

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Mr. Claus Matthes,
Director of PCT Business Development Division
World Intellectual Property Organization
Geneva, Switzerland

Re: JIPA Comments on "Review of the Supplementary International Search System"

Dear Director Matthes,

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 930 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned that the "Review of the Supplementary International Search System", published by World Intellectual Property Organization (WIPO) in Circular PCT 1429, on October 23, 2014. We would like to offer our comments as follows.

JIPA again thanks the WIPO for the opportunity to provide these comments and welcomes any questions on them.

Sincerely, yours,



Kenji KUMAKIRI
Chairperson of 2nd International Patent Committee
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JIPA Comments on the "Review of the Supplementary International Search System"

We conducted a survey in the form of a questionnaire for the members of 2nd International Patent Committee and received the responses from 11 members. We summarize these responses and reply to you.

D1. Are you aware of the supplementary international search system and have you considered using it?

- Only one company replied that the company has considered using the system.
- Two companies replied that they know the system but have not considered using it.
- Eight companies, the rest of respondents, replied that they have not considered using the system, and two of the eight companies replied that they did not know the system.

D2. If you have used the supplementary international search system, what are your main experiences with that system?

(No reply is obtained)

D3. If you have used the supplementary international search system, would you consider using it again? If so, please specify the circumstances in which you would consider requesting supplementary international search again. If not, please specify the reasons why not.

(No reply is obtained)

D4. If you have not yet used the supplementary international search system, what are the main reasons for not doing so?

Some members reply the reason why they have not yet used the system is that:

- the additional cost is needed or the cost-effectiveness is unclear,
- SIS is not available in applications written in Japanese language unless translation is provided, or
- they have already selected EPO as ISA when they want English document search.

D5. Would you consider requesting supplementary international searches if specific Offices, which do not yet offer supplementary international search, would offer this

service? If so, could you specify why this would make the supplementary international search service more attractive for you?

Some members reply that they may consider if SIPO would offer the search service. However, most members reply that they may not consider using the system because the advantage of the system is unclear.

D6. Are you interested in supplementary international searches being carried out in specific other languages?

Some members show interests in SISs carried out in Japanese, Chinese, and Korean. However, more than half of the replies show no interest because of the same reason as question D5.

D7. Are you interested in supplementary international searches being carried out in specific subject matter? If so, please specify.

All members reply that they have no interest at the present. However, one member implies that he/she may have an interest if differences of the search results would arise in specific subject matter.

D8. What, in your view, are the main reasons for the low uptake of the supplementary international search system?

The main reason for the low uptake of the SIS system by Japanese applicants is that the SIS is not available in the applications written in Japanese unless translation is provided. Furthermore, some members reply the reasons for the low uptake of the SIS as below.

- Lack of awareness
- Lack of information on usefulness
- ISR is sufficient and there is no advantage from coexistence of the two systems
- SISAs are less and do not include a desired authority

D9. Do you have any suggestions on how the awareness of the supplementary international search service among users could be improved?

Some members suggest showing the data such as usefulness of SIS (i.e. timeliness of SIS, how average OA in DO is reduced as compared with no-use of SIS). And some members also suggest increasing in SISA capable of carrying out search well in

user-demanded language.

D10. Do you have any suggestions what should be changed so that the supplementary international search system better meets users' needs?

Some members suggest the way to meet users' needs as below.

- Reasonable cost
- Omitting re-search in examination by designated office that has served as SISA.
- Eliminating the language requirement for applications (let applications in Japanese, Chinese etc. be eligible)
- Increase in SISA
- Increase in SISA capable of carrying out search well in user-demanded language

D11. Do you have any suggestions for alternative ways in which the objective of increasing the scope of prior art searched effectively during the international phase could be achieved more effectively?

We think that it is important that each ISA improves the quality of their ISR. So we suggest establishing such a scheme that feeds back new documents cited by DO to ISA and ISA improves the quality of its ISR based on the feedback.

D12. Do you have any further suggestions on ways of improving the overall attractiveness of the system for PCT applicants?

Some members suggest the way to improve the overall attractiveness of PCT system as below.

- Improvement in ISR is more important than improvement in SIS because SIS is optional.
- Decrease in difference between ISR and FA in DO
- It is preferable that Taiwan be a member state
- It is helpful when national/regional entry becomes well confirmable with Patent Scope
- Some of EPC member states (e.g., FR) require entry in EP first but why don't you allow direct entry in such EPC member states.
- Reduction in fees that applicants pay, including search fee (EPO)
- Increase in countries subject to PPH and MSE based on PCT international products.

(EOD)