

11 Research and Study on Applicant's Rights and Duties in Patent Application Procedures

Different countries and regions of the world use different patent systems. Hence, the patent application procedure, which is the first step of the process for obtaining patent rights, differs according to the country or region.

This research and study has two aspects: one which is focused on the U.S. provisional application system and similar systems in terms of the applicant's rights, and one which pertains to duty of information disclosure from the standpoint of responsibilities of applicants.

The provisional application system is noted as being an applicant-friendly system that allows applicants to be entitled to application date in a simpler, less-expensive way. Several of universities in Japan are very interested in this type of system. The first aspect of this research and study is therefore directed to sound the feasibility of introducing this type of system into the Japanese patent system.

The IDS (Information Disclosure Statement) system that is now being used in the U.S. is also notable as being an effective measure that accelerates examination while ensuring adequate examination. The research therefore also concerns the feasibility of introducing such an information disclosure system into the Japanese patent system.

I The Applicant's Rights

1 Outline of Provisional Application System in the U.S.

(1) Background and Purpose of the Legislation

The provisional application system now legislated in the U.S. was enacted for the purpose of preventing any inequity that U.S. citizens as national applicants may suffer as a result of enactment of the 1995 GATT/Trips agreement.

The Uruguay Round Agreements Act has brought about a significant change in U.S. patent practice: namely, the Act states to the effect that the new 20-years term from filing applies to patents filed on or after June 8, 1996, instead of the old 17-years term from issuance. This change created an inequity between U.S. citizens and foreigners in regard to claiming of priority for U.S. patent applications. More specifically, when a foreign applicant has filed a patent application with the USPTO, claiming priority under the Paris Convention of an application filed in a first country other than the U.S., the term of any patent derived from this application expires after 20 years from the filing date of the U.S. patent application with the USPTO rather than from the filing date in the first country. In countries having an internal priority system such as Japan, when a later application is filed claiming an internal priority of an earlier application, the term of the patent derived from the later application is counted from the filing date of the later application. Such priority systems offer the following advantages. Firstly, a foreign applicant can file a later U.S. application which consolidates a plurality of earlier national applications filed in

the first country within the previous one year of filing of the later U.S. application, claiming priorities under the Paris Convention of these earlier national applications. This allows the applicant to protect an invention in a comprehensive manner so as to cover all possible aspects and forms of the invention. Secondly, if a U.S. application is filed on a day close to the end of the term of the priority under the Paris Convention, the right of any patent derived from this U.S. application is set to expire after 20 years from the filing date of the application with the USPTO. Thus, the applicant can effectively enjoy a one-year extension of the term of the patent right. U.S. citizens who file patents with the USPTO cannot enjoy this advantage because there is no internal priority system in the U.S. Discussions have therefore begun to introduce into the U.S. patent system a system similar to the internal priority systems used in some other countries. The provisional application system in the U.S. has been legislated under such circumstances in order that, when a nonprovisional application is filed with the USPTO based on an earlier provisional application, the term of a patent derived from such applications is commencing from the filing date of the nonprovisional application rather than from the filing date of the provisional application.

The provisional application also meets the demand for an easier and inexpensive patent filing system by relieving applicants of the burden of making complete filing documents.

(2) Revision of U.S. Provisional Application System

The American Inventor's Protection Act (abbreviated to AIPA) of 1999 was enacted on November 29, 1999, effecting revisions to the

provisional application system regarding the following three points.

① Automatic extension of deadline

When any deadline set for a provisional application is a day on which the USPTO is closed, the deadline shall be automatically extended to the earliest forthcoming day on which the USPTO is open.

② Abolishment of "co-pendency" requirement

A nonprovisional application filed within 12 months from the filing date of a provisional application can claim priority of such a provisional application corresponding to the nonprovisional application, even if the provisional application has been explicitly abandoned before the filing of the nonprovisional application.

③ Conversion from provisional application to nonprovisional application

Conversion of a provisional application into a nonprovisional application is now possible. This provision is a legal technical measure, rather than a practically effective measure, for dealing with an existing question as to whether a provisional application should be deemed to be an application under Paris Convention. Therefore, this revision has no practical effect.

(3) Outline of the Provisional Application System

The procedural requirements are as follows:

(i) Subjective requirements

Each provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application (37 CFR § 1.78(a)(3)).

(ii) Objective requirements

① The object of the disclosure, i.e., an invention, disclosed in the later filed nonprovisional application should be identical to that of the provisional invention(s). More practically, technical matter claimed in the nonprovisional application must be disclosed in the provisional application(s) in a manner satisfying the requirements of 35 U.S.C., § 112. Thus, multiple priorities and partial priorities are available also in the provisional application system (37 CFR § 1.78(a)(3)).

② The provisional application system applies to applications filed on or after June 8, 1995.

③ The provisional application system does not apply to design patents (35 U.S.C. § 172).

(iii) Period requirements

Any nonprovisional application claiming priority of a provisional application shall be filed within 12 months from the filing date of the provisional application. After the 12 months, the provisional application shall be regarded as being abandoned. In case of a lapse of this period, the provisional application cannot not be subjected to revival (35 U.S.C. § 111b(5), 37 CFR § 1.137(e),

and MPEP § 201.04(b)). As explained above, if the USPTO is closed on the day of the deadline, the 12-month period is automatically extended to expire on the earliest forthcoming business day of the USPTO.

(iv) Procedural requirements

① In order that a provisional application is entitled to a filing date, the applicant must submit a specification which meets the requirements of 35 U.S.C. § 112 and, when necessary, drawings, otherwise the retroactive effect cannot be produced. No amendment may be made to a specification submitted under the provisional application system.

The specifications of provisional applications need not be accompanied by claims, although applicants are free to submit claims with the specifications.

② Other requirements are submission of a cover sheet identifying the application as a provisional application and identifying also the name(s) of the inventor(s), and the prescribed filing fee. These requirements may be fulfilled after filing of the provisional application.

③ Documents which are not needed in provisional applications are oath of the inventor(s) or declaration in lieu of oath, IDS (Information Disclosure Statement), and so on. These documents may be submitted with nonprovisional applications.

④ Provisional applications is not entitled to the right of priority of other applications (37 CFR 1.53(c)(4)). It is assumed that a provisional application will be followed by a nonprovisional application and, hence, the provisional application is effective only as the basis of priority for the later filed nonprovisional application. Like nonprovisional applications, a license for a foreign application is necessary when a patent application for an invention made originally in the U.S. is first filed in a country other than the U.S. prior to filing of a provisional application with the USPTO.

