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VIA E-MAIL

Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Re: Public Hearings on the Study of Prior User Rights
Written Comments

Dear Sirs,

(1) My comments and proposals are based on the prior user rights system in Japan as a Japanese professional practitioner, particularly relating to the interpretation and expected practice thereof.

(2) The prior user rights system is a new system in the USA and it is desired to achieve a harmonized protection thereunder in the USA with the existing prior user rights system in the other countries.

(3) Particularly, the scope of protection under the prior user rights will be an issue of importance, which includes the following items.

(3.1) Not only the actual production and sales activities, but the preparation therefor prior to the filing date (or priority date, if claimed) should be covered under the prior user rights.

(3.2) With respect to the scope of the activity concerned, not only the actual embodiment of a product or method concretely worked, but a concept of an invention which can be grasped as an "invention" derived (or extracted) from the actual working embodiment should be protected under the prior user rights.

In other words, a modification such as a design change which falls in the same inventive concept should be protected under the prior user rights.

(3.3) It is required to provide certain guideline or rule concerning the manner of comparison between the claim concerned and the object or activity concerned (product, method or process) for which the prior user rights is claimed.

In this regard it is suggested to determine the extent of generalization of the object of the prior user rights considering the concretely disclosed embodiment(s) with the claim, not only solely relying on the literal limitations of the claim. For instance, if a broad claim is granted based on a very narrow

embodiment, certain corresponding generalization of the object of the prior user rights should be acknowledged. Otherwise, inbalance in the equity between both the parties would result.

(3.4) Also, this issue may be understood as an issue of insufficient disclosure (disclosure requirements) of the claim concerned in the interpretation of the prior user rights.

In such a case where there is insufficient disclosure in support of a granted claim, there is a question of invalidity, however, there is also a question of a possible flexible interpretation of the claim even if it be supposed valid.

(a) a claim should be interpreted restrictively to certain extent in light of the disclosed embodiment, in a case where the object of prior user rights is interpreted narrowly (or restrictively);

(b) alternatively, the object of the prior user rights should be determined conceptually generic as an invention, without being limited to the exactly worked embodiment itself, if the claim be interpreted broadly extending beyond the actually disclosed embodiment.

That is, under the first-to-file system, it would be necessary to introduce a new doctrine of construction of the claim which might be different from those under the first-to-invent system. The disclosure requirement should play a much greater role in the construction of the claim in association with the interpretation of the prior user rights.

(3.5) The prior user rights should be acknowledged based on the activities outside U.S.A. in certain special case where the protection under the patent is extended to the import of a product manufactured outside U.S.A. by a method covered by a granted method claim. In this case, fair balance will be established provided that the activities outside U.S.A. are qualified as activities that support the prior user rights likewise activities in the U.S. A.

Thank you for your attention.

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