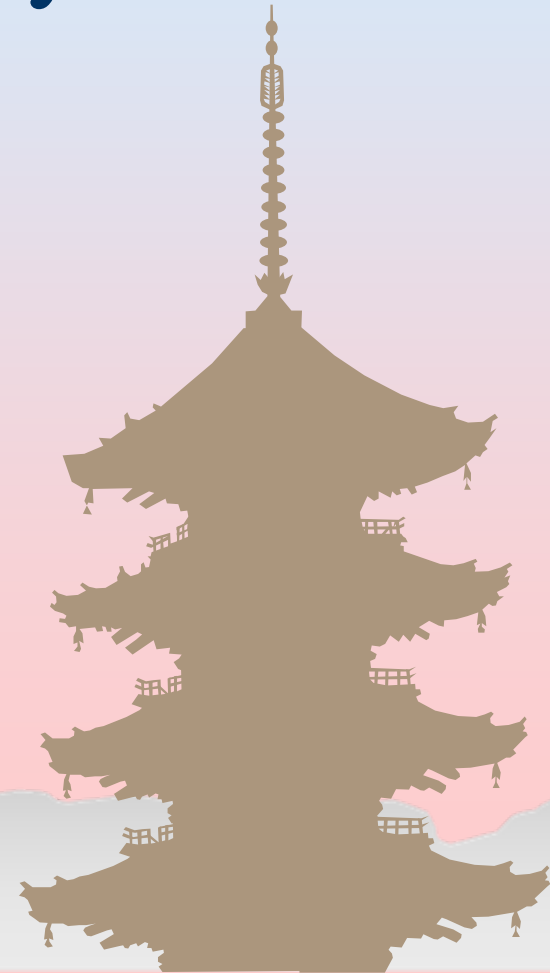


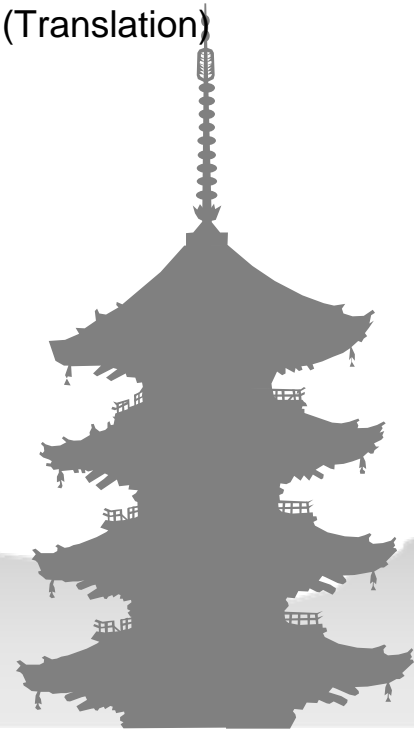
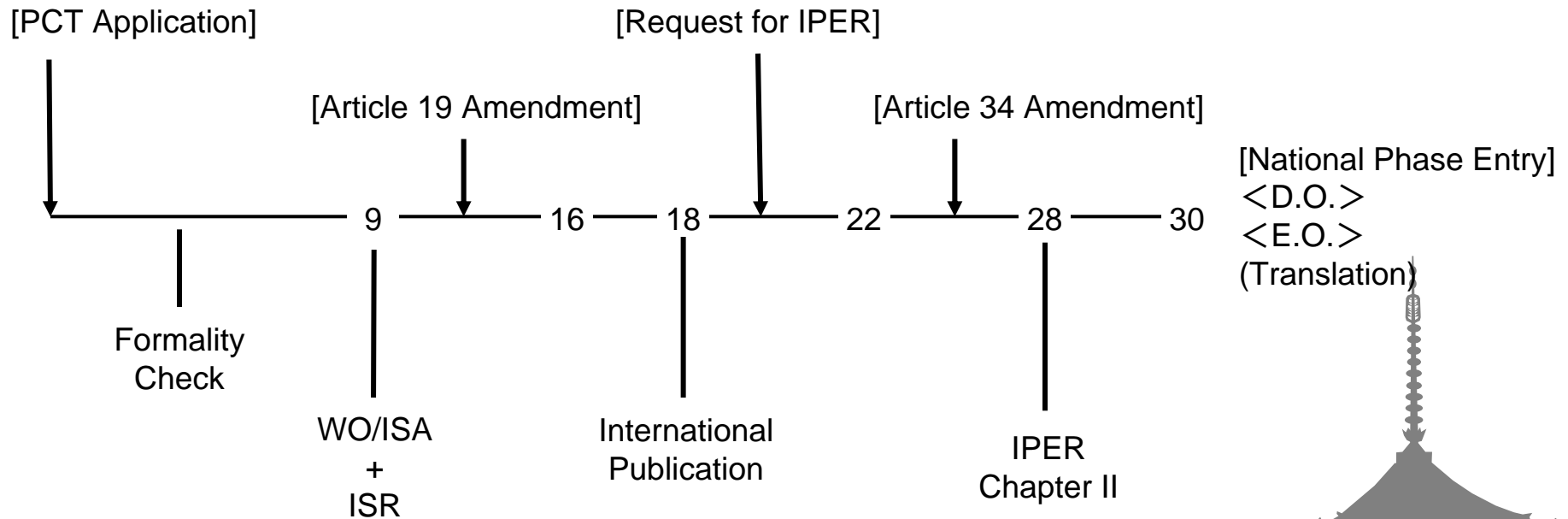
PCT System as an Important Tool for Business in a Global Market The Role of Attorneys

Tokyo, Japan
November 2010

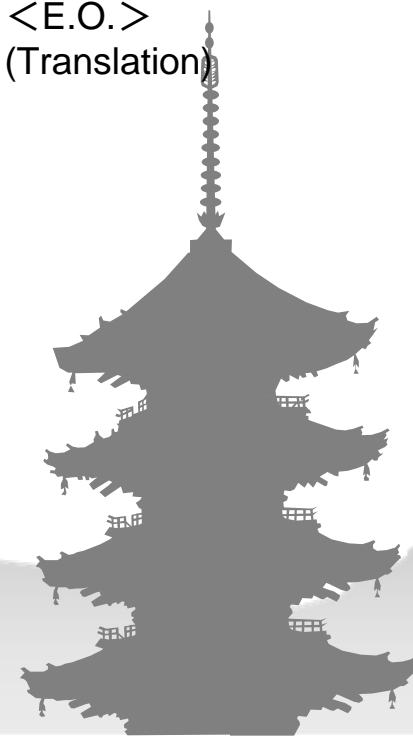
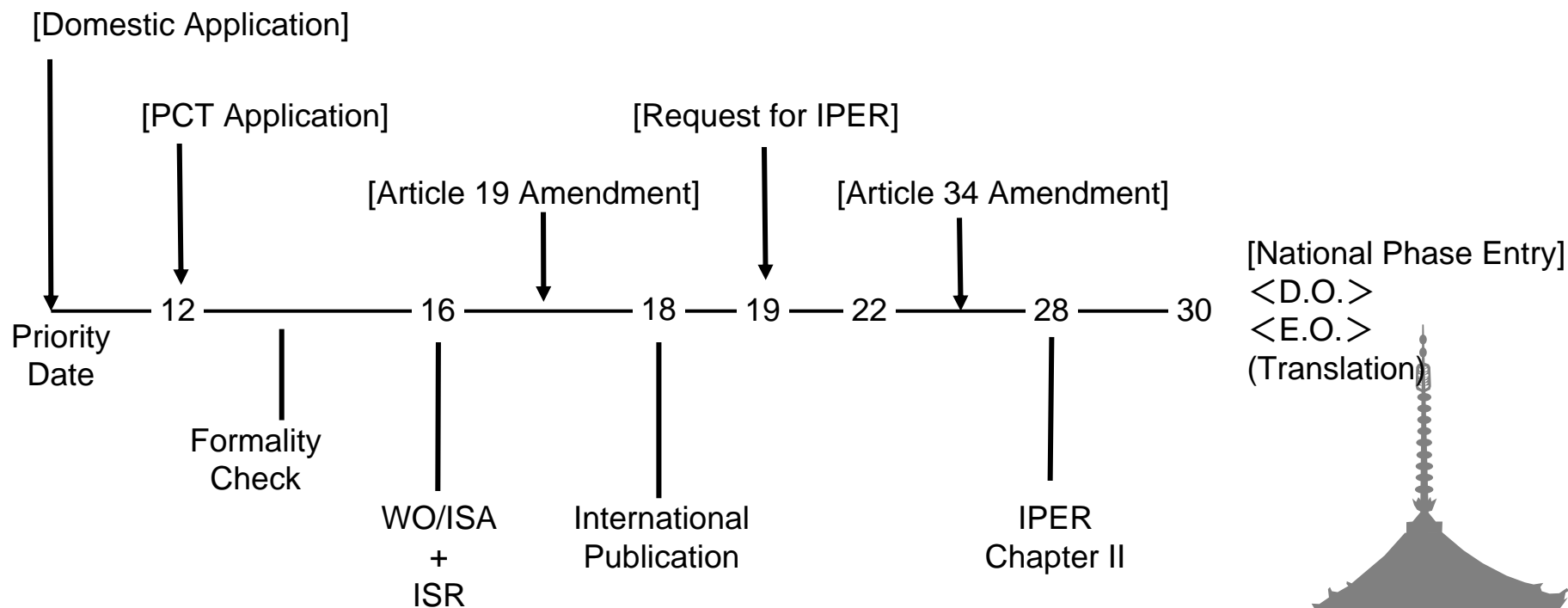
Takaki Nishijima



