

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

October 5, 2012

Re: Comments by AIPPI Japan in response to request for comments on
proposed rules and examination guidelines
on the first-inventor-to-file published on July 26, 2012 in Fed. Reg.

Dear Director Kappos:

AIPPI Japan is a Japanese national group of AIPPI, a truly global group of IP system users and attorneys. AIPPI Japan is the largest national group of AIPPI and has a membership of more than 1,100 including lawyers, patent attorneys, corporate managers, corporations and academics working in all areas of intellectual property, such as patents, trademarks, designs, copyrights, unfair competition. AIPPI Japan greatly appreciates to have this opportunity of providing USPTO with our comments in this very historical occasion of enactment of the “first-inventor-to-file” system in the U.S., because Japanese corporations are no doubt in the top users group of the U.S. patent system.

In general, AIPPI Japan supports the proposed rules and examination guidelines. However, we respectfully offer our comments and specific suggestions below, which we believe would improve the implementation of the Leahy-Smith America Invents Act.

Our comments cover “Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act” as published in the July 26, 2012 issue of the Federal Register, 77 Fed. Reg. 43742 (in PART 1) and “Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act” as published in the July 26, 2012 issue of the Federal Register, 77 Fed. Reg. 43759 (in PART 2).

PART 1: On Proposed Changes to 37 C.F.R.

1. As regards § 1.55 Claim for foreign priority, paragraph (4).

Paragraph (4) reads as follows:

(4) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.

According to the proposed rule shown above, the applicant must provide a statement to that effect within the later of:

- (1) four months from the actual filing date of the application,
- (2) four months from the date of entry into the national stage as set forth in § 1.491 in an international application,

- (3) sixteen months from the filing date of the prior foreign application, or
- (4) the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application.

It may not be, however, easy to determine whether a newly added claim has the effective filing date before March 16, 2013. Although the applicant believes the new claim is within the scope of the original foreign application, the Examiner may contend it is not. If such discrepancy occurs, are there any ways to reconcile such discrepancy, or the Examiner will be instructed to accept the applicant's statement as true. Also, assuming the applicant acted in good faith, what would be the consequence of failing to submit the statement or making an erroneous determination of the effective filing date? We ask the Office to include some statements in CFR that the applicant will not be put in disadvantageous position with respect to the application procedure or validity of a resulting patent by the statements in question.

Suppose the application does not contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, but discloses subject matter having not disclosed in the foreign application and the statement is filed timely. When the applicant adds a new claim which the applicant believes has the effective filing date before March 16, 2013, the Examiner may contend that the new claim has the effective filing date after March 16, 2013. Will the applicant have any chance of rebuttal?

Also, if, in the absence of the required statement, the Examiner is going to automatically apply the pre-AIA provisions, please insert a statement to that effect in the guidelines.

2. Our proposal of creating a new "Divisional Requirement" scheme

Further to our comments above concerning proposed 37 C.F.R. § 1.55(a)(4), we propose to create a new "Divisional Requirement" scheme, and we have two alternative proposals as we will discuss below.

The proposal includes the following comments regarding proposed 37 C.F.R. § 1.55(a)(4):

Section 1.55(a)(4) is proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in Sec. 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. Section 1.55(a)(4) is also proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in Sec. 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.

Proposed Sec. 1.55(a)(4) would not require that the applicant identify how many or which claims in the nonprovisional application have an effective filing date on or after March 16, 2013, or that the applicant identify the subject matter in the nonprovisional application not also disclosed in the foreign application. Proposed Sec. 1.55(a)(4) would require only that the applicant state that there is a claim in the nonprovisional application that has an effective filing date on or after March 16, 2013 (e.g., "upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16,

2013"), or the applicant state that there is subject matter in the nonprovisional application not also disclosed in the foreign application (e.g., "upon reasonable belief, this application contains subject matter not also disclosed in the foreign application).

If an applicant fails to timely provide such a statement and then later indicates that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the foreign application, the Office may issue a requirement for information under Sec. 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the foreign application for the remaining claims in the nonprovisional application. Likewise, if the applicant later seeks to retract a previous statement that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the foreign application, the Office may issue a requirement for information under Sec. 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the foreign application for each claim in the nonprovisional application.

