

Japan's view on the proposed "Supplementary International Search"

I. Japan's basic stance on Supplementary International Search (SIS)

Japan is opposed to the concept of the Supplementary International Search (SIS) for the following reasons.

1. SIS in the context of objectives of International Search (IS)

No difference can be found between an ISR and a national/regional search report in terms of the functions they perform as well as the contents that can be expected. Therefore, no good reason can be found to institutionalize in the existing PCT scheme the new type of international search that goes beyond the existing national/regional search.

The objectives of an International Search Report (ISR) are considered to be as follows:

- (1) To provide an applicant with information for making a decision about whether it is worth proceeding further with the international application;
- (2) To increase the predictability of patentability and reduce the burden of surveillance on the part of a third party;
- (3) To allow Designated Offices to more easily carry out national/regional searches using the results of international searches; and
- (4) To reduce the number of potentially unpatentable applications filed in countries having no sufficient examination capability or pre-grant examination system.

These objectives of ISR are similar to the objectives of national/regional prior-art searches to be conducted by the National Offices (NO). For instance, prior-art search reports for national/regional applications are supposed to provide applicants and third parties with the useful information implied in the aforementioned objectives (1) and (2). From the standpoint of the countries that wish to make use of the search results obtained in other countries/regions for corresponding foreign applications, such search results are expected to play the roles mentioned in aforementioned objectives (3) and (4).

As described above, no difference can be found between an ISR and a national/regional search report (at least the one prepared by a NO which is qualified as an ISA) in terms of their functions as well as their contents. As a national office, an ISA is considered to have the capability of conducting adequate national/regional searches to the extent necessary and sufficient, including the capability of conducting

searches of prior-art documents written in specific languages for PCT minimum documents. Therefore, an ISA would be able to satisfy the necessary and sufficient condition for preparation of an ISR, if the ISA does what it usually does in its national/regional searches.

No difference can be found between an ISR and a national/regional search report (prepared by a NO which is qualified as an ISA) in terms of their functions and their contents. Therefore, no good reason can be found for the SIS proposal which is intended to institutionalize in the existing PCT scheme the new type of international search that goes beyond the national/regional search. If an ISA wishes to conduct an international search surpassing the extent of its national/regional search (e.g., an international search for a document in a specific language which is not covered by its national/regional search), that kind of search should be considered an additional service to be voluntarily provided by that ISA, but it should not be institutionalized in the PCT system.

2. Responsibilities and discretions of ISA

It is the responsibility of an ISA to conduct a search to the extent it considers appropriate. If an ISA considers it lacks sufficient ability to search for documents in a specific language, the ISA may outsource a part of the search to an outside search organization to conduct a search for documents written in such a specific language on the condition that the ISA bears full responsibility for the final result of the ISR. Under the current PCT system, the decision to outsource a part of the search has been left to the discretion of an ISA.

Article 15(4) of the PCT stipulates that “the International Searching Authority...shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.” It is not Japan’s position to give an excessively broad interpretation to this provision, so that the provision is interpreted as meaning that ISAs are, in every case, responsible for conducting searches for every prior art document written in any of the specific languages required for the PCT minimum documents. On the contrary, we believe that, in light of the objectives listed in (1)-(4) of point 1, it is sufficient for a national office acting as an ISA to conduct an international search in the same manner and to the same extent that it conducts a national/regional search.

Taking into account this provision on the duties of an ISA for international searches, however, it seems to be the responsibility of an ISA to conduct a search for the scope of

documents to the extent it considers appropriate, including a search for prior-art documents written in a specific language.

The way to fulfill such responsibilities of an ISA should be determined by each ISA at its discretion. If an ISA considers that it lacks the ability to sufficiently search for documents in a specific language, the ISA may outsource a part of the search to an outside search organization having the ability to conduct a sufficient, detailed search for documents written in such a specific language, and thereby supplement the search of the ISA on the condition that the ISA bears full responsibility for the final result of the ISR as a whole.

Thus, it should be the responsibility of the ISA to take the necessary measures to fulfill the responsibilities of an ISA outlined in the corresponding provision. It is our understanding that under the current PCT system, ISAs are already permitted to outsource a part of their search for supplementary purposes, and the decision of an ISA to outsource a part of its search has been left to the discretion of each ISA. No good reason can be found why such supplementary searches must be institutionalized in the PCT.

It should be added that for the JPO to be an outside search organization seems to exceed the scope of the role expected and permitted of a governmental organization.

