JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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Jan 11,2023

Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark
Office P.O. Box 1450
Alexandria, Virginia 22314

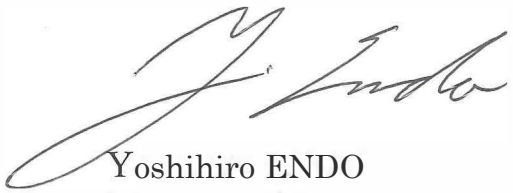
Re:JIPA Comments on USPTO Initiatives
To Ensure the Robustness and Reliability of Patent Rights

Dear Director Kathi Vidal,

We,the Japan lntellectual Property Association "JIPA",are a private user organization with about 970 major Japanese companies as members.
When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems.
Having learned a consultation, the state of bolstering the robustness and reliability of patents to incentivize and protect new and nonobvious inventions, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,



Yoshihiro ENDO
Managing Director
Japan Intellectual Property
Association

JIPA Comments on "Request for Comments on USPTO Initiatives To Ensure the Robustness and Reliability of Patent Rights"

With the expectation of enhancing the robustness and reliability of US patents, JIPA makes responses as follows.

Q2.
How, if at all, should the USPTO change claim support and/or continuation practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents?

Comments on Q2
The procedures described in Q2-a to Q2-c, and Q2-f should not be required to applicants. The reason therefor is that the procedures must be taken carefully when the impact on claim interpretation is taken into consideration, and thus, these cannot minimize the burden to applicants. Further, even in the case that the support for a claim is clear, if applicants are requested to take the procedures, not only the applicants would have a larger burden but also examiners would have increased tasks to confirm the procedures, resulting in the delay of examinations. If the support for a claim is unclear, the examiners may point out so through an office action. Applicants will explain or identify the support in response to the office action.

In order to reduce the burden of examiners to identify the support, IT should be utilized instead of the procedures taken by applicants. For example, a tool utilizing search and AI should be used to carry out efficient extraction of the support for a claim from a specification.

Comments on Q2-d
The change described in Q2-d is not acceptable. The reason therefor is that in a novel technical field having no established terms, it is impossible to define an invention with optimal wording and it is sometimes difficult to bring the wording of a claim in line with the statement of the specification. A rigid rule cannot give appropriate protection to epoch-making innovations and it is against the aims of fostering innovation.

Q3.
How, if at all, should the USPTO change RCE practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents? Specifically, should the USPTO implement internal process changes once the number of RCEs filed in an application reaches a certain threshold, such as transferring the application to a new examiner or increasing the scrutiny given in the examination of the application?

Comments on Q3
We favorably accept transfer of the application to a new examiner for RCE. The reason therefor is that when an examiner does not accept an applicant's assertion and the examination is at a deadlock, transfer of the application to a new examiner promotes the examination. However, it is desirable that transfer is carried out only when an applicant wishes the transfer. The reason therefor is that when the

examination is not at a deadlock, it is efficient that the examiner having understood an invention or examination procedures should continue the examination after RCE.

Q4.
How, if at all, should the USPTO limit or change restriction, divisional, rejoinder, and/or non-statutory double patenting practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents?

Comments on Q4
We favorably accept easing of the unity requirement. For contributions to innovations, it is necessary to protect innovative basic inventions and individual products utilizing them in an appropriate and efficient manner, and it should be accepted to claim multiple inventions from a specification as of the filing. Then, to achieve this aim, we favorably accept easing of the unity requirement. Further, decrease in the number of office actions that refer to the violation of the unity requirement can reduce the number of divisional applications or continuation applications. According to the survey of JIPA, it is clear that the violation of the unity requirement is pointed out in US with several times higher probability than in Japan or EP. For enhancement of the utility value of the US patent system, the enforcement of the unity requirement should be changed. When the enforcement is changed, it is desirable to refer to the unity requirement in Japan, EP or PCT.

Comments on Q4-f
The revision described in Q4-f should not be made. The reason therefor is that the change would generate many divisional applications thereby to increase the burden of examiners and decrease the value of patents. If the time period for divisional applications is set, this results in possible situations that: applicants would file divisional applications without sufficient studies on whether or not patent rights will be needed; and divisional applications will be filed due to preventive reasons with the prediction that nonelected claims will be not rejoined. The limitation to the time period would be a cause to generate many low-value divisional applications.

