, as in person hearings or interviews may be preferred. - IPO has a concern about one party being ordered to attend a hearing by ViCo over its objection when in-person oral proceedings are planned. - Also, some IPO members have expressed that their organizations have security concerns with and/or do not permit the installation of certain ViCo platforms; - IPO suggests the Offices consider whether it is possible to provide an alternative platform when appropriate. Also, IPO believes that it is essential that the right of all parties to be heard does not get impaired or denied if and when technical difficulties arise. 	IPO
All Offices	Video oral proceedings	<ul style="list-style-type: none"> - They are useful and efficient in opposition appeal or post-grant procedures. It is highly appreciated that Offices provide video oral proceedings services in the COVID-19 epidemic period. - If the participants involved in the oral proceedings are from different countries, it is expected that the impact of jet lag can be properly considered in the scheduling of the oral hearing. 	PPAC

1c. Measures taken by each office beneficial in opposition, appeal or post-grant procedures 2/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Interview with Appeal Examiner	- Promote mutual understanding between examiner and appellant (inventor) regarding the issue on the patentability. Smoothly acquire patent rights with less time.	JIPA
USPTO	Post-grant review process before the Patent Trial and Appeal Board	- It has proven to be cost-effective and generally efficient approach to resolving many patent issues.	AIPLA
USPTO	Reissue	- Useful for correcting errors and/or changing scope of invention at the post-grant stage.	KINPA

2. Measures taken by each office beneficial in responding to COVID-19 1/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices?	Examiner interviews and hearings by ViCo		IPO
All Offices	Oral proceedings by videoconference	- European industry would like to see various platforms allowed for oral proceedings.	BE
All Offices	The increased flexibility regarding time-limits		BE
All Offices	Appropriate extension of the time limit and reestablishment of rights in response to COVID-19		PPAC
EPO	Allowing applications for extension of Oral Proceeding schedule	- Both Parties involved in the proceeding must agree	KINPA
JPO	Abolishing the use of stamps and paper documents	- JPO is considering to abolish the use of stamps and paper documents. It would be great if other patent offices would abolish wet-signatures and allow electronic signatures.	JIPA
JPO	Allowing Extension of Time once		KINPA

2. Measures taken by each office beneficial in responding to COVID-19 2/2

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
USPTO	Provisions related to relief for delays in filing certified copies of foreign priority applications and relief to restore priority or benefit rights for patent applications		AIPLA
USPTO	Oral proceedings by videoconference	- Industry would like to see various platforms allowed for oral proceedings.	AIPLA
USPTO	Waiving its remaining original handwritten signature requirements	- IPO suggests, where the national laws permit, that IP Offices accept and recognize simple e-signatures for office correspondence, declarations, powers of attorney, assignments, and any other documents that require signing. - IPO encourages the IP5 to allow IP owners the option to use advanced or qualified e-signatures to help alleviate burdens associated with in-person authentication.	IPO
USPTO	Deferred fee provisional application pilot program	- Applicants to defer payment of the provisional application filing fee until the filing of a corresponding non-provisional application (for COVID-19 related inventions).	KINPA

3. How the IP Office will interact with users in the future under the New Normal 1/3

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Virtual engagement, particularly with examiners during patent prosecution	<ul style="list-style-type: none"> - For some offices accustomed to readily-granted applicant/applicant's representative interviews, this will not be so difficult. For other offices where interviews are less common the transition may be more difficult. - In addition, current interview technology will need to be upgraded to allow applicant/applicant's representative to exchange documents real-time for discussion purposes. 	AIPLA
All Offices	E-signatures	<ul style="list-style-type: none"> - It helps the user community address the challenges it has faced with having documents signed and authenticated during the pandemic. - This could be accomplished by, where the national laws permit, accepting and recognizing simple e-signatures for any documents that require signing, while also allowing IP owners the option to use advanced or qualified e-signatures. 	AIPLA
All Offices	Virtual tools to have frequent exchanges, both at strategic and working level.	<ul style="list-style-type: none"> - Face-to-face meetings should however be maintained as these have some advantages compared to virtual meetings. 	BE
All Offices	Options for users that would accommodate increased virtual engagement with the IP Offices		IPO

3. How the IP Office will interact with users in the future under the New Normal 2/3

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Application and intermediate procedures that could be carried out via e-mail without a special system		JIPA
All Offices	Interview with an examiner for foreign patent applications that could be carried out in applicant's native language (using AI translation).		JIPA
All Offices	Expanding the virtual environment	<p>- Increase in active engagement between Examiner-Applicant/Inventor/Agent communications through virtual platforms. Systems such as Examiner interviews, appeals, oppositions, post-grant procedures being conducted in a virtual environment.</p> <p>- Conducting Examiner interview via sharing Desktop screens in a virtual environment to effectively communicate discussion points (increase in visual elements)</p> <p>DISCUSSION NOTE:</p> <p>- How will we deal with unauthorized recording of virtual communications (i.e. via smart-phone, video/screen recording tools)? Is it practical to not allow recordings? What penalties can we enforce?</p>	KINPA

3. How the IP Office will interact with users in the future under the New Normal 3/3

*Partially omitted. Please refer to original responses in details.

Office	Measures	Notes	Suggested by
All Offices	Virtual engagement (interviews, conference)	<ul style="list-style-type: none"> - However, considering that the effect of the virtual conference is not as good as that of the onsite conference, we hope that the procedural can be designed to give users sufficient opportunity to provide opinions, rather than just to speed up the process. 	PPAC
All Offices	Reviews with examiners	<ul style="list-style-type: none"> - They are useful for both clarifying the complex technology involved in the application and accelerating the grant procedure. - Under the pandemic, more virtual interviews are implemented with examination and post grant procedures. - However, the current tele-communication software is not functioning very well. - Explanations to the complicated mechanism could be weakened due to inconvenience/ ineffective information exchange. - We hope that more effort could be invested to tele-communication technologies, for example, portals to upload any documents, real-time demonstrative hand-sketch exchange and screen sharing. 	PPAC

Thank you

