

**Requests to the United States for the Seventh Round of the Japan-US Regulatory Reform and  
Competition Policy Initiative (1)**

<b>Person in Charge</b> Hideo Doi (Secretary General, Japan Intellectual Property Association)	<b>Contact Information</b> TEL: 03-5205-3432 E-Mail: doi@jipa.or.jp
<p><b>1. Outline of regulations, customary practices or administrative procedures (hereinafter referred to as “regulations, etc.”) that are causing hindrance or inconvenience to business activities of Japanese companies or economic activities of Japanese individuals in the United States. (Please also indicate whether such regulations, etc. are <u>those of the federal government or those of state governments.</u>)</b></p> <p>&lt;Accelerated examination system&gt;</p> <p>With the revision of rules on the accelerated examination system last year, the system was changed so as to deem applications wherein the applicant fails to reply to an Office Action within one month as having been abandoned, and this period was made inextensible. As a result, Japanese companies, which are required to carry out such work as translation of documents, are encountering considerable difficulty in using the accelerated examination system, in consideration of the risk of being deemed as having abandoned their applications. The regulations also have other limitations that greatly restrict actual use of the system. (For details of the issues and the degree of impact, see Annex.)</p>	
<p><b>2. Laws or ordinances on which the regulations, etc. are based. (Please attach the text of the laws or ordinances wherever possible.)</b></p> <p>See the URL (FR) below.</p> <p><a href="http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.htm">http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.htm</a></p>	
<p><b>3. Problems for business activities conducted by Japanese companies or economic activities by Japanese individuals due to the presence of the regulations, etc.</b></p> <p><b>(Please indicate the actual monetary value represented by the effects in question, if possible.)</b></p> <p>See Annex.</p>	

**4. Detail of requests for reform of regulations, etc. (Please provide specific responses by indicating how laws or ordinances should be revised, etc.)**

We request the following in order to rectify the internal-external gaps:

- 1) Introducing a system that allows for extensions for overseas applicants or extending the current one-month reply period
- 2) Making PCT applications subject to accelerated examinations

**Annex**

Changes in the Accelerated Examination System in the United States and their Impact on Japanese Companies

	Changes (Issues)	Impact
1	An inextensible one-month reply period presents difficulties for overseas applicants. (Although implementation of this system has already been confirmed, we request that the US government urge the USPTO to implement some kind of reform, given that Japan permits extension of its reply period for overseas applicants.)	Extremely serious
2	Submission of petitions is restricted to the time of the filing. Infringement cannot occur by the time of the filing and companies usually have yet to use their inventions at the time of the filing. Therefore, under the new system, a company would practically be unable to request an accelerated examination based on such reasons.	Extremely serious
3	Deeming applications to have been abandoned following the elapsing of the period for replying to Office Actions is excessively restrictive to applicants. It would be reasonable in such cases to deem that the applicant in question has withdrawn from the accelerated examination process and return the application to the ordinary examination process. (Related to item 6 below) Considering the shortened replay period mentioned in item 1 above and the risk of being deemed as having abandoned the application, as mentioned in this item, overseas applicants will inevitably have to refrain from requesting accelerated examination.	Extremely serious
4	PCT applications are not subject to accelerated examination.	Extremely serious
5	Support document is too extensive. 1) Implementation of preexamination search - The search method, database service, search logic, date of search and other relevant information must be disclosed. 2) Explanation of patentability 3) Explanation of utility of the invention 4) Explanation of where each limitation of the claims finds support in the written description of the specification	Serious  It would be <b>extremely problematic</b> if fraud (inequitable conduct) or estoppel were to arise as a result of a failure to conduct an appropriate search.

