



## Procopio Perspectives Podcast

### Greater Speed and Efficiency: Steps IP Offices Around the World Are Taking to Streamline the Patent Process

#### EPISODE SUMMARY

Intellectual property offices around the world are competing to see which agency can make the most strides in streamlining the patent application process, seeking to make obtaining a patent easier and more cost-effective. Changes could be in the application process itself, adjustments to fee schedules, or other innovations entirely. In this podcast, seasoned IP attorneys from the United States, Japan, India and Taiwan discuss IP office trends happening around the world.

#### EPISODE SPEAKERS

[Robert "Bob" Sloss](#), Procopio Partner and IP Litigator, United States (moderator)

[Miku Mehta](#), Procopio Partner, Patent Prosecution Attorney and Asia Pacific Group Leader, United States

[Chikako Mori](#), Trademark Team Leader at Sun East IP firm, Japan

[Aditi Verma Thakur](#), IP Attorney, Ediplis Counsel, India

[Chaoming Chen](#), Founding Member of CMC Intellectual Property Firm, Taiwan

#### EPISODE TRANSCRIPT

Host ([00:07](#)):

Welcome to Procopio Perspectives, a podcast featuring award-winning corporate and litigation attorneys providing useful legal insights on the latest issues of the day. Now here's your host.

Robert "Bob" Sloss ([00:19](#)):

Welcome to our podcast on regional patent office trends. My name is Bob Sloss and I have the great privilege and honor of moderating this discussion. I'm a partner in the Silicon Valley office of Procopio, Cory, Hargreaves & Savitch, where I specialize in complex commercial and intellectual property dispute resolution. We have four outstanding panelists from diverse parts of Asia and the US who will be discussing recent developments in the patent offices and their jurisdictions. Let me begin by introducing these truly excellent intellectual property professionals. First, we have Chikako Mori, who is the head of the trademark team at Sun East IP firm in Japan. Chikako is a highly experienced registered patent and trademark attorney who also litigates patent and trademarks in Japan with over 20 years of experience handling trademark and design cases. She advises clients on a variety of matters involving IP rights.



[\(01:19\)](#):

Next, we're lucky to have from India Aditi Verma Thakur. She is a senior partner at Ediplis Counsel in India where she is a seasoned intellectual property lawyer and advisor focusing on soft and commercial IP matters. Aditi has many mirrors of diverse experience and advising clients on contentious and non-contentious aspects of IP subjects and on intricate corporate and commercialization aspects of IP and related rights.

[\(01:47\)](#):

From Taiwan, we have Chaoming Chen, who is the founding member of CMC Intellectual Property firm in Taipei, as well as a visiting professor at the Osaka Institute of Technology. He provides clients with an array of services relating to patents and trademarks and collaborates closely with lawyers throughout the world.

[\(02:07\)](#):

Miku Mehta works in Silicon Valley, California and is a partner in the Intellectual property group at Procopio, Cory, Hargreaves & Savitch. Miku advises clients in the U.S. and Asia on intellectual property, patent prosecution, and counseling matters, as well as trademarks and copyrights and expert control matters. Miku has extensive experience in a vast range of technologies. So with that, let's begin our discussion. The first topic we'd like to talk about is what patent offices in various jurisdictions are doing to improve the ease of administration. And I'll begin by asking Chikako, what is the Japan Patent Office doing to try to make things easier for people?

Chikako Mori [\(02:50\)](#):

Since 2020, in order to simplify administrative process for applicant and right holder, Japan Patent Office has been working to reduce the need for wet signatures and seal for about 800 documents, including power of attorney forms. Japan Patent Office no longer requires wet signature or seal for many documents, around 30 in total, such as those for recording a change in ownership still require a wet signature or seal. Aditi, how about in India?

Aditi Verma Thakur [\(03:23\)](#):

So in India, the digitization of the records over the years has resulted in the law permitting signing of documents using digital signatures as well. So any digital signature issued by a government authorized certifying authority is allowed. The patent law specifically makes it clear that along with the version that is digitally signed, a scanned copy of the original document should also be sent to the patent office electronically. So this is a very easy administration of documents at the intellectual property office in India.

