

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Mr. John Alty
CEO, UK Intellectual Property Office
Chair, Group B+ Subgroup on Patent Harmonization
Via email: Group B+ Secretariat Saito-kenji2@jpo.go.jp

Re: JIPA Comments on the “Objectives and Principles, with Commentary on Potential Outcomes”

Dear Chairman Alty,

We truly appreciate for an opportunity to review and comment on the “Group B+ Objectives and Principles, with Commentary on Potential Outcomes” with your letter dated on June 2015.

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 940 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>)

We find this outcome encouraging to see a progress on harmonization discussion. We will continue to study by ourselves and with other associations. Interactive communication with B+ group would be greatly appreciated.

Sincerely, yours,

Masahiro Kamei
President

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JIPA Comments on the “Objectives and Principles, with Commentary on Potential Outcomes ”

Japan Intellectual Property Association (JIPA) as well as a member of Industry Trilateral appreciates the work product, namely “OBJECTIVES AND PRINCIPLES, WITH COMMENTARY ON POTENTIAL OUTCOMES” (“B+ Paper”), provided by B+ subgroup on patent harmonization.

First of all, JIPA would like to emphasize that JIPA is in fully aligned with overall objectives of the global patent system as described in the Preamble (first page of the B+ Paper). JIPA takes the position that one should always keep in mind of a fair balance and legal certainty to inventors/applicants and third parties. Also, as enterprises continue to expand their market and activities, “efficiency” and “consistency” of acquisition of patents in multiple jurisdictions as described in section (iv) are significantly important.

In response to the B+ Paper, JIPA would like to comments on some specific issues raised in the B+ paper as follows.

1. Non-prejudicial disclosures / grace period (grace period system)

(1) Differences in views among countries on the grace period system exist on the basic idea of the patent system, and therefore a process of harmonization has been very hard. JIPA appreciates that the B+ subgroup has now shown some common views, i.e. (i) to (iv) in second page of the B+ Paper.

Especially, JIPA highly supports the following points:

- providing a high level of legal certainty for applicants and third parties (*)
- enabling to file according to globally harmonized principles and rules.

(*) Please see (ii) on “Objectives of the global patent system” in the preamble.

(2) JIPA would like to address the following considerations to be taken into account for future discussion on harmonization.

(i) Clarification of the position of the grace period system in the patent system

In order to harmonize the grace period system, consensus on the position thereof in the patent system is essential and efficient.

JIPA is of the opinion that the most appropriate ~~best~~ principle on which the legal certainty of the patent system is ensured is a novelty under the first-to-file system. This means the principle that an invention lacks a novelty at the time of patent filing would lose patentability. This principle should remain under the first-to-file system.

From this point of view, it should be confirmed that a) early filing is encouraged, b) the grace period system is not intended to encourage a publication of an invention before filing, c) the grace period is to relieve an invention which has been published before filing for certain circumstances and d) the grace period system is an exception to this principle.

(ii) Ensuring transparency

One specific aspect of the positioning of the grace period system is to ensure a transparency. Reduction in legal certainty for the third parties due to an invention to which the grace period is applied should be minimized and balanced. JIPA is of the opinion that in case of a prior publication by the applicant itself declaration or notification or something similar should be in principle be provided by the applicant.

For example, third parties recognize applications filed by others by means of the patent publication (18-month publication, publication of granted patent). Third parties would evaluate a patentability of such potential patent publication for their own practice, e.g. initiate, continue, or discontinue their own business. Unless it is notified by the applicant, third parties would have no idea if any prior disclosure by the applicant that third parties have found as prior art has been subjected to non-prejudicial disclosure.

In case of publication caused by theft of information or not intended by applicant, it is difficult to realize it and it is severe for the applicant to compensate for what cannot be realized.

In case of publication by the applicant, the applicant must be aware of such publication. Having declaration or notification or something similar to be filed by the applicant is reasonable means in practice. Effective penalties are needed to be considered to assure such transparency and thus to avoid causing any unbalanced legal certainty for third parties.

(iii) JIPA highly appreciates that the B+ subgroup expressed the following view as a common view: publication by a third party before filing affects the patentability of the application in which grace period is applied. This view is consistent with the principle of novelty under the first-to-file system, and is essential to retain a legal certainty.

2. Publication of applications

JIPA is of opinion that no additional exceptional reason should be allowed to voluntarily opt out of publication by the applicant.

3. Conflicting applications

If earlier-filed applications ("secret prior art") would be cited against subsequent applications of incremental and improvement inventions filed by the same applicant ("self-collision"), such inventions cannot be filed. Self-collision may constraint technical innovation. JIPA is expecting further study of harmonization of principles and rules for protecting such incremental inventions by the same applicant.

B+ Paper recites "there are differing views as to the extent to which their secret prior art should count against other applicants - in particular whether it should count for the purposes of "enlarged novelty" or novelty and inventive step."

JIPA is aware that it is an important issue to what extent secret prior art can have an impact on subsequent applications. However, the extent of the impact due to actual application in each country cannot be necessarily expressed by the terms "novelty," "enlarged novelty," and "inventive step." JIPA proposes that what is specifically meant by each of these terms should be clearly defined in the future in order to promote a more detailed discussion.

B+ Paper recites "There may be benefits to a harmonised system in which PCT applications apply as secret prior art upon international publication in any language."

JIPA basically understands this concept and would like to address following to be further considered. Suppose that examination of a certain application is underway before publication of a PCT application which is a secret prior application. JIPA understands that in such a case the examiner may not be able to take such nonpublic information on the PCT applications in all the other countries into consideration in the examination. In order to avoid the risk that a patent is invalidated later by the presence of such nonpublic information, JIPA considers that examination of the nonpublic information should be ensured reliably regardless of differences among languages.

4. Prior user rights

JIPA strongly believes, as in an agreement within Industry Trilateral, effective and serious business preparations for use before the filing date of the application should qualify for prior user rights. Such preparation is important for business activities, as well as actual use. JIPA proposes to clarify such preparations to be included in "use" of the prior user rights as described in the paragraphs (i) and (ii).

5 Prior art

It may also be referred to the definition of prior art in the draft substantive patent law Treaty (SCP/10/4) prepared by the International Bureau of WIPO in 2004 as follows, in which the prior art is stated everything has been made available to the public. It may be clear that public use (practice or implementation) of the invention would be covered.

"The prior art shall be consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world."

(END)