(4) U.S. Provisional Application System vs. Priority under the Paris Convention

Provisional applications are treated as U.S. domestic applications and, therefore, are entitled to the following advantages over U.S. patent applications claiming priority under Paris Convention of applications filed in other countries.

(i) 35 U.S.C. § 102(b)

So-called "on-sale bar" is cleared if a provisional application is filed within one year from the date on which the invention was put on sale or made available to the public. A U.S. patent application claiming priority under Paris Convention of an application filed in other country within one year from the date of "on-sale" and within the previous one year of the U.S. filing date cannot clear such "on-sale bar".

(ii) 35 U.S.C. § 102(e)

A provisional application provides an effective measure to avoid the Hilmer doctrine in regard to the exclusion of later filed applications.

More specifically, a provisional application as a U.S. domestic application does not come under the Hilmer doctrine, so that the effect to exclude later filed applications is valid as of the filing date of the provisional application. The revision of the U.S. Patent Law of November, 1999 introduced system of laid-open publication into the U.S. patent system. The above-mentioned effect to exclude later filed applications also applies to the disclosures of U.S. patent applications published under this new system.

(iii) 35 U.S.C. § 102(g)

The applicant can also clear the bar of 2nd Hilmer Case regarding 35 U.S.C. § 102(g) by filing a provisional application. Enforcement of 35 U.S.C. § 135 concerning interference may also be avoided if a claim is included in the provisional application.

(5) Advantages of the Provisional Application System

(i) From the standpoint of applicants

From the standpoint of applicants, the U.S. provisional application system is expected to offer the following advantages.

① Material extension of term of patent right

The term of a patent is not counted from the filing date of a provisional application but from the filing date of a nonprovisional application which follows the provisional application. It is therefore possible to materially extend the term of the patent right by at most one year, by filing the nonprovisional application just before the expiration of the prescribed period.

In addition, the applicant of a provisional application is authorized to mark "Patent Pending".

② Easier and inexpensive application procedure

The filing fee for provisional applications is significantly lower than that for patent applications. Payment based on the number of claims submitted is also unnecessary. The workload of preparing patent application documents, as well as costs, is appreciably reduced as compared with patent applications, because claims may be omitted.

③ Translation unnecessary

Provisional applications with documents written in a language other than English is also acceptable and translation is unnecessary until a nonprovisional application is actually filed. By way of example, a Japanese applicant can be entitled to a filing date by filing a provisional application with

the USPTO in Japanese language and can then carefully consider whether to file a nonprovisional application to obtain a patent right. The cost of translation will not be incurred if the applicant decides to abandon the case.

④ Multiple priorities / partial priority

A nonprovisional application may claim priorities on a plurality of earlier provisional applications, provided that the filing date of the nonprovisional application is within one year from the filing date of the earliest provisional application. The applicant can thus enjoy the same advantage as that of multiple priorities.

The applicant can prepare a consolidated specification for the nonprovisional application by fully incorporating possible aspects and forms of the invention in addition to the disclosure of the provisional application, claiming priority from the provisional application to enjoy the advantage of so-called partial priority in which the filing date is retroactively considered to be the filing date of the provisional application only for features which were disclosed in the provisional application. These advantages are almost the same as those offered by the internal priority system used in Japan.

⑤ Deferral of examination

Provisional applications are not subjected to examination. This gives applicants an almost one-year period to enable them to carefully determine whether to proceed with the applications, by researching marketability and technical trends of the invention of the provisional applications, while attempting to find financial support and licensees. In addition, applicants are still free from the obligation of submitting IDS.

⑥ Claim drafting unnecessary

The current decision of the CAFC (Court of Appeals for the Federal Circuit) on the Festo case (*1) holds that any restrictive amendment effected by an applicant in the course of prosecution disclaims features excluded as a result of such an amendment. Consequently, the applicant as a patentee can no more rely upon the doctrine of equivalents when attempting to institute a lawsuit against infringement by other parties. In view of this fact, it is recommended that an applicant of a provisional application conducts a prior art search after filing the provisional application and, when filing a nonprovisional application, submits claims which are carefully and adequately worded in light of the results of the search so as to avoid application of this new holding.

⑦ Strategic use of provisional application system

The provisional application system enables

(*1) Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F. 3d 558, 56 USPQ 2d 1865 (Fed. Cir. 2000).

applicants to take the following two strategic measures (a) and (b).

(a) Material extension of term of patent right

An applicant who has filed a patent application in the normal way and received an Office Action within 12 months from the filing date can convert this application into a provisional application and then file a nonprovisional application based on this provisional application. When this nonprovisional application is allowed for registration, the term of the patent right is counted from the filing date of the nonprovisional application. The applicant can therefore enjoy a material extension of the term of the patent right.

(b) Selective extension of period of claiming priority under the Paris Convention

Allegedly, an applicant who has filed a plurality of provisional applications having different filing dates can select any of these filing dates as the date from which the period of 12 months commences.

It is also said that an applicant can file a provisional application and then file another provisional application that deals with the same technical subject matter with enriched disclosure, even after abandonment of the earlier provisional application. It is alleged that, when such a series of provisional applications have been filed, the applicant can claim a priority under the Paris Convention on either of these provisional applications. This measure, if true, would enable applicants to materially extend the period of claiming priority under the Paris Convention. At the present stage, however, whether such a strategic measure is valid or not has not yet been legally established.

This should be contrasted with the Japanese internal priority system in which co-pendency of earlier and later applications is an essential requisite.

(ii) From the standpoint of the USPTO

A provisional application system will enable potential applicants to file patent applications more easily than ever. If majority of provisional applications are converted to nonprovisional applications, the number of patent applications is expected to grow significantly.

(6) Disadvantages of the Provisional Application System

(i) From the standpoints of applicants

① Delay of examination

Substantive examination does not start unless a nonprovisional application is filed. Thus, the examination is delayed corresponding to the period until the nonprovisional application is filed.

② Necessity of filing nonprovisional application

The applicant cannot be entitled to a patent based on a provisional application alone. Filing a nonprovisional application is essential for

obtaining a patent right. In this respect, the cost is undesirably increased by the work of preparing and filing a provisional application in comparison with filing a non-provisional application alone.

③ Necessity of deadline control

Any provisional application is regarded as being abandoned unless followed by a nonprovisional application filed within 12 months of the filing date of the provisional application. A system for recording and observing deadline is therefore necessary to prevent lapse of this period.

④ Restrictions on provisional applications

Amendment of provisional application is not allowed, except for prescribed formality amendments (37 CFR § 1.53(c)).

