Introduction of JPO and its Function as a Receiving Office Under the PCT

December 2018
Japan Patent Office
1. Introduction of Japan Patent Office (JPO)
   (1) Introduction of the JPO
   (2) A bit of history

2. JPO’s Function as a Receiving Office (RO) under the PCT
   (1) Office for International Applications under the PCT
   (2) Processing International Applications in RO/JP
   (3) JPO’s Customer Service
1. Introduction of Japan Patent Office (JPO)
Intellectual Property related laws in Japan

- Patent Law (Invention)
- Utility Model Law (Device)
- Design Law (Industrial Design)
- Trademark Law (Trademark, Service mark)
- Copyright Law (Copyright)
- Unfair Competition Prevention Law
- Law concerning the Circuit Layout of Semiconductor Integrated Circuits
- Seed and Seedlings Law
- Geographical Indications
1. (1) Introduction of the JPO

Organization structure of the METI

- Ministry of Economy, Trade and Industry
  - Agency of Natural Resources and Energy
    - Japan Patent Office
      - Small and Medium Enterprise Agency
1. (1) Introduction of the JPO

Organization structure of the JPO

Japan Patent Office

- Policy Planning and Coordination Dept.
- Trademark and Customer Relations Dept.
- Patent and Design Examination Dept. (Physics, Optics, Social Infrastructure and Design)
- Patent Examination Dept. (Mechanical Technology)
- Patent Examination Dept. (Chemistry, Life Science and Material Science)
- Patent Examination Dept. (Electronic Technology)
- Trial and Appeal Dept.

National Center for Industrial Property Information and Training (INPIT)
1. (1) Introduction of the JPO

Budget of the JPO

2017FY Total: JPY 147 billion (about US $1.34 billion)
1. (1) Introduction of the JPO

Personnel organization of the JPO

- Clerical Officials: 519
- Administrative Judges: 383
- Examiners: 1,874

Total: 2,776 (2018FY)

- Patents/Utility model: 1,690
- Designs: 48
- Trademarks: 136
### Goals to Be Achieved in FY2018

<table>
<thead>
<tr>
<th>Goals to Be Achieved in FY2018</th>
<th>Objectives</th>
</tr>
</thead>
<tbody>
<tr>
<td>Average first action (FA) pendency</td>
<td>9 to 11 months</td>
</tr>
<tr>
<td>Average total pendency for examinations</td>
<td>14 to 16 months</td>
</tr>
<tr>
<td>Level of user satisfaction on communications with JPO examiners</td>
<td>The ratio of users who rated the level 4 and higher on a scale of 5: More than 60%</td>
</tr>
<tr>
<td>Total number of circuit interview examinations in local areas and video-conferencing examinations</td>
<td>More than 1000</td>
</tr>
<tr>
<td>Formality examination pendency for applications</td>
<td>On-line filings for patents, designs and trademarks: The same day</td>
</tr>
<tr>
<td>Publication of patent gazettes</td>
<td>Within 3 to 4 weeks after rights are registered</td>
</tr>
<tr>
<td>Response to inquiries about applications and registrations, etc.</td>
<td>By phone: In principle, immediately By e-mails: Within 2 business days, in principle</td>
</tr>
<tr>
<td>Average FA pendency in Japan under the Patent Prosecution Highway (PPH) program</td>
<td>Less than 3 months</td>
</tr>
<tr>
<td>Number of invited trainees from emerging countries, who are involved in administrating intellectual property</td>
<td>More than 360</td>
</tr>
</tbody>
</table>

The JPO sets its goals to be achieved in each fiscal year and publishes the results.
Long-term goal since 2014:
Making Standard Total Pendency* less than **14 months** by FY2023
Making FA Pendency less than **10 months** by FY2023

*Excluding some cases where the JPO requests an applicant to respond to the second notification of reasons for refusal and where the applicant performs procedures they are allowed to use, such as requests for extension of the period of response and for an accelerated examination.

