

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable 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 "Notice of Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need To Review Criteria Used in Determining Secrecy Orders Related to National Security"

Dear Under Secretary Kappos:

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 900 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>)

Having learned that the "Notice of Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need To Review Criteria Used in Determining Secrecy Orders Related to National Security", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.77, on April 20, 2012. 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,

Yoichi Okumura

President

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**JIPA Comments on the “Notice of Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need To Review Criteria Used in Determining Secrecy Orders Related to National Security”**

JIPA has closely and carefully examined the proposed Congress’s idea, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of April 20, 2012, under the title of "Notice of Request for Comments on the Feasibility of Placing Economically Significant Patents Under a Secrecy Order and the Need To Review Criteria Used in Determining Secrecy Orders Related to National Security". JIPA hereby presents its comments on this proposed amendment.

1. With careful consideration of the proposed Congress’s idea of expanding the scope of patent applications that may be placed under a secrecy order, which currently covers patent applications significant for national security concerns, to further include those significant for economic security, we would like to express a dissenting view to the proposed idea especially in consideration of two points as we shall explain later. In our view, if the proposed system were to be introduced, it would be more detrimental than beneficial.

2. Firstly, it would be an obstacle to an economic growth. Suppose a case where a patent application is placed under a secrecy order as being significant for economic security, and this order is later lifted. In this case, the patent would be granted and issued without the application for a patent being published. This would force those working on the development of the same kind of technology as the one involved in the patent to start all over from scratch even though they were midway toward achieving commercialization, which would result in incurring a considerable economic waste.

This problem seems to be common to the problem of submarine patents that existed before the publication system was introduced in the United States. As JIPA sees, the proposed system of excluding specific types of patent applications from publication would go against the efforts that the USPTO has made thus far to improve the US patent system in order to prevent the creation of submarine patents in consideration of international harmonization of patent systems.

3. Secondly, the proposed system would go against the international harmonization of the patent system. If the United States introduced such system as proposed by Congress, other countries might try to introduce similar systems. JIPA is concerned that this would make all countries free to choose to publish applications or not, ultimately causing confusion and unexpected problems. JIPA considers that such system is not fair and against the harmonization of the world patent system. Therefore JIPA insists that the introduction of the proposed idea must require international consensus.

4. Furthermore, from the perspective of protecting inventors who have made significant inventions for economic security, JIPA would recommend accelerated examinations of patents for significant inventions rather than keeping them secret, as it would match the USPTO's initiative to expedite the examination process and would therefore be more acceptable to patent users. As a prerequisite, however, an adequate examination should be duly conducted.

5. For the above mentioned reasons, JIPA disagrees with the introduction of the proposed system.

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