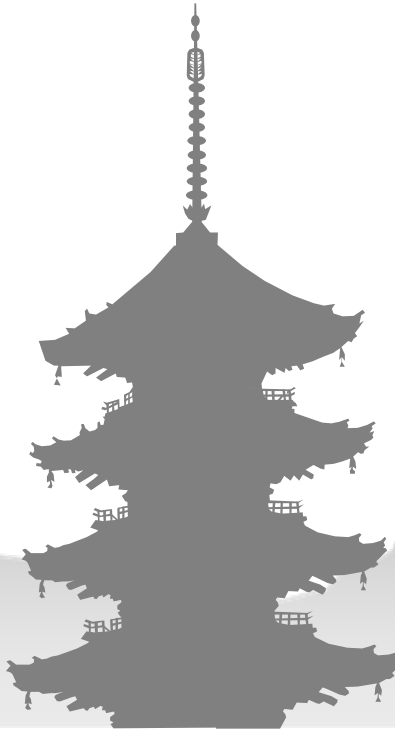
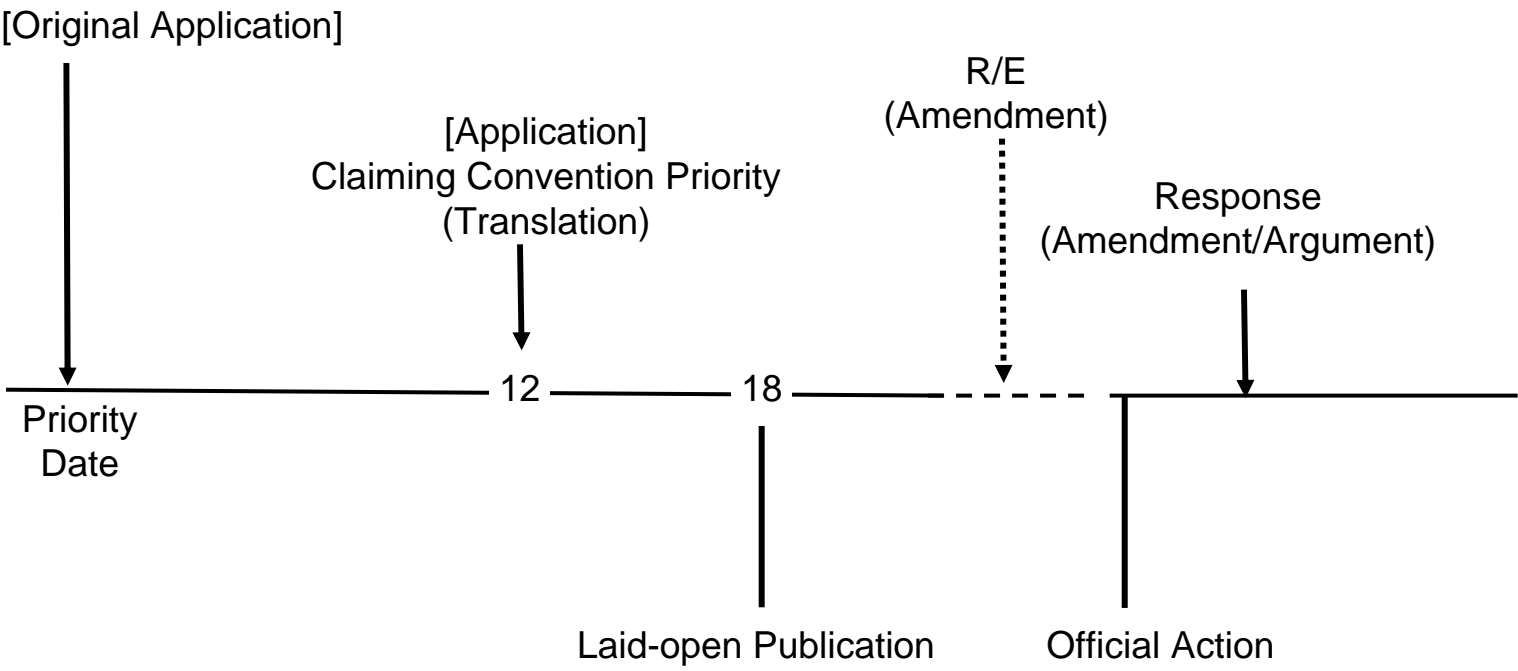
PCT Procedural Flow (Non-convention Priority Case)



PCT Procedural Flow (Claiming Convention Priority Case)

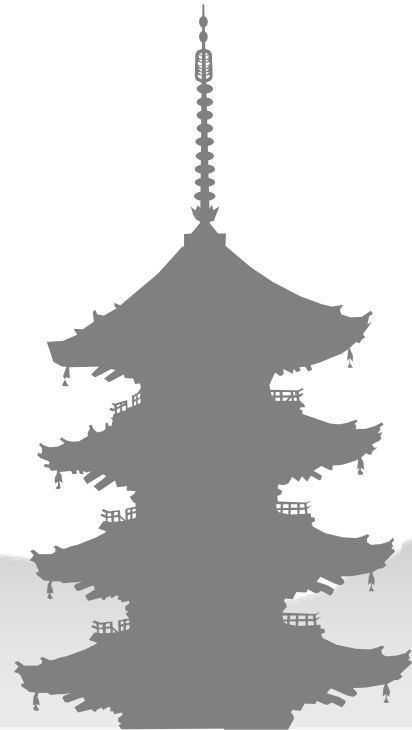


Paris Convention application Procedural Flow (Claiming Paris Convention Priority Case)



Comparison with Paris Convention route and PCT route

Time, Cost, Workload and Quality



Time

Paris Convention route

12-month Convention Priority term from original filing in a first country to a second country.

