

May 22, 2000

Ms. Karin L. Tyson
Box Comments-Patents
Assistant Commissioner for Patents
Washington, D.C. 20231
United States of America

Re. Changes To Implement Patent Term Adjustment Under Twenty-Year
Patent Term

Dear Ms. Tyson,

On behalf of Japan Intellectual Property Association, a non-profit IP organization in Japan with over 800 corporate membership, allow me to provide you with some comments on the subject matter, as described hereinafter.

1)§1.701 - Extension of patent term due to examination delay under the Uruguay Round Agreement Act (original applications, other than designs, filed on or after, June 8, 1995, and before May 29, 2000)

In "heading" of this article, it is clearly indicated that "filed on or after June 8, 1995 and before May 29, 2000".

Therefore, it should be ruled in §1.701 (e) that the provisions of this sentence apply to original patents, except for design patents, issued on applications filed on or after June 8, 1995 and before May 29, 2000.

2)§1.705 (a) – Notice of allowance

According to this section, the "notification of the patent term adjustment" is contained in the notice of allowance.

May we understand that this " patent term adjustment " is included in the patent official gazette, too?

3)§1.705 (d) - Revised patent term adjustment

It provides that if the patent is issued on a date other than the projected date of issue and this change necessitates a revision of the patent term adjustment, the patent will indicate a revised patent term adjustment.

May we understand in section §1.705(b) and so on that the patent will indicate a revised patent term adjustment before the patent will be issued, even if the patent term adjustment is revised based on the applicant's request?

Also, it is unclear how to publish to the third parties the revision of the patent term adjustment after the patent was issued.

4) - General

The big problem will raise for the third parties who use such invention without being aware of it, in case that the examination will be left unexamined for the long term for the examiner's failure.

Therefore, it should be ruled that 1) the applicant should request for promoting the examination promptly after the predetermined date of patent term adjustment

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such as fourteen months or four months, and the patent term adjustment will be shortened unless the applicant will request for it, or 2) the patent term adjustment will be limited within certain period.

It would be appreciated if you will consider the above comments.

Yours very truly,

Kunio Obara
President
Japan Intellectual Property Association