

From: IWAI, Seiji
Sent: Monday, March 11, 2013 9:36 PM
To: RCE outreach
Subject: Comments by AIPPI Japan in response to request for comments on Preparation of Patent Applications and Continued Examination (RCE) Practice

Dear Sirs:

Please find attached the Japanese Group of AIPPI Comments on the proposed "Continued Examination (RCE) Practice." and confirm safe receipt of them.
If you have any questions, please do not hesitate to contact me.

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(2) What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs?

Regarding the "new issue" standard employed after a final office action, the current pilot program "After Final Consideration Pilot (AFCP)" can be effective to reduce applicants' needs to file RCEs as long as an examiner is guaranteed certain hours for further examination. If the USPTO is considering whether the AFCP pilot program should be further extended or made permanent, we support such an idea as one of the promising changes in the current procedures.

Moreover, an RCE is inevitable due to the current regulations if an applicant finds a material reference as an IDS after payment of an issue fee. We appreciate and support that another pilot program "Quick Path Information Disclosure Statement (QPIDS)" may be also one of the promising solutions to reduce RCEs under such a situation.

Incidentally, if the USPTO is considering whether the QPIDS pilot should be further extended or made permanent, we wish the USPTO to review the current payment procedure. As voices from some Japanese applicants, the current payment procedure for the QPIDS pilot program is sometimes troublesome in that they are required to pay the fees for both an IDS and an RCE and get one of them refunded afterwards. Since the Japanese applicants are required to be represented by a registered attorney or agent, the current payment procedure usually causes certain loss of fees due to additional handling by the attorney or agent for the refund. Accordingly, we wish the USPTO issue another notice to instruct an applicant pay the fee for an RCE (or the shortfall thereof) only when the examiner decides that an RCE is necessary.

In addition to the two pilot programs, we would like to propose an amendment to 37 CFR 1.97(d) to reduce applicants' needs to file RCEs as follows:

Proposed 37 CFR 1.97(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by either of:

(1) The statement specified in paragraph (e) of this section and the fee set forth in § 1.17(p); and or

(2) The fee set forth in § 1.17(p) plus a surcharge of \$ ().

We assume that an IDS after the term as provided in 37 CFR 1.97(c) and on or before payment of the issue fee may be sometimes necessitated by the difference in the timing of office actions in counterpart applications outside the U.S. and/or applicant's oversight. For these cases, there are cases where it is difficult to prepare appropriate statements specified in 37 CFR 1.97 (e) with certainty. Moreover, as long as 37 CFR 1.97(d) allows a case where an IDS to be reviewed by an examiner under certain conditions, we assume that proposed rule may not invite significant increase in burden among examiners to consider an IDS filed after the term as provided in 37 CFR 1.97(c).

Furthermore, it is preferable to introduce another available procedure other than an RCE in a case where an IDS needs to be considered after the term as provided in 37 CFR 1.97(c) in view of the balance between a burden on an examiner and the new fee to be effective on March 19, 2013.

We also understand that supplemental examination is available under the post-AIA law. However, we believe that it is reasonable to allow an IDS to be reviewed by an examiner at more convenient procedures and reasonable fees (for example, at a surcharge of \$200 to 300) in comparison with the ones for supplemental examination.

Accordingly, the proposed 37 CFR 1.97(d) will also be meaningful to reduce applicants' needs to file RCEs.