PCT route

30-month from Receiving Office to Designated Office through International Searching Authority

Cost

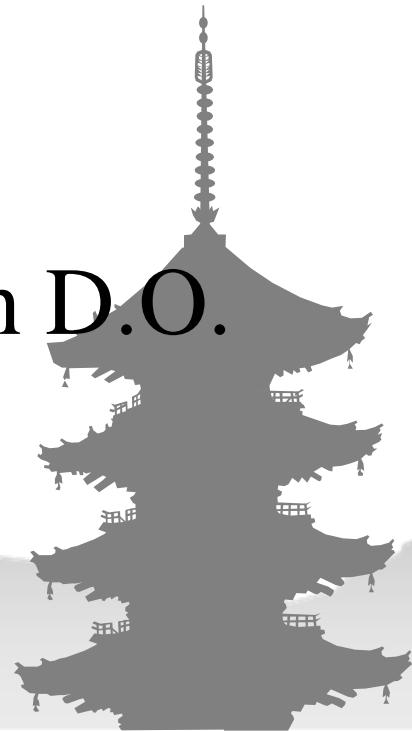
Paris Convention route

Application Fee for each second country
(Translation Cost)

PCT route

International Filing Fee

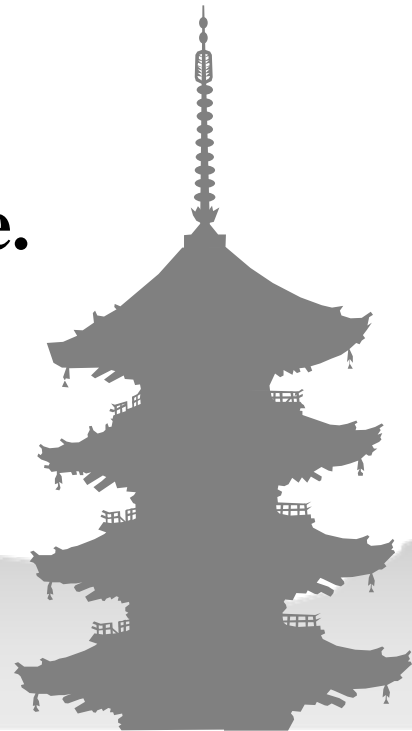
Entry Fee to National Phase of each D.O.
(Translation Cost)



Workload

Paris Convention route---It is necessary to manage the proceedings for each of the second countries in International Stage.

PCT route---- The proceedings are consolidated in the International Stage.



Quality

Paris Convention route---no information to evaluate the invention in International Stage before filing a second country.

PCT route---- The applicant can evaluate the invention based on International Search Report (ISR/WO) before entering D.O/E.O.

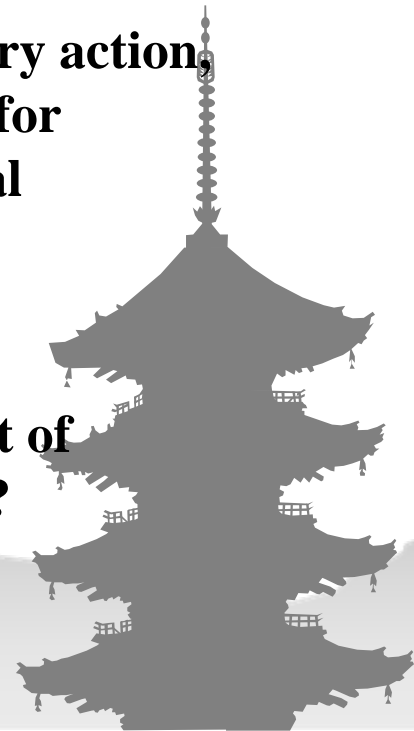


Consideration(1)

In PCT route, the applicant has to pay International Application Fee and Entry fee to Designated Office (D.O). In this context, the cost of PCT route looks higher than Paris Convention route since there is no need to pay International Application Fee in Paris Convention route.

However, the applicant of PCT application can evaluate the patentability of the invention based on the International Search Report (ISR/WO) and take a necessary action, such as filing an amendment based on Article 19, Request for International Preliminary Examination to get International Preliminary Examination Report (IPER), and thereafter, Amendment based on Article 34 and/or argument.

When the applicant receives a negative report of patentability in ISR/WO, how does the applicant proceed ?

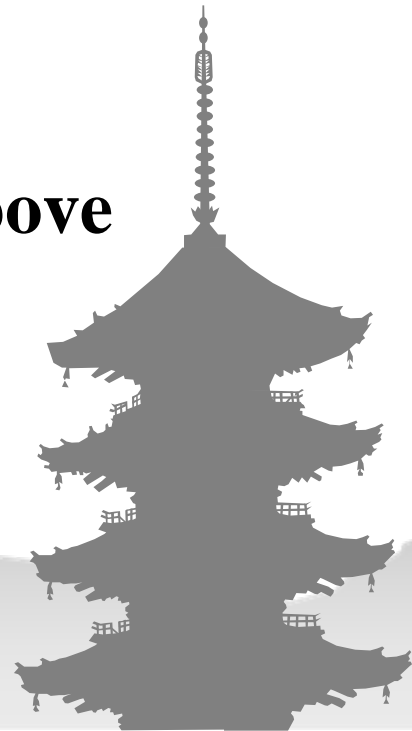


Consideration(2)

International Application Fee is about 215,000 Yen.

Request for International Preliminary Examination is about 55,000 Yen.

How does the applicant evaluate the above cost in the International Stage ?



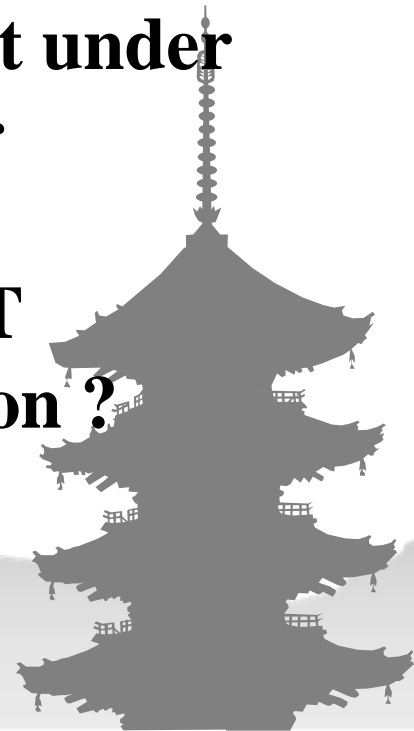
Consideration(3)

Where a negative report of patentability is included in ISR,

(1) should the applicant file an amendment under Article 19 ?

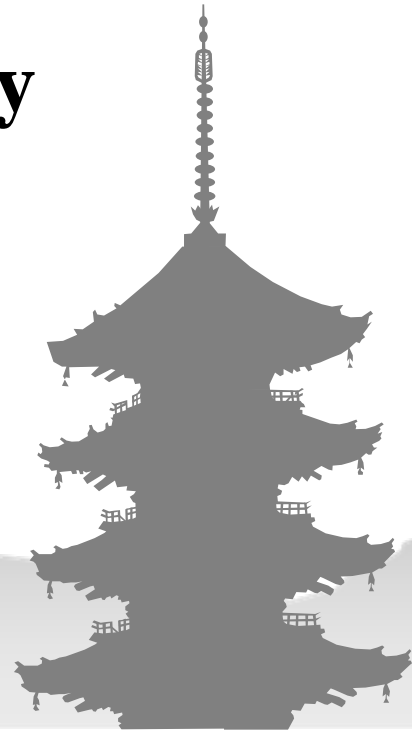
(2) should the applicant file an amendment under Article 34 concurrently with a Request for International Preliminary Examination ?

(3) should the applicant withdraw the PCT application before International Publication ?



Consideration (4)

The applicant will be influenced by the fact as to whether D.O. or E.O. adopts “Due Care” Criteria or “Unintentional” Criteria with regard to the “Reinstatement of Rights” or “Restoration of Priority Right”



Consideration(5)

Depending of the nature of invention, there is two situations ;

(1) quicker allowance is desirable,

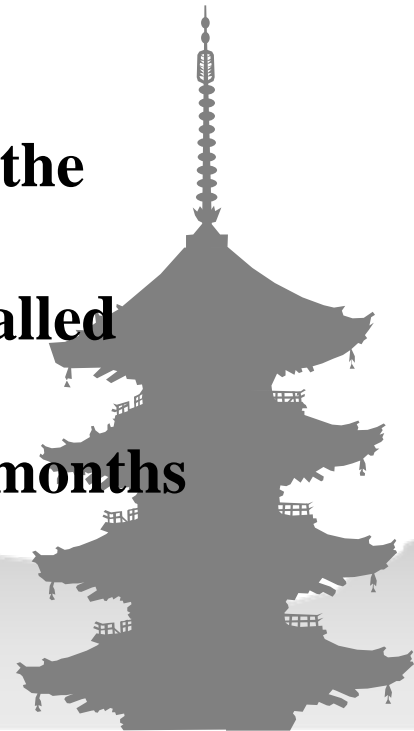
(2) take a time to evaluate the invention, such as market development, licensing condition, and the like.

