

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable 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
Alexandria, Virginia

Re: JIPA Comments on the "Inventor's Oath or Declaration Provisions" of the Leahy-Smith
America Invents Act

Dear Under Secretary Kappos:

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 900 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned that the "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.4, on January 6, 2012. We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

JIPA again thanks the USPTO for this opportunity to provide these comments and welcomes any questions on them.

Sincerely, yours,

Kenji Koumoto
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JIPA Comments on the “Inventor’s Oath or Declaration Provisions”

JIPA has closely and carefully examined the proposed amendment to 37CFR, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of January 6, 2012, under the title of "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. Section 1.47 in the Proposed Amendment provides that if an inventor refuses to execute the oath or declaration, or cannot after diligent effort be found or reached to execute the oath or declaration, then the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign the invention, or a party who otherwise shows sufficient proprietary interest may execute the oath or declaration. JIPA considers this rule to be helpful for enterprises and other patent users who file patent applications with regard to inventions that have been assigned thereto from inventors.

However, JIPA would request that the USPTO expand the scope of applicability of this procedure whereby the assignee, etc. is allowed to execute the oath or declaration on behalf of the assigning inventor. For example, along with the globalization of enterprise activities, it is more likely to happen in the current economic environment that: (i) the inventors, etc. reside in more than one country, (ii) by the time when the second patent application is filed in the United States, the inventor has moved to a country that is different from where he/she made the invention, (iii) due to labor-market liquidity, by the time when the US application is filed, the inventor has moved to an enterprise that is different from where he/she made the invention. In these situations, the enterprises planning to file US patent applications with regard to their employees' inventions would find it a cumbersome process to ask the inventors to execute the oath or declaration. There could also be such a situation where it is difficult to reach the inventor due to his/her suffering a disease, in which case the patent applicant would have to follow the same cumbersome process.

For these reasons, JIPA would request that the USPTO expand the scope of applicability of this procedure whereby the assignee, etc. is allowed to execute the oath or declaration on behalf of the assigning inventor.

2. 35USC.115(f) has been amended so as to allow a delay in submitting the inventor's oath or declaration until a notice of allowance is provided; however, no amendment has been proposed for the corresponding provisions of 37CFR, 1.53(f)(2), on the grounds that the USPTO needs to know who the inventors are to prepare for the publication of applications and conduct an examination. Accordingly, JIPA understands that the inventor's oath or declaration must be submitted within two months from the filing date of application, as

before. However, in view of the facts that an application is to be published 18 months after the date of filing and that the "average first action pendency" at the end of 2011 was not less than 20 months, JIPA cannot find any reasonable grounds for setting the time limit for submission of the oath or declaration as two months from the filing date. In addition, from the viewpoint of enterprises, etc. which have acquired inventions assigned from the inventors, such time constraints as requiring the inventor's oath or declaration to be submitted within two months from the filing date would be a burden, for the inventor is not always easy to reach. Therefore, JIPA would request that the USPTO take into account such circumstances on the part of the patent users and consider extending the time limit for submitting the inventor's oath or declaration within a scope that would not significantly affect the preparation for application publications or the progress in the examination process, for example, to the earlier of 18 months from the priority date, or the date of the first action.

3. The patent laws of Europe, Japan, China and South Korea do not require the submission of the inventor's oath or declaration. From the perspective of procedural harmonization, JIPA would also request that the USPTO consider dispensing with such oath or declaration.

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