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Ms. Mary C. Till
Senior Legal Advisor, Office of Patent Legal Administration,
Office of the Deputy Commissioner for Patent Examination Policy
United States Patent and Trademark Office
Alexandria, Virginia
U.S.A.

Re: JPO Comment on the Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act

Dear Ms. Mary C. Till,

Regarding "on sale" provision, public comment is sought on whether to require a sale to be sufficiently public to preclude the grant of a patent on the claimed invention.

The following is our comment on the issue.

Under the pre-AIA system, publicity was not required for "on sale" in precluding the grant of a patent on the claimed invention. Whether a sale is made public or not does not present a problem under the first-to-invent system because the major issue in granting a patent is the time the invention was completed. Therefore, the practice of not requiring publicity for a sale may be allowed, if it is under the first-to-invent system.

Many countries including Japan that do not adopt the first-to-invent system establish the condition that an invention which could have been known to the public before the filing will constitute prior art.
For example, in Japan, "inventions which were publicly known and publicly worked" are regarded as prior art. But inventions disclosed under an obligation of secrecy will not form part of the prior arts.

Because we understand that the AIA will change the patent system in the US from this first-to-invent system to the first-to-file system or the first inventor-to-file system, it would be preferable for the new system under the AIA to abolish current practice which is unique to the first-to-invent system. It should be explicitly described in the examination guideline that a sale should be sufficiently public to preclude the grant of a patent on the claimed invention. Moreover, we believe that this will lead to the international harmonization of patent laws and practices.

In relation to this "on sale" provision issue, we note an issue on "experimental use". Under the pre-AIA system, use or sale of inventions for experimental purposes could not preclude the grant of a patent on the claimed invention.

This experimental use doctrine that does not deem incomplete inventions as prior art is also a practice which is unique to the first-to-invent system in which the time the invention was completed is the main issue in granting a patent.

In many countries including Japan that do not adopt the first-to-invent system, an invention worked under circumstances where it could have been known to the public on the effective filing date, constitutes prior art even if use or sale of the invention is for experimental purposes.

Furthermore, 35 U.S.C. 102(a)(1) in the AIA provides a "catch-all" provision that does not grant a patent to a claimed invention if it was "otherwise available to the public" before its effective filing date. If the experimental use doctrine is maintained together with the presence of such "catch-all" provision, the experimental use doctrine would become an exception for the "catch-all" provision and make implementation of "catch-all" provision complicated.

As the AIA will change the patent system in the US from the first-to-invent system to the first-to-file system or the first inventor-to-file system, it would be preferable for the new system under the AIA to abolish the experimental use doctrine which is unique to the first-to-invent system. It should be explicitly described in the examination guideline that the experimental use doctrine be abolished under the AIA. Moreover, we also believe that this will contribute to the international harmonization of patent laws and practices.

Sincerely yours,

Susumu Iwasaki
Director
International Affairs Division
Japan Patent Office