(ii) From standpoint of the USPTO

From the standpoint of the USPTO, no particular disadvantage seems to be incurred by a provisional application system. It is to be noted, however, that the examiners may be required to confirm whether claims of a nonprovisional application are supported in a manner set forth in 35 U.S.C. § 112, if needed during examination. In addition, examiners may be troubled by an increase in the number of files to be handled.

(7) Allowability of substitution by academic paper

The answer to the question as to whether an applicant can substitute an academic paper for the specification of a provisional application is that retroaction to the filing date of the provisional application is possible if the academic paper supports the claims of nonprovisional application in a manner set forth in 35 U.S.C. § 112. In other words, any academic paper which is used in lieu of the specification of a provisional application must meet the requirements of 35 U.S.C. § 112.

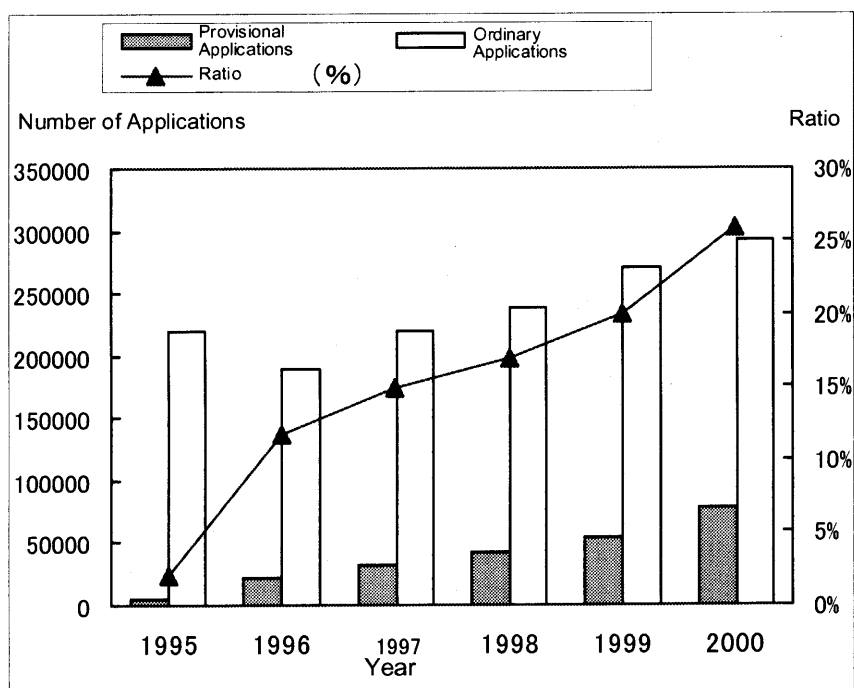
(8) Future prospects

At the present stage, no revision of the Laws and Rules pertaining to the provisional application system seems to be planned or expected. In order to cope with the demand for a simplified application procedure, maintaining the running system is considered to be necessary and feasible.

2 Actual Situation of Use of the Provisional Application System in the U.S.

There is no official report concerning the number of provisional applications. An investigation, however, was conducted by a U.S. law firm, which revealed the data shown in Fig. 1. The ratio of the number of provisional applications to the number of ordinary applications is noticeably high as compared to the ratio 5% of the number of Japanese applications claiming internal priority to the total number of Japanese applications.

Fig. 1 Numbers of Ordinary Applications and Provisional Applications



Tables 1(a) to 1(c) ^{(*)2} show the tendency of patent registrations based on provisional applications. By nationality of applicants, it can be seen that the rate of use of provisional applications is high, especially for applicants in the U.S., as well as those in Canada. By type of

applicants, universities show a relatively high rate of use of the provisional application system. The attitude towards the use of the provisional application system differs significantly depending on manufacturers.

Table 1(a) Use of Provisional Application System By Nationalities of Applicants (2000)

Applicants' nationalities	Number of patents based on provisional applications / Total number of patents
United States of America (US)	12.0%
Canada (CA)	12.4%
United Kingdom (GB)	2.5%
Germany (DE)	0.8%
France (FR)	1.4%
Japan(JP)	0.3%
South Korea (KR)	0.7%
Taiwan (TW)	0.7%
Australia (AU)	2.0%
World Average	7.4%

(*)2 Numerical values in these Tables show ratios of the number of patents which were derived from applications filed on or after June 8, 1995 claiming priorities on provisional applications to the total number of patents derived from all applications in the same period.

Table 1(b) Ratio of Number of Patents on the Basis of Provisional Applications to Total Number of Patents Assigned to U.S. Companies

Companies(US)	Number of patents based on provisional applications /Total number of patents
International Business Machines Corporation	2.7%
Lucent Technologies, Inc.	7.6%
Motorola, Inc.	1.1%
Eastman Kodak Company	1.8%
Intel Corporation	0.9%
General Electric Company(GE)	5.5%
Texas Instruments Incorporated (TI)	55.1%
Xerox Corporation	3.5%
Minnesota Mining and Manufacturing Company (3M)	2.7%
The Procter & Gamble Company (P&G)	17.5%
Sun Microsystems, Inc.	4.2%
Applied Materials, Inc.	1.8%
Caterpillar Inc.	7.2%
E. I. Du Pont De Nemours and Company	41.6%
Microsoft Corporation	6.6%

Table 1(c) Ratio of Number of Patents on the Basis of Provisional Applications to Total Number of Patents Assigned to U.S. Universities

Universities	Number of patents based on provisional applications /Total number of patents
University of California	28.3%
University of Florida	30.2%
Stanford University	29.3%
Harvard University	16.7%
Massachusetts Institute of Technology (MIT)	31.0%

3 Provisional Specification Filing System in the United Kingdom

(1) Provisional Specification Filing System under 1949 Act

(i) Purpose of the system

Prior to 1852, the UK patent system granted a patent on an application which specified only the "Title of the Invention". Thus, the applicants had no obligation to submit patent specifications when filing patent applications, although the applicants had to submit specifications by the time of issuance of the patents.

The 1852 Act stated to the effect that the inventors were required to file a "provisional" specification or a "complete" specification when filing a patent application. This requirement was

succeeded in the 1949 Act.

The provisional specification filing system of the 1852 Act and the 1949 Act was primarily intended to enable inventors to improve and complete their inventions in the interim between the filing of a patent application based on a provisional specification and the submission of a complete specification.

(ii) Features of provisional specification filing system

The 1949 Act stated to the effect that patent applications under this Act were divided into two types: Convention Applications and Non-Convention Applications. This Act prescribed that either a provisional specification or a complete specification could be submitted in a Non-Conventional Application, whereas a

Conventional Application essentially required a complete specification. A provisional specification was required only to disclose the content of an invention, and was not required to be accompanied by drawings and claims.

