

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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October 4, 2012

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 "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act"

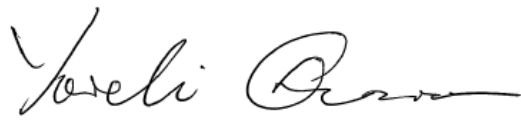
Dear Under Secretary Kappos:

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 "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.144, on July 26, 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
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**JIPA Comments on the “Changes To Implement the First Inventor To File Provisions
of the Leahy-Smith America Invents Act”**

JIPA has closely and carefully examined the proposed amendment to 37CFR, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of July 26, 2012, under the title of “Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act”. JIPA hereby presents its comments on this proposed amendment.

1. §1.130(b) of the Proposed Rules provides as follows:

(b) If the disclosure on which the rejection is based is by the inventor or a joint inventor, the affidavit or declaration under paragraph (a)(1) of this section must provide a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure.

An "unequivocal statement" is required to meet this "satisfactory showing" requirement. However, the proposed rulemaking does not specifically clarify what facts a statement needs to explain to fall under an "unequivocal statement." Therefore, JIPA would request that specific guidelines are clarified in the MPEP or other materials.

Furthermore, §1.130(b) of the Proposed Rules states that, "Where the authorship of the reference disclosure includes the inventor...accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence..." (Discussion of Specific Rules in column 1 in FR43750). In this regard, JIPA would also request that specific guidelines for what explanation would be determined as reasonable be specifically clarified in the MPEP or other materials.

2. §1.130(c) of the Proposed Rules provides as follows:

If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the disclosure with sufficient detail and particularity to determine that the disclosure is a public disclosure of the subject matter on which the rejection is based.

JIPA understands from this provision that there is difference between "disclosure" and "public disclosure." JIPA would request that what facts need to be indicated to fall under "public disclosure" be specifically clarified in the MPEP or other materials.

3. §1.130(f) of the Proposed Rules provides as follows:

The office may require the applicant to file a petition for a derivation proceeding pursuant to §42.401 et seq. of this title if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor and the patent or pending application claims an invention that is the same as the applicant's claimed invention.

Are there any cases where the PTO does not require the applicant to file a petition for a derivation proceeding even if the claims are the same and the inventors are different? A derivation proceeding is an important procedure to determine the actual inventor. However, it is a heavy burden on interested parties. Therefore, JIPA would request that standards for determining whether the PTO requires the applicant to file a petition for a derivation proceeding be indicated.

(EOD)