

Notice Concerning the Japan Patent Office's Action
as an International Searching Authority and
International Preliminary Examining Authority for
International Applications Received by the United
States Patent and Trademark Office

The arrangement under which the Japan Patent Office (JPO) will act as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT) for international applications filed with the United States Patent and Trademark Office (USPTO) as a Receiving Office (RO/US) has been renewed with modifications. The modified arrangement is effective for the five year period from July 01, 2018, to June 30, 2023. The condition in the previous arrangement that the JPO will only act as an ISA for applications in which the claims are directed to the field of green technology as defined by certain International Patent Classification classes has been removed.

The modified arrangement is the result of the "Modification to the Arrangement between the United States Patent and Trademark Office and the Japan Patent Office Concerning Action of the Japan Patent Office as an International Searching Authority and Preliminary Examining Authority under the Patent Cooperation International Treaty for International Applications Received by the United States Patent and Trademark Office" signed on June 29, 2018, by the Under Secretary of Commerce for Intellectual Property and Director of the USPTO and by the Commissioner of the JPO.

Under the modified arrangement, the JPO may act as an ISA under the PCT for international applications filed with the RO/US provided that: (1) the applications are submitted in the English language; and (2) the JPO has not received more than 8,400 international applications from the USPTO during the 5-year period from July 01, 2018, to June 30, 2023, and not more than 300 applications per quarter during the first and second years, and not more than 500 applications per quarter during the third, fourth, and fifth years. The JPO will also act as an IPEA if these two requirements are met, and the JPO acted as the ISA.

The USPTO will continue to collect the search fees from the applicants, and will transmit the search fees to the JPO. The search fee for the JPO acting as an ISA for international applications received by the USPTO can be found on the World Intellectual Property Organization (WIPO) website at: <http://www.wipo.int/export/sites/www/pct/en/fees>. Any other fees necessary for search or examination or incidental thereto will continue to be paid by applicants directly to the JPO.

The newly concluded Arrangement between the USPTO and the JPO follows.

2/7/2018
Date

Andrei Iancu
Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Modification to the Arrangement between the United States Patent and Trademark Office and the Japan Patent Office Concerning Action of the Japan Patent Office as an International Searching Authority and Preliminary Examining Authority under the Patent Cooperation Treaty for International Applications Received by the United States Patent and Trademark Office

Whereas an Arrangement between the United States Patent and Trademark Office (hereinafter “USPTO”) and the Japan Patent Office (hereinafter “JPO”) Concerning Action of the JPO as an International Searching Authority and Preliminary Examining Authority under the Patent Cooperation Treaty for International Applications Received by the USPTO exists and is currently effective through June 30, 2018.

Consistent with Sections 7(2) and 8 of said Arrangement, the USPTO and the JPO (“the Participants”) seek to renew this Arrangement with the following modifications:

A. Section 1 of the Arrangement is hereby replaced by the following:

(1) The JPO intends to act as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty for international applications filed with the USPTO as Receiving Office insofar as the following conditions are met:

(i) the international applications are submitted in the English language and

(ii) The JPO has not received more than 8,400 international applications from the USPTO during the 5-year period from July 1, 2018, to June 30, 2023, and not more than 300 applications per quarter during the first and second years, and not more than 500 applications per quarter during the third, fourth, and fifth years.

(2) Consistent with paragraph (1), the JPO intends to act as an International Preliminary Examining Authority only where the JPO had acted as the International Searching Authority.

(3) The USPTO intends to inform the International Bureau, pursuant to the Patent Cooperation Treaty (hereinafter the “PCT”) Rules 35 and 59, that the JPO is competent for the searching and international preliminary examination under paragraphs (1) and (2) of this Section of this Arrangement.

B. Section 4 of the Arrangement is hereby replaced by the following:

Conduct of technical and procedural matters including transfer of fees and exchange of documents is as specified in Annex A of this arrangement.

C. Section 7 of the Arrangement is hereby replaced by the following:

(1) This Arrangement comes into effect upon July 1, 2015.

(2) The USPTO and the JPO intend that this Arrangement end on June 30, 2023, or upon the termination of the Agreement between the JPO and the International Bureau if such termination is earlier. The USPTO and the JPO may continue this Arrangement by mutual written consent upon any renewal of the said Agreement between the JPO and the International Bureau.

