



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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Lois M. Boland
Director
Office of International Relations
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P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Lois:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present to the USPTO its views on the Report of the Trilateral Offices dated November 16, 2006 with regard to the 3rd meeting of the Technical Working Group on the Formal Aspects of Patent Applications that was held on November 13-14, 2006 (the “Government Working Group Report”). These comments are presented by AIPLA as one of two U.S. organizations nominated by the USPTO to participate in a meeting of the Technical Working Group to be held from February 27 to March 1, 2007 in Tokyo Japan. At that meeting, the Government Working Group Report will be discussed in the Working Group with several users nominated by the Trilateral Offices. Those discussions are intended to provide a basis for planning for a Pilot Project and subsequent steps.

AIPLA is a national bar association of more than 17,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA also is a member of the Industry Trilateral, an organization of non-governmental groups that include representatives from Japan (JIPA), Europe (BusinessEurope – formerly UNICE) and the U.S. (IPO and AIPLA), individually and collectively having a strong interest in improving procedures and policies that are applicable to the protection of intellectual property both internationally and domestically, so that rights may be protected more efficiently and more effectively. One area of focus for the Industry Trilateral is the development of a “common format” or “single format” for what ultimately will be a “global patent application.” Applications

conforming to such a single format could be filed, preferably electronically, in any patent office without the need for any changes to accommodate national/regional rules, and would facilitate machine translation of applications.

The Industry Trilateral issued a report on the Global Patent Application dated November 14, 2006 (the "Industry Trilateral Report") that considers and, indeed, was the basis for many of the proposals in the Government Working Group Report. While there are important commonalities between the two Reports, there also are significant differences that AIPLA believes must be resolved because of the likely unfavorable procedural and legal impact on users, if the goal of a common format application is to be attained.

I. INTRODUCTION

In framing our comments, we have considered the Mandate of the Technical Working Group, the Draft Basic Principles underlying a Draft Resolution and Roadmap for Further Work, and the several Draft Specific Issues, as stated in the Government Working Group Report. These comments are provided, where applicable, by comparison with the Industry Trilateral Report. In addition, the comments are made in consideration of (1) a goal of establishing and achieving successful results from a Pilot Project, and (2) a goal of identifying and implementing a platform from which further advances in achieving a global application can be undertaken and accepted by users. However, we begin with an identification of some Essential Considerations that must be appreciated by the Trilateral Offices if the Roadmap is to avoid impassible roadblocks along the way.

II. ESSENTIAL CONSIDERATIONS

AIPLA believes that there are several essential considerations that should be considered by the Trilateral Offices in planning for a Pilot Project and any Roadmap for Further Work.

A. No Legal Disadvantage to Participants:

Neither the Pilot Project nor the finalized implementation of a Single Format policy should have requirements that would create or even raise a risk that the scope of the protected invention would be compromised. Thus, substantive representations by an applicant must be avoided because of their possible impact on enforcement. Several provisions have this potential:

Reference Signs - Reference signs in the abstract or claims can be valuable aids in attaining greater efficiency during prosecution, but their use in the U.S. would create a risk that the claim scope will be limited by the referenced structures or steps in a

preferred embodiment. Currently, U.S. users avoid the use of reference signs in the abstract and claims. Similarly, users from Europe or Japan are advised to remove reference signs from the abstract and claims in the applications that they file in the USPTO, either beforehand or by way of preliminary amendment. In order to protect users of the U.S. Patent system from such risks and to encourage them to include reference signs, U.S. law must preclude courts from restricting claim scope based on the reference signs, as in Europe. USPTO Rule changes will not be sufficient. Thus, we request that the USPTO seek appropriate changes in title 35.

Titles - Certain specified section titles use terminology (e.g., “invention” “technical,” “art”) that may (1) restrict or be incompatible with the scope of a patent under U.S. law or (2) raise other legal issues.

Pilot Project - During the Pilot, U.S. applicants would not include reference signs in their applications, and European or Japanese applicants can file preliminary amendments that delete reference signs from the abstract and claims. However, this is clearly not a best practice. With regard to the mandatory use of the Titles suggested in the Government Working Group Report, preferably, the problematic terms would be removed. For purposes of the Pilot, however, it is likely that participants will simply select applications covering inventions that would not be affected by use of such terms.

B. Post Filing Amendments Should Be Avoided:

While a common format provides certain cost and efficiency advantages at the time of filing, those advantages should not be lost by subsequent requirements to amend the application. The goal of the Standard Format proposal made by the Industry Trilateral was to avoid non-substantive amendments to the specification (additions or deletions) from the time of filing to issuance. Two possible solutions might be considered:

Procedural Solutions – Simply postponing the addition of non-substantive text in the USPTO or the deletion of such statements in the EPO or JPO (e.g., Federal funding statements) is inconsistent with this goal. National requirements should be relegated to separate documents outside of the application. One example is a “Single Format Application Filing Sheet” that specifies inserts to be made to the applications filed in each Trilateral Office after filing.

