

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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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 "Preparation of Patent Applications"

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 "Preparation of Patent Applications", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.78, No.10, on January 15, 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,

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Takashi Ohashi  
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## **JIPA Comments on the "Preparation of Patent Applications"**

JIPA (Japan Intellectual Property Association) is one of the world's largest IPR user organizations. The First International Patent Committee ("Committee") is an expert committee of JIPA engaged in research and studies on the U.S. 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 on Preparation of Patent Applications ("Proposal") issued by the USPTO through the Federal Register ("FR") dated January 15, 2013. The Committee would like to make the following comments on the Proposal.

### 1. Our comments on the Proposal in general

The Committee considers it necessary to have open discussions in order to facilitate examination and to enhance patent quality by bringing more certainty to the scope of issued patents. While some of your suggestions are beneficial to place the application in a better condition for examination, many of the practices specifically proposed therein go beyond the conventional practices required by other Patent Offices.

Basically, we would appreciate if you could take measures to prevent the introduction of these practices from imposing additional burdens on applicants who are trying to globalize their patent prosecution activities. More specifically, we would be against the idea of making it obligatory to employ a certain practice and against the establishment of penal provisions. Furthermore, the Committee has found that the Proposal should be more specific about the effects of the employment of the proposed practices. For example, we would like to know how a certain practice would benefit examiners and how a certain practice would affect legal proceedings. We would appreciate your explanation on these points before the introduction of any of these practices.

Our comments on each of the proposed practices are as follows.

### 2. Our comments on "Clarifying the Scope of the Claims"

#### (1) "A multi-part format"

Regarding the format of claims required at the commencement of examination, we consider it appropriate for the USPTO to provide guidance on the recommended format. However, since presenting claims in a multi-part format might be unsuitable depending on the technical field of invention or the scope of patent protection, a flexible approach should be taken if this practice is introduced. More specifically, we would be against the idea of making it obligatory to employ a multi-part format and against the establishment of penal provisions.

#### (2) "A claim chart or the standardized template"

If this practice is required for the preparation of every application, it would significantly increase the procedural and monetary burdens on applicants. Therefore, the Committee is against the introduction of this practice. A case-by-case approach would be more appropriate. For instance, an examiner may be allowed to request the submission of a claim chart from an applicant if his/her application is unclear in terms of support for claims.

(3) "Indicating whether examples in the specification are intended to be limiting or merely illustrative."

If the applicant wants an examiner to interpret that the claims are "limited" by the examples in the specification, the applicant is likely to write claims by using the terms related to the examples in the specification. Therefore, the introduction of this practice would not bring about any positive effect in terms of facilitation of examination and improvement of the quality of issued patents. Thus, the Committee is against the introduction of this practice.

(4) "Expressly identifying clauses within particular claim limitations"

If the applicant wants an examiner to interpret that a particular claim invokes 35 U.S.C. 112 (f), the applicant is likely to make MPF claims. Therefore, the introduction of this practice would not bring about any positive effect in terms of facilitation of examination and improvement of the quality of issued patents. Thus, the Committee is against the introduction of this practice.

(5) "Using textual and graphical notation systems"

If this practice is required for the preparation of every application, it would significantly increase the procedural and monetary burdens on applicants. Therefore, the Committee is against the introduction of this practice. For example, even if an applicant attaches program code such as C-language to the application documents, it would be difficult to understand the algorithm from the program code. Therefore, the introduction of this practice would not bring about any positive effect in terms of facilitation of examination and improvement of the quality of issued patents.

### 3. Our comments on "Clarifying the Meaning of Claim Terms in the Specification"

(1) "Indicating whether terms of degree"

The way of using certain terms in claims such as "substantially," "approximately," "about," and "essentially" and the intended meanings thereof would differ depending on the technical field and the product described in the claims. If the scope of such terms is required to be clearly explained in the specification, it could result in an excessively narrow interpretation of the scope of a patent right or in the relinquishment of the equivalents that should be taken into consideration in principle when interpreting claims. Therefore, the Committee considers it inappropriate to require every application to contain an explanation for the scope of such terms. Thus, the Committee is against the introduction of this practice.

(2) "Including in the specification a glossary"

If this practice is required for the preparation of every application, it would significantly increase the procedural and monetary burdens on applicants. Therefore, the Committee is against the introduction of this practice. A case-by-case approach would be more appropriate. For instance, an examiner may be allowed to request the submission of a glossary from an applicant if his/her claims or specification contain ambiguous terms.

(3) "A default dictionary"

While this practice could facilitate examination, it would be burdensome for applicants to choose an appropriate dictionary for each application, each term used in the specification, or each claim. Since applicants might simply use common dictionaries in relevant technical fields, the Committee considers that the effect of this practice would be limited in terms of facilitation of examination and improvement of the quality of issued patents. Therefore, the Committee is against the introduction of this practice, especially against the idea of making this practice obligatory. A case-by-case approach would be more appropriate. For example, if an applicant has used an ambiguous term in his/her claims or specification, an examiner may be allowed to request the applicant to submit the definition presented in a dictionary.

If the USPTO decides to introduce this practice, the Committee considers it desirable to establish an explicit rule specifying that, even if an applicant submits the definition of a claim term by using a dictionary, the definition presented in the dictionary is merely an example and that the claim term shall not be limited by the definition.

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