

March 25, 2009

To: Secretariat of Intellectual Property Strategy Headquarters,
Cabinet Office

First Patent Committee,
Japan Intellectual Property Association
Toshio NAKAMURA, Chairman

Opinions on the Review of the “Intellectual Property Strategic Program 2008”

The Japan Intellectual Property Association (JIPA) has submitted its general opinion on the above issue separately. As a committee responsible for the matters concerning patent application practice, we, the First Patent Committee of the JIPA, are submitting our opinion separately and from the perspective of practitioners, with a focus on “the extension of the period for responding to a notice of reasons for refusal”, in the hope that the Intellectual Property Strategic Program 2008 might be reviewed in regards to what is for us a rather familiar issue.

Your kind consideration of this matter would be sincerely appreciated.

Notes

1. Request for review

With respect to the extension of the period for responding to a notice of reasons for refusal, this has once been reviewed under the Intellectual Property Strategic Program 2006. The result of a questionnaire survey, however, shows that in many cases applicants are having difficulties in obtaining Japanese patents within this extended period, due to the fact that the examination by the JPO is completed faster than that in other countries, and that the global expansion of businesses is promoting the licensing of patent applications. In order to comply with the Patent Law Treaty (PLT), many countries are moving gradually towards the extension of the response period.

In view of the circumstances, as mentioned, that domestic applicants are facing more difficulties in obtaining Japanese patents than overseas applicants, and from the perspective of international harmonization, we sincerely request you to reconsider the “extension of the period for responding to a notice of reasons for refusal”.

2. Previous development, reasons, etc.

(1) The Intellectual Property Strategic Program 2006 states in 3 (2), Section I, Chapter 2 of the Main Part that “with respect to the extension of the period for responding to a notification of reasons for refusal (currently 60 days), the GOJ will develop systems as appropriate by the end of FY2006 so as to grant an extension of about one month if there is rational reason to do so.” (p. 44)

Following this, the Patent System Subcommittee, Intellectual Property Policy Committee, Industrial Structure Council reviewed this matter, and published a report on the “Future Patent System” in February 2006. From April 2007, an extension of another one month has been granted to domestic applicants, in cases when they have the prescribed reasons.

(2) Section 11 (1) of the PLT and Rule 12 (1) and (2) of the Regulations provide that the extended time for the response period shall be not less than sixty days. According to this, many countries amended their laws and regulations as follows: the extension required no indication of any reasons; the period of extension applied to domestic and overseas applicants equally; and the extension would be granted up to six months.

On the other hand, the extension of period granted to domestic applicants for Japanese applications is a maximum of three months, and we do not think there to be any other countries granting such a short period as Japan.

< A list of time limits for response by country >

Japan (as of April 1, 2007)

(domestic applicants) sixty days + one-month extension (reason required/up to three months)

(overseas applicants) three months + three-month extension (reason required/up to six months)

USA: three months + three-month extension (no reason required/up to six months)

EPC: four months + two-month extension (no reason required/up to six months) + extension at discretion (reason required)

China: four months + two-month extension (no reason required/up to six months)

Republic of Korea (as of July 1, 2008): two months + four-month extension (no reason required/up to six months) + extension at discretion (grant of which is limited to the following seven cases:

1) change of representative, 2) change of applicant, 3) response to an overseas examination, 4) one-month delay in receiving the notification of grounds for refusals or rejections, 5) parent application being under appeal or pending, 6) examination, or 7) grounds for which the applicant is not to blame.)

Republic of China (as of January 1, 2008):

(domestic applicants) sixty days + sixty-day extension (reason required/up to 120 days)

(overseas applicants) ninety days + ninety-day extension (reason required/up to 180 days)

Canada: six months + no extension possible

(3) We sent out questionnaires to our 85 members who are engaged in the practice of examining patent applications, and 80% of the members who have applied for patents, particularly those in the chemical or medical and pharmaceutical fields, indicated that they had difficulties in responding within the period due to various grounds, and hoped for a further extension be granted.

We therefore would like to request you to reconsider the further extension of the response period, as mentioned in paragraph 1.

(4) The Patent System Subcommittee of the Intellectual Property Working Group of the Industrial Structural Council provided the following as reasons why domestic applicants are granted only a one-month extension: to reduce the abuse of extensions, to alleviate the burden of monitoring other people's patent applications, and to secure the efficiency of examinations (because the memory of the examiner about a specific patent examination fades after a period of over four months).

In view of this, we think that it would be a well-balanced system, if a response period of up to four months would be applied to most patent applications, while charging a somewhat large fee to grant an extension of over four months, since such extension should be granted only to exceptional cases. This should be applied to domestic and overseas applicants equally.

Furthermore, we would like to request you to consider charging applicants "a kind of reexamination" fee for extensions of over four months, since the examiner needs to recall the past examination procedure all over again.

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