This information is needed to assist the Office in determining whether the application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2013. If the Office must determine on its own the effective filing date of every claim ever presented in an application filed on or after March 16, 2013, that claims priority to or the benefit of a foreign application filed prior to March 16, 2013, examination costs will significantly increase. This proposed provision is tailored to the transition to 35 U.S.C. 102 and 103 under the AIA. Thus, for a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a foreign application, the applicant would not be required to provide any statement if: (1) The nonprovisional application discloses only subject

matter also disclosed in a foreign application filed prior to March 16, 2013; or
(2) the nonprovisional application claims only the benefit of the filing date of a
foreign application filed on or after March 16, 2013.

77 Fed. Reg. 43745

Similar discussions can be found elsewhere in the proposal. *See, e.g.*, 77 Fed. Reg. 43747, 43748, 43755, 43756, and 43757. Although the Office explains that statements from an applicant regarding the presence of claims having an effective filing date on or after March 16, 2013 or the presence of disclosure not present, e.g., in an earlier foreign application, as described in the fourth paragraph of the excerpt above, are needed to assist the Office in determining whether an application is subject to AIA §§ 102 and 103 or pre-AIA §§ 102 and 103, the statements are of limited value, particularly in view of the fact that the statements do not require identification of particular claims having an effective filing date on or after March 16, 2013, or identification of particular subject matter in an application not also disclosed, for example, in an earlier foreign application.

Before addressing this issue in detail, we direct attention to Section 3 (n) of the AIA, which states:

(n) EFFECTIVE DATE.—

(1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time

such a claim.

Pub. L. 112-29 §3(n) (Sept. 16, 2011).

It is apparent from the foregoing text that AIA 35 U.S.C. §§ 102 and 103 are to be applied to all claims of a patent application, if the patent application, e.g., contains at least one claim to a claimed invention that has an effective filing date on or after March 16, 2013 – regardless of whether or not the application also contains a claim to a claimed invention that has an effective filing date before March 16, 2013. We believe that wholesale application of AIA 35 U.S.C. §§ 102 and 103 to an application including claims having an effective filing date before March 16, 2013 is not reasonable. In particular, we believe that an applicant having an application including one or more claims having an effective filing date before March 16, 2013 should be permitted to obtain a patent directed only to such claims under pre-AIA §§ 102 and 103.

In order to address this concern, we propose a new scheme we call "Divisional Requirement" (described in more detail below), instead of requiring an applicant to submit statements as described in the proposed rules.

We believe that the Office can, without contradicting the spirit of the AIA, issue a Divisional Requirement to an applicant, providing the applicant with the opportunity to (i) cancel any claims to a claimed invention having an effective filing date before March 16, 2013 from the application, and, if desired, (ii) file a divisional application directed to the cancelled subject matter. If the applicant takes advantage of the opportunity to file a divisional application including only claims to claimed inventions having an effective filing date before March 16, 2013, pre-AIA 35 U.S.C. §§ 102 and 103 should be applied to the divisional application.

To the extent that the Office finds the issuance of a Divisional Requirement or application of pre-AIA 35 U.S.C. §§ 102 and 103 to a resulting divisional application inconsistent with its authority under the AIA, we believe that the Office should consider and propose modifications to the AIA to obtain such authority.

As indicated above, e.g., proposed 37 C.F.R. § 1.55(a)(4), requires an applicant to provide a statement: (i) if a non-provisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, and also (ii) if a non-provisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application.

As our second proposal, we recommend the PTO to eliminate the requirement of statement (i) and statement (ii) described in the previous paragraph and, instead, require that similar indications be provided in an application data sheet. Particularly, we propose that the application data sheet for applications filed on or after March 16, 2013 include the following field on the front page (page 1), in which an applicant is required to mark one of two boxes, box 1 or 2 and further one of three, box 3, 4 or 5 to simply indicate whether statement (i), statement (ii), or neither is applicable to the application:

Our proposed new fields in ADS are as follows:

Check any one of the following two boxes; box 1 or box 2:

1. This application DOES NOT claim the benefit of any of (a) a foreign application, (b) a provisional application or (c) a nonprovisional application, having the filing date prior to March 16, 2013.

<< AIA 35 U.S.C. §§ 102 and 103 apply >>

2. This application claims the benefit of (a) a foreign application, (b) a provisional application and/or (c) a nonprovisional application, having the filing date prior to March 16, 2013.

