

From:
Sent: Tuesday, August 17, 2010 1:21 AM
To: 3-tracks comments
Cc: uemura@jbmia.or.jp
Subject: submission of comments for USPTO

Mr. Robert A. Clarke
Commissioner for Patents
United States Patent and Trademark Office

Dear Mr. Clarke,

This is Shoko Shiramizu for Japan Business Machine and
Information System Industries Association (JBMIA).

Please find attached document ("Comments on Enhanced Examination
Timing Control Initiative by USPTO").
The document is locked with password.
The password will be sent to you later.
We hope the document would be well received.

Thank you again.

Sincerely yours,

Shoko Shiramizu (Ms)
Japan Business Machine and Information System
Industries Association (JBMIA)
3-24-33, Nishi-Shimbashi, Minato-ku,
Tokyo 105-0003 Japan

cc: Mr. T. Uemura, JBMIA



**Japan Business Machine and Information
System Industries Association**

NP Onarimon Bldg.
3-25-33 Nishi-Shimbashi, Minato-ku
Tokyo 105-0003 JAPAN

Phone: +81 3 5472 1101 Fax: +81 3 5472 2511

August 16, 2010

Comments on Enhanced Examination Timing Control Initiative by USPTO

This letter is for Japan Business Machine and Information System Industries Association (JBMIA) to submit its comments in response to solicitation of public comments by USPTO as announced in Federal Register /Vol. 75, No. 107 /June 4, 2010. The comments are attached hereto.

JBMIA is a Japanese incorporated association which was renamed in 2002 from Japan Business Machine Makers Association established originally in 1960. JBMIA consists of thirty-five (35) member companies engaged in business machine and information system and twenty-four (24) supporting companies. Almost all of the member companies have actively filed patent applications in the USA.

A handwritten signature in black ink, appearing to read 'for Masaru Iwano', written over the printed name of Kiyonori Mitsunushi.

KIYONORI MITSUNUSHI, Committee Chairman
Intellectual Property Committee

Japan Business Machine and Information System Industries Association
NP Onarimon Building, 3-25-33 Nishi-shimbashi, Minato-ku, Tokyo 105-0003

TEL +81-3-5472-1101

FAX +81-3-5472-2511

Contact Person: Takashi Uemura,
Director, JBMIA Secretariat
Mail Address: uemura@jbmia.or.jp

Attachment:

1. Tree-track Initiative

First of all, we agree with introduction of a system under which applicants can choose the timing of examination. With respect to the following aspects, however, we believe they have some flaws that will significantly undermine the system. We, therefore, hope that the system will be introduced after the flaws are cured.

Secondly, we are against the aspect of the proposal to limit the benefits of Tracks I and III only to applications filed in the USPTO that are not based on a prior foreign-filed application for two reasons.

In the first place, the desire to control timing of establishment of an invention as property right is equally shared by applicants whose US applications are based on prior foreign-filed applications. Nearly half of US patent applications are filed by foreigners, and most of them are based on prior foreign-filed applications. Given that, allowing US applications based on prior foreign-filed applications to enjoy Tracks I and III should contribute more to the reduction of overall pendency of patent applications compared than allowing the benefits only to US applications not based on prior foreign-filed applications.

We believe, therefore, that allowing US applications based on prior foreign-filed applications for Tracks I and III will be a very effective way for USPTO to achieve the aim of the initiative.

The second reason of our opposition is based on the fact that it is a normal practice for most applicants, even mandatory in some countries, to file the first/original patent application for an invention in the country where it is actually made. Given those facts, precluding applications based on prior foreign-filed applications from Tracks I and III will virtually result in unequal treatment of applicants by their nationalities, depending on whether they are US citizens or not. Such possibly unequal treatment may violate the Paris Convention and Article 3 of TRIPs Agreement.

Third, we don't agree with the aspect that applications would be published shortly after a request for prioritization based on Track I is granted based on the following reasons.

It is expected that during the period until a patent application is published, the applicant might continue to develop its technology or business strategy. Track I with early publication system will thus make it less attractive to applicants.

Fourth, we propose the improvement that examination may also be initiated by the request of a third party. The reason is as follows: A third party whose business may be affected by whether or not the application on Track III will be registered must wait for a long time to know the result. It may cause an unreasonable damage

to such third party, which requires, we believe, a system compensating such damage.

Lastly, we hope the new system will be introduced after full consideration so that introduction of prioritized examination system will not cause delay in examination of other applications.

2. Initiation of Examination at USPTO after Reply to First Foreign Office Action

We are against introduction of this scheme for the following reasons.

First, we believe that introducing only to the US the scheme under which examination of an application starts after the applicant replies to a foreign office action with respect to the prior, equivalent application may defy the trends of international harmonization. It is also likely to violate the Paris Convention and Article 3 of TRIPs Agreement.

Secondly, requiring an applicant to submit examination documents of a prior foreign-filed application would impose an excessive burden on the applicant.

The third reason of opposition is that under the proposed scheme, examination in the US would be automatically delayed if the first office action (FA) against the prior foreign-filed application takes a long time to issue.

The fourth reason is that the scheme may rather increase the workload of USPTO because foreign applicants who find the burden and/or delayed examination described above may file the first/original application in the US without foreign priority (as completely original or priority applications and provisional applications in foreign languages).

Secondly, we would like to propose alternatives.

We have two alternative proposals based on different point of views.

The first proposal aims for USPTO to have more chance to use foreign examination information while preventing a surge in the number of US applications without foreign priority. We propose to achieve the aim not by requiring an applicant to submit examination documents of a prior foreign-filed application but by offering incentives such as reducing, for example, examination fees if the applicant submits relevant information on examination of the prior application.

The second proposal is based on the viewpoint of international harmonization. For instance, we propose to introduce a scheme under which US applications claiming foreign priority benefit based on the Paris Convention become subject to prioritized examination. This proposal is based on the same idea with the Japanese system called JP-FIRST. In this way, we propose that phased introduction of international work-sharing while securing consistency with the system of other countries.

Lastly, as we indicated in Part I, while we are against introduction of this initiative we strongly hope the following if this initiative is to be implemented:

(1) to establish a system under which it is exceptionally allowed that examination at USPTO may be initiated before reply to the first foreign office action;

(2) to exempt applicant from submission of documents and IDS if the first/original application is filed in a foreign office which provides data to Dossier Access System;

(3) not to activate a system under which PTA is reduced when examination in the first-filed country is delayed because it would be unfair for the applicant to suffer from the negative effect of delayed examination in the first-filed country which is often caused by the foreign office, not by the applicant;

(4) it seems that under the proposed initiative, an application with respect to which documents relating to the first foreign office action is submitted would be placed at the end of line waiting for examination. If that is the case, the scheme should be improved as follows: an application with respect to which documents relating to the first foreign office action is not submitted would be placed in the waiting line for applications not based on a prior foreign-filed application. When it becomes the turn for such foreign-based application to be examined but documents relating to the first foreign office action have not been submitted, the application would be kept at the head of the waiting line.

END