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From: Hideo Doi

Sent: Wednesday, September 06, 2006 8:30 PM

To: AB95 Comments

Subject: Comments on Changes To Information Disclosure Statement Requirements and Other Related Matters

Dear Sirs,

Enclosed please find the comments on Changes To Information Disclosure Statement Requirements and Other Related Matters on behalf of the Japan Intellectual Property Association.

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

Best regards,

Hideo Doi
Japan Intellectual Property Association

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September 7, 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 Comments on USPTO's Proposal of "Changes to Information Disclosure Statement Requirements and Other Related Matters"

Dear Director Dudas,

We, the Japan Intellectual Property Association (JIPA), are one of the world's largest Intellectual Property (IP) user groups with membership of 1,117 Japanese companies (as of September 6, 2006). Because of the large number of U.S. patent applications that our member companies file, we are very interested in the USPTO's proposal of "Changes to Information Disclosure Statement (IDS) Requirements and Other Related Matters", as the revision of the IDS rule will have a significant impact on our member companies' patent practices.

Our basic request is relaxation of the IDS requirements. Since even the requirements of the current IDS rule are heavy burden for many Japanese companies, we have, so far, requested that measures should be taken to relax the requirements, e.g. not requiring translations of IDS submissions and reducing the period during which applicants are subject to the IDS requirements.

As is well known, applicants of Japanese patent applications are required to specify prior art documents in the Japanese patent specifications. In order to meet this requirement and obtain more effective patents, many Japanese companies voluntarily conduct prior art searches before filing applications by using internal or external databases. When filing US patent applications, they select documents containing material information from among those prior art documents and submit them as IDSs. Because the failure to comply with the IDS requirements may result in severe penalty of "unenforceability of the right", many Japanese companies carefully select the documents to be submitted and decide which parts (or the whole part) of the documents should be translated from the viewpoint of safe side. Such careful analysis and translation of prior art documents thus necessitate a huge amount of human resources and costs.

Further, relaxation of the IDS requirements is also discussed in the trilateral patent office (USPTO, EPO, JPO) conference in connection with the development and

utilization of the Dossier Access System. We, JIPA, hope that reduction of applicants' burden relating to IDS can be realized as well as improvement of work efficiency in the patent offices through the development of the Dossier Access System.

Based on our basic stance and view on the current IDS system and present situation shown above, we cannot agree to the proposal because it demands applicants to submit new documents such as (1) Explanation, (2) Non-cumulative Description, and (3) Patentability Justification in the four time periods during prosecution and applicants' burden will be obviously increased by the additional documents.

The original purpose of the IDS system is to ensure that prior art that applicants know or could have know is disclosed and considered in the examination procedure, thereby achieving higher examination quality and more stable patent rights. However, the proposal requires applicants to not only disclose the prior art information but also submit additional documents, such as the Explanation and the Patentability Justification documents, which USPTO should be primarily responsible to prepare for examination. We have no objection to the idea that high quality examination can be achieved through cooperation between examiners and applicants, but we should say that the current proposal is extremely problematic from the viewpoint of role-sharing between applicants and USPTO, because it imposes an excessive burden on applicants in light of the original purpose and duty of the IDS requirements.

Furthermore, with respect to non-English-language documents, the proposal requests to submit explanation documents that show the "identification of relevant part" and the "correlations with the claimed invention" in addition to the translations of the prior art documents even in the first time period.

These requirements have significant impact on foreign applicants including Japanese applicants, who frequently cite non-English-language documents in IDS in that:

- (1) Applicants would incur more expenses necessary for detailed analysis and preparation of the documents.
- (2) The description in the explanations might be subject to file-wrapper estoppel and could be utilized to limit the scope of the patent right.

We are also unable to understand why these explanation documents are additionally required to non-English-language documents whereas they are not required with respect to English-language documents. There is no reasonable ground for imposing different requirements on English-language documents and non-English-language documents other than the translation. From the viewpoint of uniformity of requirements between non-English-language documents and English-language documents, we think that, in the first time period, the USPTO should require only translations with respect to non-English-language documents.

In recent years, the USPTO has been trying to revise rules aiming at "improvement of

examination quality” and “reduction of pendency”, e.g. the rule of IDS requirements, the rule of continuing application practice, the rule of initial examination, and the examination guidelines for accelerated examination.

If these rules were actually introduced, the burden on applicants would be significantly increased and only applicants who could afford the costs could utilize the US patent system effectively. We are very much concerned that whether or not applicants can use the US patent system effectively would depend on their financial resources.

As explained above, JIPA recognizes that the USPTO’s proposal of the change to the IDS requirements has problems in that:

(1) it would increase the burden on applicants and

(2) it would impose unequal requirements on English-language documents and non-English-language documents,

and therefore we strongly desire the USPTO’s reconsideration on the proposal.

We hope that our comments mentioned above will be taken into consideration in the USPTO’s future discussion on the changes to the IDS requirements.

Sincerely yours,



Kazuo Kamisugi
President
Japan Intellectual Property Association