

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable Benoit Battistelli
President
European Patent Office

Re: JIPA Comments on the "Opening EPO's Chapter II to PCT applicants who do not use the EPO as ISA"

Dear President Battistelli:

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 "Opening EPO's Chapter II to PCT applicants who do not use the EPO as ISA", published by the European Patent Office (EPO) in the Web-site of EPO, on October 8, 2012. We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

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

Sincerely, yours,

Yoichi Okumura

President

Japan Intellectual Property Association

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JIPA Comments on the “Opening EPO’s Chapter II to PCT applicants who do not use the EPO as ISA”

JIPA has closely and carefully studied the proposed initiative, publicized on the EPO website, under the title of "Opening EPO's Chapter II to PCT applicants who do not use the EPO as ISA". JIPA hereby presents its comments on the proposed initiative.

First of all, JIPA would like to express its appreciation for your proposal to enhance the convenience for PCT users.

Considering the content of this proposal, this initiative is worth considering in view of providing a new option to users in a situation where the applicants do not select the EPO as the ISA, but want an international preliminary search and examination by the EPO.

However, since most PCT member countries (including Japan) can designate the EPO as the ISA, the current PCT system has already enabled most PCT applicants to receive an international search and examination report from the EPO. Thus it is possible that the applicants who need EPO's Chapter II select the EPO as the ISA in the earlier stage of international phase. Therefore, JIPA is concerned that there would be few cases to obtain the merit of this initiative even if the proposal is introduced.

In addition, many Japanese applicants living in a non-English-speaking country typically determine whether it is worth investing in an English translation to enter National Phase based on the initial ISR/WO outcome in Japanese. Therefore, for such applicants, in order to participate in the proposed initiative, if they are required to submit the same English translation as currently required for selecting EPO as ISA, they hesitate to use the proposed initiative. JIPA also would like EPO to consider so that non-English language-speaking applicants could use this option more easily from the view of translation costs.

Furthermore, this initiative assumes that the ISR is issued within 16 months from the international filing date. However, there are now some cases where the ISRs are not issued within 16 months. Under such current situation, we anticipate it would be hard for applicants and the IPEA to secure sufficient time for the international preliminary examination, and are concerned they would be unable to operate this initiative. So JIPA also would like EPO to take consideration of such current situation into detailed design in the initiative.

Finally, since this initiative seems to have possibility of increasing users' convenience, JIPA would like more information and explanation concerning the background and detailed objective of this initiative.

Again, JIPA appreciates EPO's continuous effort to enhance PCT convenience with users' comments.

(EOD)