3. De-centralized system of ISAs

In a system that allows two or more ISAs to work on a single international search (if not single physically but functionally), an individual ISA's responsibility for the production of an ISR would become unclear and result in an irresponsible system in which no one has sense of responsibility for their collaborative work results. Instead, a de-centralized system in which all ISAs have clear responsibility and compete with each other to offer users better and more user-friendly service is desirable.

The concept of SIS can be viewed as an attempt to unify ISAs in a sense that multiple ISAs can collaboratively conduct a "single international search" (if not single physically but functionally) for a single international application. In fact, Article 16(2) of the PCT mentions, "pending the establishment of a single International Searching Authority," and thereby suggests that the ultimate objective of this provision might be the integration of ISAs.

With the rapid progress of information technology, however, we are now in a situation where searchers/examiners can access the same database from anywhere in the world. This is a development which nobody could have foreseen at the time when

the PCT was established; i.e., at a time when prior-art documents were in a form of paper collection. Under the current circumstances, a de-centralized system consisting of multiple ISAs can be regarded as more suitable for effectively utilizing the search resources in various parts of the world than a centralized system with “a single world-ISA.” There currently exist 12 separate and independent ISAs, and the number of the ISAs is and will be increasing. Such a situation can no longer be regarded as a transitional stage toward centralization. Instead, we are moving toward de-centralization.

In order to make such a de-centralized system work more effectively and efficiently, however, all ISAs should be held responsible for the ISRs which they produce and display capability equivalent to other ISAs. If these conditions are not satisfied, an ISA/NO will be unable to rely on an ISR prepared by another ISA.

In light of the above, the JPO cannot shake off the doubt that, in a system that allows two or more ISAs to work on a single international search (if not single physically but functionally), an individual ISA's responsibility for the production of an ISR becomes unclear, and the result would be an irresponsible system in which no one has a sense of responsibility for their collaborative work results. Instead, a de-centralized system in which all ISAs having a clear responsibility compete with each other for better and more user-friendly service is desirable.

4. Discrimination in terms of national language

The SIS would, by its nature, result in a systematic shift of burden, which otherwise would be equally borne by all ISAs, to a specific ISA on the sole ground that such a specific ISA has a specific procedural language (normally its national language). This is equivalent to unfair treatment of such an ISA (i.e., a Member State) based on its national language.

Under the current practice, the jurisdiction or competence of a Receiving Office (RO) is determined, taking into account the procedural language of the RO as a NO (PCT Rule 19). Similarly, the jurisdiction or competence of an ISA is determined, taking into account the procedural language of the ISA as a NO (PCT Article 1(2) and Rule 35). Accordingly, the procedures before an RO/ISA have to be conducted in the pre-determined procedural languages. This is done for the benefit of applicants as well as in consideration of the capability/burden of the ROs/ISAs.

For prior-art search purposes, on the other hand, each ISA is required to carry out a search for PCT minimum documents irrespective of the language of the documents.

This is because the novelty/inventive step criteria in an international search must be examined over the prior-art documents which have been published anywhere in the world (i.e., regardless of the place of publication) and because the value of relevant prior-art documents relies solely on the technological contents described in such documents but not on the language used in the documents.

Therefore, each ISA should carry out an international search for all prior-art documents regardless of the language used for the documents, to the extent considered appropriate for providing the information necessary to determine the novelty/inventive step in light of the objectives listed in (1) - (4) of point 1 above. In fact, the JPO as an ISA conducts searches for non-Japanese prior-art documents if deemed necessary for preparing an adequate ISR. In the same manner, another ISA whose procedural language is non-Japanese should conduct searches for Japanese-language prior-art documents in an international search if deemed necessary for preparing an adequate ISR.

In contrast to the above analysis, the SIS, even if it is on an optional basis, is designed to institutionalize in the PCT the wrong concept to transfer the burden of search for prior-art documents in a specific language (e.g., Japanese or other non-English languages) from an ISA having a procedural language different from such a specific language to another ISA having such a specific procedural language.

The burden of conducting an international search for prior-art documents in a specific language (e.g., Japanese or other non-English languages) should be equally borne by all ISAs to the extent necessary to prepare an adequate ISR. Therefore, it is not appropriate to institutionalize a system, even if it is optional, which would result in placing additional burden on a specific ISA having a specific procedural language. The proposed SIS is, by its nature, intended to justify the systematic shift of the burden, which otherwise should be equally borne by all ISAs, to a specific ISA on the sole ground that such a specific ISA has a specific procedural language (normally its national language). This is equivalent to unfair treatment of such an ISA (i.e., a Member State) in terms of its national language. This argument is not limited to Japan, but in any country, only few legislators/politicians would agree with the attempt to institutionalize in an international treaty such an unfair treatment in terms of its national language.

