

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Hon. David J. Kappos  
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 Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures in the United States

Dear Under Secretary Kappos:

1. The Japan Intellectual Property Association (hereinafter referred to as "JIPA") is one of the world's largest users associations for intellectual property, which has a membership of more than 900 Japanese corporations (as of June 1, 2010). JIPA member companies file many U.S. patent applications. JIPA makes comments below on the proposal of introduction of the prioritized examination system (Track I), which was released by the USPTO on February 4th.

2. JIPA agrees to (welcomes) the introduction of the prioritized examination system.

The introduction of a new prioritized examination system provides users with a new option regarding the flexibility of timing of obtaining rights, and is very beneficial from the perspective of effective exploitation of rights according to the business circumstances. In addition, regarding the coverage of this system, the deletion of the requirement of "being an application filed first in the United States," which was in the original draft proposed last year, increases the availability for foreign users who file U.S. applications mainly as second applications. JIPA highly welcomes this. JIPA wishes for the success of this measure, and also hopes for further consideration on some points indicated below from the perspective of increasing the effectiveness of the introduction of this system.

(1) Reconsideration on the point that applicants can request prioritized examination only at the time of filing

There are many cases in which a certain time is required from the creation of an invention in the process of research and development and product development to the distribution of products in which the invention is worked in the market. In addition, for inventions which have been created in countries other than the United States that adopts the first-to-file system, there is not necessarily a need for early obtainment of rights at the time of filing of applications in the United States, which is decided based on the priority period. Moreover, the system that allows applicants to choose whether they wish to use a procedure for early obtainment of rights after filing is common in many countries that have already had an

accelerated examination procedure, including the EPO and the JPO. Therefore, it is the JIPA's opinion that it is desirable from the perspective of expanding users not to limit the timing of requesting prioritized examination to the time of filing but to make it possible for applicants to choose prioritized examination even after filing. JIPA believes that if it is set as one of the objectives to appropriate income from fees obtained owing to the adoption of this system as resources for reducing the backlog of applications awaiting examination, the system will become one that is advantageous not only for users but also for the USPTO, specifically, reduction of the backlog of applications awaiting examination will be realized in the long run, by promoting wide utilization of the system through presentation of conditions accessible for more users outside the United States.

#### (2) Relaxation of limits on the number of claims

Depending on the content of an invention, the number of claims sometimes needs to be large in order to protect the invention with certainty. For example, in the field of telecommunications, there is, by necessity, no other choice but to state many claims in order to ensure the protection of a specific technology or products, compared to the field of medicine. Therefore, if applications with many claims are excluded in a single uniform way, applicants may not be able to benefit from the prioritized examination system depending on their type of business. In the same way as (1), JIPA would like to request relaxation of the limits on the number of claims in order to make the prioritized examination system accessible for more users, taking into account that applicants already pay an additional fee in cases where the number of independent claims exceeds three or where the number of dependent claims exceeds twenty.

#### (3) Relaxation of other requirements

A fee of \$4,000 is the proposed fee for requesting the prioritized examination proposed this time. This amount is extremely high compared to the fee for the existing accelerated examination procedure (petition to make special) that is planned to exist concurrently with the prioritized examination system, which is \$130 (37CFR1.17(h)), even taking into account that prior art search is made by applicants in the existing accelerated examination procedure. This practically results in the situation where a small portion of users who have enough funds receive benefits, and seems likely that it would lack fairness among applicants. Therefore, JIPA hopes that the fee would be reduced so that more users can use the system.

In addition, it was indicated that, in the prioritized examination procedure proposed this time, an application ceases to be subject to prioritized examination if the applicant requests an extension in the process of examination. This is understood as a concept common to the existing accelerated examination procedure. However, JIPA hopes not for inflexible operation in which an application is excluded from the subject of prioritized examination in a single uniform way if the applicant requests an extension but rather wishes for flexible operation for such cases as where an applicant's request for an extension does not interrupt promotion of examination but eventually leads to early issuance of a patent.

Sincerely, yours,

A handwritten signature in black ink, appearing to read 'F. Moriya', with a large, sweeping flourish extending to the right.

Fumihiko MORIYA

President

Japan Intellectual Property Association

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