6	A system that has no procedure for withdrawal from the accelerated examination system but deals with such situations by way of abandonment and continuing applications would lead to an increase in the number of continuing applications. However, no coordination has been made with the other USPTO measures, such as revisions of rules on continuing applications. A procedure for withdrawal from the accelerated examination system (returning the application to the normal examination system) is needed.	Serious
7	Claims have been limited in number (three or fewer independent claims and twenty or fewer total claims) and multiple dependent claims have been prohibited. There are similar restrictions on the addition of claims upon responding to Office Actions.	Rather serious
8	Interview examinations and frequency of correspondence by telephone	Tolerable (Problem with which we can cope) (The fact that the applicant is contacted by telephone before the actual Office Action is welcomed.)
9	When all the claims presented are not directed to a single invention, the matter is dealt with over the telephone. If no agreement is reached, the examiner automatically makes an election.	Tolerable (Problem with which we can cope)
10	Applications must in principle be filed electronically.	None

**Requests to the United States for the Seventh Round of the Japan-US Regulatory Reform and  
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<b>Person in Charge</b> Hideo Doi (Secretary General, Japan Intellectual Property Association)	<b>Contact Information</b> TEL: 03-5205-3432 E-Mail: doi@jipa.or.jp
<b>1. Outline of regulations, customary practices or administrative procedures (hereinafter referred to as “regulations, etc.”) that are causing hindrance or inconvenience to business activities of Japanese companies or economic activities of Japanese individuals in the United States. (Please also indicate whether such regulations, etc. are <u>those of the federal government or those of state governments.</u>)</b>  <Revision of the Patent Act> We strongly request early approval of a patent reform bill that includes a shift to a first-to-file system and abolishes the Hilmer doctrine, something which we have been requesting for some time. The amended bill of the House of Representatives that recently passed the Committee on the Judiciary proposes an amendment, replacing the original first-to-file system with a first-to-publish system, and demands that Japan and Europe accept the same grace period as that observed by the United States as a precondition for enforcement of the revised Act. However, we strongly request that the system be shifted to a first-to-file system as was originally proposed. (The amendment creating a first-to-publish system has not been incorporated into the bill that was submitted to the Senate.) 1) The first-to-file system regards rights as arising at the time of filing, so therefore a first-to-publish system that regards rights as arising at the time of publication runs against such a principle, although it would be understandable to allow a grace period as an exception to lack of novelty. Grace periods should only be made available so as to ensure that applicants are not be disadvantaged by their own acts. 2) Should rights be granted based on publication, the contents of said rights are likely to become unclear. Every country has its own established format for how inventions are to be described, and discussions aimed at creating a unifying international format are presently underway. Since contents are usually published in ways that deviate from such description formats, granting rights for such contents would make it impossible to precisely define the published inventions in question, and as such would cause confusion in practice.	
<b>2. Laws or ordinances on which the regulations, etc. are based. (Please attach the text of the laws or ordinances wherever possible.)</b>	
<b>3. Problems for business activities conducted by Japanese companies or economic activities by Japanese individuals due to the presence of the regulations, etc.</b> (Please indicate the actual monetary value represented by the effects in question, if possible.)	

Omitted.

**4. Detail of requests for reform of regulations, etc. (Please provide specific responses by indicating how laws or ordinances should be revised, etc.)**

As described above.

**Requests to the United States for the Seventh Round of the Japan-US Regulatory Reform and  
Competition Policy Initiative (3)**

