

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 "Setting and Adjusting Patent Fee"

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 "Setting and Adjusting Patent Fee", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.173, on September 6, 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

Japan Intellectual Property Association

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JAPAN

JIPA Comments on the “Setting and Adjusting Patent Fee”

JIPA has closely and carefully examined the proposed rule, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of September 6, 2012, under the title of “Setting and Adjusting Patent Fee”. JIPA hereby presents its comments on this proposed amendment.

1. §1.20 Post issuance fees (e)-(g) provide that maintenance fees shall be raised considerably as follows:

Maintenance fee due at 3.5 years: \$1,130→\$1,600 (+42%)

Maintenance fee due at 7.5 years: \$2,850→\$3,600 (+26%)

Maintenance fee due at 11.5 years: \$4,730→\$7,400 (+56%)

These increases in maintenance fees are defined as “fees to be set above cost recovery.” FR55053 column 2 explains that “maintenance fees will be paid only by patent owners who believe the value of their patent is much higher than this fee for renewing these patent rights,” and column 1 explains that “maintenance fees benefit the Office and the patent system by generating revenue that permits the Office to keep front-end patent prosecution fees below cost.”

JIPA understands the outline of the above explanations but cannot agree with the proposed fee increases because these explanations do not specifically rationalize the respective rates of increase depending on years or the difference in these rates. JIPA would request that the USPTO reconsider and explain a practical fee schedule which can provide a more specific and clearer rationalization for these matters.

2. §1.17 Patent application and reexamination processing fees (e)(1),(2) provide that the fees for RCE (request for continued examination pursuant to §1.114) shall be raised from the current \$930 to:

\$1200 (+29%) for a first RCE; and

\$1700 (+83%) for a second and subsequent RCEs.

JIPA appreciates that the rate of increase for the fees for a first RCE has been reduced from the level proposed in February 2012. JIPA understands that with the present proposal, the USPTO intends to reduce the number of unnecessary RCEs and make the examination process more compact.

Please suppose an applicant amends a claim after receiving the final rejection notice. In such case, the applicant need not file an RCE in case of having his/her amendment accepted, but it is often the case that he/she files an RCE with a response in order to have the amendment entered in the examination process.

As far as JIPA understands, whether this amendment would be accepted or not is often up to the examiner in charge of the case. In other words, the necessity to file an RCE can be determined at the examiner’s discretion.

To avoid such situation, JIPA would request that examiners' practices be standardized so that if an amended claim is found to be patentable, examiners will accept the amendment even when the applicant does not file an RCE. More specifically, JIPA would request that the After Final Consideration Pilot (AFCP) be formerly adopted.

3. §1.21 Miscellaneous fees and charges (h)(1) provides that when an assignment is submitted electronically, the patent owner does not have to pay the fees for recordation (currently \$40).

JIPA appreciates this proposed fee exemption. However, JIPA would request that the USPTO take a further step forward to provide an automated assignment recordation framework by linking the Electronic Filing System (EFS) and the Electronic Patent Assignment System (EPAS), or to authorize the transfer of a patent from the inventor to the original applicant without the recordation of an assignment.

In the case of an application filed by a corporate body, it is obvious that the invention has been transferred from the inventor to the corporate body, without being proved separately by the recoding of an assignment. As JIPA considers, this is clear from the fact that the provision of 37 C.F.R §3.73(a), "The inventor is presumed to be the owner of a patent application," has been amended to, "The original applicant is presumed to be the owner of a patent application." Also from the perspective of harmonization of world patent systems, JIPA would stress that major countries do not require registration of an assignment of a patent from the inventor to the original applicant.

(EOD)