

AIPPI • JAPAN



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International Association for the Protection of Intellectual Property of Japan

July 31, 2014

The Honorable Andrew Hirshfeld
Deputy Commissioner for Patent Examination Policy
The United States Patent and Trademark Office

Re: The Myriad guidance

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the "the Myriad guidance" or "Guidance for Determining Subject Matter Eligibility of Claims Reciting or Involving Laws of Nature, Natural Phenomena, & Natural Products," published on March 4, 2014. AIPPI Japan also applauds and appreciates recent USPTO's successful efforts toward the implementation of the America Invents Act and the reduction of examination back logs as well as the realization of international harmonization among different patent systems and examination work sharing.

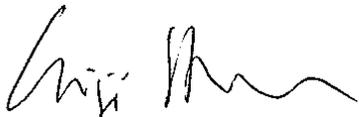
AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

Our comments are as follows.

First, please supply a copy of the Myriad Supreme Court decision of June 13, 2013 to each patent examiner and do nothing else. The 18-page Supreme Court opinion drafted by Justice Thomas is easy to read. It is also easy to understand as to what Justice Thomas wanted to convey. At the end and elsewhere, such as pages 17 and 18, in his opinion, Justice Thomas is most clearly trying to limit the applicability of his opinion to DNAs or genes. To quote from the last paragraph of the opinion, Justice Thomas stated: "We merely hold that genes and the information they encode are not patent eligible under §101 simply because they have been isolated from the surrounding genetic material." He uses "merely" between "we" and "hold". It is very clear that the Myriad Supreme Court decision is not applicable to naturally occurring products in general. Therefore, it is improper for the USPTO to expand the applicability of the Myriad Supreme Court decision to naturally occurring substances in general, and it is entirely unnecessary for the USPTO to issue a guidance that is more confusing than the Myriad Supreme Court decision.

Secondly, has the USPTO considered any balance or harmonization with practices used in jurisdictions outside of the United States? The Myriad guidance is clearly against what the U.S. government has been promoting outside the U.S. With continuous efforts and advocacy of the U.S. government, chemical substances including naturally occurring chemical substances have now become patent eligible in Japan, China, and many other countries. At the same time, the practice of such a county as India, where "non-living substance occurring in nature" is not patent eligible (Article 3(c) of the Indian Patent Act), is being questioned. The Myriad guidance is apparently inconsistent with what the U.S. government has been advocating, and it should be withdrawn. AIPPI was established as a result of the successful conclusion of the Paris Convention, and has championed global patent harmonization more than 100 years. AIPPI Japan considers it very unfortunate to see such a major force like the U. S. move away from patent harmonization.

very truly yours,



Eiji Katayama
President
The Japanese Group of AIPPI