Technical Solutions - Technical solutions (e.g., where tagged “place-holders” are used in the common format to facilitate automatic insertion from separately filed documents)

would appear to offer a preferred solution. However, it would be preferable if any technical formatting requirements are not implemented in a proprietary file format.

Pilot Project - The use of either preliminary amendments for USPTO cases to add required statements to a standard format application, or an agreement by the JPO and EPO that such statements need not be deleted during prosecution, would be necessary during the Pilot. However, the use of preliminary amendments would not be consistent with the goals of the Industry Trilateral Report long term.

C. Standard Format Should Be Optional

The Pilot and any final implementation should make clear that the use of the Standard Format is an applicant's option. Applicants should have a clear option of using the national format.

D. Incentives for Trilateral Participants May Be Desirable

The implementation of a Standard Format in new applications as proposed in the Government Working Group Report could involve significant added costs and efforts for applicants (e.g., the additions of tags), costs which will not be recouped until subsequent filing in an Office of Second Filing occurs (and may not be recouped even then if additional activity is required during prosecution). Thus, the prospects for achieving a successful Pilot and ultimate large-scale adoption of the proposed Standard Format by users of the Trilateral Offices could be enhanced if the Trilateral Offices would minimize the added costs and/or offer appropriate incentives.

Pilot Program - At the least, beginning with the Pilot, the program should avoid creating disadvantages for the applicant when the application is being processed or examined by the Offices.

E. Pilot Project Goals

The Pilot Project should focus on achieving clearly defined goals and establishing specific principles that ultimately will lead to acceptance of a Standard Format, implementation of regulatory changes, and enactment of proposed statutory changes as needed. AIPLA believes that such clear focus will be essential to encourage users to participate in a Pilot Project.

Simple and Doable - The program should be simple, and make it easy for users to adopt a Standard Format for the Pilot. Possible impediments and problems should be anticipated during the Working Group meetings.

Additional Costs - The program should assess the impact of the Standard Format on translation costs, which are a major factor in many filing programs, and other administrative costs for users.

Statement of Principles - A clear statement of the principles that are to be established by the Pilot Project and a critical evaluation of whether the Pilot Project will effectively demonstrate or support those principles should be prepared.

III. MANDATE OF THE TECHNICAL WORKING GROUP

AIPLA is generally in agreement with the Mandate stated in the Government Working Group Report:

The Technical Working Group shall formulate recommendations for addressing the following issues:

1. Standardization of the patent application forms, with a view to maximizing compatibility with the requirements of the PLT, PCT, and Trilateral Offices;
2. Standardization of the patent application format, taking into consideration the promotion of electronic filing and processing;

In formulating these recommendations, the Technical Working Group should work on them concurrently and attempt to identify issues that can be dealt with rapidly at a practical level, drawing on current practices and formats and taking into consideration the potential impact on the offices and the viewpoints of the relevant stakeholders.

As noted above, the potential legal and practical impact on users must be considered. Moreover, there are provisions in the PCT Rules that were established prior to developments in U.S. law that, if strictly followed, may preclude participation in any Pilot Project and acceptance of a single format program. Thus, AIPLA suggests that the Mandate should be open to possible changes to the PCT Rules.

IV. DRAFT BASIC PRINCIPLES

Again, the nine recited draft Basic Principles are generally supported by AIPLA. However, with respect to Principle 1, the basis for filing applications should both be beneficial and not detrimental to applicants. With respect to Principle 8, an application which complies with the Standard Format shall be “accepted” by any of the Trilateral Offices. A clearer understanding of what “accepted” means is basic to this entire program. If “accepted” means that an applicant will get a filing date, but must amend the application within a fixed period of

time (for example, three months), then very little would be accomplished by the “Global Application” concept. The PLT already has minimum requirements for obtaining a filing date and, if “accepted” only means getting a filing date, the Global Patent Application concept will have limited value. If, on the other hand, “accepted” means “accepted without any further amendment,” this should be clearly stated.

Pilot Project - One possibility for the Pilot is to postpone amendments until an application is found to be allowable. However, this should not be the policy of any final implementation of a Single Format policy.

V. DRAFT SPECIFIC ISSUES

A. National Legends and Designations - Cross Reference to Related Applications and Federal Funding

The Industry Trilateral Report stated that national legends should not be required and, ultimately, that US law and regulation should be changed. However, the Government Working Group Report provides that PCT practice should be followed, that applicants MAY include statements, and that such statements may be added according to US law. This appears to suggest that such legends may be kept when filing and prosecuting corresponding EP/JP applications.

