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Subject: JPO's View on the USPTO's New Proposal of the "Inter-Office Document Sharing"

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JPO's View on the USPTO's New Proposal of the "Inter-Office Document Sharing"

1. Outline of the New Proposal

The JPO would like to express our respect for USPTO's efforts in the "Inter-Office Document Sharing" projects. Also, the JPO recognizes that the new proposal from the USPTO will further develop IP5 cooperation and would like to contribute to the future discussions.

According to the working document submitted by the USPTO, the JPO recognizes that the outline of the new proposal is as follows:

- Extract data from Global Dossier (GD) and provide automatic input tool to the form of documents to be filed to each Office. Due to this, it is expected to reduce burden on generating documents to be filed by an applicant.
- While the new proposal is a broad concept on the data processing of GD, in the short term, generating IDS documents of the USPTO is primarily concerned. Specifically, it is assumed that the system where the cited document information is to be input automatically with the utilization of the Dossier information in other Offices is selected.

2. Considerations on the New Proposal

(1) Validity of Policy Change

As being pointed out in the working document by the USPTO, in order to realize work sharing, many legal and practical issues remain, so it seems that it is difficult to immediately solve these issues.

Therefore, the JPO can agree to the USPTO's new proposal in starting to address these issues from feasible items.

(2) Possibilities as the Inter-Office Document Sharing

Since the new proposal focuses on data processing of GD and does not provide system solution regarding the procedures for submitting documents from an applicant to the Office, there is concern that some of the elements for realizing the Inter-Office Document Sharing are missing and that a great development toward cross filing cannot be made.

Therefore, the JPO thinks that it is necessary to consider additionally the construction of linking system that can submit generated documents to the Office directly through GD. In the short term, we should consider aiming for the IDS documents generated by using GD to be submitted directly to the USPTO by not using the existing USPTO's document

submission system but by linking GD with the USPTO's system. However, in considering such an Inter-Office Document Sharing, it is necessary to pay attention to not only for technical viewpoints, but also the consistency with the legislation regarding attorney of each country and language differences.

(3) Consistency with Statute

The JPO understands that, in the new proposal, a tool to support for generating documents of an applicant is provided and applicants and local agents should be responsible for the content of generated document. If this understanding is correct, it seems that no conflicts with the statute of each country will occur.

(4) Contribution as the JPO

The USPTO has pointed out in the working document that XMLization is important for extracting citation information. For the JPO, we would like to contribute to this projects by also promoting the XMLization projects.

(5) Applicant's benefit by reducing work burden of IDS document generation

In generating IDS documents, it is a fact that many applicants from IP5 Offices find it burdensome so if the work burden of an applicant can be reduced by the new proposal, IP5 Industry Groups will welcome this.

When an examiner refers to GD, it is now possible to refer to the prosecution history of the examination of each Office, so requesting an applicant to provide prior art documents has become less meaningful. Considering such circumstances, the JPO is requesting the USPTO to relax IDS, and also in PHEP, the study toward relaxing IDS is being carried out.

3. Conclusion

The JPO supports the fundamental ideas of the USPTO's new proposal. However, as mentioned in the above 2. (2), the JPO would like to propose to proceed with considering the proposal including the Active Component.

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