D. Section 11 of the Arrangement is hereby replaced by the following:

Annex A is part of this Arrangement.

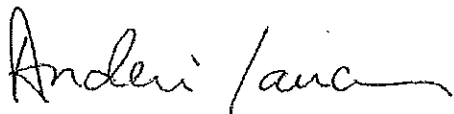
E. Section 12 of the Arrangement is hereby modified to replace the words "Annex B" with the words "Annex A."

F. Annexes A and B are deleted and replaced with Annex A as included in Attachment 1 to this Modification.

G. All other Sections of the original Arrangement remain unchanged by this Modification.

H. This Modification becomes effective upon signature by both participants.

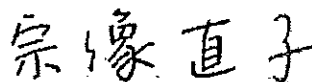
For the United States Patent and Trademark
Office:



Andrei Iancu
Under Secretary of Commerce for
Intellectual Property and
Director of the USPTO

Date: 6/29/2018

For the Japan Patent Office:



Naoko Munakata
Commissioner of the JPO

Date: 6/29/2018

Arrangement between the United States Patent and
Trademark Office and the Japan Patent Office
Concerning Action of the Japan Patent Office
as an International Searching Authority
and Preliminary Examining Authority
under the Patent Cooperation Treaty
for International Applications Received by
the United States Patent and Trademark Office

Annex A

Outline of Technical and Procedural Matters

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1 Contact Details

- 1.1 Language of Communication: English
1.2 Contact Details for JPO's PCT Section ("JPO"):

Phone number: +81-3-3592-1308

Fax number: +81-3-3501-0659

E-mail: pal a31@jpo.go.jp

- 1.3 Postal Address for the JPO:

Japan Patent Office

Office for International Applications under the PCT

3-4-3, Kasumigaseki, Chiyoda-ku, Tokyo 100-8915, Japan

- 1.4 Postal Address for the USPTO:

Director of the U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

United States of America

- 1.5 Contact Details for the Receiving Office of the USPTO:

Phone number: +1 703 756 1399

Fax number: +1 571 273 8300

E-mail: rori.burch@uspto.gov

tracei.hale@uspto.gov

2 Payment Procedure and Fees for ISA/IPEA Services

For the most up-to-date information on the amount of fees applicable for International Searching Authority (ISA) service, please refer to PCT Applicants Guide International Phase Annex D 'JP,' and for the International Preliminary Examining Authority (IPEA) information, refer to PCT Applicants Guide International Phase Annex E 'JP.'

- 2.1 Classification of Fees:

Search fee: See PCT Applicant's Guide Annex D

Preliminary examination fee: See PCT Applicant's Guide Annex E

Handling fee: See PCT Applicant's Guide Annex E

Current fees can be found at: <http://www.wipo.int/pct/en/fees/index.html>

2.2 Procedure for Remitting Fees:

Search fee: U.S. applicant ⇒ USPTO ⇒ JPO
Preliminary examination fee: U.S. applicant ⇒ JPO
Handling fee: U.S. applicant ⇒ JPO
Additional fees: U.S. applicant ⇒ JPO

* The method for payment of fees by U.S. applicants to the JPO is by Bank Transfer or patent revenue stamps. (The patent revenue stamps are only available in Japan.)

2.3 Acceptable Currency for Fee Payment:

USD for fee payment by the USPTO to the JPO

JPY for fees paid to the JPO by U.S. applicant

2.4 The JPO's Bank Account Details for Fee Remittance:

A. Bank account designated by the JPO for fee remittance by U.S. applicants

Swift code: SMBC JP JT
Name of bank: SUMITOMO MITSUI BANKING CORPORATION
BSB: 096
Account number: 173377
Name of beneficiary: JAPAN PATENT OFFICE

* Any expenses required by the bank(s) in connection with the remittance are to be borne by the applicant. Therefore, whenever there is a shortfall in the fee received by the JPO due to the various expenses required by the bank(s), and the shortfall is not paid within the payment deadline, the JPO intends to proceed with necessary procedures concerning unpaid prescribed fees. The JPO does not intend to bear any responsibility with respect to payment problems with the bank(s), which have arisen due to the applicant, for any reason whatsoever.

