

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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November 10, 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 "Post-Prosecution Pilot Program"

Dear Under Secretary Lee:

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.

We were pleased to learn the "Post-Prosecution Pilot Program", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.81, No.132, on Monday, July 11, 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)

Managing Director

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JAPAN

JIPA Comments on the “Post-Prosecution Pilot Program”

JIPA has closely and carefully examined the "Post-Prosecution Pilot Program (P3 Program) ", publicized in the Federal Register (FR) issued by the United States Patent and Trademark Office (USPTO) as of July 11, 2016. JIPA hereby presents its comments on the proposal.

1. Pros and cons of introduction of the P3 Program

JIPA supports introduction of the P3 Program because the applicant is provided with more options for effective right acquisition means that are available after a Final Office Action (Final OA). However, JIPA would also like to request maintaining the current pilot programs (AFCP 2.0 and Pre-Appeal Brief Conference) that have an advantage of allowing acquisition of rights at lower costs.

2. Details of the P3 Program system

(1) Request period

Particularly because the applicants outside the U.S. (overseas residents) are not equivalent to U.S. residents in terms of geography and require more time to communicate with U.S. agents due to time differences, etc., the two-month period of request set forth as a preparatory period for filing documents may not be sufficient. Therefore, JIPA would like the USPTO to accept a request filed after a lapse of two months from the issuance of the Final OA.

(2) Extension fee to prosecute an RCE, etc. after decision of Final Rejection Upheld

Even if a request is filed within two months from the mailing date of the Final OA, extension of the period for reply to the Final OA may be possibly required in the P3 Program to prosecute an RCE, etc. subsequently, depending on the mailing date of the Final Rejection Upheld.

If an Advisory Action is mailed with a notice of decision of the Final Rejection Upheld, the initial date from which an extension fee is calculated is considered to be the mailing date of the Advisory Action, or three months from the mailing date of the Final OA, whichever is later. However, if an Advisory Action is not mailed with a notice of decision of the Final Rejection Upheld, the initial date from which an extension fee is calculated is considered to be three months from the mailing date of the Final OA.

Thus, the initial date from which an extension fee is calculated is considered to be variable depending on whether or not an Advisory Action is mailed. Therefore, clarification as to whether or not an Advisory Action is mailed with a notice of decision of the Final Rejection Upheld is requested.

Additionally, if an Advisory Action is not mailed with a notice of decision of the Final Rejection Upheld, JIPA requests the USPTO to establish measures to reduce the extension fee, in light of the applicant's burden of extension fee, by specifying the initial date from which an extension fee is calculated as, for example, the mailing date of a notice of decision

of the Final Rejection Upheld or three months from the mailing date of the Final OA, whichever is later.

(3) Disclosure of statistical data on the period until issuance of a panel decision

Due to the system design of the P3 Program, a panel decision may be reached after a lapse of the statutory period (three months) for reply to the Final OA. Therefore, any measures that allow the applicant to estimate the timing at which the procedure for the P3 Program is terminated would be appreciated.

Therefore, JIPA proposes that the USPTO disclose detailed statistical data of the period from request of the P3 Program until a panel decision as far as possible to the extent recognized by the USPTO. Note that the statistical data should be disclosed at least by each individual technology center because the period required until a panel decision may be different in each technology center.

(4) Filed argument/amendment

The Examiner's impression of review of argument/amendment should be notified to the applicant in advance before presentation. Owing to such an advance notice to the applicant, the applicant is allowed to modify the direction of a presentation so that a meaningful presentation for the USPTO and the applicant can be provided. Using the USPTO's internal material for reporting the examiner's review results of argument/amendment as an advance notice will reduce the examiner's work burden.

(5) Procedure in RCE, etc. after notification of panel decision

JIPA proposed in the above 2.(3) that "the USPTO disclose detailed statistical data of the period from application of the P3 Program until a panel decision as far as possible to the extent recognized by the USPTO".

If many cases are found to have a lapse of six months from the date of the Final OA before a panel decision as a result of disclosure of detailed statistical data, the current P3 Program is considered to be a system that is less convenient for the applicant. Therefore, JIPA proposes that the applicant be provided with an opportunity to prosecute an RCE, etc. within a prescribed period after notification of a panel decision.

In the case where a lapse of six months from the date of the Final OA occurs before a panel decision even though the applicant took appropriate measures such as filing designated documents within an application period, a part of such a lapse should be treated as a delay of examination by the USPTO. Therefore, JIPA also proposes clarifying in advance how to treat patent term adjustment in the above case.

(6) Materials used in the presentation

The FR describes that any materials used by the applicant during the presentation, e.g., a PowerPoint(R) or exhibit, will be placed in the file, which is an unprecedented unique definition. JIPA proposes that materials used during the presentation be treated in the same manner as in the case of the conventional interview as set forth in the MPEP, etc.

(7) Establishment of a new examination route subject to a panel decision based on documents such as argument/amendment without presentation

According to the FR, the current examination route in the P3 Program is such that the examiner's review of documents filed by the applicant is followed by making a presentation by the applicant to the panel so as to reach a decision. The P3 Program is therefore understood to have a system structure in which a presentation is essential.

However, even though the system structure in which a presentation is essential has an advantage, in some cases, the following disadvantages for both the applicant and the USPTO are considered.

Firstly, there is an anticipated disadvantage of increased costs such as agent fees for presentation by U.S. agents, as opposed to the current pilot programs that allows the applicant to acquire rights without a presentation. Besides, the presentation conducted in the panel conference, which is absent in the current pilot program, is a first challenge to the USPTO and there is an anticipated disadvantage of increased work burden within the USPTO, if the request of the P3 Program itself is enough persuasive to allow the application.

In order to resolve these disadvantages and provide the P3 Program as a more valuable program to both the applicant and the USPTO, JIPA proposes, while maintaining the current examination route, establishment of another route in which a panel decision is based on documents such as argument/amendment without making a presentation.

(EOD)