Robert "Bob" Sloss [\(04:00\)](#):

Chaoming, what's going on in Taiwan?

Chaoming Chen [\(04:02\)](#):

Thank you, Bob. Taiwan, on the other hand, may not have implemented an electronic signature requirement for foreign applicants yet, including the U.S. applicants. However, in fact, Taiwan intellectual property office has introduced electronic filing systems for both patent and trademark applications since August 2008, which allows only the domestic applicants or the agent of record to file applications online by using an electronic signature. However, because foreign applicants without an address in Taiwan must entrust a local agent to file and prosecute their applications on their behalf, a power of attorney with a wet signature to be scanned and emailed as a PDF file is still required for such foreign applicants. So now we also would like to know about the U.S. part. So Miku please?



Miku Mehta ([05:07](#)):

Yes. So I can tell you that the USPTO has accepted what we call S-signatures or slash signatures for quite some time, I believe since around 2004 and recently the question has come up with respect to commercial platforms, the use of a stylus and using special commercial platforms that actually provide the e-signature. The USPTO has put together a very nice list of examples of what the preferred, proper and improper approaches are with numerous examples. I would encourage anyone who has a question as to whether a signature is appropriate or not to take a look at it. It's really helpful. It was actually put out quite some time ago, but we always refer back to it.

([05:57](#)):

The other thing I would say to keep in mind is that in addition to signing the declaration, we also have to be careful with the assignment. Keep in mind that an assignment may be used as a property transfer for purposes beyond the USPTO. So in addition to being compliant for USPTO purposes, we want to be sure that whether it's a federal or state agency, another court or another jurisdiction, another country, whatever we're doing in terms of the signature, if we're conveying rights would be compliant for those forum or jurisdiction. So that's a little bit about what's going on with the signatures and how the USPTO has worked.

Robert "Bob" Sloss ([06:43](#)):

Can I ask each of you to kind of quickly say how is DocuSign or S-signature working in your jurisdictions? Is that going pretty well?

Chikako Mori ([06:52](#)):

No. In Japan, DocuSign is not acceptable.

Robert "Bob" Sloss ([06:55](#)):

Okay.

Aditi Verma Thakur ([06:56](#)):

So in India also there is no practice of using S-signatures, but the practice of having documents imposed with signatures before the IP authorities is being explored, it's not very common and we are still exploring that practice, but I believe that should be okay because it ultimately uses digital signature process.

Chaoming Chen ([07:19](#)):

Not in Taiwan yet. So, that's a very simple answer.

Robert "Bob" Sloss ([07:23](#)):

Do you see it coming soon?

Chaoming Chen ([07:26](#)):

No, haven't heard anything about that unfortunately.

Robert "Bob" Sloss ([07:32](#)):

Same in Japan and India?

Chikako Mori ([07:33](#)):



Yes.

Miku Mehta ([07:35](#)):

As I mentioned, a commercial platform signature programs are acceptable. However, there are rules on that in terms of whether or not you're using the forward slashes, how you're placing the forward slashes and other procedural aspects. So if you're going to be using those, I would encourage anyone to check what the USPTO has put out for guidelines and also check with that particular commercial platform provider because usually they list on their websites the jurisdictions for which they understand their product is compliant.

Robert "Bob" Sloss ([08:13](#)):

Before we go on to the next topic, if you could each briefly tell me how these changes are working. Are they better? Do they make things easier for the applicant?

Chikako Mori ([08:23](#)):

For Japan, I think it makes much easier for many users. It reduces also other administrative work. I think it's a good change for users.

Aditi Verma Thakur ([08:35](#)):

As well. It's a good change. It's a welcome change for the users of the IP office website because it's all online, it's all digital and it's quite time saving. So definitely very, very useful process.

Chaoming Chen ([08:51](#)):

Yes, same in Taiwan. We used to just like USPTO needs the power of attorney and all the assignment, but now we only need the power of attorney, although we still need that, not like in Japan. I believe that in Japan you don't need even the power of attorney. Thank you.

Robert "Bob" Sloss ([09:12](#)):

All right, let's go on to the next topic. And that's kind of a similar question except rather than focus on changes that are being made for the benefit of the applicants, what types of things are patent offices in your jurisdiction doing to improve matters for stakeholders and the actual owners of the intellectual property? Chikako?