<b>Person in Charge</b> Tomoko Miyashita (First License Committee, Japan Intellectual Property Association)	<b>Contact Information</b> TEL: 03-5344-4040 Intellectual Property Department, Hewlett-Packard Japan Ltd.
<p><b>1. Outline of regulations, customary practices or administrative procedures (hereinafter referred to as “regulations, etc.”) that are causing hindrance or inconvenience to business activities of Japanese companies or economic activities of Japanese individuals in the United States. (Please also indicate whether such regulations, etc. are <u>those of the federal government or those of state governments.</u>)</b></p> <p>1) A claim may be broadened by filing a reissue application within two years of the grant. Although intervening rights are available, they are unstable since they are based on equity.</p> <p>2) In order to have the examiner reconsider the information disclosure statement (IDS), procedures such as requests for continued examination (RCE) are required, depending on the stage of the examination.</p> <p>3) The principle of use is adopted for trademarks.</p>	
<p><b>2. Laws or ordinances on which the regulations, etc. are based. (Please attach the text of the laws or ordinances wherever possible.)</b></p> <p>1) 35USC251, 252</p> <p>2) Rule 1.56, 1.97</p>	
<p><b>3. Problems for business activities conducted by Japanese companies or economic activities by Japanese individuals due to the presence of the regulations, etc.</b></p> <p><b>(Please indicate the actual monetary value represented by the effects in question, if possible.)</b></p> <p>1) As long as there is a possibility for claims to be broadened, the scope of right remains unstable and invention cannot be commercialized with a sense of security.</p> <p>The question of whether or not intervening rights will be recognized is based on equity, and as such it is difficult for even patent attorneys to predict such outcomes.</p> <p>2) In such a case, the applicant would need to file an RCE, a continuation, or a petition for the reconsideration, which imposes a considerable burden on the applicant both in terms of cost and time.</p>	

3) Applicants cannot file preliminary applications for a trademark that they plan to use in the future (in three to four years' time).

**4. Detail of requests for reform of regulations, etc. (Please provide specific responses by indicating how laws or ordinances should be revised, etc.)**

1) Broadening claims by reissue applications should be prohibited. We request that the broadening of claims be permitted only to the extent permitted in Japanese trials for correction.

2) We request that submission of IDS documents be allowed without any additional fees at the time when applicants discover prior art, and we request that examinations be carried out based on said prior art. For example, IDS documents should be examined even if they have been submitted after the final Office Action or after the claims have been allowed, and that opportunity be provided for amendments by raising new grounds of rejection.

3) We request that use should not be made a strict requirement for trademark registration, so as to comply with the international standard.



**Requests to the United States for the Seventh Round of the Japan-US Regulatory Reform and  
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<p>[Federal law] A patent is not necessarily protected during the entirety of a patent’s duration. The law clearly places patentees who manufacture products at a disadvantage.</p> <p>(If a patentee has failed to indicate the patent number of the patented product in question or its package, the patent is only protected for the period after the patentee’s delivery of a written warning to the alleged infringer.)</p>	
<b>2. Laws or ordinances on which the regulations, etc. are based. (Please attach the text of the laws or ordinances wherever possible.)</b>	
<p>35 U.S.C. Sec. 287(a)</p> <p>(The original purpose of legislation was to require patentees to actively disclose the presence of their patents to the public in order to prevent people from committing patent infringement through lack of knowledge of the existence of said patents.)</p>	
<b>3. Problems for business activities conducted by Japanese companies or economic activities by Japanese individuals due to the presence of the regulations, etc.</b>	
<p><b>(Please indicate the actual monetary value represented by the effects in question, if possible.)</b></p>	
<p>Even if a company discovers that its patent is being infringed by another company, it can only claim damages and license fees for the period after a written warning to the infringing party has been sent. (The company cannot claim damages for past infringement.)</p> <p>[Reason A] For a company manufacturing or selling products that are protected by numerous patents, it is extremely difficult to indicate all patent numbers.</p>	

[Reason B] At the time when a company begins to manufacture a product, the technology is often not yet patented, although patent applications have been filed. If patents are granted after the initiation of manufacturing, it is difficult to indicate the patent number of the product or its package. (It would require a change in the manufacturing process and would make management of product numbers an arduous process.)

[Reason C] In the case where Company A supplies its components to Company B and Company B sells products using these components in the United States, it is not necessarily easy for Company A to indicate the patent numbers of said patented components on Company B's product. Company A would thus have to coordinate matters with Company B.

**4. Detail of requests for reform of regulations, etc. (Please provide specific responses by indicating how laws or ordinances should be revised, etc.)**

We request that the patentee be protected against infringement committed prior to the delivery of a written warning to the alleged infringer, even if the patentee did not indicate the number of the patent in question on the patented product.