If box 2 is checked, then check any one of the following three boxes: box 3, box 4

or box 5:

- 3. *This application contains both of (i) a claim to a claimed invention that has an effective filing date on or after March 16, 2013, AND (ii) a claim to a claimed invention that has an effective filing date before March 16, 2013*

⇒ “Divisional Requirement” to be issued.

(NOTE: If our proposal of “Divisional Requirement” is not accepted in the Rule, AIA 35 U.S.C. §§ 102 and 103 apply to the application of this box.)

- 4. *This application contains (i) a claim to a claimed invention that has an effective filing date on or after March 16, 2013, BUT does not contain (ii) a claim to a claimed invention that has an effective filing date before March 16, 2013*

<< AIA 35 U.S.C. §§ 102 and 103 apply >>

- 5. *This application DOES NOT contain (i) a claim to a claimed invention that has an effective filing date on or after March 16, 2013, BUT contains (ii) a claim to a claimed invention that has an effective filing date before March 16, 2013.*

<< pre- AIA 35 U.S.C. §§ 102 and 103 apply >>

We further propose that if an applicant fails to timely submit a new application data sheet indicating any change of the status above, the Office may issue a requirement similar to those as described in the proposed rules for situations in which an applicant fails to timely provide a statement.

We strongly believe that this proposal is more advantageous than the requirements for statements proposed in the proposed rules from the following perspectives:

- (1) An application data sheet including the above-described fields allows stakeholders such as examiners, applicants and third parties to identify which law (pre-AIA or AIA) applies with ease and transparency; and

- (2) Elimination of such statements will reduce paper and paperwork, which is highly desirable in view of the Paper Reduction Act.

As our third proposal, we recommend the PTO to adopt a procedure for providing notice, e.g., in a field in the bibliographic portion of the front page of an issued patent, of whether the patent was issued under pre-AIA 35 U.S.C. §§ 102 and 103 or AIA 35 U.S.C. §§ 102 and 103.

We strongly believe that the notice mechanism of our third proposal would allow stakeholders (not only third parties, but also practitioners, examiners, and administrative law judges who may later deal with the patent) to easily identify which law (pre-AIA or AIA) is applied to the patent. It would be invaluable to the patent community to know with clarity which law applies to a particular patent to foster sound usage of the patent system, e.g., so that the validity of a patent can be properly considered by patent owners, licensees, and third parties.

PART 2: Our comments on the proposed Examination Guidelines

1. General concern on discrepancies between the AIA and proposed guidelines

We quote Section 3(n) of the AIA Section:

(n) EFFECTIVE DATE.—

(1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as

defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

Pub. L. 112-29 §3(n) (Sept. 16, 2011).

In the middle of the introductory section of the proposed guidelines before starting the Detailed Discussion of AIA 35 U.S.C. 102(a) and (b), however, we find that following statement:

The AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. These new provisions apply to any patent application that contains or contained at any time: (1) A claimed invention that has an effective filing date that is on or after March 16, 2013; or (2) a designation as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. The AIA 35 U.S.C. 102 and 103 also apply to any patent resulting from an application to which the AIA 35 U.S.C. 102 and 103 applied.

The AIA provides that the provisions of pre-AIA 35 U.S.C. 102(g) apply to each claim of an application for patent if the patent application: (1) Contains or contained at any time a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date before March 16, 2013. Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied.

Thus, if an application (1) contains or contained at any time any claimed invention having an effective filing date that is before March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon an earlier application ever containing a

claimed invention having an effective filing date that is before March 16, 2013, and (2) also contains or contained at any time any claimed invention having an effective filing date that is on or after March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon an earlier application ever containing a claimed invention having an effective filing date that is on or after March 16, 2013, then AIA 35 U.S.C. 102 and 103 apply to the application, but each claimed invention is also subject to pre-AIA 35 U.S.C. 102(g).

77 Fed. Reg. 43762 (emphasis added). We are concerned that differences between the above-excerpted portions of the proposed guidelines and the AIA (and the Rules) could result in misunderstandings regarding what is "contained" in an application for patent.

As defined in AIA 35 U.S.C. § 100(j), the term "claimed invention" means the subject matter defined by a claim in a patent or an application for a patent. Understanding the foregoing will be critical in determining which law (pre-AIA 35 U.S.C. §§ 102 and 103 or AIA 35 U.S.C. §§ 102 and 103) applies, because there is a significant difference between whether a "claimed invention" is contained or was ever contained in a patent or an application for a patent, and whether a claim to a "claimed invention" is contained or was ever contained in a patent or an application for a patent.