Chikako Mori ([09:33](#)):

Since 2019, the Japan Patent Office has operated a fee reduction program for patent applicants who meet the criteria to be considered small or medium size entities. This increase fee deduction for substantive examination request as well as patent fee for one year through 10 years. The Japan Patent Office also offers an accelerated examination for both patent and trademarks available upon request. For trademark applications, under the accelerated system, the range of substantive examination is reduced from 10 months to two to three months approximately and no official fee will incur for making this request. This would be useful for example, when the trademark applicant is already using the mark in relation to certain goods or service in Japan, even if not all, and all designated goods and service can be found in the JPO manual. Also from 2020, a fast track examination is conducted automatically for trademark application that meet the relevant criteria. The length of examination is reduced from 10 months to six months. How about in India, Aditi?

Aditi Verma Thakur ([10:43](#)):



Thank you Chikako. In India as well, there are a lot of fee benefits and fee concessions which are on official fees. There is an 80% official fee relaxation for individuals, startups, and small entities under the patent law as compared to other regular enterprises. Last year, educational institutions were also included in this list of parties receiving these benefits. This is done with the view to promote innovation and R&D in the new tech domains. So foreign startups here can also get fee reductions. These qualifies for a foreign startups are, they should be less than seven years of age except for biotech startups, which should be less than 10 years of age to get the fee reduction. They should also have an annual turnover of less than INR 25 gross. If they are service enterprises, which is about 3 million USD; it should be involved in developing a new product or service driven by technology or IT.

[\(11:45\)](#):

And this is one of the most important ask in order to be a recognized startup and there should be a valid declaration to prove all the above from the startup seeking this fee benefit. So this is actually a very good inclusion for foreign startups as well. Similarly, under the design law there is a 75% fee reduction in the official fee for startups, small enterprises and individuals. Now under the trademark side as well, there is a similar fee reduction. There's a 50% fee reduction in the trademark official fee for startups, small entities and individuals, 10% further reduction is all provided for all stage filings if the filings are done online, but we've seen that the trend of foreign startups seeking official fee benefits with concessions are very less so this with foreign startups exploration has not happened in cases of trademarks so much from my past experience.

[\(12:42\)](#):

Now on the patent side, there is an expedited examination process which is provided by the patent law. Expedited examination of applications is a process that has resulted in the issuance of patent grants quite swiftly. The fastest patent that was granted in India was in 41 days from the date on which the expedited examination was requested for. Under this fast track system, many patent grants are happening within one year as well. Earlier, this scheme was available to only startups. By way of an amendment in the patent rules in 2021, new types of applicants were eligible for the scheme and this includes applicants under the patent prosecution highway, female applicants, and other small and medium enterprises. There is also a system of well-known trademarks on the trademark side. Do you want me to elaborate on that, Bob?

Robert "Bob" Sloss [\(13:37\)](#):

Well I think maybe we can come back to that. Let's first hear from Chaoming about what Taiwan is doing in terms of fee reduction in perhaps fast tracking applications.

Chaoming Chen [\(13:47\)](#):

Well, regarding the fee, actually thank you. The official fees have not been increased in Taiwan since 2009. For example, the filing fee for patent application is approximately 120 US dollars. And for filing on trademark application in one class, it is nearly a hundred US dollars. So, which is not particularly expensive when compared with other jurisdictions. However, as for individuals, schools and small and medium sized enterprises, the annuity will be reduced to around 70% for the first to six years. Further, the domestic or foreign startups established within five years are able to participate the so-called positive patent examination pilot program for startups from the first date of this year for an accelerated examination through the Taiwan Patent office initiated interviews with a shortened pending schedule, which is similar to a PPH program.

[\(15:06\)](#):

Regarding the green technology related to patent applications, accelerated examination can be requested with a fee since 2014. In addition, a new measure of remote video interviews with talent,



intellectual property office examiners for pending patent applications has been implemented from March 1st of this year, which is applicable for both domestic and foreign applicants. So especially this is very beneficial for foreign applicants, so they don't have to go all the way, come to Taiwan for in-person interview like before. So that would be a situation in Taiwan.

