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From: Yoshiharu Ohashi

Sent: Thursday, September 07, 2006 9:34 PM

To: AB95 Comments

Cc: ???

Subject: JPAA public comments (poposed rule IDS)

September 8, 2006

Honorable Commissioner of Patents and Trademarks

U.S. Patent and Trademark Office

United States Department of Commerce

P.O. Box 1450

Alexandria, VA 22313-1450

U.S.A.

Yoshikazu Tani

President, JPAA

September 8, 2006

Honorable Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
United States Department of Commerce
P.O. Box 1450
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Attention: Hiram H. Bernstein AB95.comments@uspto.gov

Re: JPAA Comments on Proposed Rule Changes to Information Disclosure Statement Requirements, Federal Register, Vol.71, No.131 (July 10, 2006) [Docket No. PTO-P-2005-0024]

Dear Commissioner:

The Japan Patent Attorneys Association (JPAA) appreciates the opportunity to present its views on the Proposed Rule Changes to Information Disclosure Statement Requirements, published in the Federal Register on July 10, 2006.

(1) Additional burden related to non-English documents

The Proposed Rules impose additional disclosure requirements for all non-English documents, whereas, for English documents, the Rules do so only when they are of large quantity. Since many of the documents Japanese applicants submit in an IDS are non-English documents such as Japanese documents, the additional disclosure requirements for all of these non-English documents definitely imposes a considerably increased burden (particularly the cost) of the IDS on Japanese applicants as compared to US domestic applicants.

We consider that in the case where a full machine or manual English translation of non-English documents (for Japanese applicants, laid-open patent applications in most cases) is readily available from the JPO website or the like, such an English translation should be identifiable as an "English document."

The JPAA, therefore, strongly requests the USPTO to include provisions in the

Rule to the effect of allowing the submission of a non-English document being taken as that of an English document in certain cases; in other words, not to impose the additional requirements on a non-English document as long as the volume of the filed document does not exceed the threshold (i.e., over 20 documents or over 25 pages per document), and so long as a full machine or manual English translation of such a non-English document is submitted.

(2) Clarification of materiality criteria

Presently, many Japanese applicants adapt an approach which may be called an "if in doubt, just submit in an IDS" practice in fear of possible penalties of unenforceability of their resulting patents. This approach results in many documents being submitted without intent to deceive.

The JPAA suggests that some materiality criteria for 'material information' such as those included in the Proposed Patent Reform Act currently under discussion in the Senate and the House of Representatives should be clarified in the Rules. In particular, it would be helpful if it is enumerated that "documents not requiring submission" include documents marked "A" in the PCT International Search Report (ISR) if the applicant or agent agrees with the opinion of PCT International Searching Authority (ISA). Furthermore, it would be helpful to have some criteria regarding to what extent any Office Action in a corresponding foreign application needs to be submitted.

(3) Dischargeability for agents

We, Japanese patent attorneys (Benrishi) representing Japanese applicants, may not feel that the submission of an IDS is warranted in some cases. However, we could not help advising our clients to submit an IDS in view of unforeseeability with respect to the fulfillment of the IDS requirements and possible heavy penalties of unenforceability of a resulting patent, based on a balance between the materiality of information and intent to deceive.

The JPAA proposes that some provisions be included in the Rule to the effect that no intent to deceive is presumed if an agent submits a declaration stating "the IDS is submitted after having put forth best efforts by the agent." Such presumption would be helpful to encourage agents not to submit essentially unnecessary documents.

(4) Omission of submission of a copy of a document

Presently, while submission of copies of issued US patents and published applications can be omitted when predefined requirements are satisfied, no omission of foreign publications is permitted.

The JPAA requests that the submission of copies be waived for documents that are readily available from foreign patent office websites or the like which have been determined as reliable by the USPTO. If such website provides some English

translation, machine or manual, of a non-English document, the submission of such translation should also be waived. For example, we suggest to state in the Rules that submission of copies of documents readily available from the JPO website may be omitted.

(5) IDS Submission after payment of issue fees

Presently, even after the payment of issue fees, obligation to submit an IDS continues until the issuance of a patent, while the period from the payment of issue fees to the issuance of a patent is not predictable. While a patent should ideally be issued promptly after the issue fees are paid, the period during which obligation to submit an IDS continues may vary due to delays in patent issuance processing at the USPTO. This uncertain situation creates further burdens on the part of the applicant and agent.

The JPAA urges the USPTO to abolish imposing the obligation to submit the IDS after issue fees are paid, since the payment of issue fees should trigger the immediate issuance of a patent and any issuance delay is only technical.

(6) Submission of IDS after Notice of Allowance

Presently, even after a Notice of Allowance is issued, obligation to submit an IDS continues until the patent issues, and during this period, a search report or an office action is often issued in a corresponding foreign application. Furthermore, while an reviewing period of three months from the day of receiving a search report or an office action is given if it is before the Notice of Allowance, after the Notice of Allowance, no extension is available on the period for issue fee payment, resulting in a significant burden on the applicant or agent. Moreover, in many of such cases, we are required to file a request for continued examination (RCE) only for submitting foreign cited documents and having them considered by the examiner.

The JPAA requests the USPTO not to impose the obligation to submit an IDS after the Notice of Allowance, or at the least, the USPTO to presume the lack of intent to deceive after the Notice of Allowance. This leads to a reduction of the burden on part of the applicant or agent. We consider that substantive examination is completed by the examiner with the issuance of the Notice of Allowance, and document submission is no longer beneficial for the substantive examination. Removing the requirement after the Notice of Allowance or presuming the lack of intent to deceive would not undermine the purpose and rationale of the IDS system. Furthermore, we suggest the approval of free petition for extension of the issue fee payment due date to assure a reviewing period for determining whether or not IDS submission is necessary.

In conclusion, the JPAA would highly appreciate the USPTO's efforts of Proposed Rule changes seeking for more efficient examination with well-secured examination quality, and we hope that a future IDS system is more functional for both the Examiners and the applicants.

Very truly yours,

Yoshikazu Tani
President, JPAA