

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Alexandria, Virginia

Re: JIPA Comments on the "Examination Guidelines for Implementing the
First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act"

Dear Under Secretary Kappos:

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 "Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.144, on July 26, 2012. We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

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

Sincerely, yours,

Yoichi Okumura

President

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JAPAN

**JIPA Comments on the “Examination Guidelines for Implementing the
First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act”**

JIPA has closely and carefully examined the proposed the Examination Guidelines, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of July 26, 2012, under the title of “Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act”. JIPA hereby presents its comments on this proposed amendment.

1. In column 2 in FR43761, there is the following statement regarding 102(a)(2):

WIPO publications of PCT applications that designate the United States are treated in the same way as U.S. patent application publications for prior art purposes, regardless of the international filing date or whether they are published in English.

PCT applications are regarded as U.S. applications when they enter the national phase. JIPA would request that only the WIPO publications which have been entered into the national phase in the United States are treated as prior art under 102(a)(2). In addition, JIPA would request that translations are disclosed for non-English WIPO publications that are designated to the United States, for which the national phase entry procedures have been completed. Alternatively, JIPA would request that, when a non-English WIPO publication is treated as prior art under 102(a)(2), an English translation thereof is provided to the applicant.

2. Regarding "on sale" in column 1 in FR43765, JIPA would request that "a secret commercialization" does not constitute "on sale" and "offer to sell." This is because, in commercial practice, the subject matter of the claimed invention is assumed to be disclosed among specific interested parties under the explicit or implicit confidentiality obligation and JIPA believes that such secret commercialization is not included in the scope of public availability.

3. In column 3 in FR43766, there is the following statement regarding "grace period inventor disclosure”:

Where the authorship of the prior art disclosure includes the inventor or a joint inventor named in the application, an “unequivocal” statement from the inventor or a joint inventor that he/she (or some specific combination of named inventors) invented the subject matter of the disclosure, accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence to the contrary.

The proposed examination guidelines do not specifically clarify what facts a statement needs to explain to fall under an "unequivocal" statement. JIPA would request that the final examination guidelines clarify specific guidelines for meeting the "unequivocal" requirement.

Moreover, JIPA would request that specific guidelines be clarified regarding what explanation of the presence of additional authors meets the "reasonable explanation" requirement.

4. In column 1 in FR43767, there is the following statement regarding "grace period non-inventor disclosure":

The applicant also must show a communication of the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.

The proposed examination guidelines provide that the applicant must show a communication of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention. However, there is no clear standard for determining whether the communication enabled one of ordinary skill in the art to make the claimed invention. Therefore, JIPA would request that the final examination guidelines clarify the standard.

5. In column 2 in FR43767, there is the following statement regarding "Prior Art Exception Under 35 U.S.C. 102(b)(1)(B) to 35 U.S.C. 102(a)(1)":

The provisions of 35 U.S.C. 102(b)(1)(B) indicate that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not prior art if the disclosure was made (1) One year or less before the effective filing date of the claimed invention; and (2) after a public disclosure of the subject matter of the disclosure which would otherwise qualify as a prior art under 35 U.S.C. 102(a)(1) by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor.

JIPA thinks that difference exists between "public disclosure" and "disclosure." However, the proposed examination guidelines do not clarify the cases where a disclosure is determined to be a "public disclosure." JIPA would request that the final examination guidelines clarify the standard for determining a "public disclosure."

6. In column 2 in FR43767, there is the following statement regarding "Prior Art Exception Under 35 U.S.C. 102(b)(1)(B) to 35 U.S.C. 102(a)(1)":

Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial change, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.

The proposed examination guidelines do not clearly define degree of change in the "mere insubstantial change." JIPA would request that the final examination guidelines show specific examples and clarify the wording, "mere insubstantial change." Specifically, the public disclosure by the inventor and prior art disclosure by a person other than the inventor can have slightly different contents since they are written by different people. Therefore, JIPA would request that whether the content of prior art disclosure and the content of public disclosure by the inventor are identical or not is not determined too strictly.

