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From: IWAI, Seiji

Sent: Wednesday, March 27, 2013 4:22 AM

To: QualityApplications_Comments

Subject: Comments by AIPPI Japan in response to request for comments on Preparation of Patent Applications

Dear Sirs:

Please find attached the Japanese Group of AIPPI Comments on the proposed "Preparation of Patent Applications."and confirm safe receipt of them.

If you have any questions, please do not hesitate to contact me.

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A. Clarifying the Scope of the Claims

1. Presenting claims in a multi-part format by way of a standardized template that places each claim component in separate, clearly marked, and designated fields. For instance, a template may facilitate drafting and review of claims by separately delineating each claim component into separate fields for the preamble, transitional phrase, and each articular claim limitation.

As long as such a template does not cause narrower interpretation of claimed invention, it is acceptable for some cases. However, we submit that such a template should be available as an applicant's option. This is because, in view of existing case law on file wrapper estoppel in the U.S., it is hard for applicants to follow a template requested by the USPTO unless the Patent Law assures that the template should not be used as a way for narrowing interpretation of the claimed invention.

Moreover, if the USPTO is considering requesting applicants to draft a claim with the so-called "two-part form" template in which the characterizing part of the invention needs to be recited followed by the phrase "characterized in that," it is doubtful whether the template is effective in facilitating drafting and review of claims since applicants are not necessarily aware of all relevant prior art when drafting claims.

2. Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart or the standardized template described above. This practice could be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed.

This practice is not acceptable for us. Because, although we understand that this could be beneficial from the viewpoint of examination, it would take the applicant a lot of time, effort, and money to prepare this kind of chart. If there are unclear terms in relation to corresponding support, an Office Action should be issued to this effect on a case-by-case basis, as has been done traditionally.

Another possible way for identifying corresponding support will be the addition of numbered references in a claim as often required by an examiner of the European Patent Office. Again, however, it is hard for applicants to follow such a practice unless the Patent Law assures that the numbered references should not be used as a way for narrowing interpretation of the claimed invention.

3. Indicating whether examples in the specification are intended to be limiting or merely illustrative.

This practice may seem effective for the purpose of smoother examination. However it also means that a third party is required to review every detail of file history to find applicant's indication whether examples in the specification are intended to be limiting or merely illustrative in order to properly construe the claimed invention. It is burdensome for the third party. Further, in principle, all limiting features of a claimed invention should appear in patented claims. In comparison with the above drawback, the introduction of this practice would bring little positive effect in terms of facilitation of examination and improvement of the quality of issued patents. Accordingly we disagree to introduction of this proposed practice.

4. Identifying whether the claim preamble is intended to be a limitation on claim scope.

This practice may have both advantages and disadvantages. We think, however, it may contribute to the improvement of predictability of claim scope and public notice function of patents.

If the USPTO implements this practice, we wish that the Patent Law will provide certain guidance on claim construction of such a preamble in order to avoid unnecessary controversy at the time of litigation.

5. Expressly identifying clauses within particular claim limitations for which the inventor intends to invoke 35 U.S.C. 112(f) and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations.

This practice may have both advantages and disadvantages. We think, however, it may contribute to the improvement of predictability of claim scope and public notice function of patents.

We venture to say, for the purpose of harmonization of patent practices, it would be desirable to remove 35 U.S.C. 112(f) because applicants (including Japanese applicants) outside the U.S. are sometimes forced to adapt their original claims due to the difference in the claim scope of a means-plus-function claim.

6. Using textual and graphical notation systems known in the art to disclose algorithms in support of computer-implemented claim limitations, such as C-like pseudo-code or XML-like schemas for textual notation and Unified Modeling Language (UML) for graphical notation.

There is doubt about whether the use of e.g. C programming language for disclosure of algorithms will help the examiner or a third party better understand a claimed invention or will help clarify a claim scope. We think the disadvantage will be greater in the sense that the volume of application documents may increase due to the inclusion of unrelated code. We do not approve of this proposal because this does not seem to be better than the current practice of using a flow chart in the description.

B. Clarifying the Meaning of Claim Terms in the Specification

1. Indicating whether terms of degree—such as substantially, approximately, about, essentially—have a lay or technical meaning and explaining the scope of such terms.

Any of the above-mentioned terms, "substantially," "approximately," "about," "essentially," etc. is sometimes not used adequately nor has an adequate meaning when trying to express a degree of something in a quantitative manner. Moreover, whether a degree of something should be expressed or not is dependent on the technical field or product concerned. For this reason, we are not in favor of requiring the explanation of the scope of such terms in all cases.

With the intention of clarifying the scope of claims, the applicant should describe an invention in more detail in the specification. If unclear terms are found at the stage of examination, an Office Action should be issued on a case-by-case basis, as has been done traditionally.

2. Including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims, particularly for inventions related to certain technologies, such as software.

We are not in favor of the inclusion of a glossary in the specification by reason of workload. At the time of preparing an application under the European patent system, there is a practice of adding the numbers of figures corresponding to the claim elements beside language of the claim elements. Such a practice is expected to facilitate examination and acceptable for us. However, like in the case of the European system [Rule43(7)EPC], it is important and indispensable for the USPTO to clearly state that any figure shown in the specification and referred to in the claims should be understood as a typical example if such a practice is introduced.

Designating, at the time of filing the application, a default dictionary or dictionaries (e.g., a technical dictionary and a non-technical dictionary) to be used in ascertaining the meaning of the claim terms.

We hope the USPTO will make clear to what extent a dictionary or dictionaries should be designated to ascertain the meaning of claim terms. We will approve of this if it is enough to designate dictionaries only in relation to a certain set of important terms the applicant can specify. Even in this case, however, it will be indispensable to clearly state that any definition given by the designated dictionaries should be understood as just an example. If it is necessary to cover a large number of terms, it is possible that the applicant may have to search various dictionaries for an adequate definition for each of these terms. Such an onerous task won't be acceptable for us.