August 4, 2005

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property, and
Director of the United States Patent and Trademark Office

Re: JIPA's Comments on Green Paper Concerning Restriction Practice, 70 Fed. Reg. 32761, (June 6, 2005)

Dear Director Dudas:

We, the Japan Intellectual Property Association (JIPA), are one of the world's largest associations of IP users, with a membership of 873 Japanese companies (as of July 15, 2005). JIPA members have filed a large number of U.S. patent applications, and therefore, are very interested in the USPTO's study on unity of invention and restriction practices.

As mentioned in our comments as of July 21, 2003, in response to the request published in May 2003 (68 Fed. Reg. 27536), our basic desire regarding unity of invention practice is global unification of standards. More specifically, in the circumstances where a unity of invention standard has frequently been discussed under the Patent Cooperation Treaty (PCT), we consider it reasonable and realistic to harmonize standards with the PCT rules. If unity of invention standards are unified among the USPTO, the EPO, and the JPO in line with the PCT standard, there will be a substantial benefit for the JIPA members who file a number of applications in these nations/region, since it will enable the JIPA members to file patent applications in the nations/region in a common specification format. We believe this approach will also be beneficial to the USPTO, as it will facilitate the use of examination and/or search results conducted by other patent offices.

From the standpoints shown above, among the four restriction reform options suggested by the USPTO, we consider Option 2 to be the most favorable, on the condition that the Section 112 requirement, which is not included in the PCT standard, should be excluded from the unity of invention standard.
Introduction of the Section 112 requirement into the unity of invention standard suggested in Option 2 involves the following problems, and thus we strongly desire that the Section 112 requirement be excluded from the unity of invention standard.

1) Requiring the compliance with local rules in addition to the PCT standard in each nation/region would hinder substantive global harmonization.
2) Compared with novelty and non-obviousness requirements, which are determined on the basis of clear criteria (e.g. prior art), the Section 112 requirement, which could cause a wide variation among examiners' determinations, would result in more uncertainty in unity of invention practice. (Introducing a requirement, which would reduce predictability in unity of invention practice, would result in further uncertainty in the subsequent examination process, placing excess burden on examiners and applicants. Therefore, in order to realize a fair, effective, and efficient

examination process, we consider it more appropriate for the Section 112 requirement to be evaluated during the substantive examination phase following the phase of examining unity of invention, while providing applicants with opportunities to argue and resolve the Section 112 requirement issue.)

3) Including the Section 112 requirement into a unity of invention standard would require further segmentation of an invention than current restriction practice, depending on operations of the standard. In that case, this approach would not only make the introduction of a PCT-style unity of invention standard meaningless but also invite more divisional applications, which are contrary to the purposes of the study, e.g. to improve cost effectiveness and reduce the number of divisional applications.

We sincerely hope that this comment be reflected in the USPTO's future study on unity of invention and restriction practices.

Sincerely yours,

Naoto Kuji
President
Japan Intellectual Property Association