JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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October 28, 2016

The Honorable Michelle K. Lee
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 "Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance"

Dear Under Secretary Lee:

We, the Japan Intellectual Property Association (JIPA), 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.

We were pleased to learn the "Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.81, No.167, on Monday, August 29, 2016. 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,

(Minoru KATO)
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JIPA Comments on the "Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance".

Japan Intellectual Property Association (JIPA) has closely and carefully examined the "Leveraging Electronic Resources To Retrieve Information From Applicant's Other Applications and Streamline Patent Issuance", publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of August 29, 2016. JIPA hereby presents its comments on the proposed changes.

1. JIPA believes that Leveraging Electronic Resources is a breakthrough approach that reduces burden imposed on applicants, and deeply appreciates the USPTO's efforts and the opportunity provided for the applicants to give opinions. JIPA understands that this approach originates from the PHEP (Patent Harmonization Expert Panel) where the IP5 offices are approaching to harmonize consistent procedural patent rules among IP5 offices. The USPTO's IDS is a very unique system based on the good faith principle, unlike the citation of prior art duty in the other offices, and requires significant costs and man-hours for not only the examiner but also the applicants in comparison with the other offices. One of the causes is found in the current circumstance where the applicant files more documents than necessary with the USPTO for fear that the patent might be held unenforceable due to violation of the IDS duty. Thus, JIPA would like to express our opinions as follows so as to reasonably reduce the burden imposed on both the applicants and the examiner resulting from bearing the USPTO's IDS duty, from the viewpoint of system harmonization and in light of streamlining practices.

2. FR59199, column 3 recites the following question:

1. In balancing the goals of examination quality and efficiency, should the USPTO monitor other applications, besides domestic parent and counterpart foreign applications, for relevant information located therein for consideration in the instant U.S. application? If so, which other applications should be monitored (e.g. siblings, applications involving the same or related technology, etc.)?

Regarding the above question, JIPA believes that there are other applications for the USPTO to monitor besides domestic parent and counterpart foreign applications, taking into consideration the balance of examination quality and efficiency. The reason is as follows.

JIPA considers other applications correspond to only (i) continuing applications (CA, CIP and DA) of the instant U.S. application, and (ii) "other U.S. patent applications" recognized as "double patenting" of the instant U.S. application by the USPTO during the examination of the instant U.S. application.

Note that the above term "other U.S. patent applications" refers to U.S. patent applications found to be "double patenting" by the USPTO during the examination.

Therefore, even if the other applications are considered as applications of (i) and (ii) described above, no burden will be newly imposed on the examination by the USPTO and examination quality will be ensured by monitoring highly relevant applications in the USPTO.

Also, as discussed in section 5 below, improvement in examination efficiency and reduction in the examination period can be anticipated, by listing information on the above other applications on the data display page of the instant U.S. patent application in the databases (Patent Application Information Retrieval(PAIR) system, Global Dossier(GD), and Common Citation Document(CCD)) used by the USPTO.

3. FR59199, column 3 recites the following question:

2. What is the most convenient way to bring an application to the USPTO's attention that should be monitored for information during the examination of a U.S. application (e.g., automated system, applicant notifies the USPTO, etc.)?

Regarding the above question, JIPA believes that an "automated system" is the most convenient way. The reason is as follows.

According to research conducted by JIPA, prior art disclosed in the IDS by the applicant for the instant U.S. application often includes prior art relevant to an Office Action (OA) of the U.S. parent patent application (domestic parent) and counterpart foreign applications. Here, prior art relevant to the OA is entirely recorded in the existing databases (e.g., PAIR, GD and CCD), and accessible to the examiner. Therefore, an "automated system" using the databases will be appropriate. Meanwhile, the current circumstance is such that not only prior art relevant to the OA but also more documents than necessary are filed by the applicant with the USPTO, out of concern that the patent might be held unenforceable due to violation of the IDS duty. In light of this circumstance, even if an "automated system" can be used by examiners, there are still an enormous number of the above documents that have to be reviewed by the examiner and a problem arises with overburdening the examiner with checking all the documents. Therefore, JIPA would like to propose one solution (i.e. an appropriate automated system) that can be the most convenient way for both the USPTO and the applicant in the answer to the following question.

4. FR59199, column 3 recites the following question:

3. How should the USPTO determine which information from the monitored applications to provide examiners while ensuring they are not overburdened with immaterial and marginally relevant information?

Regarding the above question, JIPA believes, in the application that should be monitored as stated in section 2, that only category-X documents (evidence for lack of novelty: Article 102) and category-Y documents (evidence for obviousness: Article 103) are

information that should be monitored from the viewpoint of preventing the examiner from being overburdened. The reason is as follows.

JIPA examined, in the application(s) that should be monitored as stated in section 2, what are the material documents to the examiner by investigating the percentage of documents that were actually cited in the USPTO's OAs, out of documents that are cited in the ISR, EESR and other countries' OAs and that were filed by the IDS with the USPTO.