II. Additional observations on the document PCT/R/WG/9/2

Based on the basic position indicated in I above, Japan remains opposed to the specific proposal on SIS described in the document PCT/R/WG/9/2 of the PCT Reform

Working Group. Additional observations regarding the specific proposal are listed below.

1. Lack of fact-based analysis

There should be a quantitative analysis of the alleged problem arising in the existing scheme of the PCT as well as an identification of the actual scope and nature of the needs of the users. Otherwise, one cannot evaluate whether the benefit of the proposed SIS exceeds the cost of institutionalizing the SIS within the PCT framework. Introducing a new system into the PCT scheme without such a fact-based analysis could result in a mere waste of the PCT budget which could otherwise be allocated to other programs.

In the third paragraph on page 10 of the document PCT/R/WG/9/2, it is stated that, as a supporting reason of institutionalizing the SIS, “eight Authorities supported the proposals for a supplementary international search system..., reiterating the strong desire of users for the introduction of such a system.” However, it is still unclear to us what the “strong desire” means because no in-depth analysis has been conducted to capture the actual needs.

In this relation, the document 9/2 (Page 5, second paragraph) also states, “A number of representatives of users urged the introduction of a system of supplementary international searches as soon as possible. Applicants had different needs and there were different views on what would be the ideal system. Sometimes applicants wanted as much information as possible as soon as possible. In other cases, additional searches would only be requested where a particular need was seen.”

These statements indicate that the needs, if they exist, might be limited to the needs of specific industries of specific countries with respect to the specific documentation in specific languages in a specific technical field, etc. If this is the case, such needs might be more appropriately taken care of by other means, such as bilateral arrangements. Thus, there seems to be no reason to justify the institutionalization of the SIS in the multilateral framework of the PCT. In addition, it is not clear whether the proposed SIS can equally benefit all types of users including universities, SMEs, individuals or applicants who do not have sufficient funds.

The same paragraph of the document also states, “The greatest costs and duplications occurred when new prior art was discovered in the national phase, resulting in multiple examinations raising unexpected objections.”

However, Japan has not seen any quantitative analysis showing how frequently a new prior art is discovered in the national phase which is more appropriate than the prior art cited in the ISR nor any quantitative analysis showing how seriously it affects the applicants. In this regard, it is necessary not only to identify the scope and nature of the actual user needs but also to conduct a quantitative analysis of the alleged problem.

Even between two corresponding non-PCT applications via the Paris route, a new prior art which has not been cited by one National Office can be found in the subsequent search by another National Office. Despite this, Japan has not heard of any strong needs for an attempt to establish a universal system where a National Office is requested to carry out an additional different search other than the normal national/regional search solely for a foreign application filed via the Paris route. If an NO carries out an adequate national/regional search under normal procedures, the NO should not be required to provide any additional search other than the normal national/regional search.

To summarize, we are not convinced that the benefit of the proposed SIS exceeds the cost of institutionalizing the SIS within the PCT framework because the scope and nature of the need has not been identified with a quantitative analysis. On the contrary, Japan has a concern that the proposed SIS could result in a mere waste of the PCT budget which could otherwise be allocated for other programs.

2. Other problems of the SIS proposal in PCT/R/WG/9/2

There are concerns over the specific SIS proposal in PCT/R/WG/9/2 in terms of (1) ambiguous legal ground of the SISR under the PCT, (2) lack of quality assurance of the SISR, (3) lowering morale for the quality of the ISR, (4) discrepancies in contents between ISR and SISR, and (5) inefficient usage of search resources worldwide.

The mechanism of the SIS proposed in the document PCT/R/WG/9/2 is that, after the issuance of a primary international search report (which is supposed to be the same as the normal ISR) by the ISA, the Supplemental International Searching Authority (SISA) carries out a supplementary international search which covers at least the documentation previously agreed upon with the IB while taking due account of the primary search report and issues a Supplementary International Search Report (SISR) under the SISA's own responsibility which is transmitted to the applicant afterwards.

The first problem to be pointed out is that the legal ground of the SISR under the

PCT is ambiguous. Unlike the ISR, which is clearly mandated in the Treaty language of the PCT, the SISR which is separate from the ISR is not clearly grounded by the Treaty language. If the SIS is institutionalized in the PCT, its administration would consume substantial financial resources. Therefore, the SIS should be clearly grounded in the Treaty language of the PCT.

