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**The Patent Office
Japanese Government**

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November 4, 1998

Mr. Robert L. Stoll
Administrator for Legislative and International
Patent and Trademark Office
U.S. Department of Commerce
Washington, D.C. 20231
U.S.A.

Dear Mr. Stoll:

This is to reply your letter dated October 30, 1998.

Regarding the possibility of conducting a comparative study on the patentability of ESTs, I understand the USPTO's situation that the public comment has been requested relating this issue and the comment period has not yet closed.

The JPO still believe that the patentability of ESTs (or patentability of DNA fragments) is a good subject for further comparative study and would like to propose and adopt as the subject of the next study in Project B3b at the coming Miami meeting. However, it will be proper to defer to actually start the activity in the study until the USPTO finalizes the Written Description guidelines.

In regards to the questions 10 and 11 in the Notice of Hearing, I appreciate your invitation but I would withhold comments as they both are relating to the interpretation under the U.S. law. However, these questions are interesting and could be the points of discussion in the comparative study. Besides, it would be appreciated if you could kindly let us know the results of the public hearing in at the Miami meeting.

As to the JPO practice on the patentability of ESTs, the JPO would handle it in

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line with "Implementing Guidelines for Inventions in Specific fields - Chapter 2 Biotechnology" (see attached). ESTs should fulfil all requirements for patentability (industrial applicability, novelty, inventive step and description requirement), as well as any other gene. However, we are still discussing this issue in detail. I believe it is meaningful to discuss and exchange information and opinions among the three offices on this issue through a comparative study.

I look forward to seeing you in Miami.

Yours sincerely,

守屋敏道

Toshimichi Moriya
Director
International Affairs Division

CC: Mr. Yung, EPO