Any application based on a provisional specification was regarded as being abandoned unless followed by a complete specification filed within 12 months from the filing date of the provisional specification. The patent application was examined based on the complete specification.^(*3)

(iii) Outline of the application procedure

In order for a patent to be entitled to the priority date on the filing date of a provisional specification, it was necessary that the claims of such a patent were "fairly based" on the content of the disclosure of the provisional specification (Section 5, Para. 2 of 1949 Act).

For instance, a claim attached to a complete specification, more distinctively and more restrictively claiming an invention disclosed in a preceding provisional specification in a more generic form, was not regarded as failing to meet the "fairly based" requirement for that reason (Decision on Glaxo's Application).

(iv) Requirements for deciding filing date

① A provisional specification must describe an invention and must be headed by a title of the invention which indicates the subject matter of the invention (Section 4, Para 1 of 1949 Act).

The disclosure of a provisional specification must include: (a) a description of the general nature of the invention, (b) the field to which the invention is applicable, and (c) the expected results of the invention. A provisional specification can omit a description of any practical method of carrying out the invention and a description of the advantages, if the general nature of the invention is fully disclosed in the provisional specification.^(*4)

② Omission of Drawings

A provisional specification need not always be accompanied by drawings, although the Commissioner of the U.K. Patent Office reserves the right under Section 4 para. 2 to request an applicant to submit drawings together with a provisional specification whenever necessary.

③ Any provisional specification should be in accordance with Form 1 (Section 9 of Patent Rules).

④ Language

Any provisional specification must be written in English. (Section 5 of 1958 Patent Rules)

⑤ Declaration^(*5) unnecessary (Section 4, Para.

5 of 1949 Act, Section 11 of Patent Rules)

(v) Matters concerning submission of complete specification following application with a provisional specification

① A complete specification must be submitted within 15 months (inclusive of 3-month extension) from the filing date of an application with a provisional specification. An additional extension of up to 6 months is available upon request submitted within the above-mentioned 15-month period.

② It seems that examiners were not responsible for confirming fulfillment of the requirement for complete specification "fairly based" on the provisional specification (Section 7, Section 8 of 1949 Act).

(vi) Statistics on applications with provisional specifications

The state of use of the provisional specification filing system is not clear, since no formal statistical data concerning applications under the provisional specification filing system could be confirmed.

(2) Patent Application System Under the 1977 Act

(i) Issues in Parliament in legislating new patent application system

① Conformance of the system in the U.K. with EPC and PCT

② Preservation of benefits offered to inventors under the 1949 Act

(ii) Requirements for establishment of filing date
The 1977 Act prescribes that an application is entitled to a filing date when the application contains the followings (Section 14(2) and Section 15(1)):

① the documents filed at the Patent Office contain an indication that the patent is being sought in pursuance of the application;

② those documents identify the applicant(s) for the patent;

③ those documents contain a description of the invention;

④ the filing fee (The filing fee has been set at zero since 1998).

Thus, submission of a claim is not essential.

Section 15(5)(a) of the 1977 Act and Section 25(1) of Rule, if not filed with the application, the claims and the abstract must be filed within 12 months after the filing date, or if priority is claimed, within 12 months after the declared priority date or 1 month after filing, whichever is later.

(iii) Advantages and disadvantages of the system

① Advantages

(*3) See Motoaki Hisaki, *Igirisu tokkyoseido no kaisetsu*, Hatsume Kyokai, 1983, pp 79-80.

(*4) See Motoaki Hisaki, *supra* note 3.

(*5) Declaration must be attached to complete specification.

- (a) From the standpoint of applicants
- * The U.K. Patent system is based on the “first to file” concept compared with the US “first to invent” concept. The U.K. patent application system allows an inventor to obtain a priority date without the need to fulfill all of the formal requirements of drafting a full application where he is concerned that competitors might be researching and close to solving the same problem.
 - * The U.K. application system can be used as an effective measure for securing a priority date in a short time.
 - * The U.K. application system, which does not require submission of a claim at the time of filing of an application, makes it possible to establish a priority date prior to the determination of the scope of the exclusive right which is limited by claims.
 - * Applicant can file an application without incurring the expense of instructing a professional agent.
 - * Applicant may later decide whether or not to pursue the application at their convenience after filing the application.
- (b) From standpoint of the UK Patent Office
- Potential applicants are encouraged to file patent applications. Thus, an increase in the number of patent applications is expectable.
- ② Disadvantages
- (a) From the standpoint of applicants
- * Even though a filing date for an application can be obtained, the application will not be useful unless it can support valuable claims on basis that the information contained in it is sufficient to enable one skilled in the art to practice the invention.
- (b) From the standpoint of the Patent Office
- * Additional work is necessary to deal with applications filed under the simplified application system.
 - * Additional work is necessary for examining later-filed complete specifications in addition to the application filed under the simplified application system.
- (iv) Use of academic papers to file patent application
- The homepage of the U.K. Patent Office contains a recommendation entitled “Use of academic papers to file a patent application”. Actually, however, almost no application has been found based on an academic paper.
- (v) Statistical data concerning use of this system
- The state of use of this application system is not known, as no statistical data seems to have

been published in this connection.

4 Feasibility of Introducing Provisional Application System in Japan

(1) Comparison with Japanese Internal Priority System

A discussion will be made in this section on the feasibility of introducing a system similar to the provisional application system used in the U.S. and the simple application system adopted in the U.K. (collectively referred to as a “provisional application system”). The discussion essentially needs, first of all, a comparison between the provisional application system and the internal priority system now used in Japan. In particular, the discussion should be focused on how the Japanese internal priority system facilitates the procedure for securing the benefit of a filing date. However, almost no study has been made in Japan on this issue, both judicially and theoretically. Thus, the answer to this question is still uncertain.

In order that an internal priority is claimed under the Japanese Patent Law, it is necessary that the following requirements be met:

- ① An earlier application is pending at the JPO.
- ② The applicant of the later application is the same as that of the earlier application.
- ③ The later application is filed within one year from the filing date of the earlier application.
- ④ The earlier application is not a divisional or a conversion from another application.^(*6)

The major point of difference between the Japanese internal priority system and the provisional application system lies in the fact that the latter does not essentially require any claim to be submitted at the time of filing of a provisional application. A question therefore arises as to whether the Japanese internal priority system, in connection with the requirement ① above, affords the benefit of the filing date of the earlier application when such an earlier application without drawing claims.