Secondly, there is a concern about the quality of the SISR. Since Article 15(4) of the PCT does not apply to the SIS, the quality of the SIS is not ensured by the PCT. Due to such a concern, an applicant and a Designated Office might not regard the SISR in the same manner as the ISR in terms of quality and reliability.

Thirdly, there is a concern about the lowered morale for high quality ISR, as well. If the JPO, for example, were committed to act as an SISA to conduct a supplementary search for Japanese patent documents, there would be a large possibility that the sense of responsibility of other ISAs having non-Japanese procedural languages would be undermined, which is stipulated in Article 15(4) that an “ISA shall endeavor to discover as much of the relevant prior art (including Japanese patent documents) as its facilities permit.” Such possible lowering of morale of the ISA can give rise to the risk of a lower search quality of ISR, especially regarding the search of documents in the SISA language.

Fourthly, there is a concern about the discrepancies between ISR and SISR in terms of their contents. Because an ISR and a SISR are prepared and issued separately, the contents of the ISR can be inconsistent with that of the SISR. Yet, the document PCT/R/WG/9/2 does not refer to any procedure by which the ISA coordinates with the SISA to determine which result is more appropriate. Therefore, applicants and Designated Offices using the SISR would become confused over which search report is more reliable when the ISR and SISR contain contradictory prior art citations. (For instance, when two documents are the same in view of technological contents but different in languages, one can be cited with category X in the ISR, and another can be cited with category A in the SISR.)

Fifthly, there is a concern about the inefficient use of resources for search worldwide. According to the PCT/R/WG/9/2, the SIS system is to be implemented only among ISAs and cannot make use of the capacities of other NOs, which are non-ISAs but still have adequate search capability. Therefore, the specific proposal is not adequate from the perspective of the effective and efficient utilization of such search resources of non-ISAs, which is desirable for coping with ever-increasing patent applications all over the world.

III. Other alternatives to be examined

The SIS is neither the only solution nor the appropriate solution. A problem of the difficulties in prior-art searches for documentation written in specific languages could be better solved by other measures, such as (i) improvement in search environments of ISA, (ii) entrustment of international search to other organizations, and (iii) early entry into national phase. After identifying legitimate needs of users by conducting a fact-based analysis with quantitative data, we should carry out discussions on the other alternatives including the above.

As stated in II.1 above, Japan views the current discussion as lacking a fact-based analysis on the problems and needs of users, the result of which might justify the SIS. Even if such a fact-based analysis reveals that there exist problems to be solved, however, Japan is of the view that the SIS is neither the only solution nor the appropriate solution.

If the promoters of the SIS were proposing the SIS as a solution to address a problem of the difficulties in prior-art searches for documentation written in specific languages (Paragraph 4 of PCT/MIA14/7), such a problem could be better solved by the following measures (i) to (iii) among others.

The following alternatives have not been discussed at the meeting of the PCT Reform Working Group nor other relevant meetings. Therefore, after conducting the fact-based analysis of the actual user needs with quantitative data and identifying legitimate needs, an adequate time should be taken to carry out a practical, empirical and logical discussion about appropriate alternatives for addressing the legitimate needs of the users.

(i) Improvement in search environments of ISA

While the ISAs should make due efforts to improve their search abilities on one hand, the ISAs could take collaborative measures for improving search environments so as to enable other ISAs/NOs to more easily search patent documentation. More specifically, it would be useful for ISAs/NOs, which issue patent documentation in certain languages, to provide a translation service which will help other ISAs/NOs to search patent documentation originally issued in such languages. In this regard, Japan has been widely distributing Patent Abstracts of Japan, which is a collection of English-version abstracts of Japanese patent documents, and electronically publishing the specifications of Japanese patent documents on the Industrial Property Digital Library (IPDL) with a

machine translation function attached to it.

(ii) Entrustment of international search (Entrusted International Search system)

It is our understanding that an entrustment of international search to other bodies can be done at the discretion of an ISA under the current framework of the PCT. However, another possibility is the addition of some provisions to the PCT Regulations or the formulation of another kind of rule for the purpose of confirmation and clarification that a part of an international search can be entrusted to another NO or another organization as long as the ISA takes the full responsibility for the final results of the international search.

While it is of a provisional nature, the concept of the “Entrusted International Search” (EIS) which could be prescribed in the Rule is shown in ANNEX to this document in order for members to easily understand the concept. As stated in the ANNEX, as far as the ISA takes full responsibility for the final result of an international search, the ISA may entrust a part of the international search to a NO (which is not necessarily an ISA) with adequate search ability.

