

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

Asahi-Seimei Otemachi Bldg. 18F.
6-1, Otemachi 2-Chome
Chiyoda-ku, Tokyo 100-0004 JAPAN



Tel: 81 3 5205 3433
Fax: 81 3 5205 3391

September 16, 2011

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 Notice of Proposed Rulemaking — "Revision of the Materiality to Patentability Standard for the Duty to Disclose Information in Patent Applications"

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 37CFR "Revision of the Materiality to Patentability Standard for the Duty To Disclose Information in Patent Applications," published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.76, No.140, on July 21, 2011. We would like to offer our opinions as follows. Your consideration would be greatly appreciated.

JIPA again thanks the USPTO for this opportunity to provide these comments and welcomes any questions on them.

Sincerely yours,

(Kenji Koumoto)

President

Japan Intellectual Property Association

Asahi Seimei Otemachi Bldg.18F

6-1 Otemachi 2-chome Chiyoda-ku Tokyo, 100-0004,

JAPAN

JIPA Comments on USPTO Proposals for “Revision of the Materiality to Patentability Standard for the Duty to Disclose Information in Patent Applications”

1. Section 1.56(b) of 37CFR is proposed to be amended as follows:

(b) ... Information is material to patentability under *Therasense* if:

(1) The Office would not allow a claim if it were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction; or

(2) The applicant engages in affirmative egregious misconduct before the Office as to the information.

(emphasis added)

JIPA believes that the decision by the U.S. Court of Appeals for the Federal Circuit (CAFC) in *Therasense, Inc. v. Becton, Dickinson & Co.* adopted a stricter standard for proving inequitable conduct. Patent users seeking fair and reasonable patent protection would welcome such stricter standard. Since the proposed change to 37CFR complies with the indications made in *Therasense*, JIPA is in favor of the proposed change.

An applicant seeking fair and reasonable patent protection would not file an application while knowing the existence of prior art whereby the claims would not be allowed. Also, if such an applicant discovers such prior art after filing an application, the applicant would amend the claims and try to secure patentability. Since §1.56(a) of 37CFR provides that "There is no duty to submit information which is not material to the patentability of any existing claim," the amount of information to be submitted to the USPTO will be effectively reduced, and as a result, the burden on the examiner to process the submitted information will also be reduced. If so, this will lead to reduction in the examination processing time, which is desirable for both the USPTO and for patent users.

2. Meanwhile, the Federal Register on July 21, 2011 states that the USPTO is considering actions that may provide an incentive for applicants to cooperate in patent examination by explaining/clarifying the relationship of prior art to the claimed invention. While the details of the incentive under consideration are unclear, JIPA opposes a measure to uniformly require applicants to submit documents for explaining/clarifying the relationship of prior art to the claimed invention (hereinafter referred to as "documents explaining the relationship"), due to the following reasons.

Background art of a claimed invention highlights the novel points of the claimed invention. Therefore, disclosure of such prior art would be useful for the examiner to understand the invention. However, such prior art is already disclosed in the specification of the application as filed. Thus, except for such cases as where prior art that the applicant did not know is cited during the examination of a corresponding foreign application after filing the U.S. application, an examiner is unlikely to be able to obtain information more useful in advancing examination than that disclosed in the specification of the application as filed.

Also, a measure to uniformly require applicants to submit documents for explaining/clarifying the relationship will upset the balance of the burden to be borne by applicants between an ordinary examination and an accelerated examination, which applicants can enjoy in return for conducting prior art searches, presenting all prior art documents relating to the invention, and providing an explanation on the comparison and on the utility of the invention, etc. by themselves.

Furthermore, if a requirement to submit such information is imposed on applicants hastily, it would not only increase the burden on applicants unnecessarily, but also be unsuccessful in effectively reducing the examiners' burden to process the submitted information, and would run contrary to the purpose of the proposed change.

In the meantime, for cases where prior art that the applicant did not know is cited during the examination of a corresponding foreign application after filing the U.S. application, there are systems already in place to share information on the examination status between major patent offices, such as between the USPTO and the Japan Patent Office (JPO). Through these systems, USPTO examiners can obtain similar information without requiring applicants to submit documents for explaining/clarifying the relationship as mentioned above. Accordingly, JIPA believes that this problem can be resolved more effectively through procedural harmonization between patent offices by developing the same kind of information-sharing environment between the USPTO and other patent offices as well and promoting system solution to allow examiners to easily acquire similar information as documents for explaining/clarifying the relationship, rather than seeking the cooperation of applicants for individual applications.

With regard to prior art cited by the foreign patent offices which can already share information on the examination status with the USPTO through the above-mentioned system, JIPA hopes the USPTO will allow to skip the submission of such prior art by applicants in the future.

Due to the reasons above, JIPA opposes the measures to uniformly require applicants to submit documents for explaining/clarifying the relationship of prior art to the claimed invention. JIPA suggests that this measure be reconsidered.

(EOD)