JIPA's Opinions on the U.S. Patent Reform Act of 2007 (as Amended by the Judiciary Committees)

The Japan Intellectual Property Association (JIPA) declares its opinions as follows on the amended versions of the U.S. Patent Reform Act of 2007 that have passed the U.S. House and Senate Judiciary Committees on July 18 and 19 respectively.

JIPA is concerned that the following two items, which have been introduced in the recent amended versions, pose serious problems shown below with regard to operation of the system and actual practices.

1. Amendment of the first-inventor-to-file system

Regarding 102(b)(2)(B), an exception provision in Section 102, which has been introduced in the recent amended versions, we have the following concerns:

1) Since each public disclosure is usually made in different styles with different contents, the granting of some right in association with public disclosure is very likely to cause confusion in patent practice in that it is difficult to precisely identify an invention in the publicly disclosed information.

2) As a result of the stronger tendency to prioritize public disclosure over patent filing, there is a risk that the procedure and function of filing in the patent system will be used less.

3) Since there are various means of public disclosure, the priority of applications including priority in terms of public disclosure will become complicated and unclear. This could reduce the efficiency of patent examinations and the stability of rights.

4) In principle, the right arises at the time of filing in the first to file system and this is the concept that JIPA has been seeking for many years. Also from the viewpoint of achieving international harmonization of patent systems, the United States should promote a system that more clearly defines and specifies the time that the right arises.

2. Introduction of obligation to submit a prior art search report, etc.

Regarding the obligation for applicants to submit a search report and other information and analysis relevant to patentability (Section 123), which has been introduced in the recent amended versions, we have the following concern:

1) In filing U.S. applications, relevant documents have already been presented under the information disclosure statement (IDS) system and JIPA has repeatedly requested relaxation of this IDS system. This requirement for additional information imposes an even greater burden on applicants in terms of cost and workload and runs counter to the requests that have been made by JIPA.