Under PCT system,

it is possible to meet the above requirement in the both condition.

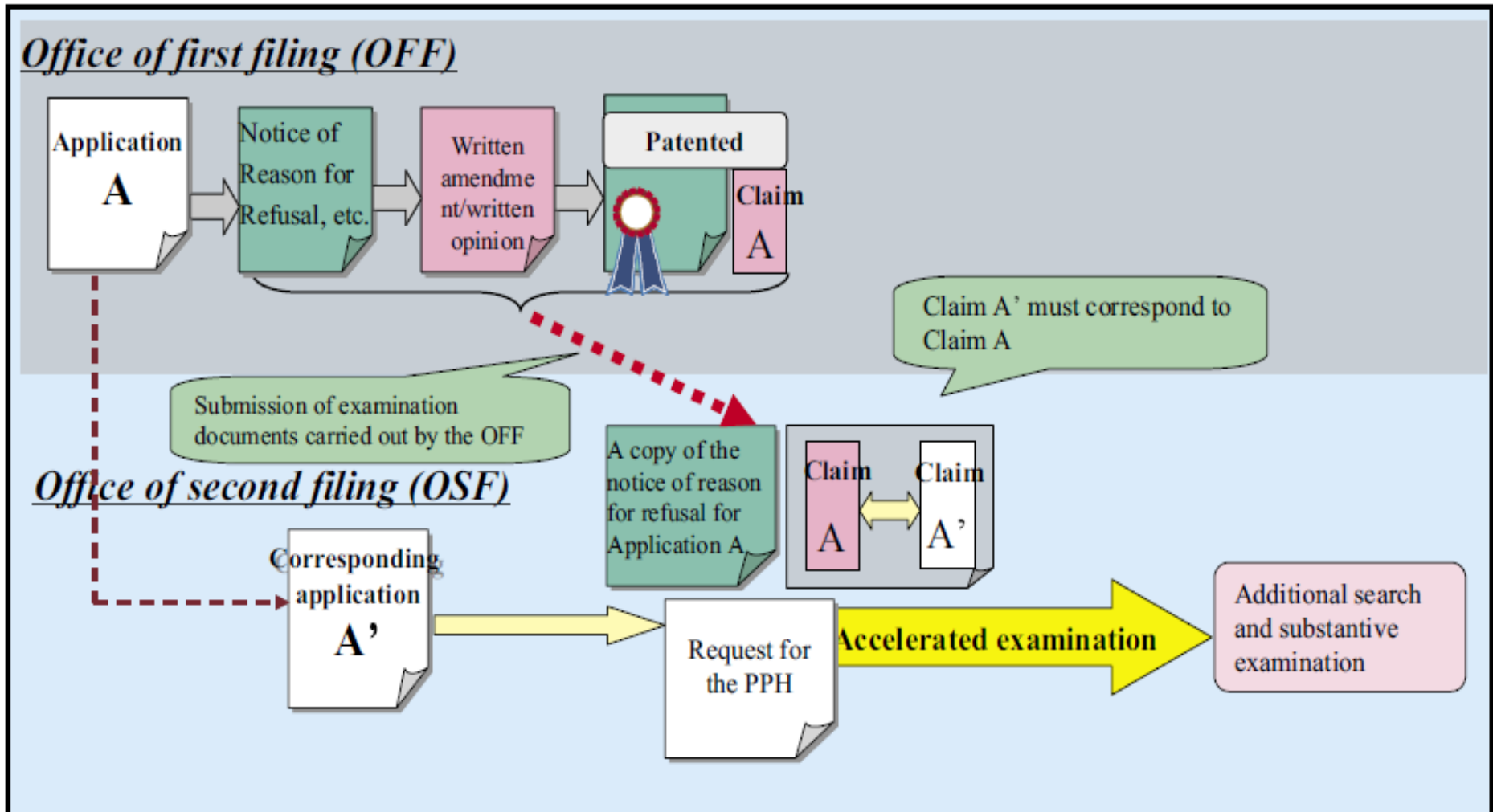
In the case of (1), the applicant can utilize so called PCT-PPH system.

In the case of (2), the applicant can wait of 30 months before entering to national phase.



Patent Prosecution Highway (PPH)

Outline of the Patent Prosecution Highway



Requirements for PPH using PCT International Work Products (PCT-PPH)

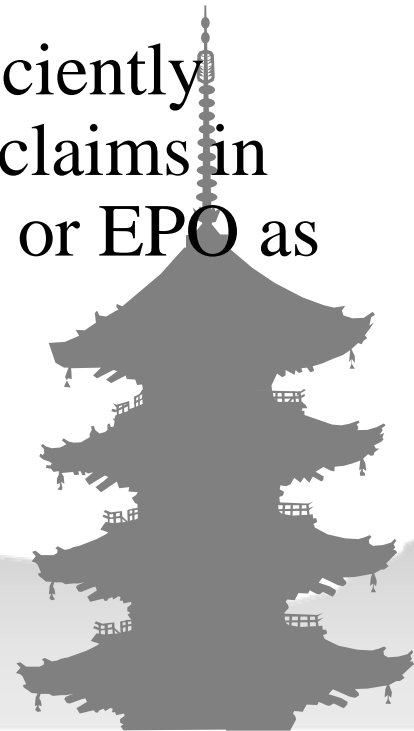
- ⌘ Corresponding PCT application has allowable claim(s) in the latest PCT international work products (*i.e.*, WO or IPER prepared by USPTO or EPO as ISA or IPEA).
- ⌘ All claim(s) in the JP application must sufficiently correspond to the claim(s) of the allowable claims in the latest WO or IPER prepared by USPTO or EPO as ISA or IPEA.

*WO : Written Opinion

*IPER : International Preliminary Examination Report

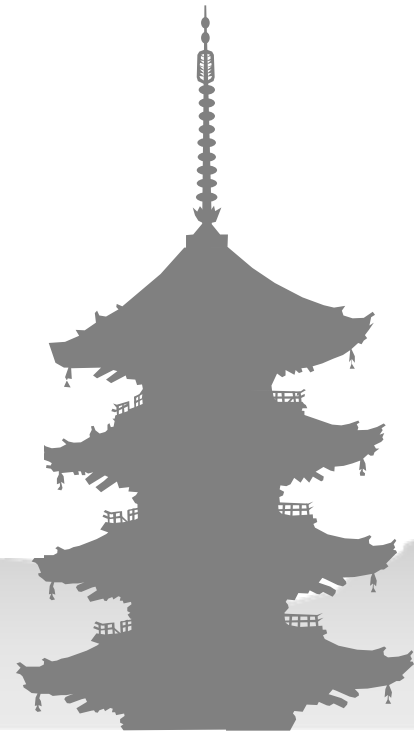
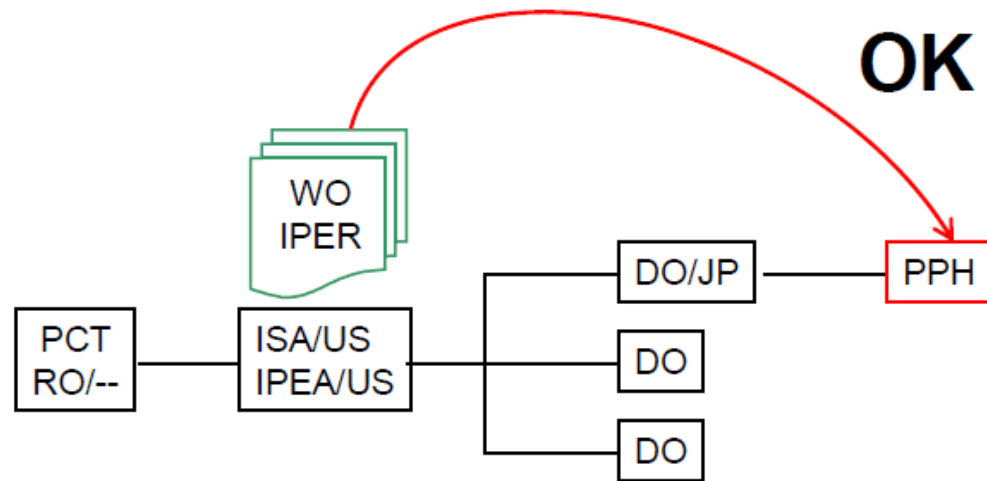
*ISA : International Searching Authority