Pilot Project: With respect to the Pilot Project, as one alternative, permissive inclusion of required national legends might be a way forward, provided the legends do not have to be removed during prosecution of JPO/EPO applications. As a second alternative, consideration might be given to the submission of such statements in a Preliminary Amendment or during prosecution so that a Single Format application could be used in EPO/JPO filings. However, this is not considered a desirable long-term practice since it would add costs for U.S. applicants.

Future Issues: Offices should not require subsequent deletion of statements that are permitted at the time of filing. Also, US law should be modified to permit statements to be made in a document separate from the description, taking into account possible technical solutions that would permit automatic insertion into tagged areas of an application.

B. Inclusion of Industrial Applicability

The Industry Trilateral Report recommended that the statement of Industrial Applicability be made optional consistent with PCT practice - a matter of preference. However, the Government Working Group Report provides that an Industrial Applicability Section should be

part of the Standard Format, commenting that such a statement may be inserted optionally, as it is a matter of preference under the PCT.

Pilot Project: Solely for the Pilot, the Government Working Group Report approach would be acceptable if modified to provide that, while the Section heading would be included, the text following the heading either would be (1) completed at the option of the applicant (possibly with a statement that “Industrial Applicability is apparent from the entire disclosure herein” or with a similar generic phrase acceptable to the Trilateral), or (2) kept blank in the U.S. at the option of the applicant. As to the latter option, leaving out text under a mandatory title may prove to be disadvantageous to U.S. applicants when enforcing their patents. Also, PCT Rule 5.1(a)(vi) appears to make inclusion of the statement mandatory (“shall indicate explicitly...”), and Rule 5.1(c) “prefers” that the statement be preceded by an appropriate heading as “suggested” by the Als. We would support a proposal to eliminate the mandatory inclusion of a statement of Industrial Applicability, and instead permit an optional section and statement so that Offices will permit such a statement in an application but not demand it. However, this appears contrary to Rule 5.1(a)(vi) and we would like to know the USPTO’s view.

Future Issues: Reconcile substantive law regarding industrial applicability, utility, and best mode.

C. Citation of Prior Art in the Application

The Industry Trilateral Report stated that PCT Rule 5 should be followed, but advocated that the citation of prior art should not be mandated in applications. The Government Working Group Report stated that PCT Rule 5 and WIPO Std. 14 may be followed and recommended that the prior art should be tagged with special indicators. The Government Working Group Report stated that there may be a List of References in the specification and that a separate U.S. IDS would be acceptable.

Pilot Project: With some clarifications, we believe the approach in the Government Working Group Report would be an acceptable basis on which to proceed. PCT Rule 5.1(a)(ii) does not require “citation” of prior art—it requires only an indication of background art that may be useful to understand, search, and examine the application. Specific citation of documents reflecting such art may “preferably” be cited, but citation is not mandatory. The pilot should differentiate between citing art and merely describing the background of an invention, and should permit an application to have the Standard Format even if it does not cite prior art.

Tagging and other specific indications relating to prior art should be limited to actual citations, and should be required during the Pilot only if such citations are included in the description.

Future Issues: Citations supplied in a separate document, such as a U.S. IDS, should be accepted by all Offices. Technical solutions for automatic insertion of a listing of prior art documents into published patents should be aggressively pursued. Serious consideration should be given to changing post-filing requirements to amend specifications to add citations or statements about prior art.

D. Abstract with Limited Size and Reference Numbers

The Industry Trilateral Report recommended that PCT Rule 8 should be followed [50-150 words (400 characters)] and urged changes to U.S. law so that reference numbers should not be used to interpret the claims. The Government Working Group Report has similar provisions only with respect to the size of the Abstract.

Pilot Project: We believe that, if reference numbers are required, the success of the pilot will be seriously jeopardized. Reference numbers in the abstract and claims pose an unacceptable risk of limiting patent scope, and should not be required for the Pilot. In addition, the size restriction of 150 words or 400 characters should apply only to the first filed application, regardless of the subsequent impact of translation.

Future Issues: Reference numbers in the abstract and claims are useful to both Examiners and to the public in reading an application or patent. U.S. law should be changed to preclude the use of reference numbers in the abstract and claims to limit patent scope.

E. Section Titles and Order

The Industry Trilateral Report recommended that use of headings should be standardized for “major titles” according to PCT/PLT practice. There was considerable concern with respect to the use of terms having significant legal implications, such as “Technical Field.” However, the Government Working Group Report provides that certain specific titles should be used, including those with the terms “Invention,” “Technical” and “Art.” There also is a requirement to use brackets for tagging purposes in support of future electronic processing of the document.