**Total Pendency and FA Pendency**

<table>
<thead>
<tr>
<th>Examination Requests</th>
<th>9.4 months (2016FY)</th>
<th>First Actions</th>
<th>Final Decision</th>
</tr>
</thead>
<tbody>
<tr>
<td>JPO</td>
<td>14.6 months (2016FY)</td>
<td></td>
<td></td>
</tr>
<tr>
<td>USPTO</td>
<td>25.6 months (2016CY)</td>
<td></td>
<td></td>
</tr>
<tr>
<td>EPO</td>
<td>26.5 months (2016CY)</td>
<td></td>
<td></td>
</tr>
<tr>
<td>CNIPA</td>
<td>22.0 months (2016CY)</td>
<td></td>
<td></td>
</tr>
<tr>
<td>KIPO</td>
<td>16.2 months (2016CY)</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Source: Japan Patent Office
1. (1) Introduction of the JPO

Accelerated Examination system (1)

Meeting any of the requirements

- (1) Applied for foreign countries
- (2) Related to Green Technology
- (3) Filed by the SMEs etc.

The application is... Free of charge

Following the necessary procedures

(1) conduct prior art search
(2) disclose prior arts
(3) make a comparison between the claimed invention and prior arts

Accelerated examination
average period from request to FA
- about 2.3 months

Request

 Applicants

Free of charge
1. (1) Introduction of the JPO

Accelerated Examination system (2)

Expanding Utilization of Accelerated Examination System

- Accelerated examination system launched (Feb. 1986)
- Internationally-filed applications made eligible (Jul. 1996)
- Applications of SMEs, universities, etc. made eligible (Jul. 2000)
- Applications regarding green technology made eligible (Nov. 2009)
- Applications relating to the Asian Business Location Law made eligible (Nov. 2012)

(number)


- 19492
- 17511
- 17086
- 15187
- 14717
- 12170
- 11042


(Number)
The number of countries (Receiving Offices) which specify the JPO as competent to carry out international search and preliminary examination for international applications under the PCT has increased up to 11 countries, including those in the ASEAN countries.

For instance, applicants in any of the above countries, only if their PCT applications have been filed to the patent offices in their own countries, can request the JPO to conduct initial examination (international search), so that they can use JPO's search capacity for evaluating their applications.

### Countries which specified the JPO as competent ISA

<table>
<thead>
<tr>
<th>Country</th>
<th>Starting Date</th>
<th>No. of International ISA (2015 – 2017)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Korea</td>
<td>Sep. 1990 (Discontinued in Dec. 1999 and resumed in July 2001)</td>
<td>4</td>
</tr>
<tr>
<td>Philippines</td>
<td>Jan. 2002</td>
<td>3</td>
</tr>
<tr>
<td>Thailand</td>
<td>April 2010</td>
<td>87</td>
</tr>
<tr>
<td>Viet Nam</td>
<td>July 2012</td>
<td>7</td>
</tr>
<tr>
<td>Singapore</td>
<td>Dec. 2012</td>
<td>154</td>
</tr>
<tr>
<td>Indonesia</td>
<td>June 2013</td>
<td>7</td>
</tr>
<tr>
<td>Malaysia</td>
<td>April 2013</td>
<td>1</td>
</tr>
<tr>
<td>United States</td>
<td>July 2015</td>
<td>341</td>
</tr>
<tr>
<td>Brunei</td>
<td>Oct. 2015</td>
<td>0</td>
</tr>
<tr>
<td>Laos</td>
<td>Jan. 2016</td>
<td>0</td>
</tr>
<tr>
<td>Cambodia</td>
<td>Dec. 2016</td>
<td>0</td>
</tr>
</tbody>
</table>

The JPO was ranked
- **No. 1** for timeliness in transmitting ISRs (99.6% (CY2016)*)
- **No. 2** for the number of ISRs (45,949 (CY2017))

(*out of ISAs having established more than 1,000 ISRs)
1.(2) A Bit of History

40th Anniversary

On October 1, 1978, Japan joined the PCT.
2. JPO’s Function as a Receiving Office Under the PCT
2. (1) Office for International Applications under the PCT

Organigram

(...)

Office for International Applications under the PCT

Director

- Administrative Affairs Section
- Policy Planning and Research Affairs Section
- Specialists for Formality Examination
- Specialist for Electronic Data Management
- Senior Analyst for Intellectual Property Information

(...)

...
2. (1) Office for International Applications under the PCT

Functions

- In the capacity of **RO/JP**
  - **receives** international applications, other subsequent documents, and fees from applicants and the IB;
  - **checks formal and physical requirements** under the PCT. When necessary, invites applicants to correct defects and sends notifications to applicants, the IB, and other Offices (ISAs);
  - **sends** documents and fees to the IB and other Offices (ISAs) before the due date.