*IPEA : International Preliminary Examining Authority



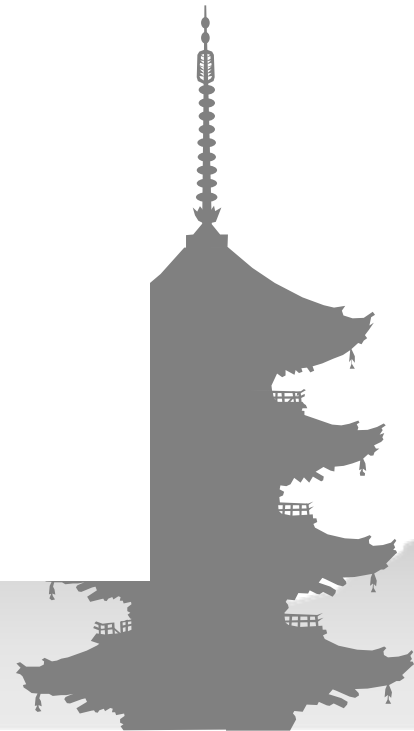
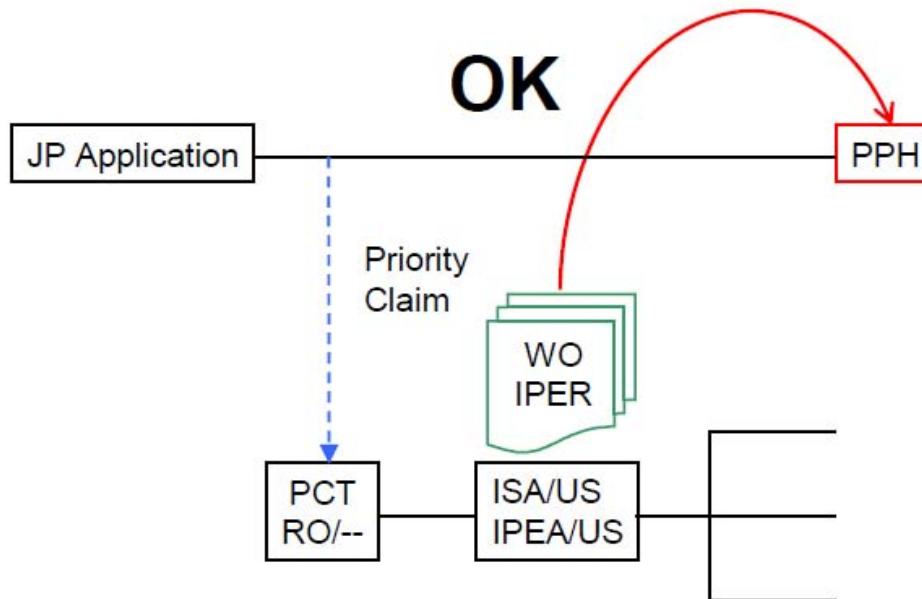
Eligibility for PCT-PPH -- Case (A)

(A) The application is a national phase application of the corresponding international application.



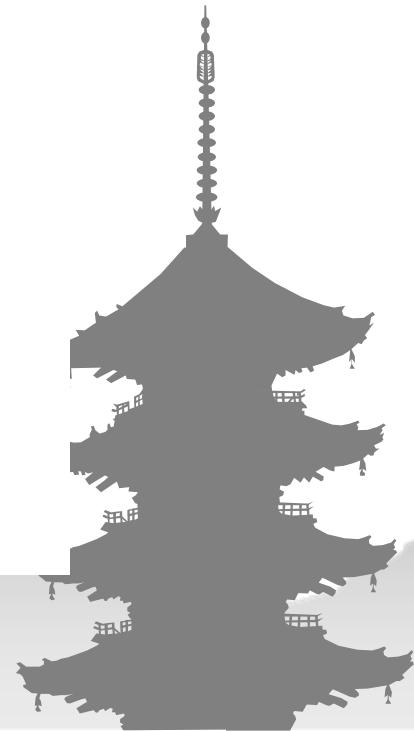
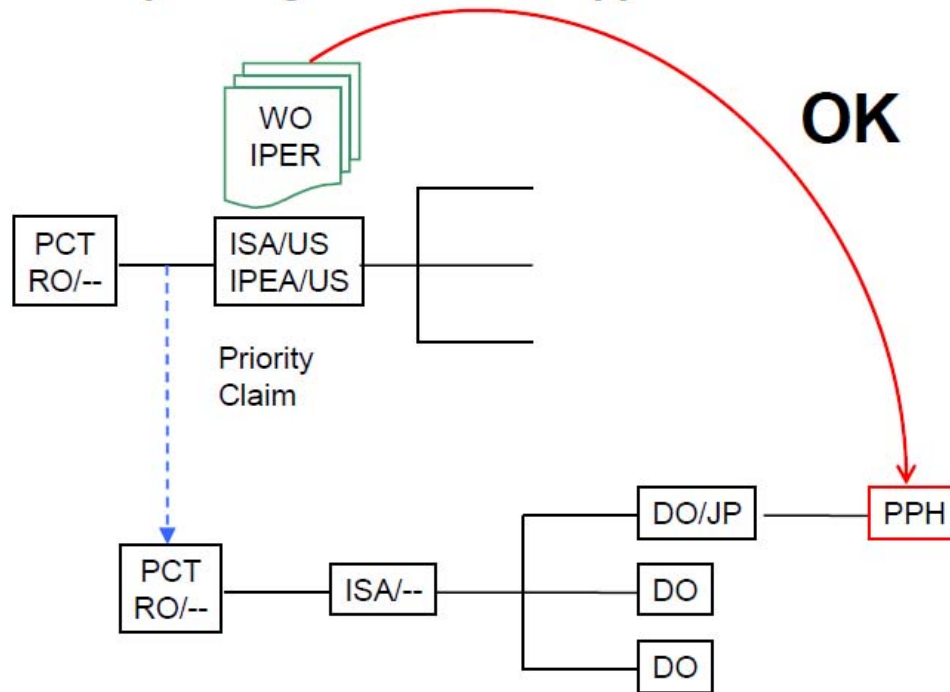
Eligibility for PCT-PPH- Case (B)

(B) The application is a national application as a basis of the priority claim of the corresponding international application.



