

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property, and
Director of the United States Patent and Trademark Office

Re: JIPA's Comments on the Proposed USPTO Rule Changes Pertaining to the
Examination of Patent Applications That Include Claims Containing Alternative
Language, 72 Federal Register 44992-45001

We, the Japan Intellectual Property Association ("JIPA"), are one of the world's largest IP user organizations, with a membership of 1,153 Japanese companies (as of October 1, 2007). Having filed many U.S. patent applications, our member companies are greatly interested in the proposed USPTO rule changes published on August 10, since these changes concerns not only presentation of claims containing alternative language but also the unity of invention issue including a definition of a single invention and practice of restriction requirements.

As mentioned in our public comments on the previously proposed USPTO rule changes (68 Federal Register, 27536 (May 20, 2003), 70 Federal Register, 32761 (June 6, 2005)), our basic policy to the issue of the unity of invention is global unification of standard. More specifically, in consideration of the fact that the standard of the unity of invention has been discussed under the PCT, we think it reasonable and realistic to harmonize the standard of individual countries with the PCT including practice of restriction requirements and presentation of alternative language in claims.

If we can harmonize the standard with PCT, we can expect the following benefit:

- (1) Applicants can file a common patent specification among the countries and thus can greatly reduce costs and administrative work.
- (2) The patent offices can utilize the search reports and the examination results carried out by other patent offices and expedite examination process with higher efficiency.

From the viewpoint mentioned above, we appreciate the proposed rule in that the proposal includes changes toward the international harmonization. For example, provisions similar to the PCT guidelines are introduced in § 1.75 and § 1.140 and §

1.141 clarifies that restriction requirements is not mandatory.

However, in order to further promote the harmonization, we would like to request the following improvements on the proposed rule changes:

1) § 1.75(j)

The proposed rule § 1.75(j) specifies that the following four requirements shall be satisfied when alternative language is used to define multiple species in a single claim:

- (1) The number and presentation of alternatives in the claim does not make the claim difficult to construe;
- (2) No alternative is defined as a set of further alternatives within the claim;
- (3) No alternative is encompassed by any other alternative within a list of alternatives, unless there is no other practical way to define the invention; and
- (4) Each alternative within a list of alternatives must be able to be substituted one for another.

Since the requirements (2) and (3) are not included in the PCT guideline 5.18, which corresponds to the rule, we consider the requirements (2) and (3) should be removed from the USPTO rule changes in order to seek further conformity with the PCT guidelines.

Moreover we think such presentation of alternatives in a claim is necessary to have appropriate protection of an invention with a reasonable number of claims, especially in the pharmaceutical or chemical fields. We believe the necessity will further increase from November 1, on which the new rule limiting the number of claims in an application will be effective.

Thus we request the removal of the requirements (2) and (3) from the proposal.

2) § 1.140(a)

The proposed rule § 1.140(a) requires that each claim should be limited to a single invention and specifies that a claim that reads on multiple species may be regarded as a single invention when either of the following two conditions are met:

- (1) The species share a substantial feature essential for a common utility; or
- (2) The species are prima facie obvious over each other.

Regarding (1), it is further explained on page 44997 in the Federal Register that:

Alternatives share a substantial feature necessary for a common utility when they share a utility that complies with the requirements of 35 U.S.C. 101. A substantial feature in this context is a feature, such as a particular structure, material, or act, without which the claimed alternatives would not retain the shared utility.

In the meantime, PCT guideline 10.17(a) prescribes that

- (a) When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled:
 - (A) all alternatives have a common property or activity, and
 - (B)(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives, or
 - (B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

While expecting that concrete criteria for determining whether species share a substantial feature essential for a common utility will be specified in the MPEP, we would like to request to bring the criteria into line with the PCT with providing examples for clear understanding.

3) § 1.141

The “Discussion of Specific Rules” in the Federal Register explains the rule § 1.141 is revised to clarify that a restriction requirement is not mandatory. However, we are still concerned that the same sort of restriction requirement may continue to be issued in future if the current interpretation of “distinct invention” persists. Regarding the practice of restriction requirements, we have requested USPTO to harmonize the inventions that can be included in a single application with the unity of invention standard of the PCT. We hope that the proposed rule and the MPEP will be revised so as to further improve the harmonization in this respect.

We understand that a certain degree of relationship among the claims in one application should be required and that certain restrictions should be imposed on claim presentation in order to improve efficiency of search and examination. However it is also obvious that adoption of different standards and implementation rules by individual countries would increase applicants’ burden and decrease the patent offices’ examination efficiency.

Thus JIPA sincerely request the USPTO to pay consideration to the conformity with the PCT so that the rule changes would benefit both of applicants and the USPTO.

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Taisuke Kato', with a stylized flourish at the end.

Taisuke Kato
President
Japan Intellectual Property Association