Section 15.20 of the JPO Formality Examination Manual to “dismissal of proceedings based on illegal application document”. It is understood from the statement of this section that omission of claims from an application document does not constitute a reason for dismissal. Thus, any application which is not accompanied by a claim will not be dismissed but will be held pending at the JPO. The omission of a claim is then regarded as being a deficiency that can be corrected by an amendment (Art. 17 of Japanese

(*6) Art. 41 of Japanese Patent Law. See Nobuhiro Nakayama, “Kogyo syoyuken ho (jou) Tokkyo ho” Kobundo, 2nd Edition, Revised Version, 2000, pp 194-195.

Patent Law). Therefore, the deficiency is corrected if a claim is submitted by the applicant in due course, so that the application can be relied upon as the basis for a priority. The benefit of the filing date is construed to be derivable also from an application which is not accompanied by any claim.

Whether this construction is correct still remains in question because, as stated before, full discussion in this regard has not yet been made in Japan, either judicially or theoretically. Nevertheless, under the law in force, the above-described construction seems to be only one persuasive conclusion, insofar as an application lacking a claim is not regarded as being an object of dismissal.

The foregoing discussion may lead to an expedient of using the presently operative internal priority system by filing a patent application without any claims, since the benefit of filing data is obtainable even with such an application. Should the case be so, the Japanese internal priority system is discriminated from the provisional application system of other countries, i.e., the provisional application system in the U.S. and the simple application system of U.K, solely by the period in which an applicant is required to submit a claim. More specifically, under the Japanese internal priority system, an applicant is allowed to submit a claim at any time in due course, whereas the U.K. simple application system and the U.S. provisional application system require that a claim be submitted within 12 months and 16 months, respectively, from the filing date.

The application on which internal priority is to be claimed must have been filed in the Japanese language or in English (Art. 36(2) of Japanese Patent Law, Art. 25(4) of Regulations under the Patent Law). When the application has been made in English, the applicant has to submit a Japanese translation within 2 months from the filing date (Art. 36(2) of Japanese Patent Law). This system is much less friendly to applicants than the U.S. provisional application system which allows the applicants to file provisional applications in any language and which affords a period of 16 months from the filing date for the submission of a translation.

(2) Methodology of Introduction of New System

As will be clear from the foregoing discussion based on the comparison with the U.S. provisional application system and the U.K. simplified application system, the use of the Japanese internal priority system for the purpose of obtaining the benefit of a filing date by filing an application without any claims is nothing but an expedient measure. Therefore, the introduction of a new application system which would explicitly

and legally support such a measure should be considered.

In this regard, Section 5 of Patent Law Treaty of the WIPO (World Intellectual Property Organization) prescribes that the benefit of filing date is obtainable when an application document meets the following three requirements:

- ① The document contains an explicit or implicit indication of being a patent application.
- ② The document contains indication which enables confirmation of the identity of an applicant or communication with an applicant.
- ③ The document has a portion which is seemingly regarded as being a patent specification.

Theoretical studies and discussions, including discussions as to whether Japan should adopt the Patent Law Treaty, are considered to be necessary, in order to clarify the minimal requirements for enabling applicants to obtain the benefit of filing date. Hopefully, such studies and discussions will provide a basis for stepping toward the establishment of a provisional application system in Japan.

II Duties of the Applicant

1 Outline of Information Disclosure System

(1) History of the System

- (i) The duty of information disclosure was not a duty that was originally prescribed by statute or rule, but was a duty that was accepted under case law. (*Kingsland v. Dorsey*, 338 U.S. 318 (1949), *Precision Instrument Mfg. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945))
- (ii) Up to the 1950s, there was a predominant understanding that the content to be disclosed in compliance with the duty of disclosure was limited to any prior art which would anticipate the claimed invention. Then, in the period up to the 1970s, decisions were made to require "uncompromising candor and good faith" and the "highest degree of bona fide", resulting in an expansion of the duty of information disclosure.
- (iii) The result of failure to comply with this duty was unenforceability of a patent.

(2) Establishment of Provisions Regulating Duty of Information Disclosure (1977 Revision of 37 CFR § 1.56)

(i) Background

In the 1970s, Congress discussed the introduction of a statutory rule which would impose on applicants a duty to submit a list of all kinds of information which are "reasonably considered to be possible to affect the PTO's decision" and which were considered by the

applicant when filing. As a result, in March 1977, the USPTO accepted a draft of revisions to 37 CFR § 1.56 which prescribed the “reasonable examiner” standard in regard to the “materiality” of information.

(ii) The 1977 revision is outlined below.

① Regarding 37 CFR § 1.56

“(a) All such individuals have a duty to disclose to the Office information they are aware of which is material to the examination of the application. Such information is material where there is a substantial likelihood that reasonable examiner would consider it important in determining whether to allow the application to issue as a patent.”

“(b) An application shall be stricken from the files if it is established by a clear and convincing evidence that fraud was practiced or attempted on the Office in connection with it or that there was any violation of the duty of disclosure through bad faith or gross negligence.”

② Regarding 37 CFR § 1.97

“(a) As a means of complying with the duty of disclosure set forth in § 1.56, applicants are encouraged to file a prior art statement at the time of filing the application or within three months thereafter.”

③ Regarding 37 CFR § 1.98

“(a) Any statement filed under § 1.97 or § 1.98 shall include: (1) A listing of patents, publications, or other information, and (2) a concise explanation of the relevance of each listed item. The statement shall be accompanied by copies of each listed patents or publications or other item of information in written form or of at least portions thereof considered by the person filing the statement to be pertinent.”

“(b) When two or more patents or publications considered material, a copy of a representative one may be included in the statement and others merely listed. A translation of pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant.”

(3) Revision History of IDS-Related Rules

(i) Point of 1982 Revision

The Rules were changed as follows:

① Claims are rejectable when it has been proved that fraud was practiced or attempted on the USPTO or when the duty of disclosure was violated through bad faith or gross negligence. (37 CFR § 1.56(d))

② The “fraud” and “gross negligence” bars were broadened by explicitly providing that any misconduct in the prosecution of examination of a continuing application or of the original application of a reissue application causes claims of such continuing application or reissued application be

rejected. (37 CFR § 1.56(d))

③ Investigation as to whether the duty of disclosure is fulfilled is conducted after all other issues in the prosecution of the application have been settled. (37 CFR § 1.56(d))

(ii) Point of 1983 Revision

The “prior art statements” was renamed “information disclosure statements”.

(iii) Point of 1988 Revision

The Rule was changed so that investigation for violation of the duty of disclosure will no longer be required unless any issue is raised in an examination conducted in interference or executed by the Office of Enrollment and Discipline in regard to any practitioner’s illegal conduct. This change reflects the decision of *In Re Harita*, 847 F.2d, 801 (Fed. Cir. 1988).