Robert "Bob" Sloss ([15:50](#)):

And Miku, what's going on in the U.S. with fees and fast tracking?

Miku Mehta ([15:56](#)):

So we have the small entity system and we also have a micro entity system. So if you qualify for micro-entity or small entity you're entitled to 50 to 75% fee reductions. Be careful about the requirements so long as you meet them and be careful if your status changes, you should change the fees that you pay according to your change in status. But that's been well known. But I think recently the USPTO has provided special programs and acceleration programs to, of course there's always been one for applicants age and health and for certain technology initiatives. We've also had them for areas like counter-terrorism, energy and environmental quality. We recently have pilot programs. One is for cancer immunotherapy patent applications. Another one is for products or processes related to COVID-19. There's a climate change mitigation program. And then of course we have the standard bilateral agreements for patent prosecution highway with several jurisdictions, which are useful, but there are restrictions on claim amendment, so be careful about that.

([17:15](#)):

And then applicants can pay a fee to accelerate either using a track one or the design rocket docket. So there are a lot of opportunities for enterprises involved in technology areas to have accelerated examination. We also have other pilots in other areas of the USPTO. We have AFCP 2.0, which is a very nice post final or after final program that allows for more time for examiners to consider some types of amendments. There's a lot going on and I think it's all very helpful, particularly for SMEs but for everyone. So just keep an eye, there are a lot of changes very frequently on these at the USPTO, but I think they're, they've been really great to help promote innovation and protection of IP.

Robert "Bob" Sloss ([18:06](#)):

Great, thank you. Aditi, you wanted to say something about trademarks in India. What can you tell us about that?

Aditi Verma Thakur ([18:12](#)):

Yes, thank you so much, Bob. So it's basically the system of having well-known trademarks. So that was newly introduced in India by a 2017 amendment in the law. And the system has picked up quite well and there are many claimants of well-known marks before the trademark authority. So the U.S. originated international brands that have been determined as well-known trademarks by the Indian Trademark Authority are Kohler bathroom and kitchen fittings, Oracle for software services, 7-11 for convenience stores and Vogue for fashion and lifestyle magazines. From Japan's side, Suzuki is the word mark that has been determined as a well-known mark. The court still continue to declare these famous marks as well-known. But then this is an added practice that has introduced because of this new amendment that started in 2017. So it's a good feature to have from India.

Robert "Bob" Sloss ([19:10](#)):

Before we leave this topic, does anyone have anything they'd like to add about fees or accelerated processes? If not, let's go on to kind of a more general issue and that is, what are some of the things



that you would like to tell us about how your jurisdiction is handling IP filings? And what your firm is doing that specializes in those areas? And again, let's start with Chikako.

Chikako Mori ([19:33](#)):

Each patent office work in different way. So operation is unique in each jurisdiction. I think communication between applicant right holder attorney is vital to understand procedure and ensuring optimal outcomes. This cannot be overstated.

Robert "Bob" Sloss ([19:51](#)):

Aditi, what would you like to say about what's going on generally in India?

Aditi Verma Thakur ([19:56](#)):

Thank you so much Bob. The Indian IP office is doing quite well actually in terms of providing continuous support to applicants from India and foreign jurisdictions. Indian enterprises have also shown quite resilience in terms of getting back to normal during and after the pandemic as the trends of the office reveal a continuous growth in the IP filings. This is mostly because the R&D and innovations, especially in the drug and pharma sector, increased and so did the consumer goods for meeting the demands of the pandemic. It's a very good time to consider India a supermarket as it offers quality innovations now as well as competition. Hence, it promotes healthy business and drives revenue. The IP offices are supportive, it's a good economy to consider for expansion.

Robert "Bob" Sloss ([20:48](#)):

And Chaoming, what would you tell us generally about some of the benefits that are happening in the Taiwan patent office now?

Chaoming Chen ([20:55](#)):

Okay, thank you. For foreign applicants like the applicants in United States, we would definitely recommend to use the PPH because an active use of the PPH was significantly shortened the process for getting allowed and registered before the Taiwan patent office because the average time for receiving a notice of allowance will be less than six months for more than 90% of the pending applications using the PPH. And if foreign trademark applicants adopt the goods and or the services pre-approved by our patent office and submit the power of attorney upon filing, then a fast track mechanism for trademark examination will be automatically applied for shortening the examination up to 1.5 months without extra fees.