Therefore, we respectfully request that the Office correct all relevant passages in the proposed guidelines so that the expressions in the proposed guidelines track exactly with the expressions in the AIA and the Rules. To the best of our knowledge, such relevant passages appear at the following locations in the guidelines:

77 Fed. Reg. 43762 (nine occurrences)

77 Fed. Reg. 43772 (two occurrences)

77 Fed. Reg. 43773 (eleven occurrences)

2. Grace period inventor disclosure

As regards the grace period inventor disclosure, we find in the proposed guidelines that:

This means that in circumstances where an application names additional persons as inventors relative to the persons named as authors in the publication (e.g., the application names as inventors A, B, and C, and the publication names as authors A and B), and the publication is one year or less before the effective filing date, it is apparent that the disclosure is a grace period inventor disclosure, and the publication would not be treated as prior art under 35 U.S.C. 102(a)(1). If, however, the application names fewer inventors than a publication (e.g., the application names as inventors A and B, and the publication names as authors A, B and C), it would not be readily apparent from the publication that it is by the inventor or a joint inventor and the publication would be treated as prior art under 35 U.S.C. 102(a)(1).

This type of asymmetric treatments of discrepancies between the authors in a publication and the name inventors does not make any sense. It is much appreciate to have special considerations discussed in the subsequent four paragraphs. Since this is a US specific issue (while we do have a similar problem in Japan), the use of a certification separate from the specification is preferred; i.e., the use of an affidavit or declaration is preferable.

3. Prior art exception under 35 U.S.C. 102(b)(1)(B) to 35 U.S.C. 102(a)(1)

With regard to “subject matter”, the proposed guideline states as follows:

Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 USC 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 USC 102(b)(1)(B) does not apply.

This definition of “subject matter” is the key to keep the first-to-file system under AIA clear and simple, effective against costly discovery for litigations. Please keep this paragraph as it is.

4. Determining when subject matter was effectively filed under 35 U.S.C. 102(d)

Please make it clear in the guidelines that, when a priority claim is withdrawn, another statement may be required.

In 35 U.S.C. 102(d), we find the following passages:

“The AIA draws a distinction between actually being entitled to priority to, or the benefit of, a prior-filed application in the definition of effective filing date in 35 USC 100 (i)(2), and merely being entitled to claim priority to, or the benefit of, a prior-filed application in the definition of effectively filed in 35 USC 102(d). ... Thus, there is no need to evaluate whether any claim of a U.S. patent, U.S. patent application publication or WIPO published application is actually entitled to priority or benefit under 35 USC 119, 120, 121 or 365 when applying such a document as prior art.”

Please clarify whether an applicant is allowed to rebut an office action to reject his application based on a prior-filed application by establishing that the prior-filed application is NOT entitled to priority. If it is not allowed, neither the later applicant nor the prior applicant can obtain the patent.

5. Concerning “Requirement of ‘names another inventor’”

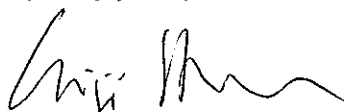
With the heading of “Requirement of ‘names another inventor.’” we find the following statement:

“This means that if there is any difference in inventive entity between the prior art US patent, US patent application publication, or WIPO published application and the application under examination or patent under reexamination, the US patent, US patent application or WIPO published application satisfies the “names another inventor” provision of 35 USC 102(a)(2).”

Even if a plurality of inventors are named in a patent application, often some portions of claimed invention are invented by a smaller group of inventors than the named inventors, and that small group may be the named inventors in the prior application. Or, if a certain portion of the prior application is not claimed, it may be claimed in the application under examination and may have been invented by inventors who are not named as inventors in the prior application, and who are named as inventors in the application under examination. The applicant of the application under examination should be able to overcome the rejection based on 35 USC 102(a)(2) and the “names another inventor” provision by explaining that the portion in the prior application disclosure relevant for examination of a claim under examination was invented by the same inventors although the prior application names an additional inventor, for example, by way of filing a declaration.

We would be pleased to answer any questions these comments may raise and look forward to participation in the continuing development of rules appropriate for patent practice and for implementation of the AIA.

Very truly yours,



Eiji Katayama

President

AIPPI Japan