7. In column 3 in FR43767, there is the following statement regarding "grace period intervening disclosure exception":

If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the

earlier disclosure is a public disclosure of the subject matter.

JIPA understands that 102(b)(1)(B) is also applicable even if the earlier public disclosure by the inventor is not a printed publication. However, the proposed examination guidelines do not clarify what explanation must be made in the declaration or affidavit in cases where the earlier public disclosure is intangible, for example, where the earlier public disclosure is oral. Therefore, JIPA would request that the final examination guidelines show specific examples and specifically clarify what facts must be described.

8. In column 1 in FR43768, there is the following statement regarding "1. Determining When Subject Matter Was Effectively Filed Under 35 U.S.C. 102(d)":

Under 35 U.S.C. 102(d), a U.S. patent, U.S. patent application publication, or WIPO published application is prior art under 35 U.S.C. 102(a)(2) with respect to any subject matter described in the patent or published application as of either its actual filing date(35 U.S.C. 102(d)(1)), or the filing date of a prior application to which there is a priority or benefit claim(35 U.S.C. 102(d)(2)).

Furthermore, there is the following statement in column 3 in FR43768:

Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, a U.S. patent, a U.S. patent application publication, or WIPO published application is effective as a prior art as of the filing date of the earliest such application, regardless of where filed, rather than only as of its earliest United States benefit date.

JIPA understands that in such a case, the examiner confirms whether the subject matter used in the rejection is described in the earliest application and determines whether it is effective as prior art. JIPA would request that the examiner properly confirms whether the subject matter is described in the earliest application even if the earliest application is described in a language other than English.

9. In "D. Applicant Statement Regarding Applicability of AIA Provisions to Claims in Applications Filed on or After March 16, 2013" in column 2 in FR43773, the following two cases are stated as cases where the applicant must provide a statement:

1) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of or priority to the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application that was filed prior to March 16, 2013, and also contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect.

2) If a nonprovisional application filed on or after March 16, 2013, does not contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement to that effect.

The proposed examination guidelines do not clarify whether the PTO may request the applicant to provide a statement during the examination process where the applicant has not provided the aforementioned statement as he/she determined that the submission was not required. In addition, the proposed examination guidelines do not clarify what disadvantages are caused to the applicant if the applicant does not provide a statement.

JIPA would request that the final examination guidelines clarify how the PTO treats the relevant application if the applicant does not provide a statement.

Regarding the statement mentioned in 2) above, the proposed examination guidelines provide that the applicant must provide a statement if the subject matter not disclosed in the earlier application is disclosed in the subsequent application. JIPA would request that the final examination guidelines specifically clarify what additions require the applicant to provide a statement. For example, is it necessary for the applicant to provide a statement if he/she adds a new constitution or an embodiment to the subsequent application though it is literally included in the scope of the claims in the earlier application?

The applicant added a subject matter not also disclosed in the earlier application, and filed the statement mentioned in 2) above. After that the applicant adds new claims relating to the added subject matter. JIPA would request to the PTO to clarify, in the proposed examination guidelines, whether the applicant must provide a further statement mentioned in 1) in this case.

JIPA understands that the examiner applies AIA to the application if the applicant files the statement mentioned 1) above. However, the proposed examination guidelines do not clarify whether the patent is valid if the examiner erroneously applied pre-AIA despite the applicant's filing a statement mentioned in 1) above. JIPA expects that flexible practice will be carried out for such patents so that applicants will not suffer disadvantages.

Moreover, JIPA understands that, regarding applications for which a statement mentioned in 2) above has been provided, the examiner determines whether AIA is applied to the application or not during the examination process. However, the proposed examination guidelines do not mention the standard for the determination. JIPA would thus request that the final examination guidelines clarify the standard for the determination.

Furthermore, JIPA would request that the PTO notifies the applicant for which applicable law has been changed from pre-AIA to AIA in the examination process. In addition, JIPA would also request the PTO to indicate which AIA or pre-AIA is applied to the application, in Office Action and other examination documents regarding all applications. Moreover, JIPA expects that an applicant will be given an opportunity to offer a counterargument if he/she has an objection to applicable law.

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