([21:58](#)):

This is also not only for domestic filers, also for foreign applicants, including applicants from the United States and also the US patentees or the trademark owners, they may also consider to [inaudible 00:22:16] before the Taiwan intellectual property and commercial court for relatively fast result, which is about just seven months. And this kind of patent application will have a winning rate favoring foreign plaintiffs and according to the statistics released by our IP court, the winning rate for foreign plaintiff, which goes more than 50% and which is higher than the overall average rate of around just 30%. And also considering the fees, the legal fees, which is also comparatively low when compared with other jurisdictions.

Robert "Bob" Sloss ([23:02](#)):



Chaoming, thank you. And I can tell you from my own experience, seven months to get a result in litigation is unheard of in the United States you can never get anything that quickly. Miku, what's generally going on in the U.S. patent office that is beneficial for everybody?

Miku Mehta ([23:16](#)):

Well, I think you can see that the USPTO is focused on some of these technology areas and the world problems, technology problems we want to solve in green and life sciences and things like that. But I think the USPTO is also doing a great job with education and roadshows or virtual road shows to provide the public with education and resources. We have the four regional patent offices and are outreaching to, there's still a lot of outreach to Asia Pacific region. We have at attaches, I think in India, Southeast Asia, China and other places. The USPTO is engaged in ID5, IP5 and other areas. And I think that's really helpful for us to have a good understanding of IP systems and end up with nice harmonization, which helps applicants, PPH, those kinds of programs that come out of that. So I think it's really exciting to see that's continuing. It's been going very well for a long time with that, but it's really nice to see that Director Vidal is continuing to do that.

Robert "Bob" Sloss ([24:26](#)):

Oh, very good. This has been a very interesting and informative discussion. I'd like to end by asking each of you to spend about one minute telling us kind of what the most important thing that we've heard today is in connection with your particular patent office. What's the takeaway that people should have? Chikako?

Chikako Mori ([24:46](#)):

Japan Patent Office is making steady progress towards speeding up the application process and also making the attainment of right more accessible to small, domestic and overseas entities. So we hope these change will keep moving the same direction.

Robert "Bob" Sloss ([25:04](#)):

Thank you. Aditi, what's your takeaway?

Aditi Verma Thakur ([25:07](#)):

Thanks Bob. The Indian patent Office and the IP office in general, it's actually very welcoming of foreign applicants and that's why it has included these fee reductions, overall benefits that are provided to Indian applicants, to foreign applicants as well. And because of the modernization, because of the overall digitization processes and all, it is actually showing that attraction for foreign applicants, I'm sure. So it's a good time to consider India filings as one of the priority filings for your expansion.

Robert "Bob" Sloss ([25:43](#)):

Excellent. Chaoming.

Chaoming Chen ([25:45](#)):

Thank you, Bob. Well, like Argentina or Pakistan, actually Taiwan is neither a contracting state for PCT nor for metric protocol. So please bear in mind and to remember to file a patent or trademark application in Taiwan within 12 months or six months of the first filing in order to claim a varied priority. That would be my takeaway today.

Robert "Bob" Sloss ([26:12](#)):



And finally, Miku, what's the takeaway from the US?

Miku Mehta ([26:16](#)):

I think the USPTO's doing a lot to make business very easy for applicants. And there are a lot of special programs out there. I think for applicants. I would recommend to consider whether your technologies and the IP that you're trying to protect is eligible. And if it is, consider taking advantage of those as well as the other resources that USPTO has. But remember that as Chaoming was saying, that the details matter and make sure you're eligible and you maintain your eligibility for those programs and follow the rules. And it's really great to be part of this program. Thank you for letting me join.

Robert "Bob" Sloss ([26:56](#)):

And with that, I think we have reached the end, wonderful presentation by all four of you. Thank you very much. If anybody would like more information on these topics, please don't hesitate to reach out to any of our excellent panelists. And with that, we will say goodbye.

Host ([27:12](#)):

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