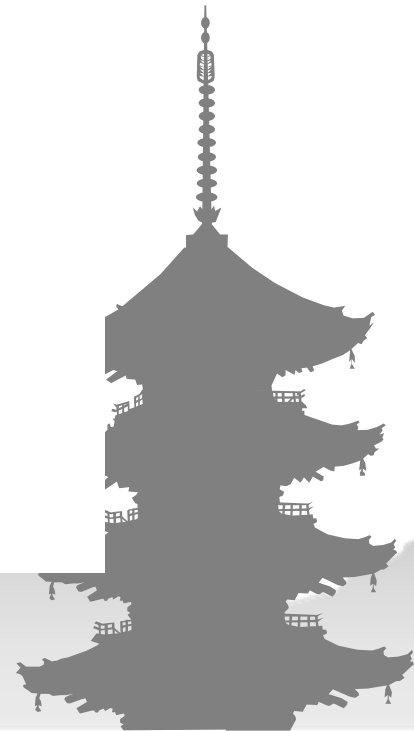
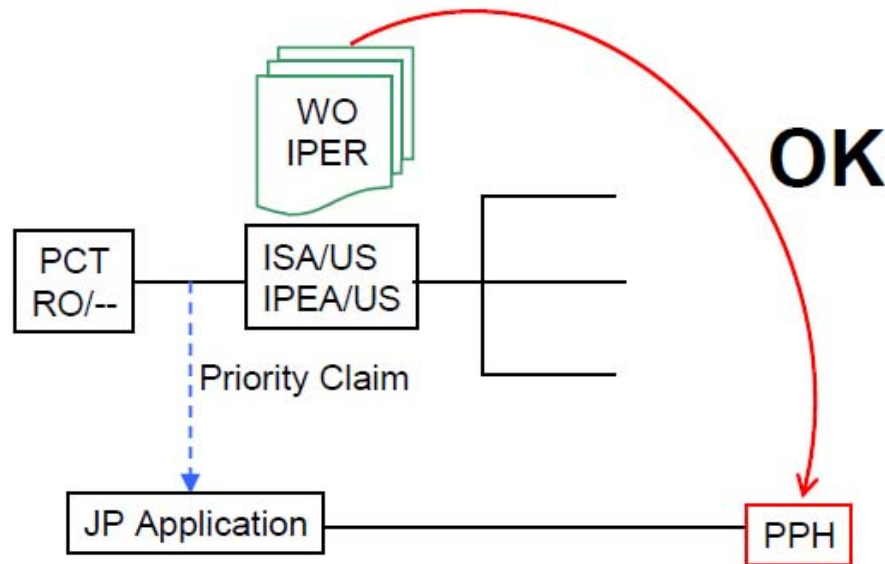
Eligibility for PCT-PPH-- Case (C)

(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



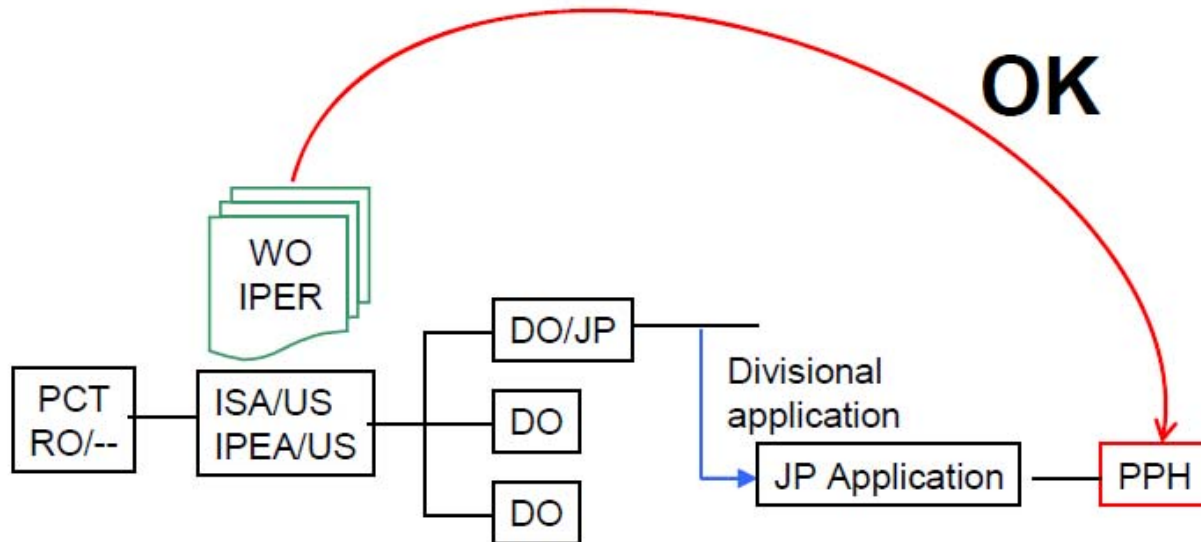
Eligibility for PCT-PPH -- Case (D)

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



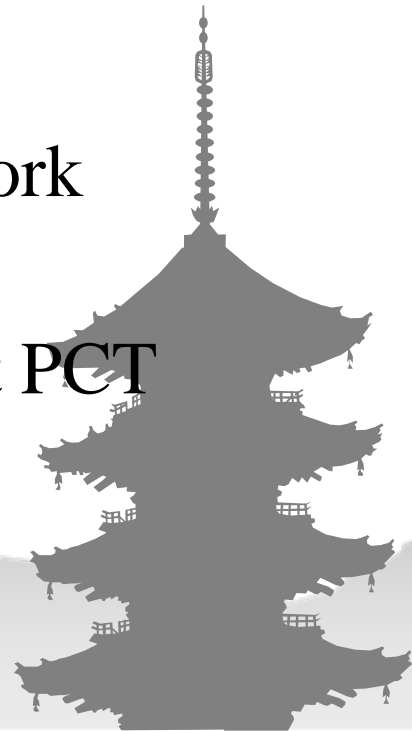
Eligibility for PCT-PPH -- Case (E)

- (E) The application is a divisional application of an application which satisfies the requirement (A).



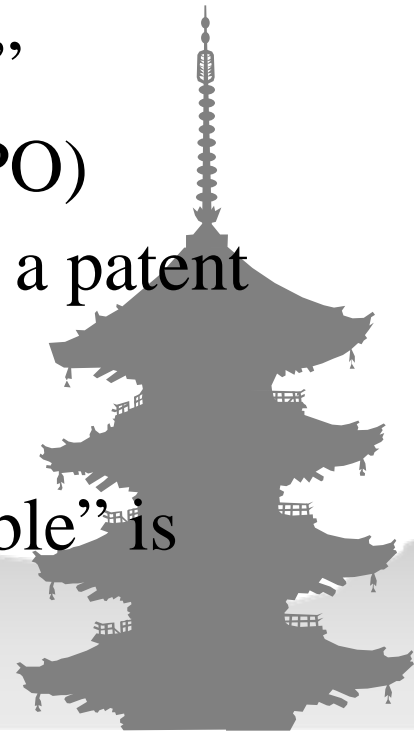
Procedure for PPH using PCT International Work Products

- ⌘ Documents to be submitted
 - a. Copies of the latest PCT International work products
 - b. Copies of all claims considered to be allowable in the latest international work products
 - c. Copies of references cited in the latest PCT international work products
 - d. Claim correspondence table



Procedure for PPH using PCT International Work Products

- ⌘ Documents to be submitted (cont'd)
 - Items (a) and (b) can be omitted if JP application is a national phase of the corresponding PCT application, or they are available on “PATENTSCOPE” (Patent Search Service provided by WIPO)
 - Item (c) can be omitted if a reference is a patent document
 - Thus, in most cases, only item (d) “claim correspondence table” is necessary