Pilot Project: Other than the use of brackets, we find the proposal for the use of section titles seriously deficient. Reference is made to standardization per the PCT, but the indicated section titles do not comport with PCT AI 204. It is, therefore, unclear which controls, the draft text or AI 204. In any event, the word “Invention” should not be included in any section title, in

light of applicable U.S. law related to the interpretation of patents. “Background Art” should be shortened to “Background.” Also, it must be clear that no “Technical Problem” is required to be stated in a compliant application. To the extent that an applicant includes such information, the heading would fit better under the “Background” section title. Likewise, “Advantageous Effects” would fit best as an optional subheading alongside “Industrial Applicability. The word “technical” presents a problem under U.S. law; however, the term “Technical Field” may not be objectionable if it is clear that it encompasses only the general area of inventive activity, and that no technical effect need be described. Finally, the proposed format makes it appear that the claims, abstract, and drawing are not part of the description—they should be included.

For the Pilot Project, applicants may participate even if such substantive terminology is required, to the extent that their disclosure is “technical,” the scope of the “invention” is clear, and the subject matter is related to an “art.”

Future Issues: Changes to PCT rules and regulations should be made so that concerns under U.S. law are avoided.

F. Reference Signs

The Industry Trilateral Report recognized the value of reference signs in the abstract and claims, but noted the significant risks of their use under U.S. law. Thus, the Industry Trilateral Report encouraged the U.S. to change its law. However, the Government Working Group Report dodges this issue by expressing a preference for the use of reference signs in claims and abstracts and further provides that the reference numbers should be tagged and that a list should be provided

Pilot Project: We believe the proposed pilot is an acceptable basis on which to proceed. As we understand it, reference signs will not be required in claims, only permitted. We also understand the sign list to be optional and not mandatory.

Future Issues: US law should be modified to make it clear that reference signs are not to be used for claim interpretation.

G. Units of Measurement

The Industry Trilateral Report and the Government Working Group Report are compatible on this topic. SI nomenclature is an accepted standard, and optional inclusion of alternatives is provided for.

H. Numbering of Paragraphs

The Industry Trilateral Report and the Government Working Group Report also appear to be compatible on this topic. While both Reports recommend Arabic paragraph numbering, the implementation details need to be clarified.

I. Drawings

The Industry Trilateral Report and the Government Working Group Report appear to be compatible and the proposed pilot appears to be an appropriate basis on which to proceed, subject to some clarifications. The Industry Trilateral Report recommended that the PCT drawing requirements be the standard, but we note that US Rule 84 is inconsistent and requires hatching to indicate material types. The hatching requirement in the US should be modified to conform with PCT.

Future Issues: Acceptance of color drawings and photographs should be pursued.

J. Formulae

The Industry Trilateral Report and the Government Working Group Report appear to be compatible and establish an appropriate basis for the Pilot. PCT Annex F offers an acceptable standard with sufficient flexibility for the pilot, although implementation details must be fully clarified.

Future Issues: Encourage use of vector notation to facilitate searching chemical structures.

K. Tables

The Industry Trilateral Report and the Government Working Group Report appear to be compatible and appropriate for purposes of the Pilot. PCT Rule 11.10 and Annex F standards are acceptable, although implementation details must be fully clarified.

L. Computer Program Listings

The issue is deferred.

M. Parts List

The Industry Trilateral Report recommended that the use of a parts list (reference sign list) should be optional but, if submitted, should be accepted by all Offices; further, there should be no requirement to amend the specification to add such list. The Government Working Group Report provides that a single reference sign list should be provided, apparently without making such list mandatory.

Pilot Project: With clarification, the proposed pilot may be an appropriate basis on which to proceed. The language is permissive, and our understanding is that a reference sign list is suggested but not required.

CONCLUSION

In conclusion, AIPLA is in general agreement with the Mandate of the Technical Working Group, the Draft Basic Principles underlying a Draft Resolution and Roadmap for Further Work, and several of the Draft Specific Issues stated in the Government Working Group Report. However, there are several Draft Specific Issues that require modification or clarification if a successful Pilot Project is to be implemented, especially for U.S. applicants. AIPLA has offered certain suggestions and is prepared to participate actively in the discussions of the Technical Working Group so that an identification of the full scope of these issues can be provided and strategies to achieve meaningful solutions for users can be devised.

AIPLA also wishes to emphasize that success in reaching the overall goal of a Single Format application will depend significantly on the success of the Pilot Project. Thus, AIPLA is looking forward to sharing with the USPTO and the Trilateral Working Group its perspectives on the concerns that users may have that would militate against full participation in and acceptance of a program based on a Single Format policy.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk
Executive Director
AIPLA