(iv) Point of 1992 Revision

① The definition of “information material to patentability” was changed as follows. (37 CFR § 1.56(b))

“(b) Information is material to patentability when it is not cumulative to information already of record or being made of of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.”

② Subjects of the Duty of Disclosure under 37 CFR § 1.56(c) are:

(a) Each inventor named in the application;

(b) Each attorney or agent who prepares or prosecutes the application; and

(c) Every other person who is substantially involved in the preparation or prosecution of the application and who is associated with the inventor, with the inventor, or with the assignee to whom there is an obligation to assign the application.

③ The “concise statement of relevance” requirement for explaining the relevance of submitted information was abolished, except for the cases of documents written in a language other than English. (37 CFR § 1.98(a)(3))

④ The prosecution was divided into four phases or categories, and different requirements were posed on different categories in regard to submission of information. (37 CFR § 1.97)

(v) Point of 2000 Revision

The Rules newly prescribed a duty for submission of a copy of a pending application mentioned in the IDS.

(4) Outline of Current IDS System

(i) USC, CFR, MPEP, and other legal

stipulations directly or indirectly to relevant IDS

* No particular article is provided in the statutory laws.

* Relevant sections of the regulations are as follows:

① 15 C.F.R. § 15 Commerce and Foreign Trade - Legal Procedure

② 37 C.F.R. § 1.56 Duty to Disclose Information Material to Patentability

③ 37 C.F.R. § 1.97 Filing of Information Disclosure Statement

④ 37 C.F.R. § 1.97 Content of Information Disclosure Statement.

* MPEP (Manual of Patent Examining Procedure) sets forth the followings:

① § 609 Information Disclosure Statement

② § 704 Search (Examination of Application)

③ § 1418 Information Disclosure Statement and Other Information (Reissue Application)

④ § 1893.03(g) Information Disclosure Statement in a National Stage Application (PCT Application)

⑤ § 1701 Office Personnel Not To Express Opinion on Validity or Patentability of Patent

⑥ § 1901.03 How Protest Is Submitted

⑦ Chapter 2000 Duty of Disclosure

⑧ § 2214 Content of Request (Reexamination)

⑨ § 2242 Criteria for Deciding Request (Reexamination)

⑩ § 2244 Prior Art on Which the Determination Is Based (Reexamination)

⑪ § 2280 Information Material to Patentability in Reexamination Proceeding

(ii) Procedure to be followed by applicant/agent

The procedure for an applicant or agent is stated in 37 C.F.R. § 1.97 and § 1.98. The basic concept of the statement is that later disclosure of information makes the applicant's procedures more difficult and costly.

(iii) Procedures at the USPTO

The IDS procedure at the USPTO is set forth in MPEP § 609.

The USPTO first considers information cited in an IDS to judge whether it meets the requirements under § 1.97 and § 1.98. If the IDS is found not to comply with the regulation, it is placed in the file wrapper without being considered by an examiner (§ 1.97(i)).

(iv) The Scope of disclosure

The scope that should be disclosed in an IDS is any information that is material. In this regard, the "reasonable examiner" standard is applied to applications filed on or before March 15, 1992, and the "prima facie case" standard is applied to applications filed on or after March 16, 1992.

(5) Handling of IDS at the USPTO^(*7)

(i) Relationship between search by examiner and IDS (IDS dependency)

The search performed by an examiner is independent of the IDS theoretically and practically.

The examiner is responsible for conducting research of the prior art (MPEP § 709), and further, the examiner is responsible for considering all information appropriately submitted in the IDS (MPEP § 609(2)).

(ii) Usefulness of information disclosed in IDS

The IDS is recognized as being considerably useful. In particular, information that is difficult for an examiner to obtain, such as search reports of a foreign counterpart application and materials distributed at conferences, is often useful for consideration in examination.

(iii) Ratios of known patent publications, known non-patent documents, foreign documents, and publicly unknown references (prior applications)

A 1999 survey of the USPTO shows that the ratio between U.S. patents, foreign patents, and nonpatent literature cited in IDS statement 57.26%, 25.53% and 17.20%. The ratio of the foreign patent publications varies depending on the nationalities of the applicants.

(iv) Actual situation of consideration of information and materials cited in IDS

In principle, all information must be considered, however, an examiner can spend only 18 to 20 hours on each application. In reality, this may result in insufficient time for each piece of information to be carefully considered, especially for an IDS containing an enormous amount of information.

(v) Control/use of IDS information for examination of other applications

IDS information is rarely used for examination of other applications.

(vi) Actual situation of use of foreign language materials as IDS information

Until now, foreign language materials have been considered within the scope understood by the examiner. Even if some information has been left untranslated, the examiner can still obtain important information from drawings or chemical formulas in foreign language materials. Naturally, unless full-text translation is available, it is impossible to consider non-English information to the same degree as information written in English.

(vii) Necessity/usefulness of translation for foreign documents (full-text translation, partial translation, abstract)

(*7) Note that this comment is not an official comment of the USPTO but is a comment by a U.S. law firm.

Any non-English language information must be accompanied by a concise explanation of relevance.

There is no requirement for a translation of a foreign document to be submitted, unless a copy of the translation is within the possession, custody, or control of a designated individual. While submission of a full-text translation is not required, some advantages of submitting a full-text translation are noted over submitting a concise explanation of relevance, partial translation, or abstract. For example, submitting a full-text translation can avoid the risk, in a later possible litigation, of being bound by interpretation about the disclosed content of a foreign document stated by the applicant in a concise explanation of relevance, or being attacked for deceiving the USPTO by intentionally excluding translation of a critical part of the document. However, in practice, a full-text translation is often not submitted for cost considerations.

(viii) Handling by the USPTO of possible violation of duty of disclosure at examination phase

The examiner does not issue any objection for the reason that the duty of disclosure has been violated, even if the examiner considers that an application fails to comply with the disclosure requirements at the examination phase.

(ix) Handling by the USPTO of possible violation of duty of disclosure in a reissuance, reexamination, or interference procedure

In a reissuance or reexamination procedure, no IDS is considered, although there are some exceptions, whereas an interference procedure may consider a violation of duty of disclosure.

(x) Practical or legal problems of current system viewed from the USPTO

It has been noted that there is an increase in the burden on the examiners due to large amounts of information being submitted with IDS.

(6) Handling in Litigation

(i) Violation of duty of disclosure in litigation

In an infringement litigation, violation of the duty of disclosure such as failure to submit an IDS provides a basis for a defendant's unenforceability defense due to inequitable conduct.

(ii) Even publicly known information that was submitted in IDS and already examined can be used for proving invalidity of a patent. However, proving any invalidity based on such information is difficult because of presumption of patentability and the presumption of due completion of the examiner's duty.