The concept of the EIS is consistent with the points 1 to 4 in I. above. The EIS would provide an ISR which would be reinforced by entrustment but not exceed the expected role of an ISR. The EIS would undermine neither the responsibility of the ISA nor the discretion of the ISA. The EIS would work under the current de-centralized system. The EIS would not result in discrimination in terms of language.

The EIS can also avoid the problems (1) to (5) indicated in II.2 above. The EIS is related to an ISR and clearly based on the PCT. The quality of entrusted search could be assured by the ISA. Since the ISA has the final responsibility for the ISR, the quality of the ISR can be assured, as well. Unlike the SIS, the EIS would not cause the problem of contradiction between an ISR and an SIS. The EIS could effectively utilize resources all over the world and not be limited to ISAs but include non-ISA NO and other organizations.

(iii) Early entry into national phase

It is always free for an applicant, who has received an ISR, to ask a commercial search organization for an additional search which covers prior-art documents written in a specific language, if the applicant considers that the ISR is insufficient in terms of prior-art documents in the specific language.

Apart from this, an applicant could also obtain an additional search/examination from a DO which is well-qualified to conduct a search for documents in a specific language, if the applicant enters into a national phase of that particular DO. Because an applicant may request earlier national entry under the Article 23(2) of the PCT, the applicant could ask for such national/regional search/examination immediately after the applicant receives the ISR if the applicant deems that the ISR is insufficient in terms of specific language.

As regards public accessibility to the office action in the national phase, in the case of the JPO, for example, any DO registered with the JPO can access the office actions issued by the JPO over the Internet.

IV. Conclusion

Japan is opposed to the proposal to institutionalize the SIS within the PCT framework. Japan is not supportive of the SIS proposal being sent to the PCT Union General Assembly.

Japan does not support any hasty drafting of text changes to the PCT, PCT Regulations, or the PCT Guidelines which presuppose the SIS.

Instead, Japan desires to see Member States first conduct a fact-based analysis of the scope and nature of the needs of users as well as a quantitative analysis of the needs, and then, if necessary, form an appropriate forum to discuss all the possible alternatives including those indicated above in a comprehensive manner.

(ANNEX)

Entrusted International Search (EIS)

- (a) Where it is considered necessary for fulfilling the obligations listed Articles 15(4) and 16(1) or considered indispensable for conducting an international search in a more efficient manner, an ISA may entrust any part of the work involved in conducting an international search (hereinafter referred to as “Entrusted International Search (EIS)”) to a national Office or another entity (hereinafter referred to as “Entrusted Party”).
- (b) If the following conditions are met, an EIS should not be regarded as a violation of any part of Article 15(4) which states that “an ISA shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulation” and Article 16(1) which states that “an international search shall be carried out by an ISA.”
- The ISA takes appropriate measures to ensure that either the ISA itself or the Entrusted Party consult the documentation specified in the Regulation in a manner as provided in Article 15(4).
 - Not all of the work necessary for conducting an international search but only a part of the work is entrusted to an Entrusted Party by the ISA.
 - The ISA takes full responsibility for the final results of the international search.
- (c) If the following conditions are met, an EIS should not be regarded as a violation of any part of Article 30(1) which states that “an ISA shall not allow access by any person or authority to the international application before the international publication.”
- The ISA and the Entrusted Party can be regarded as a single searching authority in terms of function and collaborative effort in jointly conducting an international search, if not in terms of their legal status or physical status.
 - The ISA and the Entrusted Party jointly take all necessary measures to ensure the confidentiality of an international application as provided in Article 30(1).
- (d) EIS shall not be used so as for an ISA to carry out a search which goes beyond the extent that is required under the PCT, Regulation and the Guidelines. An entrustment for conducting such an extensive search should be regarded as outside of the framework of the PCT, and should be done on the volition of the ISA.

- (e) The EIS shall not be used as a disguised and systematic means of discrimination against any ISA or national Office, including linguistic discrimination, nor as an unwarranted and systematic means of increasing the burden on any ISA or national Office. In this respect, any national Office or ISA should be free to choose whether to be an Entrusted Party. In addition, the work which can be entrusted to an Entrusted Party by an ISA should not be limited to a search for prior-art documentation in a specific language. Instead, an ISA should be permitted to entrust to an Entrusted Party any part of the work involved in conducting an international search.

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