

July 21, 2003

The Honorable James E. Rogan

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Attn: Mr. Robert Clarke

Re: Request for Comments on the Study of the Changes Needed
To Implement a Unity of Invention Standard in the United States,
68 Fed. Reg. 27536 (May 20, 2003)

Dear Director Rogan:

Japan Intellectual Property Association (JIPA) is one of the world's largest organizations of intellectual property users, which holds about 980 Japanese companies as its members. The member companies have been filing a large number of US patent applications, and therefore, are strongly concerned with what is discussed on Unity of Invention Standard within the United States Patent and Trademark Office (USPTO).

The primary desire of the JIPA with regard to Unity of Invention Standard is that the standard be unified worldwide. Especially, if the standard is unified among US, Europe and Japan, there will be a substantial benefit for the JIPA member companies, who have been filing a large number of applications

in the above nations/region, since it may be possible that they file patent applications in the nations/region in a common specification format. At the same time, it is also believed to be beneficial for the USPTO since that will make it easier for the USPTO to utilize examination and/or search results from the other patent offices. Therefore, the JIPA believes that it is preferable for the USPTO to adopt a harmonized rule of the standard among the nations/region based on discussion concerning its harmonization among the USPTO, European Patent Office (EPO) and Japanese Patent Office (JPO) or such discussion at PCT conventions.

However, the JIPA does not believe that the concept of "only one independent claim per category of invention" (EPC rule 29(2)) should be used in determining the Unity of Invention. Any applicant should be able to provide a reasonable number of independent claims per category of invention, under the determination that "Unity of Invention" exists. Therefore, in order for an inventor to claim his/her invention more adequately, the JIPA thinks that the USPTO should not include the above-mentioned EPO practice.

The JIPA hopes that each of the concerned nations/region would harmonize not only rules of the Unity of Invention Standard but also the examination practice by the patent offices in order to realize the actual harmonization from the view point of being "user-friendly". More specifically, the JIPA believes that

it is necessary to unify examination manuals of the USPTO, the EPO and the JPO that hold common examples where Unity is found and where Unity is not found, and also to further encourage the communication among examiners in these patent offices in order to realize the harmonization of the practice by the examiners.

As the USPTO stated in the Request for Comments, the Unity of Invention Standard and the restriction practice of the USPTO are two separate measures. From the standpoint of the JIPA, if the USPTO adopts the Unity of Invention Standard, it is desired that a discussion be made in view of eliminating the current restriction practice that is rather practiced for the alleviation of examination burdens (e.g. the restriction placed when a "manufacture" and a "manufacturing method" are claimed in an application) as long as there exists "Unity of Invention".

The JIPA sincerely hopes that this comment be reflected in the future discussion of the USPTO on Unity of Invention Standard.

Sincerely yours,

Yasuo Sakuta

Managing Director of JIPA