

From: Toshiyuki Hori
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To: AC6/Comments
Cc: doi@jipa.or.jp; nomoto@jipa.or.jp; HIROHIKO_USUI@denso.co.jp
Subject: JIPA Comments on the Introduction of Deferred Examination System for U.S. Patent Applications
Importance: High

Dear Sirs,

Please find the attached JIPA's Comments "on the Introduction of Deferred Examination System for U.S. Patent Applications".

If you have any question, please feel free to contact me.

Best regards,

Hideo Doi
Japan Intellectual Property Association

Hideo Doi
Secretary General
Japan Intellectual Property Association (JIPA) Asahi Tokai BLDG. 18F 6-1, Otemachi 2-Chome,
Chiyoda-ku, Tokyo 100-0004 Japan Tel:+81-3-5205-3433, Fax:+81-3-5205-3391
E-Mail: doi@jipa.or.jp,
URL: <http://www.jipa.or.jp/english/>

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

Asahi Seimei Otemachi bldg.18F
6-1 Otemachi 2-chome
Chiyoda-ku Tokyo, 100-0004, JAPAN



Tel: 81 3 5205 3321
Fax: 81 3 5205 3391
URL: <http://www.jipa.or.jp/>

February 26, 2009

The Honorable John J. Doll
Acting Under Secretary of Commerce for Intellectual Property, and
Acting Director of the United States Patent and Trademark Office

Re: JIPA Comments on the Introduction of Deferred Examination System for U.S. Patent Applications

1. We, the Japan Intellectual Property Association (“JIPA”), are one of the world's largest IP user organizations, with a membership of 1,184 Japanese companies (as of January 1st, 2009). Our member companies have filed many U.S. patent applications. JIPA welcomes that the USPTO will introduce the deferred examination system for U.S. patent applications. In combination with this system, we are also strongly hoping that all patent applications will be published in 18 months from filing (hereinafter referred to as early publication) without any exception, so that the negative aspects of the examination request system will be reduced and the merits and demerits of the system are well balanced.

2. One of the remarkable differences of the patent laws between Japan and the U.S. is the examination request system (or the deferred examination) on the side of Japan. In Japan, a patent application is examined after its examination is requested. On the other hand, in the U.S. all of the patents applied are examined. One of the advantages of the Japanese examination request system is that no examination request is made on patent applications for which it is determined by applicants to be unnecessary to obtain patent rights. As a result, such applications are withdrawn automatically, which permits the JPO to examine patent applications only for which applicants think it necessary to obtain patent rights. In addition, an initial patent application cost does not include an examination request cost. Therefore, applicants do not need to spend unnecessary money and labor. In general, the values of an invention cannot be often understood at the time of filing, and instead will be recognized after the filing date. In this context, an examination request system can keep less valuable patent applications out of the examination. In Japan, the examination request system has been successfully operated with a high

efficiency.

To make the most of the cooperation framework between the patent offices in the world, PPH (Patent Prosecution Highway), for example, it will become more and more important that applicants will be able to strategically select a starting time of examination in each of the world patent offices, with the effective use of the deferred examination system.

3. If the U.S. adopts the deferred examination system, the above-mentioned advantage will be equally obtained. The USPTO will be able to examine patent applications only for which applicants want to acquire patent rights, which will result in reduction of delay in examination on the USPTO and reduced costs on the side of the applicants.

4. In addition to the examination request system, Japan has the early publication system without exception. This system has an effect of reducing the possible risk resulting from delay in issuance caused by deferred examination: duplicated researches and investment, and the permanent injunction against business activities by a competitor's so-called "submarine" patent granted after a long period of time from its filing date. Furthermore, countries having the deferred examination adopt the early publication system for all application almost unexceptionally with a view to redeeming the system's shortcomings caused by an extended time to issuance.

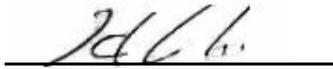
5. If the early publication system for all application is not adopted, the deferred examination system may delay the publication of the patent applications. As a result, the third parties will have a fear of not knowing patent right trends and suffering unreasonable loss. However, this fear can be reduced by the early publication of all patent applications. If patent applications are published at an early period, the third parties will be able, at least, to estimate a possible range influencing their businesses at the time when a patent is granted. When the examination request system is introduced, it is preferable that third parties are allowed to request examination in order to balance an interest of the third parties who want to have early conclusion of examination results. As a prerequisite, such early publication of patent applications will permit the third parties to know the competitors' applications. We hope that the U.S. will adopt a system of making all patent applications known to the public, when an examination request system is adopted.

6. Naturally, an early publication system for all patent applications will not resolve all problems concerning delay in granting a patent. Even at present, continuation applications, for example, will prolong time to grant a patent in many cases. It is therefore, any disadvantages to the third parties by the extended time to grant a patent, can not be caused solely by the adoption of the examination request system.

We believe that introduction of the examination request system will certainly bring more merits, as mentioned in Paragraphs 2 and 3 above, which will exceed any concerned demerits of the system. We believe that this system should be certainly adopted also in the U.S.

Thus, JIPA is hoping that the adoption of the deferred examination system will benefit both of the applicants and the USPTO.

Sincerely yours,



(Hirohiko Usui)

President

Japan Intellectual Property Association

Asahi Seimei Otemachi Bldg.18F

6-1 Otemachi 2-chome

Chiyoda-ku Tokyo, 100-0004,

JAPAN