

October 25, 2015

Office Heads, IP5 Patent Offices:

European Patent Office (EPO)
Japan Patent Office (JPO)
Korean Intellectual Property Office (KIPO)
State Intellectual Property Office of China (SIPO)
United States Patent and Trademark Office (USPTO)\

By email: ip5@epo.org

Re: AIPLA Comments on IP5-PHEP Consultation -- Patent Practices and Procedures

Dear Office Heads,

The American Intellectual Property Law Association (“AIPLA”) thanks the IP5 Offices for the opportunity to comment on the detailed reports published by the IP5 Offices outlining their relevant practices regarding Unity of Invention, Citation of Prior Art and Written Description/Sufficiency of Disclosure (terminology list). AIPLA applauds the IP5 for its efforts and for considering proposals from the Industry IP5.

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA endorses the proposals set forth in the "Industry IP5 Consensus Proposals to the IP5 Patent Harmonization Experts Panel (PHEP)" (hereinafter the "Industry IP5 Proposals") submitted October 10, 2014. The present additional comments are intended to supplement, but not replace the Industry IP5 Proposals.

1. Unity of Invention

- All IP5 Offices should use Unity of Invention as the standard for search and examination for both international and domestic applications.
- In applying Unity of Invention, the Offices should adhere to the PCT standard for Unity of Invention.

- The ultimate goal is to have Unity of Invention applied by the IP5 Offices, rather than restriction practice, for both international and domestic applications. We suggest the U.S. adopt the Unity of Invention standard for domestic applications as soon as practicable. U.S. restriction practice unfairly requires applicants to limit the number of claimed inventions in a single application that satisfy the Unity of Invention standard, but are directed to “independent and distinct” inventions under current USPTO rules. However, even under U.S. law, restriction requirements are discretionary. There is nothing in U.S. law that requires that the USPTO define independent and distinct to mean something other than what is required by the Unity of Invention standard. The USPTO continuing with restriction practice impedes uniformity and harmonization, which is the goal of PHEP.
- Even when handling PCT applications where U.S. Examiners are supposed to apply the Unity of Invention standard, U.S. Examiners apply principles of U.S. restriction practice to interpret the Unity of Invention standard based upon the independent and distinct standard.
- For example, when applicants enter the national phase in the PCT, where the searching authority is other than the USPTO, more often than not the claimed inventions have been treated as having Unity of Invention by the ISA. Yet applicants who enter into the U.S. National phase of the PCT where U.S. Examiners are required to apply the Unity of Invention standard find themselves faced with U.S.-style restriction requirements in the guise of a lack of Unity of Invention holding. Examiners are using restriction practice where the proper standard is Unity. This is contrary to U.S. law, yet still persists.
- AIPLA recommends that the USPTO consider revising its restriction practice under the independent and distinct standard applied in national applications filed under 35 U.S.C. 111(a) (non-PCT route national applications) to be consistent with the Unity of Invention standard and give applicants the option to pay additional fees to have inventions that lack Unity of Invention examined in a single application and provide Examiners additional time for searching and examining all the claimed inventions.
- For the USPTO in particular, the complete transition to the IPC-based Cooperative Patent Classification System (CPC) has helped set the stage for a move to the Unity of Invention standard for domestic applications. In CPC, applications are classified according to the entire disclosure as opposed to the USPC classification being based upon the claimed invention. The U.S. Examiner’s ability to establish the burden under restriction practice is likely to be reduced since the field of search for independent or distinct inventions in an application in a CPC classification scheme is more likely to be the same given CPC’s document placement rules (based on the entire disclosure).
- AIPLA commends the IP5 Report for including a wealth of information explaining the Unity of Invention practices of the IP5 Offices. However, more study should be made as to how to converge these practices in the application of the Unity of Invention standard to provide greater uniformity and consistency

while giving applicants safeguards against unreasonable application of Unity of Invention that differentiates by field of technology.

2. Citation of Prior Art

- As stated in the "Industry IP5 Proposals," the IP5 Offices should adopt an automatic, electronic Prior Art Citation practice, whereby prior art that is already cited with respect to the application or its foreign counterpart application in any IP5 Office, and is available to an Office in the Global Dossier system, does not need to be further cited by applicants to that Office, and all duties and obligations of disclosure shall be deemed satisfied. Examiners should be required to consider any such prior art.
- The need to submit to an Office references that are already of record and in electronic form accessible by that Office should be eliminated.
- AIPLA finds that the Report's Section III, "Potential Barriers and Possible Solutions," provides many constructive proposals that should be adopted.
- The Global Dossier, also known as One Portal Dossier (OPD), and Common Citation Document (CCD) should be designed for Examiners to be able to automatically get search reports and the cited references with machine translations into their native language such that there should be no need for applicants to provide such search reports and references to the IP5 Offices.
- There should be no need to provide copies of foreign patent references to an Office, at least where they are in a native language of that Office or where machine translations are readily available via the Global Dossier system. Where a machine translation is not available, the Examiner should have the opportunity to suggest that applicants provide a translation if they want the reference considered by the Examiner.
- Machine translations should be improved to be easier for Examiners to use. AIPLA suggests making a single machine translation document that contains specification, claims, abstract and drawings. Current translations, which place different parts of a reference in different documents, are not user-friendly. They also should be formatted for ease of use. Some Offices provide machine translations in very small type font making them difficult to read. Others provide machine translations with too much line space, resulting in documents that are much longer than necessary.
- A common citation form should be encouraged for use by all IP5 Offices.
- AIPLA suggests, as a short term goal, that the USPTO consider revising 37 CFR to no longer require Information Disclosure Statements (IDSs) where there are readily available copies of foreign patent references and their machine translations for applications covered by the IP5 Offices in the Global Dossier system.

3. List of Terminology on Written Description

- The listing of terminology on Written Description/Sufficiency of Disclosure is a good starting point by the IP5 Offices.

- AIPLA looks forward to learning how the IP5 Offices plan to further develop this initiative.
- Consistent with the Industry IP5 Proposals, AIPLA urges the IP5 Offices to take an initial narrow approach, such as a pilot project and office-specific analysis, as described in the Industry IP5 Proposals.
- AIPLA also recommends that the IP5 Offices handle this initiative by applying best practices. This should balance what is fair and reasonable for applicants with what provides adequate notice to the public. Artificial, arcane, and academic written description/sufficiency of disclosure restrictions unnecessarily cause applicants to lose rights while providing little benefit to the public. For example, it is often unreasonable not to allow a claim to a novel and non-obvious compound because (a) it was only initially claimed as part of a genus of compounds that embraces inoperative or obvious species, and (b) there is allegedly no support to amend the claim to delete the inoperative or obvious species.
- The Offices should consider what a particular description of the application, or its priority document in the event of incorporation by reference, means in the language of its home country. This would involve considering what the original description means in its native language when examining an application translated into another language. However, this could also involve modifying the understanding of an English text from U.S. practice to EPO practice, rather than reading it literally. For example, a U.S. applicant might say "in an embodiment the invention has a particular feature" but not otherwise limit the embodiment. The U.S. applicant is generally describing "the embodiment" as all embodiments of the invention combined with that particular feature and any other non-conflicting features described in the application. It would be the applicant's burden to explain to the Examiner the meaning in the event an issue arises during examination.

4. Conclusion

AIPLA congratulates the IP5 Offices for their work on these important subjects and looks forward to further progress on these initiatives and the opportunity to participate as these projects further progress.

Sincerely,



Denise W. DeFranco
President
American Intellectual Property Law Association (AIPLA)