B. Bank account designated by the JPO for fee remittance by the USPTO

Swift code: SMBC JP JT
Name of bank: SUMITOMO MITSUI BANKING CORPORATION
BSB: 096
Account number: 0176570
Name of beneficiary: JAPAN PATENT OFFICE

**Upon the transfer of the search fee, the USPTO intends to send a remittance report to the JPO by e-mail to the contact details indicated in paragraph 1.3. The remittance report should include, at the minimum, the international application number(s) and the international filing date(s) to identify the case.

2.5 Additional Search Fees:

If the JPO considers that the international application does not comply with requirement of unity of invention as set forth in the PCT regulations, the JPO intends to invite the applicant to pay additional fees (PCT Article 17(3)(a)). The applicant may pay the additional fees directly to the JPO (PCT Rule 40.2(b)) in a currency and mode acceptable to the JPO within one month from the date of the invitation (PCT Rule 40.1(ii)). Acceptable methods of payment are as follows:

- (a) The applicant pays the additional fee in JPY to the designated bank account indicated in 2.4.A, and submits the form "PAYMENT OF ADDITIONAL FEE" to the JPO with the document which can confirm the payment (See Attachment I)
- (b) The applicant submits the form "PAYMENT OF ADDITIONAL FEE" to JPO with the indicated amount of patent revenue stamps. The patent revenue stamps are only available in Japan (See Attachment I).

Where the international application lacks unity of invention under PCT Article 34(3)(a) and the JPO invites the applicant to pay an additional fee or to restrict the claims, the additional fee is to be paid directly to the JPO. The above procedures should be applied mutatis mutandis for this purpose.

2.6 Responsibility for the Cost of Remitting Fees or Refunds:

Remittance fee: sending party (U.S. applicant or the USPTO)
 Postal fee: sending party (all postage is to be prepaid)
 Refund: receiving party (U.S. applicant or the USPTO)

2.7 Refund Procedure:

A. Refund to U.S. applicant

Refund of payment under PCT Rules 16.3, 40.2, 57.4, 58.3, 68.3, and of overpayment should be commenced upon request of the applicant. The applicant is to submit a document which includes the following items to the JPO directly (See Attachment II):

- (a) the purpose of refund which the applicant requests;
- (b) bank details (bank name, branch name and address, account number, account name);
- (c) the name of the applicant;
- (d) the address of the applicant;
- (e) the international application number; and
- (f) the document that can confirm the payment.

*Refund should be remitted to the applicant in JPY. Any expenses required by the bank in connection with the remittance are to be borne by the applicant. Therefore the applicants are strongly recommended to consult with the JPO before requesting for refund, since where the amount of refund is less than bank expenses, the applicant cannot receive any refunds.

B. Refund to the USPTO

- i. The JPO determines whether the paid fee exceeds the required amount.
- ii. If so, the JPO notifies the USPTO.
- iii. The USPTO intends to deduct that amount from its next monthly payment to the JPO. If the refund is not executed as intended, the JPO intends to ask the USPTO for assistance by contacting the Director of the Receipts Accounting Division, in the Office of Finance (Mr.

Matthew Lee) at telephone number 01-571-272-6343 or e-mail address matthew.lee@uspto.gov with any questions related to the above.

iv. Currency conversion fees for refunds are intended to be borne by the U.S. applicant or the USPTO.

3 Procedure for Transmitting Documents between the USPTO and the JPO

3.1 Transmission of Search Copy:

Transmission frequency: once a week or as soon as possible after the receiving office completes its formality examination.

The USPTO and the JPO intend to allow the International Bureau (IB) to prepare and transmit search copies electronically ('eSearchCopy') to the JPO on behalf of the USPTO.

The USPTO intends to notify the IB regarding information on the payment of the search fee for electronically sending the Search Copy to the JPO.

Any sequence listing in electronic form which is furnished by the applicant for the purposes of the international search (PCT Rule 13 ter.) to the USPTO is to be promptly sent by the USPTO either directly, or via the IB, to the JPO (PCT Rule 23.1(c)).

3.2 Notice of the Receipt of Search Copy:

The JPO notifies the USPTO on paper via postal service or private carrier within 15 days of receiving the search copy.

3.3 Notification of Excess Requests:

The USPTO intends to notify the JPO via email as soon as the number of international applications had reached 98% of the quarterly application limits, which are 300 applications having been received per quarter during the first and second years, or 500 applications having been received per quarter in the third, fourth, and fifth years.

