

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Dear Mr. Michael Richardson
Deputy Director
PCT Business Development Division
WIPO
Geneva, Switzerland

Re: JIPA Comments on the "National Phase Entry Using ePCT"

Dear Mr. Richardson :

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 900 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 informal concept paper of the title of "NATIONAL PHASE ENTRY USING ePCT", published by the International Bureau of WIPO. We would like to offer our comments as follows. Your consideration on our comments would be greatly appreciated.

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

Sincerely, yours,

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JIPA Comments on the “NATIONAL PHASE ENTRY USING ePCT”

JIPA has closely and carefully studied the informal concept paper by the International Bureau, the title of "NATIONAL PHASE ENTRY USING ePCT" listing up twelve (12) items. JIPA hereby presents its comments on the informal concept paper an item-by-item basis as below:

1) Item No. 4.

Through ePCT, applicants would be offered “actions” to enter the national phase in any participating designated Office. The process would involve selecting from a list of participating designated Offices, entering any bibliographic data which was not already available to the International Bureau and uploading any documents to be transmitted.

[JIPA Comment:]

- i) It is highly expected that we would be given an opportunity to review screen images of the ePCT system in its development stages in order for us to provide further comments in terms of user operability.
- ii) With respect to any bibliographic data which was not already available to the international Bureau and which is common to the participating designated Offices, if any, entering such the common bibliographic data should be also only once.
- iii) With respect to the way of selection of a participating designated Office, a checkbox or a radio button is better than a pull-down menu in order to avoid the miss-choice with scrolling operation of a mouse.
- iv) Even after the batch entry of the national phase, the opportunity for the additional entry is needed. In other words, the ePCT system should allow us to multiple actions to enter different participating designated Offices in different timing until the deadline of the entry of national phase.
- v) The entry of multiple participating designated Offices should be able to be carried out on the same screen.
- vi) The ePCT system user may want to make sure that their input data is correct before sending a request of national phase entry. For that purpose, a function of displaying confirmation screen or outputting checklist should be provided to the ePCT system.
- vii) Per the selection way of an agent or representative for a participating county, as similar to the way of selection of a participating designated Office, selecting a checkbox or a radio button is better than typing-in information identifying such an agent or representative.
- viii) The ePCT system should allow user to be able to input different applicants or inventors in different participated Offices.
- ix) The ePCT system should provide functions of temporarily saving input data, reopening the operation with the temporarily saved input data, and clearing the input data.

2). Item No. 5.

The International Bureau will design the database structures and applicant interfaces to provide the best arrangements for the component functions in order to guarantee that each item of additional bibliographic information needs to be entered only once, no matter how many designated Offices it is entered for, and to maximize flexibility by separating the responsibilities of entering and checking details in different languages from taking the final action of sending a request to a designated Office.

[JIPA Comment:]

- i) To input county-specific bibliographic information of a participating designated country to the ePCT system, specific input fields for the country-specific bibliographic information should be displayed in a screen or a field associated with such a participating designated county.
- ii) Such the input fields for the county-specific bibliographic information should be displayed in accordance with the selected participating designated Office.
- iii) English translation should be classified in a common document to be uploaded and transmitted to all participated Offices.

3). Item No. 6.

The system would allow national phase entry to be requested in several different designated Offices in a single action, to the extent that the bibliographic data was available in the appropriate language and the same documents were to be provided to each Office.

[JIPA Comment:]

- i) A function of which respective entry of national phases can be done by respective participated county's agent or representative should be provided. Further, simultaneous operations by an agent or representative of a participating country, for example, Europe, and an another agent or representative of a different participating county, for example, United States, should be allowed in the ePCT system.

4). Item No. 8.

The system would then deliver a package to each selected designated Office using PCT-EDI , using "minspec" coding to identify it as a request for national phase entry: The package would contain:

[JIPA Comment:]

- i) Among the participating Offices, "Document Code" for documents to be submitted should be unified.
- ii) The file format of documents should be XML format.

5). Item No. 10.

Preferably, the date of receipt of the relevant documents should be considered to be the date in the time zone in which the designated Office is located (to be indicated by the relevant Office) at the time that the batch is generated by ePCT; the batch would then be placed in the PCT EDI folder of the Office for retrieval immediately .

[JIPA Comment:]

- i) The PCT EDI folder of the Office should be immediately accessible by an applicant and an agent or representative soon after sending request of the national phase entry.
- ii) Per the timing of assignment of the date of receipt, it should be the timing of opening the session of the ePCT system. This is because it is concerned that it may take long time to finish the national phase entry for many participating Offices.

6). Item No. 11.

Copies of the international application and similar documents would not automatically be delivered at this point since this would likely result in duplicates, given that some Offices will already have received copies and others will have automated systems which retrieve documents from PATENTSCOPE when national phase entry triggers occur.

[JIPA Comment:]

- i) An official filing receipt showing completion of national phase entry and an application number of a participating country should be immediately sent back to the user through the ePCT system.
- ii) A transmittal report showing all necessary documents should be transmitted to respective participating designated Offices by the ePCT system. Further, the respective participating designated Offices should be automatically send back official filing receipt indicating that the Offices actually received all necessary documents through the ePCT system.
- iii) Such transmitted documents should be able to be browsed or downloaded immediately after they are transmitted.
- iv) All of input data including bibliographic information, document or file name of uploaded document, and status information should be downloadable in a file format which is easy to edit in office application software such as Microsoft Excel, Access, etc. anytime.
- v) Such downloading should be able to be done by both a single case and multiple cases.
- vi) Such downloading condition should be able to be specified by a date or time period on which the national phase entry was done.
- vii) Csv bulk uploading of multiple participating countries or multiple cases should be able to be done.
- viii) When a csv bulk uploading file including incorrect information is uploaded, an error message should be displayed.

7). Item No. 12.

This proposal does not include payment of national fees through ePCT. This would be conducted as normal through the relevant national processes. The issue should nevertheless be included as an item for possible future development for both this and other PCT and Global Dossier purposes.

[JIPA Comment:]

- i) Payment of national fees should be able to be made through the ePCT system.
- ii) The ePCT system user should be able to pay national fees to the participating Office where the ePCT system user resides, or to the WIPO, and thereafter such the participating Office or the WIPO should remit to the participating designating Offices.

(EOD)