

JAPAN PATENT ATTORNEYS ASSOCIATION

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Via email

Attn: Mr. Hiram H. Bernstein

Senior Legal Advisor

Office of Patent Legal Administration

Office of the Associate Commissioner for Patent Examination Policy

United States Patent and Trademark Office

AC58.comments@uspto.gov

September 14, 2011

Re: Submission to Revision of the Materiality to Patentability Standard for the
Duty to Disclose Information in Patent Applications

Dear Sirs:

The Japan Patent Attorneys Association or JPAA is a professional association of more than 9,000 patent attorneys practicing in all aspects of intellectual property laws in Japan.

We express our agreement with the following statement that: “it should also continue to prevent fraud on the Office and other egregious forms of misconducts” found in the summary section of the Notice. Fraud and misconducts should not be committed in course of obtaining a patent. A patent should be given to a person with clean hands. It should not be allowed to hide material information intentionally. Any conducts which would lead the Examiner in the Office to misunderstand patentability should not be permitted.

We express our disagreement, on the other hand, with the following statement that: “the Office is considering further actions that may provide an incentive for applicants to assist the Office by explaining/clarifying the relationship of prior art to the claimed invention.” Preparing a statement that will explain the relationship between prior art references and claimed invention is burdensome to applicants. Preparing such statement is an additional burden on an applicant, which is not required under the current IDS rule. The current IDS rule does not require such statement because finding relationship between a reference and the claimed invention belongs to examiner’s duty, and is not applicant’s duty. If this additional burden is imposed on an applicant, it would be omission of duty by the Office.



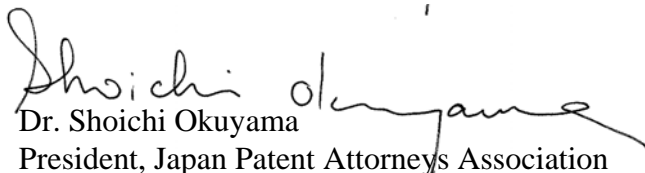
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We express our agreement with raising the materiality bar in the IDS system. Under the current IDS practice, applicants are forced to submit prior art information as much as possible in order to avoid any possibility of being charged with inequitable conduct. In reality, applicants submit prior art references even if the applicants do not consider that the information contained in those prior art references is important to patentability. Applicants suffer from such unnecessary burden. Accordingly, we agree to shift the materiality standard to the “but-for-plus” standard. This shift of standard will reduce or eliminate an unnecessary burden of submitting prior art references that contain marginally relevant information only.

With regard to the meaning of “affirmative egregious misconduct,” we insist that any unintentional conduct should not be regarded as the affirmative egregious misconduct. The holding in the Therasense case indicates that neither mere nondisclosure of prior art references to the PTO nor failure to mention prior art references in an affidavit constitutes affirmative egregious misconduct. The revised IDS rule should follow this holding.

We expect that the MPEP will be amended in line with the revised IDS rule. We would like to see many examples included in the MPEP which would show instances in which affirmative egregious misconducts are not found. Such examples will reduce the necessity of filing marginally relevant prior art references in the Office. This would be beneficial to both the Office and applicants.

Sincerely yours,


Dr. Shoichi Okuyama
President, Japan Patent Attorneys Association