As shown in the research result (table 1), the percentage of documents employed as citations for rejections under Article 102 and Article 103 in the USPTO's examination (the percentage of documents serving as citations in the USPTO's OAs), out of documents that were cited as category-X and/or category-Y documents in the ISR, EESR and other countries' OAs, is close to 20%. Therefore, these category-X and/or category-Y documents should be monitored and taken into consideration in the USPTO. If there is a function that makes these documents automatically "displayed in the 'examination terminal' used by the examiner for examination", efficiency on the examination will be improved. Further, for those documents filed as non-English documents, the USPTO's IT tool that allows automatic display of "counterpart English patent applications" will lead to improvement of examination efficiency. Even if there is no corresponding counterpart English patent application, machine translation may be used automatically or by the examiner to improve examination efficiency.

Meanwhile, the percentage occupied by documents in category A (documents defining the general state of the art which is not considered to be of particular relevance) that were cited in the USPTO's examination is about 5%, whereas the percentage occupied by documents that were voluntarily filed by the applicant and employed as citations in the USPTO's examination makes up only about 2%. Thus, even if these documents are filed in great numbers, the probability of citing these documents in the USPTO's examination is extremely low. Thus, there are concerns that the category-A documents and documents that were voluntarily filed by the applicant may be a burden to examiners. Improving the USPTO's search capability appears to be more rational than checking all the "documents filed by the IDS" by the examiner to find out the documents included in the above several percent.

Additionally, establishing the above "automated system" so as not to provide information of the category-A documents to the examiner should also contribute to prevention of overburdening the examiner. Besides, due to the low percentage of the category-A documents employed as a citation in the examination, JIPA requests that the documents with a relevance like category-A documents be specified as “not material” in the MPEP. Further, JIPA would like the USPTO to make an approach to the Courts so as to avoid holding of unenforceability due to the lack of category-A documents in the IDS.

Note that, if there are no X, Y and A classifications as in the case of the JPO's notice of reasons for rejection, the A documents correspond to "reference documents" recited in the notice of reasons for rejection. We would like the USPTO to carry out the examination after identifying documents "corresponding to the A document" automatically on the system or by the USPTO's examiner.

Documents included in information disclosure by applicants to the USPTO	Number of documents serving as citations in the USPTO's OA	Number of documents filed by the IDS	Percentage serving as citations in the USPTO's OA (%)
Total number of cases	35	640	5.47
X Documents	13	75	17.33
Y Documents	13	75	17.33
A Documents	4	83	4.82
Documents filed voluntarily by applicants	5	320	1.56
Others (ISR, ISA or Other countries' OA, etc.)		87	

Table 1) Research result: Data on each kind of document cited by the USPTO's examiners from citations in other countries' OAs, etc.

With regard to JIPA's research illustrated in Table-1, 39 cases of U.S. patent applications were randomly selected from U.S. patent applications included in 4 field of "Electrical engineering", "Instruments", "Chemistry", and "Mechanical engineering" which were defined by the WIPO based on "IPC and Technology concordance table" generated in accordance with the IPC (International Patent Classification).

JIPA has examined documents cited in the ISR, EESR or other countries' OAs as family applications of these U.S. applications and the number of documents actually cited as citations by examiners for rejections under Article 102 and Article 103. According to the research, the examiner is supposed to review, on average, 16.4 documents filed by the IDS per application. By eliminating review of the category-A documents and documents filed voluntarily by the applicant, the examiner is allowed to avoid review of 10.25 documents on average.

Note that JIPA is still investigating how the IDS documents are associated with documents referenced in the USPTO's examination and the data shown in the above table is provisional data at present. JIPA is prepared to provide further data with improved accuracy at any future occasion.

5. FR59199, column 3 recites the following question:

4. If the USPTO were to implement a fully automated system to import information from applicant's other applications, how should the USPTO document the information automatically imported into the image file wrapper of the instant U.S. application? For

example, should the record reflect which domestic parent or counterpart foreign application the information was imported from, the date that the information was imported, and whether the examiner considered the imported information?

Regarding the above question, JIPA provides the following comment. It will be desirable to post (or attach links or provide with additional tabs for the applicant's other applications, etc.) link information to allow access to information of relevant applications (or applicant's other applications) on the data display page of the PAIR system (and/or GD, CCD systems, etc.) used by the USPTO in relation to the instant US application. By doing so, the examiner is allowed to easily access information of relevant applications and thus, the examination efficiency can be improved.

In addition, JIPA requests that the PAIR system allow downloading this link information at the same time using a function to batch download files.

Lastly, JIPA is continuing this research and JIPA is starting collection of applicants' voice of JIPA's members in order to seek what the most appropriate IDS practice is, considering both examiners and applicants. And then we would like to show final result of our research in the next trilateral IP heads and users meeting if we will have opportunity.

We hope the interim result of our research (the table 1) and the final result of our research contribute to improve IDS practice of the USPTO.

(EOD)