



Japan
Intellectual
Property
Association



September 28, 2007

Alison Brimelow
President
European Patent Office

Masahiro Koezuka
Commissioner
Japan Patent Office

Jon Dudas
Undersecretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
United States Department of Commerce

Dear Trilateral Office Heads,

At the meeting of the Industry Trilateral held in Washington, D.C. on May 29, 2007, the participants reviewed the Report of the 4th Technical WG on Formal Aspects of Patent Applications dated March 1, 2007, as prepared by the Trilateral Offices. The Report stated that "the Trilateral Offices will consider discussing substantive issues in another forum." The substantive issues that were extracted from the issues addressed at the WG meeting in Tokyo from February 27-March 1, 2007 included the following five issues, as identified in Annex IV of the Report:

(1) National Legends

Whether U.S. law and/or procedure can be changed so that National Legends need not be cited by applicants in the specification of a patent application;

(2) Reference Numbers in Abstract/Claims

Whether U.S. law and/or procedure can be changed to preclude any limiting effect of the presence of reference numbers in the abstract or claims on the scope of an issued claim and the protection available to an issued patent;

(3) Requiring Conformance of Specification to Claims

Whether EP law and/or procedure can be changed to preclude the EPO from requiring conformance of the specification to the allowed claims;

(4) Requiring Amendment of Specification to Cite Prior Art

Whether EP law can be changed to preclude the EPO from requiring the insertion of a description of the prior art applied during examination into the description;

(5) Requiring Listing of Prior Art in the Specification at Filing

Whether JP law and/or procedure can be changed to provide for citation of art other than in the description of an application.

The Industry Trilateral has estimated that these five issues currently cost users alone in excess of \$300 million dollars annually, and that this amount and additional amounts related to Office activities could be saved if a solution is found that balances the needs of Offices and the interests of users. Accordingly, the Industry Trilateral respectfully requests the Offices to form a working group to study these five issues, and to involve representatives of the Industry Trilateral in the activities of such working group, to the extent practicable.

In addition, as part of its original study of areas in the laws and rules applicable to patent application filing and prosecution, where efficiencies and savings to users can be attained, the adoption of a uniform "unity of invention" standard was identified. Again, during the Industry Trilateral meeting on May 29, 2007, the participants concluded that the issue of "unity of invention" should be discussed by the Trilateral Offices with a goal of achieving uniformity, if possible. Thus, we request the Offices to include this issue as a sixth topic for discussion. Again, the Industry Trilateral would be willing to participate in a discussion of this important issue.

We would greatly appreciate your undertaking the establishment of a Working Group to consider these six issues at the earliest possible time, so that they can be examined in parallel with the formal issues involving a single application format. We believe that concurrent consideration of these issues would lead more quickly to a more efficient and simplified process for patent application preparation, filing, searching and examination. Thank you for your attention.

Sincerely,



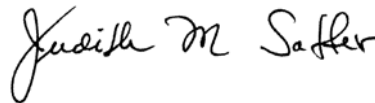
Philippe de Buck
Secretary General of BUSINESSEUROPE



Taisuke Kato
President of JIPA



Marc Adler
President of IPO



Judith Saffer
President of AIPLA