

May 22, 2000

Mr. Robert W. Bahr
Box Comments-Patents
Assistant Commissioner for Patents
Washington, D.C. 20231
United States of America

Re. Changes To Implement Eighteen Month Publication of Patent Applications

Dear Mr. Bahr,

On behalf of Japan Intellectual Property Association, a non-profit IP organization in Japan with over 800 corporate membership, allow me to provide you with few comments on the subject matter, as described hereinafter.

1) §1.18 – Patent post-allowance (including issue) fees

§1.18 (d) provides that a Publication Fee is U.S. \$300. An application fee in Japan is ¥21,000 (approximately U.S. \$200), and an application fee in Europe is approximately 130EUR. Taking into account that in both Japan and Europe a publication fee would be contained in application fees, a Publication Fee \$300 in the United States is expensive.

In accordance with this section, the applicant who does not require to publish its application may save a Publication Fee more than the applicant who requires to publish its application, because a publication fee will be unnecessary if an applicant will not require to publish its application and it will not be published. Therefore, there is an advantage in non-publishing of its application for the applicant who will not apply to any foreign countries for the economical reason as well. On the other hand, as for most of the applicants from the foreign countries it is a premise that they applies to the United States based on the first filed application in its domestic, then a publication fee is required toward most of their applications to the United States.

Under the circumstances, it should be ruled that the publication is made a principle, and a publication fee should be included in the application fees, and it should make the publication fee lowered by raising office work efficiency.

2) §1.99 – Third party submission in published application

§1.99 (b) (4) provides that as for a non-English language publication, the English language translation of all the "necessary or particular parts" should be required in relation to the submission under §199.

In order to keep a balance with a non-English language publication, it should be ruled to make all the "necessary or particular parts" do marking as for a English language publication as well.

3) §1.215 – Patent application publication

Mr. Bahr
May 22, 2000
page 2

In accordance with §1.125(b), it is the freedom of the applicant to have Assignee information included on patent application publication; provided that it will submit a separate paper indicating the Assignee information.

Even if it is made a principle that Assignee information itself is included, a disadvantage for the applicant is hard to think about, and the advantage convenience for the third party will improve.

Therefore, it should be ruled to promote the submission of Assignee information as much as possible.

4) §1.127 – Publication of a redacted copy of an application

This article provides that, in the case that the description of the United States application and that of the foreign-filed applications are different, for the publication an applicant may submit a redacted copy corresponding to the contents of application which was applied first to foreign country and then the U.S. Patent Office publishes this copy.

It is not the employment of publishing a redacted copy, but it should be made it the principle to publish a whole part of application.

Next, it is afraid that the very complicated relationship is formed between the provisional protection right and the ordinary patent right. Further, 1) it isn't clear how to indicate the portion of the redacted contents in case of publishing a redacted copy, and 2) 35 U.S.C. 154 provides that the right of the provisional protection makes an "actual notice" a necessary condition but it isn't clear whether a redacted copy satisfies this condition.

Therefore, these should be clearly ruled.

It would be highly appreciated if you will consider the above comments.

Yours very truly,

Kunio Obara
President
Japan Intellectual Property Association