Comments on Q4-h
The change described in Q4-h should not be made. The reason therefor is that which claim of which application should be patented at which timing is the freedom of applicants, and it should not be restricted. As long as a terminal disclaimer is available, no problem will occur even when there exist multiple patents obvious to each other.

Q6.
Terminal disclaimers, allowed under 37 CFR 1.321(d), allow applicants to receive patents that are obvious variations of each other as long as the expiration dates match. How would eliminating terminal disclaimers, thus prohibiting patents that are obvious variations of each other, affect patent prosecution strategies and patent quality overall?

Comments on Q6
The change described in Q6 should not be made. The reason therefor is the same as on Q4-h. Further, if obvious variations of inventions are not protected by patents, this means that though an invention is non-obvious over the prior art, the invention is not patented only due to the difference in the order of filing. This change will prevent appropriate protection of continuously-improved inventions, resulting in the decline in value of the patent system.

Q7
Currently, patents tied together with a terminal disclaimer after an obviousness-type double patent rejection must be separately challenged on validity grounds. However, if these patents are obvious variations of each other, should the filing of a terminal disclaimer be an admission of obviousness? And if so, would these patents, when their validity is challenged after issuance, stand and fall together?

Comments on Q7
The change described in Q7 should not be made. The reason therefor is that this change makes it impossible to file a terminal disclaimer, which is to avoid the discussion on the obviousness with an examiner, thereby delaying the examination. If an examiner and an applicant spend their resources for discussion over not only the difference from the prior art but also whether or not patents are obvious variations, both of them increase the burden.

The validity of patents should be individually determined. The reason therefor is that since an intrinsically valid patent is invalidated by this change, appropriate protection of patents will not be achieved. For example, even if patent A is obvious over certain prior art, it is not always true that patent B obvious over patent A is obvious over the certain prior art. If both patents A and B are invalidated simultaneously, intrinsically valid patent B would be invalidated.

Q8.
Should the USPTO require a second look, by a team of patent quality specialists, before issuing a continuation patent on a first office action, with special emphasis on whether the claims satisfy the written description, enablement, and definiteness requirements of 35 U.S.C. 112, and whether the claims do not cover the same invention as a related application?

Comments on Q8
The change described in Q8 should not be made. The reason therefor is that reinforcement for examination of only continuation applications is unfair. When different examination processes are applied between a case where a certain invention is claimed in a parent application and a case where it is claimed in a continuation application, this situation would be against the basis of the system where all of patent applications are examined equally at the same quality level.

Q9.
Should there be heightened examination requirements for continuation patents, to ensure that minor modifications do not receive second or subsequent patents?

Comments on Q9
The change described in Q9 should not be made. The reason therefor is the same as on Q8.

Q10.
The Patent Act requires the USPTO Director to set a "time during the pendency of the [original] application" in which continuation status may be filed. Currently there is no time limit relative to the original application. Can the USPTO implement a rule change that requires any continuation application to be filed within a set timeframe of the ultimate parent application? What is the appropriate timeframe after the applicant files an application before the applicant should know what types of inventions the patent will actually cover? Would a benchmark (e.g., within six months of the first office action on the earliest application in a family) be preferable to a specific deadline (e.g., one year after the earliest application in a family)?

Comments on Q10
The change described in Q10 should not be made. The reason therefor is the same as on Q4-f.

Q11.
The USPTO has fee-setting authority and has set [fees] for filing, search, and examination of applications below the actual costs of carrying out these activities, while maintenance fees for issued patents are above the actual cost. If the up-front fees reflected the actual cost of obtaining a patent, would this increase patent quality by discouraging filing of patents unlikely to succeed? Similarly, if fees for continuation applications were increased above the initial filing fees, would examination be more thorough and would applicants be less likely to use continuations to cover, for example, inventions that are obvious variations of each other?

Comments on Q11
The change described in Q11 should not be made. The reason therefor is that an increase of the filing cost does not prevent the filing of less patentable applications and it will curb the entire of filing. Further, an increase of the filing cost will generate disparities between haves and have-nots in the budget and therefore, for example, innovations of start-up companies cannot be protected.

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