

Outline of the New Route Proposal for Applications Abroad

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1. Background

In an increasingly globalized economy, it is strongly expected that internationally active companies will obtain inexpensively similar examination results in a foreign country (the Office of Second Filing (OSF)) as in their own country (the Office of First Filing(OFF)). By closely cooperating with each other and resolving common problems, the Trilateral Offices, the world's largest IP offices, play an important role in supporting the global patent activities of users.

The Trilateral Offices have been engaged in a number of joint projects aimed at promoting the mutual exploitation of search and examination results in addition to conducting the Trilateral patent examiner exchange. The results of these projects indicate that when the OFF performs a search on an application in advance of the OSF and provides the search result to the OSF and when the OSF subsequently performs an examination on the corresponding application, the workload of the OSF is reduced and the quality of the examination result of the OSF is increased.

Therefore, the establishment of a framework in which an examination result of the OFF is exploited by the OSF will significantly be beneficial to increase the global patent activity of users and to reduce the workload of each patent office.

Two application routes are currently available for obtaining patents abroad. Those are the PCT Application Routes (PCT Route) and the Direct Application Route (Paris Route). The exploitation of OFF search results by the OSF can be realized in the PCT Route if the OFF is a PCT International Searching Authority, as the search result of the OFF (PCT International Searching Authority) is available when the OSF (the Designated Office) examines the corresponding application. In the Paris Route, however, the search and examination result of the OFF is sometimes not available at the time the OSF conducts an examination. In this case, the exploitation of an OFF search result is not realized.

Enhancing the utilization ratio of the PCT Route is one method of increasing the mutual exploitation of search results. However, there is an upper limit to the utilization ratio because the PCT Route is not cost-effective if an applicant seeks to obtain patents in only a few countries. Therefore, it is inevitable that mutual exploitation ratio be boosted via the Paris Route. The New Route Proposal for Applications Abroad is a framework for transmitting to the OSF the OFF search and examination results of Paris Route applications in a limited time period, and for providing applicants with sufficient time to decide whether they should continue the procedure in the OSF. Within this framework, the complete mutual exploitation of an application which flows into the New Route from the Paris Route is achieved, and an applicant is also able to postpone the decision (and associated payment) of whether to continue with the procedure in the OSF.

The Trilateral Offices, which consist of the USPTO, EPO and JPO are discussing the New Route. In the future, in order to reduce the global workload and assist applicants to obtain patents globally, it is important that an effort is made to enlarge the framework of the New

Route and to include industrialized and developing countries in which there are markets for applicants of international applications. In regard to this enlarged framework, the candidates of countries would have examination authority which can provide search and examination results worth reliable for mutual exploitation such as patent offices qualified as International Authority under the PCT or other patent offices with equivalent qualification.

2. Outline of the New Route

a) Basic concept of the New Route

An application filed with the OFF through the New Route is deemed to have been filed with the OSF on the filing date in the OFF. The time limit for an applicant to submit a translation is 30 months from the filing date (priority date). This time limit is granted under the condition that the OFF provides the search and examination result expeditiously to the OSF and that the OSF can exploit the result in an examination of the corresponding application.

b) Essence of the New Route

- (1) The New Route is to be established by an agreement among a few countries. The central bureau (e.g. International Bureau) will not be a part of the New Route.
- (2) A New Route application filed with the OFF has the same status as a regular domestic application in the OSF from the filing date with the OFF, and the filing date in the OFF is deemed to be the actual filing date in the OSF.
- (3) A search report by the OFF is prepared based on the examination result of the OFF. An acceptable substitute for the search report and the examination result of the OFF is a search report by the OFF accompanied by a written opinion of the OFF.
- (4) There is a 30-month time limit for submitting translations to the OSF.
- (5) An examination by the OSF is based on the search and examination result of the OFF. An acceptable substitute for the search report and the examination result of the OFF is a search report by the OFF accompanied by a written opinion of the OFF.
- (6) If the OFF adopts the request-for-examination-system, an applicant must request for examination early because the search report of the OFF referred to in (3) should be completed expeditiously to enable the examination to be conducted as described in (5).
- (7) The Hilmer rule and other national law which discriminate the application in terms of the effect to defeat the later-filed application is abolished in the New Route.

c) Procedure between Applicant and Offices

(1) Filing

An applicant files an application with the OFF in the official language of the OFF. An application is filed in the unified format together with the “Declaration to use New Route” which includes bibliographic data in English (if the application is not in English) and an abstract in English. An applicant is permitted to file an application claiming priority based on a domestic application in the OFF. If the OFF adopts the request-for-examination-system, the Declaration is deemed as the submission of a request for examination. A New Route application filed with the OFF has the same status as a regular domestic application filed with the OSF from the filing date with the OFF, and the filing date in the OFF is deemed to be the actual filing date in the OSF.

(2) Declaration to use New Route

In Receiving the “Declaration to use New Route” from an applicant, the OFF notifies the OSF of the application filed via the New Route. Instead of applicant’s own action to

the OSF, the notification serves to alert the OSF of a New Route application to be examined by the OSF. If an application claims priority in the OFF based on the domestic application filed with the OFF, the application is dealt in the OSF as an application claiming priority under the Paris Convention. The application can be deemed to be a regional application, instead of domestic application, by the OSF.

(3) Publication in 18 months

The OFF publishes an application in unified format in electronic form (e.g. publication via the internet) at 18 months from the filing date (priority date). The front page is published only in English if the OFF's official language is English. Otherwise, it is published both in English and in the official language of the OFF. The specifications, claims, and drawings are published only in the OFF's official language. (Those are the same procedures as provided under the PCT system.)

(4) Issue of first office action and search report by the OFF

After the publication, the OFF issues the first office action at 24-26 months from the filing date (priority date) at the latest and then establishes and publishes electronically the search report in English at 26-28 months at the latest. An acceptable substitute for the search report and the examination result of the OFF is a search report by the OFF accompanied by a written opinion of the OFF.

(5) Applicant's procedure to enter the national stage of the OSF

Based on the first office action received at 24-26 months from the filing date (priority date) at the latest, an applicant judges whether to continue the procedure with the OSF. If the application is judged by the applicant to be worthy of continuing the procedure with the OSF, the applicant submits the translation (in unified format) of the application filed with the OFF, as well as the office action by the OFF translated in English, to the OSF within 30 months from the filing date (priority date). The applicant's responsibility to submit the examination result translated in English can be relieved by imposing a duty of the translation on the OFF.

(6) Examination in the OSF

The OSF immediately starts an examination based on the translation of an application with making use of the search report and office action of the OFF.

d) Advantages of New Route

(1) Applicant's viewpoint

- A) The burden of translation using the New Route is less than that using the Paris Route because under the New Route, it is unnecessary for translations to be done for some applications as the examination results of the OFF are available before the expiration of the 30-month time limit for submitting the translations in the official language of the OSF to the OSF.
- B) The filing date in the OSF is secured by filing with the OFF in the official language of the OFF.
- C) The total cost of using the New Route is expected to be lower than the cost of using a current foreign application route due to the enhanced mutual exploitation and simplified procedures of the New Route.

(2) Office's viewpoint

- A) The OSF can speedily issue high-quality patents by exploiting the search report and examination results of the OFF.
- B) A complete search including the wider range of secret prior art is expected as the search report in the New Route is established at a later stage compared with the PCT route.