

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Heads of five IP offices

Re: JIPA Comments on "Consultation on IP5 patent practices"

Dear Sirs:

We, the Japan Intellectual Property Association (JIPA), have learned that the "Consultation on IP5 patent practices" published by five IP offices inviting any comments from users by September 15, 2015. (<http://www.fiveipoffices.org/activities/harmonisation.html>)

We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

JIPA again express our sincere gratitude to the five IP offices for this opportunity to provide these comments and welcomes any opinions on them.

Sincerely yours,

(Masahiro KAMEI)

President

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JIPA Comments on "Consultation on IP5 patent practices"

1. Unity of invention

Thanks to the detailed report on the unity of invention published this time, we are able to understand the practice of IP5 offices and differences among the offices. JIPA expresses our sincere gratitude to the great efforts of the EPO and the SIPO as leading offices.

Meanwhile, as mentioned in the report, Industry IP5 made a proposal on the harmonization of the unity of invention in "Industry IP5 Consensus Proposals to the IP5 Patent Harmonization Experts Panel (PHEP)" (hereinafter, referred to as the "Industry IP5 Proposals") submitted on October 10, 2014.

As a background of the Industry IP5 Proposals, JIPA investigated the rejection rate of unity practice by four patent offices and the result is shown in Figure 1 (please see an attachment). The result indicated that the rejection rate in USPTO was apparently higher than that of other three patent offices, namely EPO, JPO and SIPO. With our further study, it appears that such rate is caused by different unity practice which may not be aligned with PCT standard. The higher rejection rate would also cause serious economical and practical burdens for users.

Furthermore, PCT route should also be taken into consideration. Figure 2 shows similar rate for both PCT and non-PCT applications.

We think that the direction of harmonization with regard to the unity of invention will be led by the EPO and SIPO. Because this issue has been prioritized, JIPA looks forward to demonstrating the timing when the harmonization is achieved and milestones for the harmonization.

2. Citation of prior art

JIPA expresses our gratitude to the USPTO and the KIPO who lead the citation of prior art.

According to the report, following two issues are selected for further study. .

- 1) First issue is what legal or procedural changes would be required to allow for an IT based solution to submission of prior art previously cited by another office.
- 2) Second issue is what legal or procedural changes would be required to adopt a common form for citation of prior art.

In the industry IP5 Proposals, the common form has been suggested as one of "ADDITIONAL DETAILS" and it was not categorized into the "BASIC PRINCIPLES" (e.g. IT solutions, maximum use of the Global Dossier and CCD to satisfy the disclosure

requirements, acceptance of machine translation) which Industry IP5 addresses to cope primarily.

We would like to comment on the background of the joint proposal.

As for the submission of prior art, some offices do not require whereas some offices require the submission along with translations during the examination process. In case the applicant fails to submit before such requiring offices, enforcement of the patent right may be disabled. The applicant is also required to submit the prior art documents cited in the other office(s) and to prepare a translation if those documents are foreign language documents in order to avoid such disablement. Thereby the applicants incur significant burdens on an economical, practical man-hour basis.

Meanwhile, the recent development of IT tools (Global Dossier, CCD, etc.) has enabled cross-wrapper viewing of prior art documents cited in the examination process among IP5 offices, and many of the offices require the citation of prior art only at the time of the filing of the application. Industry IP5 has proposed as the spirit of the joint proposal to request reduce and alleviate the burdens on the applicants at least for the prior art cited by the other offices in the examination process.

On this account, we respectfully proposed, as “BASIC PRINCIPLES”, IT solutions, maximum use of the Global Dossier and CCD to satisfy the disclosure requirements, and acceptance of machine translation.

We would request that the USPTO and the KIPO again recognize the background of the joint proposal and promote the “BASIC PRINCIPLES” (IT solutions, maximum use of the Global Dossier and CCD to satisfy disclosure requirements, and acceptance of machine translation).

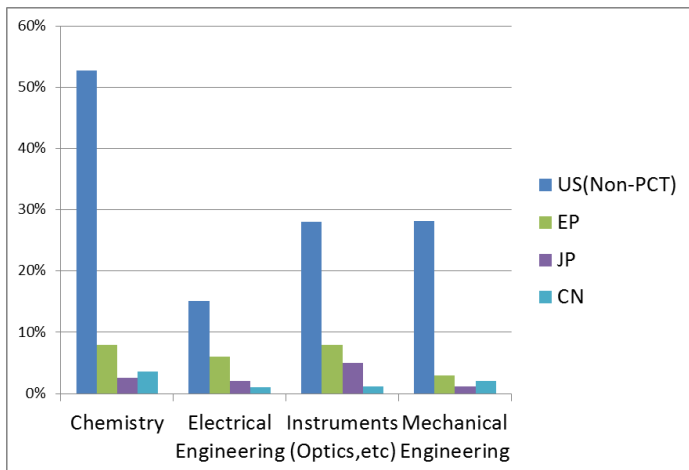
3. Written description

JIPA appreciates JPO organize the list of terms published this time. This list is helpful to understand what terms are used for each of the description requirements in each office. However, it remains unclear how the differences in the terms will be handled in the future (e.g., whether the offices aim to unify the terminology, or intend to use the list as a supporting material in judging on the description requirements in each office).

We would request that the offices should early disclose such points including how they will promote the harmonization of the description requirements in the future.

Attachment

Figure 1: The ratio of unity rejection among four offices



The ratio R is calculated based on:

$R(EP, JP, CN) = \text{number of OA containing unity rejection} / \text{total number of OA (EESR in EP)}$

$R(US) = (\text{number of Restriction Requirement} / (\text{number of first OA} + \text{number of RR}))$

*Four categories are based on “IPC and Technology Concordance Table (2008)” created by WIPO

*Over 500 cases are studied per each category of each country

*Trying to collect the cases which received OA around October 1 to December 31, 2013 (conditions are different from one country to another)

*In EP cases, EESR including rule 43(2) objection are NOT counted.

*In US cases, Election of Species are also counted.

Figure 2: Comparison the ratio of unity rejection between PCT route applications and Non-PCT route applications in USPTO