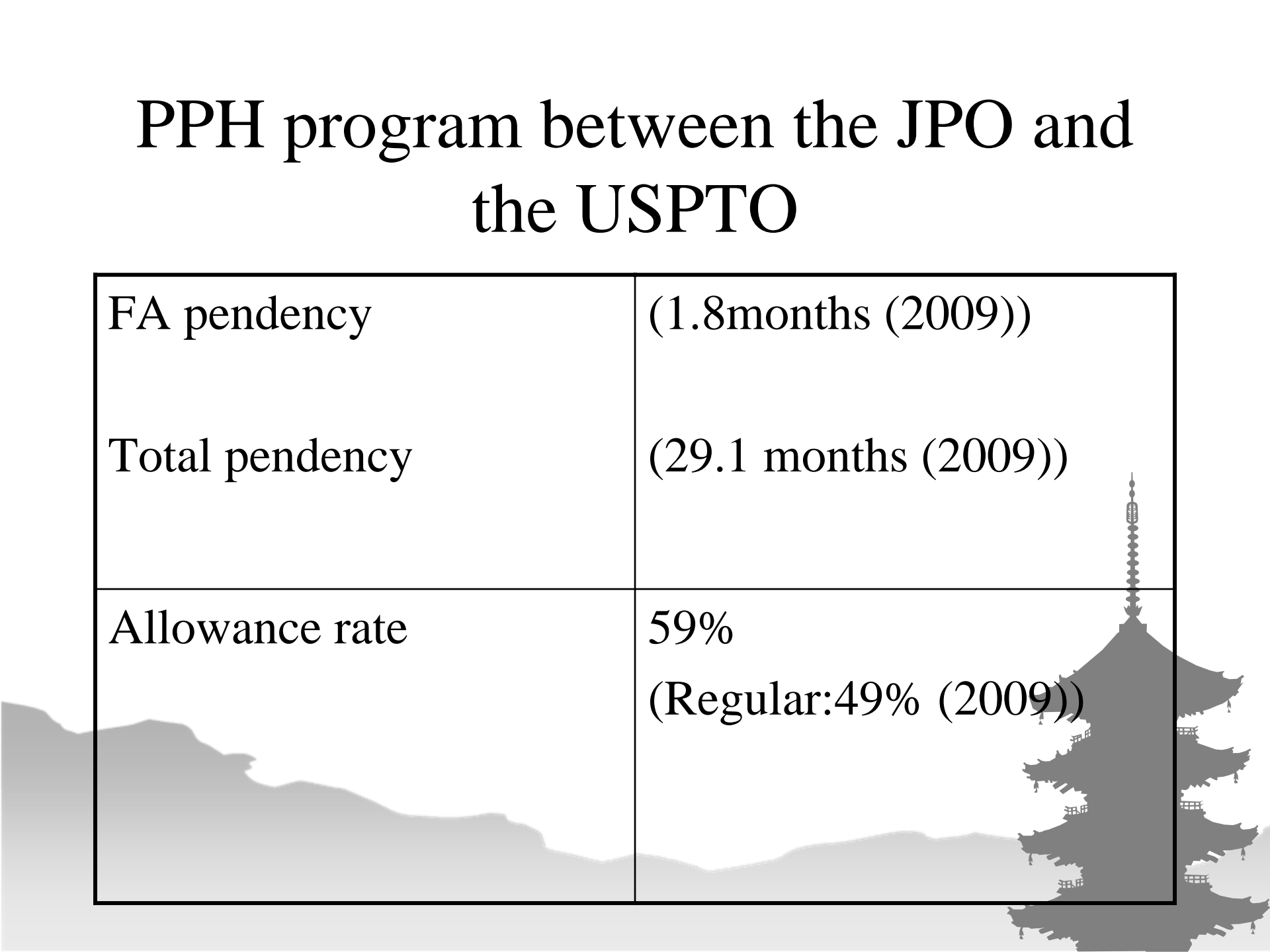
Advantages of PPH-PCT

- ⌘ Even before an application is allowed in the USTPO, an applicant can request “Accelerated Examination”
- ⌘ Accelerated Examination
 - Pendency for FA: two months, which is same as that of PPH using US national work products



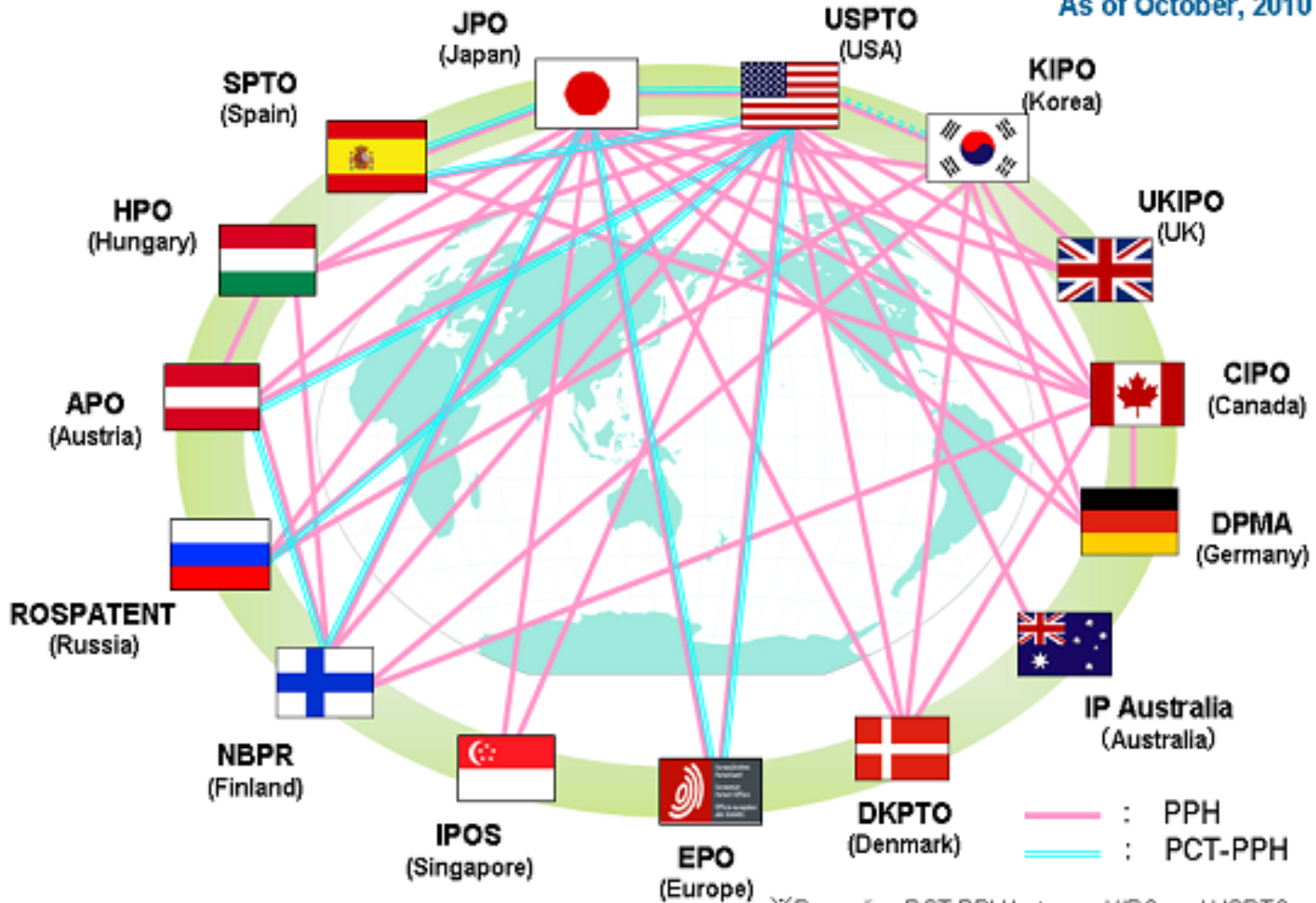
PPH program between the JPO and the USPTO

FA pendency	(1.8months (2009))
Total pendency	(29.1 months (2009))
Allowance rate	59% (Regular:49% (2009))



PPH Network

As of October, 2010



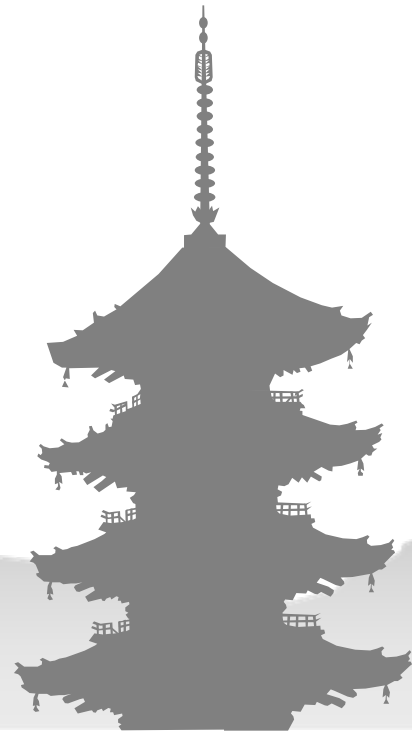
Question (1)

Is the Patentability Examination Criteria among the ISA or IPEA the same ?