(iii) Effectiveness of unenforceability defense based on plaintiff's violation of duty of disclosure and effectiveness of invalidation defense based on non-disclosed fact, in

infringement litigation for infringement of patent suspected of violation of duty of disclosure

The unenforceability defense based on violation of the duty of disclosure and the invalidation defense are related to each other but may be separately relied upon by the plaintiff.

① Method of designating unenforceability of a patent due to inequitable conduct

(a) The prior art and the related information must be material.

(b) The applicant recognizes materiality of such prior art or information.

(c) The applicant fails to disclose the art or information with the intention to deceive the USPTO.

Of these, (a) "materiality" and (c) "fraudulent intention" need to be established by clear and convincing evidence. If these are established, the court weighs inequitable conduct while considering other conditions to judge whether the inequitable conduct is sufficiently culpable to invalidate the patent.

② Gathering evidence of inequitable conduct

Gathering evidence concerning inequitable conduct will be made through a discovery. However, it is generally difficult to obtain the evidence because of, for example, bars of principles such as attorney-client privilege or work product doctrine.

(iv) Designation and proof of violation of duty of disclosure

Decisive evidence necessary for proving violation of duty of disclosure is typically a Patentee's internal document or information. Such evidence can be made available through a discovery.

(v) How to make a defense based on violation of duty of disclosure in litigation

A defense based on an inequitable conduct should be made in a written reply as possible. Unlike a non-infringement defense and an invalidation defense, however, the defense based on an inequitable conduct requires distinct and specific information. Evidence which would establish any violation of duty of disclosure is available only through discovery. Nevertheless, a delay of submission of the defense may deprive the plaintiff of the chance to submit the defense later on. While there exists such a dilemma, many practitioners have a view that defense based on inequitable conduct should be made as early as possible in litigation.

(vi) Difference between general discoveries and discoveries for prior art information

There is no difference between a discovery for disclosure of prior art information and a discovery in general litigation. However, due to the attorney-client privilege and work product

doctrine mentioned above, it is more difficult to obtain relevant evidence from a patentee than in general litigation.

(vii) Documents and other evidence to be made available through discovery

Documents to be made available through discovery in regard to violation include all the documents possessed by an inventor and indicative of the reason why the inventor did not disclose, as well as documents indicative of the inventor's state of mind in relation to the non-disclosure (all evidence indicating intention to mislead the USPTO). In addition, the inventor and an attorney who has been involved in the prosecution of the patent in question must be deposed. However, attorneys for the opposing party, relying on attorney privilege, would raise objections against most of the questions during the deposition.

(viii) Questions concerning contents of prior art search performed by examiner or examiner's position on information submitted by IDS

It is usually impossible to discover answers to these types of questions. Deposition regarding the position taken by the examiner during the prosecution is not allowed.

(ix) Participation of jury in litigation

Violation of the duty of disclosure is a legal issue to be decided by a judge. Since a judge at the first instance has an extensive directing authority in litigation, the judge can direct a jury to judge factual matters necessary to find any inequitable conduct.

(7) Cases

(i) History of cases and their influence on practice

No outstanding trend is found in cases regarding inequitable conduct. It is difficult to foresee whether inequitable conduct will be established, because:

① Recognition of inequitable conduct requires that a subjective requirement, "intention", is acknowledged; and

② Judges of the CAFC have different policies concerning "to what extent a patent should be protected", and a subjective judgment required for recognition of inequitable conduct is likely to be affected by such variation of policies.

(ii) Proportion of defense claiming violation of duty of disclosure and success rate

According to a survey in 1989, inequitable conduct (violation of the duty of disclosure in most cases) was claimed in 80% of patent infringement litigation cases. However, most of such claims resulted in failure. Although no recent data is available, inequitable conduct is claimed presumably in at least 50% of infringement litigation cases. Nevertheless, the success rate is

significantly low, i.e., 10% or less, and more specifically, 5% or less of all cases claiming inequitable conduct.

(8) Problems and future issues

(i) Problems of the current system

The following are pointed out as problems of the current system: increased burden on both applicants and the USPTO due to submission of a large amount of IDS statements; and obscurity in application by courts of rules regarding inequitable conduct, resulting from the existence of subjective requirements.

(ii) State of review of rule revision draft under consideration and related remarks

At present, revision of the rules is not being contemplated.

(iii) Desirable system

The current system is extremely fair and flexible when it is viewed as a method for encouraging a person having the duty of disclosure to submit important information to the USPTO before the patent is granted. A critical opinion exists, however, that the recent revisions have only made the system unnecessarily complicated and led to a heavier burden on applicants, in terms of, for example, certification in compliance with 37 C.F.R. § 1.97(e), requirement to submit a copy of a pending US applications, and possible adverse impact on patent term adjustment when an IDS is not submitted within 30 days have added unnecessary complexity to the system and placed greater burdens on applicants.

It is desirable to establish a database so as to find all prior art information and provide instant access to the file of all related patent applications around the world, thereby reducing the burden on patent applicants to submit important information and the burden on examiners to find the information.

2 Feasibility of Introduction of Information Disclosure System into Japanese Patent System

(1) Models of Information Disclosure System

Two contrasting models of information disclosure system are assumed as a basis for discussion of the feasibility of introducing an information disclosure system.

(i) Examination burden-reducing model

Examination is conducted based on information submitted in the IDS. The range of the examination is reduced due to the IDS, thereby allowing simpler and prompter examination.

(ii) Independent examination model

An examination by an examiner is conducted

independently and separately from the IDS. Thus, a reduction in the examination burden is not the direct purpose of the IDS in this model. The IDS is used as supplement to the examination performed by an examiner to enable more accurate examination.

(iii) System in the U.S.

The U.S. system in principle requires that an examination by an examiner is conducted independently from IDS and, therefore, is based on the above-described independent examination model. In fact, there may be an effect of reducing the examination burden, but it would be only a secondary effect.

In the U.S., the sanction of unenforceability is imposed on those who violate the duty of information disclosure by inequitable conduct, under certain requirements. This sanction, however, can actually be imposed only when such inequitable conduct is proved by the use of the discovery system. In many cases, however, establishing of violation of the information disclosure duty is difficult because of the principle of attorney-client privilege and the attorney-work-product bar.

In the case of the independent examination model, an examiner is presumed to conduct an examination independently from the IDS. Thus, violation of the duty of information disclosure does not necessarily leads to improper granting of a patent.

(2) Discussion on Introduction of IDS System

Introduction of an IDS system based on the above-mentioned examination burden-reducing model would allow an examiner to reduce the examination work to the scope covered by the IDS that an applicant has submitted based on a search.

