

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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June 10, 2013

The Honorable Teresa Stanek Rea  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Alexandria, Virginia

Re: JIPA Comments on the "Changes To Implement the Patent Law Treaty"

Dear Acting Under Secretary Rea:

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 "Changes To Implement the Patent Law Treaty", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.78, No.70, on April 11, 2013. 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,

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## **JIPA Comments on the “Changes To Implement the Patent Law Treaty”**

JIPA has closely and carefully examined the proposed rule, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of April 11, 2013, under the title of “Changes To Implement the Patent Law Treaty”. JIPA hereby presents its comments on this proposed rule.

1. In FR21804, Proposed §1.53 provides as follows:

(b) Application filing requirements—Nonprovisional application. The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims is received in the Office.

(f)(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include at least one claim or the inventor’s oath or declaration (§§ 1.63, 1.64, 1.162 or 1.175), and the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f) to avoid abandonment.

In the Proposed Rules, §1.53(b) states that a filing date will be secured for an application which does not include even a single claim, and §1.53(f)(1) stipulates that such an application will be given a period of time within which to subsequently file a claim or claims. However, the Proposed Rules do not specify the length of this period.

JIPA has a concern that allowing the subsequent filing of claims would result in unequal treatment among applicants or increase the monitoring costs incurred by third parties. More specifically, the Proposed Rules could result in: (i) enabling an applicant to draft and file claims for his application in the US after obtaining examination results in other countries; (ii) delaying the filing of claims, resulting in a delay in the publication of the application; and (iii) publication of an application without claims. If the Rules are to be amended to accord a filing date to an application which does not include even a single claim, JIPA would request that an appropriate (not unduly long) period of time for the subsequent filing of claims be clearly indicated in the amended Rules.

2. In FR21804 Column 3, Proposed §1.55(b) provides as follows:

(2) If the subsequent application has a filing date which is after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in paragraph (b)(1) of this section but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application or upon petition if the delay in the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional.

Proposed §1.55(b)(2) stipulates that the right of priority may be restored after the expiration of the priority period (12 months) if the delay is unintentional. JIPA disagrees with the introduction of this proposed provision.

If a patent obtained by claiming such a restored right of priority would be in force for 20 years from the filing date, this would substantially lengthen the exclusive right by up to two months for an applicant who has delayed claiming priority due to negligence, when compared with an applicant who has claimed priority appropriately by the due date. JIPA considers this to be unreasonable, and if this proposed provision is to be actually introduced, JIPA would request that it be clearly indicated whether the term of a patent obtained by claiming such a restored right of priority would be 20 years from the filing date. JIPA would also request that appropriate measures be taken so that an the substantially lengthened right would not be given to an application that has failed to meet the due date, such as shortening the patent term through requesting the applicant to file a TD (Terminal Disclaimer), a patent term adjustment (PTA) or setting a period during which the patent is unenforceable.

JIPA would also request that the interpretation of the term unintentional be clarified and that more examples of unintentional delay be provided via guidelines or other sources.

3. In FR21807 Columns 2 and 3, Proposed §1.137 provides as follows:

■ 20. Section 1.137 is amended by revising its section heading and paragraphs (a), (b), (c), (e) and (f) to read as follows:

§ 1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.

(a) Revival on the basis of unintentional delay. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this section to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

(b) Petition requirements. A grantable petition pursuant to this section must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

JIPA disagrees with the change from the “unavoidable” standard to the “unintentional” standard in this provision.

JIPA understands that the Patent Law Treaties Implementation Act of 2012 (PLTIA) deleted the provision on the restoration of patent rights via the revival of abandoned applications on

the basis of unavoidable delay and integrated it into the provision on the restoration of patent rights on the basis of unintentional delay. According to this change, the existing §1.137(a) has been deleted from the Proposed Rules. Specifically, the existing provision on the restoration of patent rights on the basis of unavoidable delay in responding to a notice has been deleted as has the existing reference to the petition fee set forth in §1.17(l), and the provision on the restoration of patent rights on the basis of an unintentionally delayed response, including the reference to the petition fee set forth in §1.17(m), has been changed to Proposed §1.137(a)(b) shown above. In short, the petition fee for the restoration of patent rights on the basis of unavoidably delayed response which was in force before the enactment of the PLTIA (\$640) has been amended to the petition fee set forth in §1.17(m) (\$1,700).

JIPA believes that integrating the relief afforded in cases of unavoidable delay under the existing rules into relief on the basis of unintentional delay could amount to a significant fee increase for applications eligible for relief under the existing rules (from \$640 to \$1,700). Japan suffered devastating damage due to the giant earthquake and tsunami that occurred on March 11, 2011, and is likely to suffer the same kind of damage in the future for geographical reasons. According to the Proposed Rules, applicants or patentees who have suffered damage due to a severe earthquake or tsunami might not be able to enjoy relief on the basis of unavoidable delay under the existing rules and would have to restore their rights by paying the petition fee set forth in §1.17(m). Thus, the Proposed Rules could impose an excessive cost on such applicants or patentees. To avoid this, JIPA would request that the petition fee be revised or the provision on the restoration of patent rights on the basis of unavoidable delay be maintained.

4. In FR21808 Column 1, Proposed §1.378 provides as follows:

■ 24. Section 1.378 is revised to read as follows:

§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unintentional. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unintentionally delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in § 1.20(e) through (g);

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in payment of the maintenance fee was unintentional.

The Director may require additional information where there is a question whether the delay was unintentional.

In Proposed §1.378, the provision on the restoration of patent rights on the basis of an unavoidable delay in the payment of the maintenance fee has been deleted from the existing §1.378(a), and the reference to the surcharge set forth in §1.20(i)(1) has been

deleted from the existing §1.378(b) for the purpose of maintaining consistency with the deletion of the provision on the restoration of patent rights on the basis of unavoidable delay (as in the case of the change mentioned in 3 above). As a result, the surcharge set forth in §1.20(i)(2) (\$700) under the existing 1.378(b)(2) has been amended to the petition fee set forth in §1.17(m) (\$1,700).

For the same reasons as are mentioned in relation to 3 above, JIPA believes that this amendment could amount to a significant fee increase for a patentee that is eligible for relief on the basis of unavoidable delay under the existing rules (from \$700 to \$1,700), and therefore would request that the petition fee be revised or that the provision on the restoration of patent rights on the basis of unavoidable delay be maintained.

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