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**From:** Hideo Doi [mailto:doi@jipa.or.jp]

**Sent:** Monday, May 01, 2006 1:13 AM

**To:** AB94Comments

**Subject:** Comments on Changes to Practice for the Examination of Claims in Patent Applications

Dear sirs,

Enclosed please find the opinion letter to you regarding "Changes to Practice for the Examination of Claims in Patent Applications", on behalf of Japan Intellectual Property Association.

If you have any question, please feel free to contact me.

Your consideration would be appreciated .

Best regards,

Hideo Doi  
Secretary General  
Japan Intellectual Property Association

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May 1, 2006

The Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

**Re: JIPA's Comment on the proposal of "Changes to Practice for the Examination of Claims in Patent Applications"**

Dear Director Dudas,

The Japan Intellectual Property Association (JIPA) is one of the world's largest intellectual property (IP) user groups with membership of 1098 Japanese companies (as of April 1, 2006). Because of the large number of U.S. patent applications they file, JIPA's member companies are considerably interested in the revision of rules on initial examination (Changes to Practice for the Examination of Claims in Patent Applications) recently proposed by the United States Patent and Trademark Office (USPTO), as the revision will have a significant impact on the member companies' patent practices and strategies.

The proposed revision of rules on initial examination requires applicants to provide various examination support documents including information on the pre-examination search they conducted, an explanation of the patentability of the representative claims and identification of the support of all limitations of the representative claims, when requesting an examination of more than ten representative claims.

However, from an applicant's viewpoint, the requirements appear to impose on the applicants an enormous burden that exceeds the level of burden sharing—in practice almost a penalty. Therefore, in case the proposed revision enters into force, applicants would in reality have to limit the number of representative claims, which are subject to examination, to within ten. As a result, even though all the claims could eventually be examined, it would obviously take much longer than at present for all the desired claims to be examined and patented.

Thus the proposed revision of the rules does not only diminish the rights of the applicant in that it shortens the patent term in practice, but it would also cause an unfavorable outcome for the USPTO in that it prolongs the examination period.

In addition, applicants seeking a shorter examination period would divide the claims into several applications when filing, instead of filing a single application, or in the prosecution process, the applicants would file voluntary divisional applications.

Consequently, the revision may lead to an increase in the number of applications, which would be contrary to the USPTO's objective of this revision.

Furthermore, the USPTO is proposing a revision of rules on continued examination practice as well as the initial examination rules. If the revision of rules on the continued examination practice (in particular the restriction of voluntary divisional applications and

restriction of multiple applications with overlapping disclosure) proposed by the USPTO is implemented simultaneously with the revision of rules on initial examination, it will become extremely difficult to have all of the claims desired by the applicant examined without delay.

Applicants (inventors) should be granted the right to protect their inventions from various aspects corresponding to the various modes of implementation disclosed in the application. In this respect, it is apparent the enforcement of the revision of rules on initial examination with the revision of rules on continued examination practice will further and unreasonably limit the deserved rights of the applicants and would undermine the function of the patent system.

As mentioned above, JIPA recognizes the following problems to be present in the proposed revision of rules on initial examination, and therefore cannot consent to the revision.

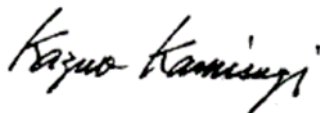
- (1) While proposing to share the burden with applicants, the contents of the documents required when requesting an examination of more than ten representative claims are enormous, and impose a far greater burden on the applicants.
- (2) As a result, the applicants would practically have to limit the number of the representative claims, which are subject to examination, to within ten. This could have the effect of even limiting the deserved rights of the applicants, for example making it take much longer for all the desired claims to be patented.
- (3) The revision is most likely to have an unfavorable influence on the USPTO's own operations as well, such as prolongation of the examination period and an increase in the number of filings, and it is questionable whether the revision is actually effective for the purpose of achieving the USPTO's goals including reducing pendency.

We strongly desire that the USPTO reconsider the proposed revision with examining:

- (1) the negative impacts of the proposed revision to applicants and the USPTO; and
- (2) the possibilities of alternative measures to improve the quality of examination and reduce pendency.

JIPA hopes that these comments will be taken into account in the USPTO's future discussions on revision of its rules.

Sincerely yours,



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Kazuo Kamisugi  
President  
Japan Intellectual Property Association