So that the USPTO may quickly stop accepting such international applications, the JPO intends to informally notify the USPTO via email that the search will not be conducted by the JPO because either: (1) more than 8,400 requests have been received in the 5 year period from July 1, 2018 to June 30, 2023; or (2) the above described quarterly application limits have been reached.

Additionally, the JPO intends to officially notify the USPTO on paper via postal service or private carrier within three weeks of receiving any search copy that exceeds the above described 5 year or quarterly period and for which the JPO does not intend to perform the international search by using a copy of the form PCT ISA 224 for the applicant.

The JPO may retain a particular amount of excess requests received in the

current quarter of up to 10% of the above discussed quarterly limits (i.e., 30 excess requests per quarter during the first and second years and 50 excess requests per quarter in the third, fourth and fifth years); the excess requests contributing to the total number of requests received in the next quarter.

The JPO intends to dispose securely of the search file if no response is received within 1 month of notifying the USPTO.

The USPTO does not intend to notify information on the payment of the search fee to the IB and forward the search fee for applications where the JPO has provided notification of excess requests to the USPTO. Should the USPTO have already sent the search fee, then the USPTO intends to withhold an amount equivalent to the search fee from a subsequent payment due to the JPO.

3.4 Sending of Receiving Office (RO) Forms to the JPO:

Where the USPTO issues any RO forms after receiving the international application, the USPTO intends to promptly send, either directly or via the IB, the copies of the RO forms (such as PCT/RO/106, 107, and 111) and attached documents (such as replacement sheets, if needed) to the JPO.

4 Direct Contact between U.S. Applicants and the JPO

4.1 Submission Procedure and Method of Making a Demand:

The JPO intends to act as a competent IPEA for any international application filed with the USPTO which meets the following conditions mentioned in the Agreement between the JPO and the International Bureau:

- (a) The international search was performed by the JPO;
- (b) The applicant chooses the JPO as the competent IPEA; and
- (c) The applicant of the international application submits the Demand (form PCT/IPEA/401) within the deadline stipulated under PCT Rule 54bis.

Paper-based demands (form PCT/IPEA/401) are to be submitted from the applicant to the IPEA/JP directly by registered mail or via courier service. E-mail or facsimile submissions are not acceptable. Postal address for the JPO: as at paragraph 1.3 of this Annex.

*Applicants that register for ePCT private services may submit the demand to the JPO using the 'Submit Chapter II Demand' Action through which the IB forwards the Demand to IPEA/JP under PCT Rule 59.3(b).

4.2 Procedure for Notifying Applicants that a Demand has been Received:
The JPO notifies applicants within three weeks of receiving the demand.

4.3 Payment Procedure for Examination and Handling Fees:
The fees can be paid by one of the following methods which are acceptable by the JPO. (Rule 57.1, 58.1 (c))

- (a) The applicant pays the international preliminary examination fee and handling fee in JPY to the designated bank account (indicated in 2.4.A), and submits the form "PAYMENT OF FEES FOR PRELIMINARY EXAMINATION"*** to the JPO with a document that can confirm the payment. **See Attachment III
- (b) The applicant submits the form "PAYMENT OF FEES FOR PRELIMINARY EXAMINATION"*** to the JPO with the indicated amount of patent revenue stamps. The patent revenue stamps are only available in Japan. **See Attachment III

5 Procedure for Transmitting Documents between U.S. Applicants and the JPO

5.1 Transmission of Various Notices and Invitations from the JPO to U.S. Applicants:
To be sent via the postal service to the postal address specified in the request or the demand.

5.2 Response of U.S. Applicants to the JPO's Invitations:
U.S. applicants should respond via postal service within the period specified in the invitation, pursuant to the various PCT regulations which are applicable, this Arrangement places no new burden on the applicant that they do not already have under the PCT. E-mail or facsimile submissions are not acceptable.

Time frame for responding to an invitation: normally one month from the mailing date.

Time frame for responding to written opinions (of an international preliminary examination): normally two months from the mailing date (time limits can be extended at the examiner's discretion as long as the due date for an international preliminary examination report is not affected, or shortened at the examiner's discretion if the due date is affected).

5.3 Method of Communication between the JPO and U.S. Applicants:
Language: English
Method: e-mail (preferred), postal service, facsimile