The above-mentioned system would penalize an applicant for any insufficient search, since this system aims to reduce the scope of the examination to be covered by the examiner. Otherwise a patent right based on an invention that is in fact unpatentable would be granted, causing negative social effects. Therefore, a severe sanction must be imposed on an applicant when the search conducted by the applicant is found to be insufficient.

In principle, an applicant would be obliged to submit an IDS prior to the start of examination, since the system to be introduced requires starting the examination upon receipt of the IDS.

On the other hand, introduction of the IDS system based on the independent examination model would not serve to reduce the examination burden of the examiner, since, in such a case, the examiners have to examine applications independently and separately from the IDS.

It should therefore be assumed that the independent examination model has a higher level of purpose: namely, to impose on an examiner a duty to examine an application based not only on the result of the search made by the examiner but also on the prior art known to the applicant. In addition, a sanction should be imposed in order to achieve a practical and equitable system.

The independent examination model, which inherently requires the examiners to examine applications independently of the IDS, involves a smaller risk that the prosecution proceeds relying upon an improper IDS to grant a patent on an application which actually should not be allowed than in the case of the examination burden-reducing model. Therefore, any sanction if applied may be less severe than that required for the examination burden-reducing model.

As the examiners in this model examine applications independently from the IDS as mentioned above, the IDS need not be submitted before the start of examination. Namely, submission of the IDS is accepted any time before the examiner completes the examination of the application.

An IDS system based on the independent examination model similar to the U.S. system when sought to be introduced into Japan raises a question as to whether a system in which an examiner is requested to rely not only on the result of a search made by an examiner but also on the information known to the applicant is acceptable, particularly when the scope of the duty of information disclosure is determined in connection with the subjective requirements which are placed upon the applicant.

Careful studies and discussions are needed on whether, from the viewpoint of consistency with other legal systems, a new system would be acceptable in which a person seeking to obtain and execute a right under a private law bears an obligation to submit information disadvantageous to such a person and sustains a strict sanction.

If the independent examination model is introduced, a sanction must be imposed on applicants for failure to fulfill the duty of disclosure, in order to achieve a practical and equitable system. It is however questionable whether an appropriate sanction can actually be imposed in Japan, where there is no discovery system. This would create a problematic issue, especially when the scope of the duty of obligatory information disclosure is determined in connection with the subjective requirements placed upon applicants.

The examination burden-reducing model, in contrast, cannot secure adequate patent examination by a sanction, especially when the scope of the duty of information disclosure is

determined in connection with the subjective requirements placed upon the applicants, as in the U.S patent system, because Japanese law system does not have any discovery system which would ensure the effectiveness of such a sanction. Accordingly, this does not seem feasible.

(3) Methodology of Introducing IDS system

As discussed above, introduction of either of the two models as they stand in Japanese patent system is still premature.

On the other hand, an opinion will become dominant in future that, since new measures will be taken for encouraging applicants and patentees to enforce their rights under the current trend of pro-patent policies, an appropriate duty appropriately balanced with the right should be stipulated.

Based on these discussions, one proposal would be to ask for applicants to disclose their information within a certain scope. However, it is not a good policy to define this scope of information disclosure in connection with the subjective requirements as in the U.S., since there is no discovery system in Japan. A desirable method therefore would be such that the scope of the information disclosure, in which applicants are requested to submit their information, should be objectively defined while avoiding subjective requirements placed upon applicants.

One tentative proposal would be that an applicant is requested to submit a search report received in connection with a foreign counterpart application.

Submission of a search report on a foreign counterpart application may be done not only by the applicant but also by the Patent Office of each country who issues such a search report, through close cooperation and communication between Patent Offices of different countries.

Desirably, a future system should rely on mutual cooperation and communication between Patent Offices of different countries, because such a system eliminates duplication of examination by different Patent Offices, while ensuring submission of arts made known to the applicant through a search report. Such a desirable system, however, cannot be developed in the near future.

Since applicants are not requested to submit search reports received in connection with their foreign counterpart patent applications, examination proceeds in the absence of such search reports, involving a risk that patent rights are wrongly granted based on inventions that are in fact unpatentable. Accordingly, it is often seen that references cited in the examination of foreign search reports are submitted in the procedures of patent oppositions or invalidation trials. Correcting the wrong grants of patents through the

procedures such as patent oppositions does not benefit society. It is therefore advantageous and feasible to set up a system which would request applicants to submit search reports received in connection with foreign counterpart patent applications.

Such a system would be understood to generalize the current accelerated examination system which uses a search report instead of searching the prior art.

Assuming that a duty of submitting search reports received by applicants in connection with foreign counterpart applications is imposed on applicants, whether a sanction should be applied for violation of this duty still remains in question. The answer to this question requires careful discussion and consideration taking into account various factors such as effectiveness of the sanction and ensuring equity, as well as the balance between applications having foreign counterparts and applications having no foreign counterparts, for which no foreign search report is available.

III Conclusion

We hope that this research has clarified the outline of the provisional application system and the information disclosure system, and also the actual use of both systems.

The provisional application system in the U.S. is characterized in that claims are not required when the provisional application is made, and that the filing fee for provisional applications is lower than that for ordinary applications. Such systems are surely friendly to applicants who are not familiar with the patent system.

The provisional application system was enacted for the purpose of preventing inequity, concerning the term of the patent right, which might have existed between domestic and international applicants by implementation of the 1995 GATT/TRIPs Agreement and which is peculiar to the U.S. patent system. In the meantime, an internal priority system has been legislated in Japan, satisfying to a certain extent the demand for a simplified application procedure. It is also to be pointed out that the U.S. provisional application system may not fully meet the demand for simplification, insofar as it requires disclosure of the best mode of the invention.

The main and fundamental issue concerning the introduction of this type of system into Japan would be how to set up a reasonable standard or requirements for entitling applicants to filing dates.

The information disclosure system operating

in the states is notable since it is a principle of law that serves to limit the protection while the US patent system is becoming more pro-patent.

The system is used in infringement litigation to provide a basis for a defense of a defendant, rather than in prosecution of applications. Since the duty of information disclosure arises regardless of whether the examiner requests the disclosure of information, applicants would be required to disclose information whenever it seems to relate to patentability. However, it is pointed out that, in an infringement litigation, establishment of any information that was not disclosed despite the duty of disclosure is difficult even under the U.S. discovery system.

Further consideration of the above issues will be required when an information disclosure system is introduced into the Japanese patent system as a rule which is accompanied by any sanctions such as unenforceability of a patent rather than as a mere bona fide duty of applicants.

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