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March 14, 2013

The Honorable Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Alexandria, Virginia

Re: JIPA Comments on the "Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents"

Dear Acting Under Secretary Rea:

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 "Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.78, No.2, on January 3, 2013. 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,

Masashi Suzaki
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JIPA Comments on the "Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents"

JIPA (Japan Intellectual Property Association) is one of the world's largest IPR user organizations. The Software Committee ("Committee") is an expert committee of JIPA engaged in research and studies on the Software patent system. Since our member companies have been filing many patent applications with the United States Patent and Trademark Office (USPTO), the Committee carefully examined the "Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents ("Proposal")" issued by the USPTO through the Federal Register ("FR") dated January 3, 2013. The Committee would like to make the following comments on the Proposal.

Our Comments on Topic 1

1. Supporting disclosure required for an invention of computer software described in functional language

We are against the idea of making it obligatory to disclose a specific algorithm for a software-related invention based on the CAFC judgments concerning requests for disclosure of means-plus-function claims. This is because such requirement would cause a discrepancy between the U.S. and other countries (Japan, European countries) in terms of the required level of disclosure. If a specific algorithm is disclosed, means-plus-function claims would be subject to rather narrow interpretation.

On the other hand, in the U.S., some examiners examining an application that contains means-plus-function claims could grant a patent without sufficiently identifying, in the specification, the algorithm and the structures corresponding to the functions of claims. Consequently, even if 35 USC 112 (f) is applied, the patentee could claim that anything that has such functions would fall within the scope of patent protection.

In view of these facts, in case that a patent application contains a function block diagram or any other similar description as well as a flowchart indicating the operation of the device to work the invention or any other similar description in its specification and those descriptions enable any person skilled in the art to implement it as a program, examiners examining the application should find that the application complies with 35 USC 112 (b) and allow the claims, even if those descriptions have been written in functional language and no specific algorithm has been disclosed. If such descriptions are not contained in a specification, examiners should reject the claims.

Our Comments on Topic 2

We would like to propose the following future discussion topics.

(1) Measures to clarify the relationship between the software-related claim language and the scope of claims

For example, we would like you to discuss what kind of claim language should be used to ensure the applicability or the inapplicability of 35 USC 112 (f).

(2) Future patent system to protect cloud-related technologies

For instance, in the case of an invention characterized by its operation on the side of a server on the network, if a patent application contains a claim concerning a terminal that communicates with the server, how would such a claim be handled? If relevant examination guidelines are established, what would the contents be like? How should such a claim be handled from the perspective of clarification of claim boundaries? We would like you to discuss these issues.

(3) Improvement of patent quality by introducing a patent/application peer review system in each industry

We would like you to evaluate the peer review system, which has been adopted by the USPTO, and to discuss the possibility of introducing it as a prominent system. Also, we would like you to discuss the possibility of introducing a peer review system only in certain industries such as the IT industry and the medical industry rather than introducing it in all industries.

(4) Improvement of patent quality by accumulating data such as sales brochures, academic papers, books and other publications

We would like you to discuss the possibility of accumulating data such as sales brochures, academic papers, books and other publications at the USPTO so that examiners can use them as prior arts. Also, we would like you to discuss the system of allowing companies to provide the aforementioned prior art documents.

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