From: E. Nishibori JPAA
Sent: Thursday, October 04, 2012 2:05 AM
To: fitf_guidance
Cc: 山川 茂樹 先生; 鈴木 孝章 先生; 花田 茜
Subject: JPAA Comments on Proposed Examination Guidelines

Dear Hon. David Kappos,

Please find the attached document.

Sincerely yours,
Emi NISHIBORI

□■*:;;;:*□■*:;;;:*□■*:;;;:*□■*:;;;:*□■□■*:;;;:*□■
Emi Nishibori
Association Business and International Affairs Section Japan Patent Attorneys Association 3-4-2 Kasumigaseki, Chiyoda-ku Tokyo, 100-0013 JAPAN TEL +81-3-3519-2703 FAX +81-3-3581-1205 Email e.nishibori-jpaa@nifty.com HP http://www.jpaa.or.jp/ □■*:;;;:*□■*:;;;:*□■*:;;;:*□■*:;;;:*□■□■*:;;;:*□■

JAPAN PATENT ATTORNEYS ASSOCIATION
3-4-2, Kasumigaseki Chiyoda-ku, Tokyo 100-0013, JAPAN
Telephone: + 81-3-3581-1211 / Facsimile: +81-3-3581-9188
http://www.jpaa.or.jp

October 4, 2012

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

Re: JPAA Comments on the "Examination Guidelines for Implementing the First-Inventor-File Provision of the Leahy-Smith America Invents Act"

Dear Under Secretary Kappos:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 9,600 patent attorneys practicing in intellectual property laws in Japan. Its members practice in all areas of intellectual property laws including copyright and unfair competition. Many are capable of representing clients before infringement courts. The JPAA would like to submit comments on the "Examination Guidelines for Implementing the First- Inventor-File Provision of the Leahy-Smith America Invents Act".

The following is the Comments of the proposed Examination Guideline.

●35 U.S.C.102(a)(1) sets forth prior document and activities. Such documents and activities include prior arts categorized into the following five groups that are prior patenting of the claimed invention, descriptions of the claimed invention in a printed publication, public use of the claimed invention, placing the claimed invention on sale, and otherwise making the claimed invention available to the public. The proposed

Examination Guideline provides the definition of the five groups.

The JPAA understands that there is no geographic limitation on the location where a prior public use or public availability may occur. However, The JPAA wishes that the proposed Examination Guideline should be more specific for whether the term “on sale” includes “motion for the sale” or not.

In addition, no geographic limitation in 35 U.S.C. 102(a)(1) will mean that time differences between countries may have more meanings for evaluating prior art references especially if they are based on facts relating to "In public use," "On sale" and "Otherwise available prior art." In this regards, the Japan Patent Office shows a clear position that the date and time should be converted into the Japanese Standard Time. Accordingly, the JPAA wishes that the Examination Guidelines restate the issues and consideration relating to the time differences in relation to applicability of prior arts under 35 U.S.C. 102(a)(1).

●35 U.S.C. §102(b)(1) provides exceptions to the prior art provisions of 35 U.S.C. 102(a)(1). In the proposed Examination Guideline, a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not prior art if the disclosure is made one year or less before the filing date of the claimed invention and was made by the inventor or joint inventor.

The JPAA understands that an Examiner would not apply prior art that falls under 35 U.S.C. 102(a)(1) if the specification contains a specific reference to a grace period inventor disclosure, or an declaration (or affidavit), that establish a disclosure is not a prior art, is provided by the inventor.

The JPAA understands that the exception in 35 U.S.C.102(b)(1)(B) requires that the subject matter in the prior disclosure being relied on under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor. The JPAA consider that the exception shown above is reasonable from the view point of the deference between “Grace period system” in US patent law and “Grace period system” in Japanese patent law.

However, The JPAA is afraid that it is difficult to identify the disclosure of the subject matter in the prior disclosure is same “subject matter” as the subject matter

publicly disclosed by the inventor. Therefore, the JPAA wishes that the USPTO should provide the example about how to determine whether “subject matter” is same or not.

Especially, the JPAA has concerns about the statement as in the section of "Grace period non-inventor disclosure" regarding 35 U.S.C. 102(b)(1) which reads as follows: "Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply." The JPAA wishes that the USPTO provides sufficient guidance and examples to determine what are "mere insubstantial changes, or only trivial or obvious variations" in consideration of good balance of benefits between an inventor and a third party.

Also, the JPAA understands that a patent and a patent application publication by any Patent Offices in the world will be regarded as the "disclosure by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor" under 35 U.S.C.§102(b)(1). Please be informed that the corresponding provision in the Japanese patent law is different, and an applicant cannot enjoy the benefit of the grace period based on a patent and a patent application publication by any Patent Offices in the world. Accordingly, the JPAA wishes that the Examination Guidelines restate the handling of a patent and a patent application publication by a Patent Office from the viewpoint of applicability of the new grace period provisions.

●35 USC §102(a)(2) sets forth three types of patent documents that is available for prior art.

The JPAA understands that an Examiner would consider that a patent application is prior art under 35 U.S.C.102 (a)(2) if it was “effectively filed” before the effective date of the claimed invention.

Also, the JPAA understands that the phrase "WIPO published application" means that any WIPO published application filed in a language other than English may be relied upon as a prior art irrespective of an entry into the U.S. national phase

and submission of an English translation of the WIPO published application. On the other hand, Japanese patent law requires both an entry into the entry into the Japanese national phase and submission of a Japanese translation of the WIPO published application to be eligible as prior art. Accordingly, the JPAA wishes that the Examination Guidelines restate that the applicability of 35 U.S.C. 102(a)(2) does not require an entry into the entry into the U.S. national phase and the submission of the English translation.

●Under 35USC §102(b)(2), certain disclosure will not be considered prior art under 35 U.S.C. 102(a)(2).

The JPAA understands that an Examiner would not apply prior art that falls under 35 U.S.C. 102(a)(2) if the disclosure of the subject matter on which the rejection is based was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor, and if the disclosure of the subject matter on which the rejection and the claimed invention were owned by the same person. However, the JPAA wishes that Examiner apply the exception in 35 U.S.C 102(b)(2) in a flexible manner to give the inventor sufficient chance for getting a patent.

Sincerely yours,

Shoichi Okuyama

Shoichi Okuyama
President
Japan Patent Attorneys Association