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

**Sent:** Monday, May 01, 2006 1:12 AM

**To:** AB93Comments

**Subject:** Comments on Changes to Practice for Continuing Applications, Requests for Continued Examination Practice and Applications Containing Patentable Indistinct Claims

Dear sirs,

Enclosed please find the opinion letter to you regarding "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice and Applications Containing Patentable Indistinct Claims", 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 Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentable Indistinct Claims"**

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 continued examination practice (Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentable Indistinct Claims) 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.

JIPA understands the USPTO's intention behind the proposed revision of rules on continued examination practice, which is to reduce the number of continuing applications and requests for continued examination, which unnecessarily prolong the examination period, and to use its examining resources for their originally intended mission — to improve the quality of examination and reduce pendency. However, the deserved rights of the applicants (inventors) should not be unreasonably limited or sacrificed in the name of attaining these goals. In particular, the proposed revision only allows divisional applications to claim inventions that were subject to a requirement of unity or a requirement for restriction, and requires that second or subsequent continued examination filings be supported by a showing as to why the amendment or argument presented could not have been previously submitted. Therefore, there is a risk that conventional voluntary divisional applications will become greatly restricted depending on the practice guidelines or the discretion of the examiners.

As you are well aware, so-called voluntary divisional applications are frequently utilized as a practice to effectively and appropriately protect inventions, for example, in order to quickly patent the parent application with narrower claims to protect their particular products from competitors at first and seek broader protection within the scope of the disclosed inventions at the same time. Such strategic patenting activities based on the business needs should be distinguished from continued examination filings that are made simply for the purpose of extending the examination period, and should be regarded as inventors' deserved rights.

We are concerned that, if inventors are deprived of the opportunity to file voluntary divisional applications, and thereby find strategic patenting difficult and become incapable of protecting their inventions appropriately, this would impede the stimulation of innovation, which is the original purpose of the patent system.

Moreover, if the USPTO were to restrict voluntary divisional applications, this would constitute a major divergence from the practices of other countries in terms of freedom of strategic patenting activities, so it would not be favorable from the viewpoint of promoting global harmonization of patent practices either.

Furthermore, the number of appeals will definitely increase under the proposed revision due to the restriction of continuing applications and requests for continued examination. Although the appeal procedures are reported to have become quicker in recent years, if sufficient capacity cannot be secured corresponding to the increase in the number of appeals, the pendency in examination will merely shift to appeals, so that the revision may not fundamentally resolve the problem the USPTO is attempting to address.

In addition to the revision of rules on continued examination practice, the USPTO is also proposing a revision of rules on initial examination that requires applicants to provide examination support documents including information on their pre-examination search and an explanation of the patentability of the representative claims, when requesting examination of more than ten representative claims.

If the proposed revision of rules on initial examination enters into force, applicants would in practice have to limit the number of representative claims, which are subject to examination, to within ten, since the proposed contents of the examination support documents would apparently impose a considerably large burden on the applicant. Therefore, in the case that the revision of rules on continued examination practice (particularly restriction of voluntary divisional applications) and the revision of rules on initial examination are simultaneously implemented, it will become extremely difficult to have all of the desired claims examined without delay. In this respect, it is apparent the enforcement of the revision of rules on continued examination practice with the revision of rules on initial examination 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 continued examination practice.

- (1) Since the guidelines on requirements for second and subsequent continuations are not clear, there is a risk that applicants' deserved rights would be unreasonably limited depending on the practice or the discretion of the examiners.
- (2) In particular, JIPA is strongly opposed to the restriction of voluntary divisional applications due to the risk of this considerably impeding rational and strategic patenting activities linked with the applicants' businesses and undermining the original function of the patent system.
- (3) The revision is most likely to have an unfavorable effect on the USPTO's operations as well, such as an increase in the number of appeals, and it is questionable whether

the revision is actually effective for the purpose of achieving the USPTO's goals including reducing pendency.

We 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,

A handwritten signature in cursive script that reads "Kazuo Kamisugi". The signature is written in black ink and is positioned to the left of a vertical line that extends from the top of the signature down to a horizontal line below the signature.

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Kazuo Kamisugi  
President  
Japan Intellectual Property Association