

April 26, 2016

VIA e-mail: nomura-kazushi@jpo.go.jp

Mr. Tatsuo Takeshige
Chair of the Workstream on Prior User Rights
Group B+ Subgroup on Harmonization
Japan Patent Office

**Re: Comments to PUR Workstream Paper from JPO dated
April 22, 2016**

Dear Mr. Takeshige:

AIPLA thanks the Japan Patent Office for the opportunity to provide comments to the Draft of Paper of Prior User Rights B+ Sub-Group on Patent Harmonization Workstream on Prior User Rights Revised on April 22, 2016

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

We appreciate that this draft paper took into account our comments submitted on April 14, 2016, and thank the JPO for these revisions.

NOTE: This set of comments from AIPLA is subject to review of all elements of Patent Harmonization as a full package, which review would then be subject to the final approval by the Board of Directors of AIPLA.

We ask the JPO to consider the inclusion in the next iteration of this paper of the following clarifications:

- 1) An explicit statement that, for clarification purposes, when the term "actual use" is referenced in connection with establishing prior user rights, such "actual use" does not rise to the level of prior art as to the claimed invention.

Explanation for the above statement: Any interpretation otherwise would result in the possibility of such prior art serving to invalidate the later filed patent application, in which case everyone can make use of the invention, and prior user rights are then no longer applicable to such a situation.

- 2) An explicit statement that, while the Industry Trilateral may have reached “consensus” (not agreement) on certain issues and elements associated with prior user rights in the effort to build a substantive patent harmonization package, it should be emphasized that the negotiated elements have NOT received final approval: Alignment resulting from the Industry Trilateral continues to be subject to review of all elements as a full package, and subject to the final approval by the competent bodies of each Industry Group Organization.

Explanation for the above statement: We are concerned that throughout the draft paper, the phrase “IT3 agreed” was often used, with no caveat that there has been no explicit agreement, but rather the discussions among the IT3 enable the reaching of “consensus” with reservations for each organization to review the entire package at a later time and also subject to final approval through the governance process of each respective organization.

AIPLA looks forward to further discussions on Prior User Rights as part of the Industry Trilateral, and continuing to move forward with Harmonization efforts.

Respectfully submitted,



Denise W. DeFranco
President
American Intellectual Property Law Association