

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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March 5, 2012

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 "Preissuance Submissions by Third Parties Provision" 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 "Preissuance Submissions by Third Parties Provision", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.3, on January 5, 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  
President  
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## **JIPA Comments on the “Preissuance Submissions by Third Parties Provision”**

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 5, 2012, under the title of "Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. JIPA favorably evaluates the rule newly introduced under 35USC.122(e), referred to as Preissuance Submissions by Third Parties, as a tool for preventing the establishment of patents that have grounds for invalidation, through a reasonable procedure. JIPA is interested in how this procedure will be operated.

2. Having examined the Proposed Amendment, JIPA considers it regrettable that the new procedure still has a time limit for submission, but as compared to the existing procedure under 37CFR1.99 (Third-party submission in published application), JIPA finds the new procedure to be more convenient in that:

- the period during which submission of information is permitted has been extended; and
- a concise description, which shows the relevance with the patent, can also be submitted.

37CFR 1.290(f) of the Proposed Amendment basically requires the payment of a fee for submitting information. This requirement is expected to motivate third parties to submit only closely examined and selected information, which will be helpful to the USPTO examiners in understanding technical matters and will finally be conducive to further improving the quality of examination. To realize this, JIPA would request that the USPTO make it obligatory under MPEP for its examiners to take into consideration the submitted information.

3. 37CFR 1.290 (g) of the Proposed Amendment provides as follows:

(g) The fee otherwise required by paragraph (f) of this section is not required for a submission listing three or fewer total documents that is accompanied by a statement by the party making the submission that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only submission under 35 U.S.C. 122(e) submitted in the application by the party or a party in privity with the party.

JIPA appreciates this provision on exemption from the fee as it will be welcomed among reasonable patent users who are to submit closely examined information and will also encourage them to use this system properly.

4. At the same time, there are some concerns about the Preissuance Submissions by Third Parties rule, described in (a) to (c) below.

(a) 35USC.122(b)(2)(B)(i) provides that if an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published. According to the Proposed Amendment, JIPA understands that the Preissuance Submissions by Third Parties rule would not be substantially applicable to such application. JIPA would request that the USPTO consider amending the provisions of 35USC.122(b)(2)(B)(i) as well to ensure that all applications will be published without condition, so that the examiners will be provided with appropriate prior art information with regard to all applications and the quality of examination will be further improved.

(b) To JIPA's understanding, when a third party makes a Preissuance Submission, the third party does not need to indentify him/herself in such submission but is allowed to make a submission in the name of his/her attorney or law firm. However, if the name of the attorney or law firm that has made a Preissuance Submission is disclosed in the process of entering the submitted information into the file wrapper and making it available to the applicant, the attorney or law firm's client might not be able to remain anonymous because such information could imply the client's identification. Therefore, JIPA would appreciate it if the USPTO will give due consideration so that the person who submitted information would not be identified. For example, JIPA would request that the USPTO take the following measures:

- if the USPTO makes the list under 37CFR1.290 (d)(1) available to the applicant, it should refrain from creating a column to be used to state the name of the third party who submitted the information in the list format, or black out such column when making the list available to the applicant;
- the USPTO should refrain from making a statement under 37CFR 1.290(d)(5) or 37CFR 1.290(g) available to the applicant, or black out the column used to state the name of the third party when making the statement available to the applicant.

(c) According to the Federal Register mentioned above, the USPTO will make the submitted information available to the applicant via the electronic image file wrapper (IFW) but will not directly notify the applicant of the preissuance submission by a third party. From the standpoint of applicants who are planning or carrying out projects based on their filed patent applications, whether or not any third party has submitted information with regard to their applications is interesting and material information. For example, Japan and Europe have a system wherein the patent office notifies the applicant upon receiving information from a third party, and such notification is helpful for many applicants in estimating the possibility and desirable direction of obtaining rights as well as grasping the status of working of the inventions by others. It may be possible for the applicants to access Patent Application Information Retrieval (PAIR) and confirm if any information is submitted for each

of their applications, but JIPA considers it more user-friendly for the USPTO to directly notify the applicants of the fact that information has been submitted with regard to their applications, so JIPA would request that the USPTO consider introducing such notification system.

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