(1) Unity of invention ?

(2) Relevant Prior Art Search (Inventive Step) Criteria ?

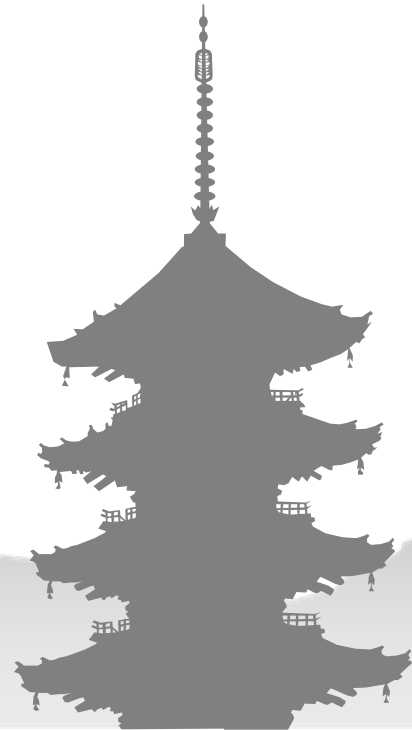
Is there any discussion with regard to harmonization of the criteria in this context?



Question (2)

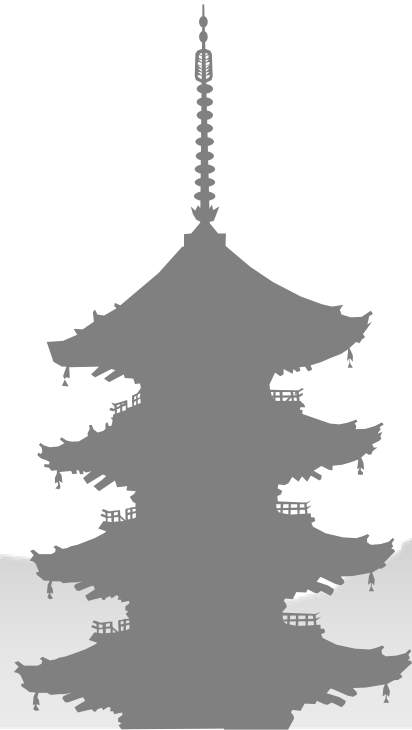
Is the Patentability Examination Criteria between the ISA or IPEA and D.O. or E.O. the same ?

- (1) Unity of invention ?**
- (2) Relevant Prior Art Search (Inventive Step) Criteria ?**



Question (3)

What is the merit of requesting IPER compared with ISR for the applicant ?



Question (4)

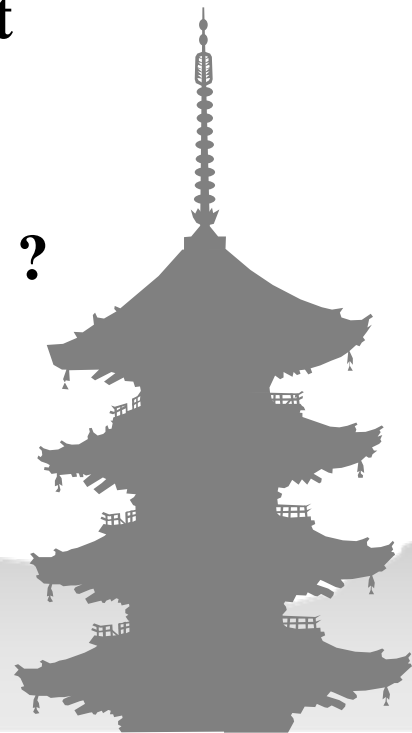
When is the best timing to file the request for IPER ?

What situation ?

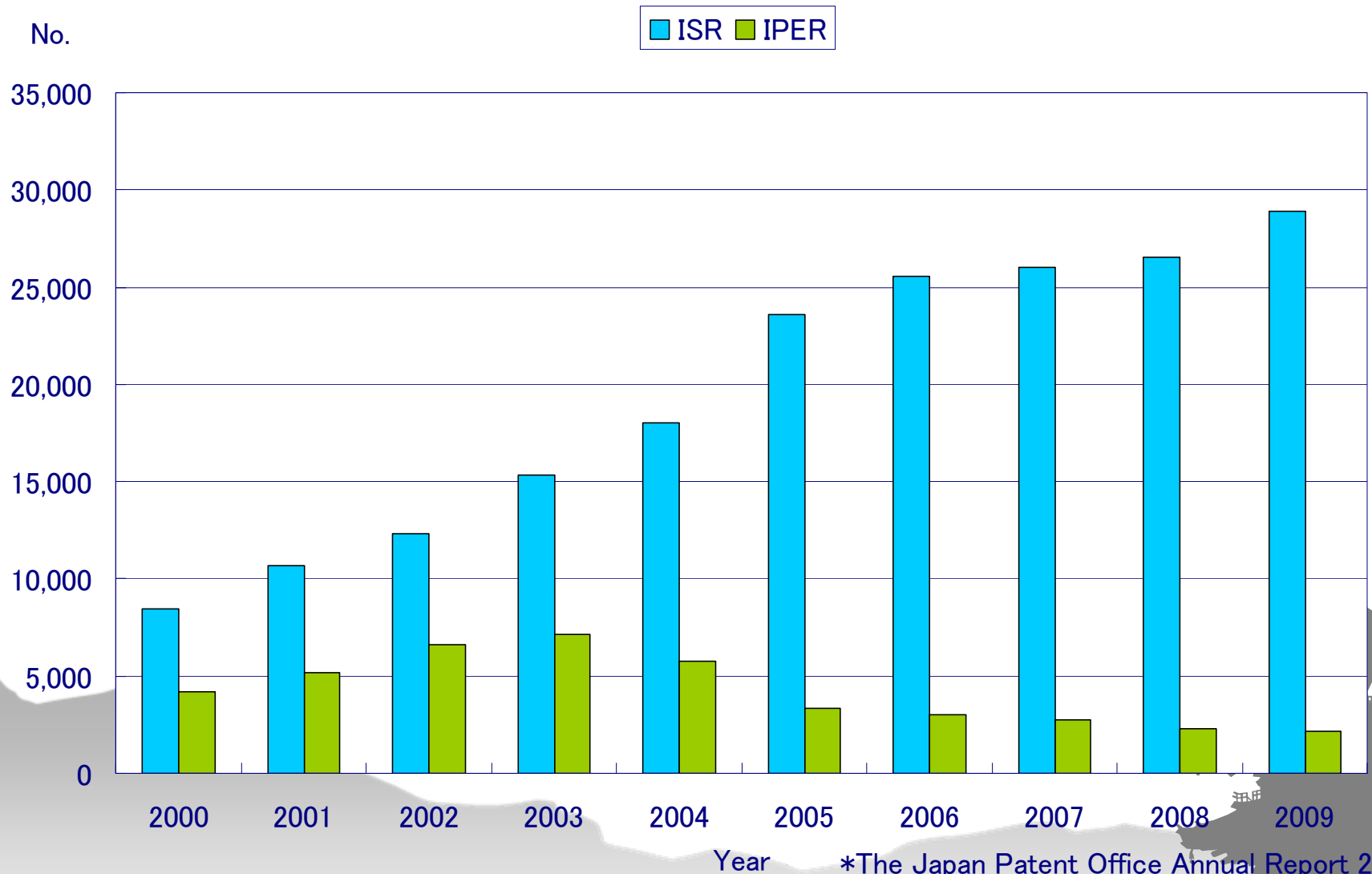
i.e.

In the case of a negative patentability report of ISR ?

Nature of the PCT application (invention) ?



Numbers of ISR and IPER



*The Japan Patent Office Annual Report 2010

Conclusion

(1) It is recommendable for the users who seek international IP protection to use PCT route as a business tool compared with Paris Convention route.

(2) The key issue would be how much the consistency between International Stage Proceedings and National Phase Proceedings can be improved in terms of substantive as well as formal and procedural matters for the future developments of PCT System.



Thank You

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Nakamura & Partners

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