- In the capacity of **ISA/JP** and **IPEA/JP**
  - **receives** search copies of IAs, demand forms, other documents and fees
  - **sends** reports, notifications, invitations and fees to applicants and the IB.
2. (1) Office for International Applications under the PCT

- **Priority Date**
- **PCT Application**
- **International Search Report**
- **International Search Opinion**
- **International Publication**
- **International Preliminary Examination**
- **National Phase**

**47,425 Applications** received in 2017

**47,127 Times** selected in 2017

**2,020 Demands** received in 2017

Additional notes:
- **ISA/JP** (International Search Authority, Japan)
- **WIPO** International Bureau (IB)
- **IPEA/JP** (International Preliminary Examination Authority, Japan)

*Graphical representation of the PCT process with timeline and key milestones.*
To Perform Proper Functions as RO

Complying with Requirements

Uniform Processing of All International Applications

- Patent Cooperation Treaty (PCT)
- Regulations under the PCT
- Administrative Instructions under the PCT, including Annexes
- RO Guidelines
- PCT Applicant’s Guide
- PCT Newsletter
- Other Resources on the WIPO PCT Website.

* * *

- National Laws and Regulations
  - provide for procedures between the JPO and applicants
- Internal Operations Manuals
2. (1) Office for International Applications under the PCT

To Perform Proper Functions as RO

- **Compliance with Requirements**
- **Uniform Processing of All International Applications**

- Intensive Internal Training Course Specialized for Specialists for Formality Examination
  - Laws; Regulations; Exercises

- On-the-Job Training
  - Small Teams Consisting of Seniors/Veterans and New Comers
2.(2) Processing International Applications in RO/JP

1. Receiving
2. Pre Formal Check
3. Digitizing
4. Full Formal Check
5. Time Management
6. Transmittal
2.(2) Processing International Applications in RO/JP

1. Receiving

RO/JP receives international applications and other accompanying documents/items

(1) through e-filing system

(2)(a) by mail

(2)(b) at the JPO reception desk

2. Pre Formal Check

3. digitizing
2.(2) Processing of International Applications in RO/JP

<table>
<thead>
<tr>
<th></th>
<th>e-filing (JPO-PAS)</th>
<th>paper form</th>
</tr>
</thead>
<tbody>
<tr>
<td>Language</td>
<td>JP, EN</td>
<td>JP, EN</td>
</tr>
<tr>
<td>Filing Methods</td>
<td>Character coded format over Internet</td>
<td>Mailing Service and Reception Desk</td>
</tr>
<tr>
<td>Operating / Opening</td>
<td>24/7</td>
<td>09.00 to 17.00 Only on Weekdays</td>
</tr>
<tr>
<td>Time</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Fee Reduction</td>
<td>300 CHF</td>
<td>-</td>
</tr>
</tbody>
</table>
2.(2) Processing International Applications in RO/JP

1. Receiving

2. Pre Formal Check

- checks international applications on paper only, before the next step of digitizing; and

- If necessary, corrects defects *ex officio* or invites the applicant to replace sheets containing the defects

3. Digitizing
2.(2) Processing International Applications in RO/JP

1. Receiving

2. Pre Formal Check

3. Digitizing

RO/JP

- Converts paper documents to text data and image files;
- Stores the data and image files in the JPO’s internal system; and
- Assigns the international application number.
4. Full Formal Check

RO/JP

- Checks whether formal and physical requirements under the PCT are complied with and whether the required fees have been fully paid;
- if necessary, invites the applicant to correct defects.
- (when the applicant responds to the invitation,) checks whether the response satisfies the requirements and was timely filed.
RO/JP has only a couple of weeks to complete all the steps 1 to 6

- the RO shall transmit the record copies of international applications in time for them to reach the IB by the expiration of the 13th month from the priority date, but
- most of the applications are filed at the last minute during 12 months after the priority date

needs to check due dates for applicants to reply to invitations to correct international applications.
2.(2) Processing of International Applications in RO/JP

4. Full Formal Check

5. Time Management

6. Transmittal

- for applications on electronic form, transferring data by electronic means; or
- for applications on paper by mail.

RO/JP, once every week,
- transmits record copies, search copies, invitations and other documents to the IB, an ISA and applicants/representatives.
2.(3) JPO’s Customer Service

Who are RO/JP’s Customers?

- **RO/JP is competent to** receive international applications filed by
  1. applicants residing in Japan;
  2. applicants who are nationals of Japan; and
  3. In the case of two or more applicants, at least one who resides in Japan or is a national of Japan.

