

From: Yutaka NIIDOME
Sent: Tuesday, August 10, 2010 5:06 AM
To: 3-tracks comments
Cc: minami-koichi@jpo.go.jp; Rai, Arti
Subject: JPO Comments on the Enhanced Examination Timing Control Initiative

Dear Sirs,

Please find attached the JPO Comments on the Enhanced Examination Timing Control Initiative.
If you have any questions, please do not hesitate to contact me.

Best regards,

Yutaka Niidome
Japan Patent Office

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August 10, 2010

Hon. 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
PO Box 1450
Alexandria, VA 22313-1450

Re: JPO Comments on the Enhanced Examination Timing Control Initiative

Dear Under Secretary Kappos:

The following are the Japan Patent Office's comments related to the Enhanced Examination Timing Control Initiative:

1. General remarks

The JPO supports the general direction of the proposal to increase the user's alternatives and at the same time decreasing the backlog without decreasing the quality of examination by utilizing foreign examination results when available and focusing work power to applications without such results and urgent applications.

The JPO has been working with the USPTO to cooperate closely in the field of work sharing towards this direction. We sincerely hope that the present proposal will enhance and not block the utilization of existing schemes. We also hope that the proposal would not discriminate our users or put any of our users at a disadvantage.

2. Specific comments

(1) Concerning the disadvantage for second filings to the USPTO

We find it difficult to support the idea to postpone examination in the U.S. until the first office makes its first action, since we fear that there would be cases where some applicants wishing for early examination results in the U.S. would not be able to do so.

Furthermore, we believe that contrary to its original objective, there could be fewer cases in which the USPTO could utilize the examination results of other offices since applicants in need of an early patent grant in the USPTO would first file in the U.S.

We believe that the proposed requirement for the applicant to submit copies of the first actions and the applicants' response to the USPTO should not be implemented since this would in effect impose an additional burden on foreign applicants. If translations of these documents were also to be required, it would be a large burden on non-English speaking applicants, who would need to pay not only for the translations but also the attorney's fee. Furthermore, we believe it would not be necessary for the applicant to submit documents since they are already available to the USPTO examiner through the dossier access system.

Concerning PCT route applications, we would like to know if the new proposal requires the applicant to submit the first office action from the first office (e.g., the office in which priority filings have been made) and the applicant's response other than the PCT-ISR or written opinion. If this is the case, we fear that such a rule might take away the value of the PCT.

Furthermore, we also would like to know if this scheme would be applied to applications already filed in the USPTO. If this is the case, we fear that this might put foreign applicants at a disadvantage.

(2) Comments on the respective tracks

The JPO believes that track I is beneficial to work sharing efforts since this increases the timeliness of office actions. On the other hand, while the proposal considers the integration of accelerating programs such as the PPH, we hope that the fee for PPH requests, which has recently been eliminated does not become charged again.

The deferred examination (track III) scheme seems similar to the Japanese examination request system. From our experience, the final examination request rate is 63.2% (provisional figure, 2009), and we believe that the JPO has been able to save the examination work power for the applications that have not been requested, which amount to more than 30% of total applications. We believe track III will greatly help the USPTO to decrease its backlog.

We also support the proposal to publish the applications after 18 months

from the first filing date. We also believe that publication at 18 months should be introduced in all three tracks. This scheme is widely adopted in many patent systems in the world and we believe it is indispensable to ensure the legal stability of business activities and to avoid the duplication of research and development. Furthermore, by aligning the publication date at 18 months, we believe problems arising from different publication timings for different tracks could also be avoided.

We appreciate your consideration and look forward to further cooperation in the future.

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Tetsuhiro Hosono', followed by a horizontal line extending to the right.

Tetsuhiro Hosono
Commissioner
Japan Patent Office