- **Natural person or legal entity**

For many applications, **agents are appointed**

- In 2017

<table>
<thead>
<tr>
<th>Type</th>
<th>With Agent</th>
<th>Without Agent</th>
</tr>
</thead>
<tbody>
<tr>
<td>Natural Person</td>
<td>80%</td>
<td>20%</td>
</tr>
<tr>
<td>Legal Entity</td>
<td>90%</td>
<td>10%</td>
</tr>
</tbody>
</table>

*No. of IAs in 2017:*
- Natural person: 612
- Legal entity: 46,813
2.(3) JPO’s Customer Service

Face-to-face Consultation at the JPO Reception Desk

9:00a.m – 5:00p.m

- Receives documents and does a quick check on formal requirements
- Advises how to fill in forms and how to properly write letters to the IB
- Provides guidance on the PCT System

Consultation by telephone, E-mail and FAX

9:00a.m – 6:15p.m
### Visitor Reception System

<table>
<thead>
<tr>
<th>International Applications for Patents (PCT Applications)</th>
<th>International Application for TMs (Madrid Protocol Applications)</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Receiving Office</strong></td>
<td><strong>Office of Origin</strong></td>
</tr>
<tr>
<td>これから出願される方、記録の変更等</td>
<td>これから出願される方、事後指定、存続期間の更新等</td>
</tr>
<tr>
<td><strong>1 Filing</strong></td>
<td>1 Filing</td>
</tr>
<tr>
<td>Touch</td>
<td>Touch</td>
</tr>
<tr>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td><strong>2 Consultation</strong></td>
<td>2 Consultation</td>
</tr>
<tr>
<td>Touch</td>
<td>Touch</td>
</tr>
<tr>
<td>0</td>
<td>0</td>
</tr>
<tr>
<td><strong>Geneva Act of the Hague Agreement</strong></td>
<td><strong>Designated Office</strong></td>
</tr>
<tr>
<td>国際出願願書／指定国日本に対する手続き等方面</td>
<td>代理人受任届・手続き補正書等</td>
</tr>
<tr>
<td><strong>1 Filing</strong></td>
<td>1 Filing</td>
</tr>
<tr>
<td>Touch</td>
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</tbody>
</table>
2.(3) JPO’s Customer Service

- Seminars for Practitioners

  - For practitioners

  - In 3 major cities in Japan (Tokyo, Osaka and Aichi) every year

  - Presentation concerning PCT international applications and other related documents, including
    - how to fill in the request form and other documents;
    - practical advice and things to pay attention to
2.3 JPO's Customer Service

- Materials for Users in Japanese
  - Material for practitioners
  - Leaflet for beginners
  - Information on the JPO website

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**PCT International Patent System**

PCT (Patent Cooperation Treaty) is an international system for the filing of patent applications. It provides a facility for obtaining patent protection in multiple countries through a single international filing, known as the international application. The PCT system simplifies the international patent process for inventors, allowing them to file a single patent application with the World Intellectual Property Organization (WIPO), which is then entered into the PCT system and can be further developed into national patent applications in the countries of interest.

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**Materials for Users in Japanese**

- Material for practitioners
- Leaflet for beginners
- Information on the JPO website

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**Japanese Materials for Practitioners**

- Information on the JPO website

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**Outstanding Features of the PCT System**

- Single international filing
- Access to multiple countries
- Examination at the applicant's choice
- Priority for national applications
- Early publication of the application
- Assistance from the International Bureau

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**PCT Related Documents**

- PCT International Search Report
- PCT International Preliminary Examination Report
- PCT Application

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**Supplementary Information**

- Examination under PCT
- Patent Cooperation Treaty
- World Intellectual Property Organization (WIPO)

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**PCT Applications**

- Filing of applications
- Examination
- Granting of patents

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**Key Points**

- PCT applications can be filed in English, French, and Spanish
- Nationalpatent offices in member states can be searched
- Priority claims can be made

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**PCT Applications and National Patents**

- Filing a PCT application
- Entry into the national phase
- National patent filing

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**Application Procedures**

- Filing a PCT application
- Search
- Examination
- Grant

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**Important Dates**

- Filing deadline
- Priority claims
- Examination
- Grant

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**Contact Information**

- Japan Patent Office
- International Bureau of WIPO

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**Additional Resources**

- PCT website
- WIPO website
- National patent office websites

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**Conclusion**

The PCT system is a valuable tool for inventors wishing to seek patent protection in multiple countries. By filing a single international application, inventors can save time and money while ensuring their inventions are protected worldwide.
Thank You!