



WINDS FROM JAPAN

The Licensing Executives Society Japan

Making a New Step by Returning to the Starting Point of the Licensing Executives Society (LES)

By **Katsumi Harashima***



It is a great honor to welcome you as I begin my second term as President of LES Japan for the year 2013/2014.

Looking back at the previous year in my position as president, it seems that the year passed rapidly and pleurably, as we were kept busy with the 40th anniversary memorial events. I wish to express my sincere appreciation to those who promoted the five events, and the members who participated in the events. Thank you to everyone involved. The details of the events are summarized in LES Japan's business report for last year. All of the events were successful far beyond our highest expectations. In my first policy speech after becoming president, I mentioned that the anniversary memorial events should not be mere festival events, believing that the events should create a platform for 10 years of discussion at LES Japan, and that by doing so the events would both be memorable and would provide useful and practical suggestions for future activities. After attending all of the events, the overwhelming response I received reflected a great volunteer spirit, which has served as the basis of LES since its establishment. This, I believe, reflects the true culture of LES, built on the foundation stones laid by my many predecessors. Members in charge of each event worked tirelessly for the benefit of other members. The basis of membership is individual, there is no reward for any activity, and the mutual volunteer spirit of members supports all activities. I would like to stress again the greatness of how this spirit has steadily developed for 40 years since the establishment of LES. The high motivation of each member, the sense of fulfillment arising from participating in LES activities, and, further, the sense of achievement of each

individual as a result of being part of the activities have all contributed to the greatness of LES and have made continuous development possible. I heard that Mr. Tanaka, a former president, often said that LES means learn and enjoy society. His words may be a pun; but still they express the very nature of LES. We often have discussions with a view to increasing the number of corporate members, preventing the number of participants in the annual conference from decreasing, or increasing the number of students attending monthly seminars or licensing seminars. We also have discussions aiming to publicize the existence of the society. However, at all times, I believe that it is necessary to continue to keep in mind the basic question of whether or not each action we take leads to the development of each member. I wish to make a first step toward the next 10 years, focusing on how to maintain the trend of the high motivation of each member, the sense of fulfillment experienced by participating in LES activities, and the development of each individual, achieved as a result of being part of the activities.

<Revitalization of Activities within the Asia Pacific Region>

For the time being, I wish to concentrate on achieving an environment in which as many members as possible can gain a real sense of the global IP network, which is an advantage of LES. The aim of the organization committee of the Asia Pacific Regional Conference was to have as many members of the Licensing Executive Society of Japan as possible attend and enjoy the LES international conference. At this International Conference, more than 200 members interacted with 100 participants from overseas. It has been more than 10 years since the previous international conference was held in Osaka in 2002. Therefore, I believe that for many of the participants the Asia Pacific Regional Conference was their first international conference. In Europe

and the Americas, in which the USA/ Canada has a central position, regional conferences are regularly held. My current target for the time being is to establish regular conferences in the Asia Pacific region. The 2013 conference will be held in Hangzhou, China. Our main role and challenge is to provide a helping hand at the conference meeting in Hangzhou, which leads to the conference to be held in Seoul in 2014, and then Kuala Lumpur in 2015, thereby making regional conferences regular events. This year, LES Japan has been requested by LESI to support the establishment of LES in Thailand. In view of this, I wish to further revitalize activities within the Asia Pacific region, and ask as many members as possible to participate in interaction within the Asia region. The Thai-Philippine Delegation 2012 and the student business plan competition also provided similar suggestions.

This trend will naturally affect our annual conference. I expect that more participants than before will come from overseas to join the conference in Shimane this year. We have already received inquiries from the Philippines, Thailand, Hong Kong, Belgium, Germany and the United States. This demonstrates that other societies of LESI, particularly those in Asia, are showing an increasing awareness of LES. In this regard, we are relying on the expertise of the organization committee of the 2013 annual conference to help break down the Japanese language barrier.

Your continued support is highly appreciated.

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\* President of LES Japan

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## Exerting Control Over Applicable Prior Art In Transitional US Patent Applications Under The AIA

By Jacob Doughty\*



The First Inventor to File (FITF) provisions of the America Invents Act (AIA) became effective on March 16, 2013. The well-known provisions defining prior art, pre-AIA 35 U.S.C. §§ 102(a) to 102(g), have given way to the seemingly more elegant provisions of AIA 35 U.S.C. §§ 102(a) and 102(b). However, for a substantial period of time, the pre-AIA definition of prior art will be applicable to some US patent applications, and the AIA definition of prior art will be applicable to others. In transitional patent applications, i.e., US patent applications that are filed after March 16, 2013 and claim priority benefit of foreign or domestic (including PCT) patent applications filed before March 16, 2013, it may be possible for applicants to control which of the pre-AIA and AIA definitions of prior art will apply.

### 1. Differences between Pre-AIA Prior Art and AIA Prior Art

Controlling whether a patent application is subject to pre-AIA prior art or AIA prior art may be desirable, as it may allow an applicant to strategically exploit the advantages and disadvantages of the different prior art regimes. For example, the AIA significantly expands the universe of prior art that is available as of its filing date against a patent application. Particularly, under pre-AIA § 102(e), a

US patent, US patent application publication, or WIPO publication (in English) may be available as prior art as of its US or International filing date. By contrast, under AIA § 102(a)(2), a US patent, US patent application publication, or WIPO publication (in any language) may be available as prior art as of its "effective filing date," i.e., the filing date of the earliest foreign or domestic patent application of which priority benefit is claimed.

On the other hand, AIA §102(b) provides several avenues for avoiding prior art that are not available under pre-AIA law. For example, it may be possible to rely on foreign grace period disclosures to eliminate prior art. Further, certain commonly owned references that anticipate a claimed invention are not AIA prior art, but remain pre-AIA prior art.

It is possible that it would be more desirable to an applicant for a patent application to be subject to one or the other of pre-AIA prior art and AIA prior art. Further, it is possible that such applicant will not discover which type of prior art would be preferable until well after filing. Thus, it may be advantageous to preserve flexibility to take advantage of the pre-AIA regime or the AIA regime after filing.

### 2. Which Prior Art Definition Applies?

Applicability of pre-AIA prior art or AIA prior art to a particular patent application is determined by statute. Particularly:

(n) EFFECTIVE DATE.—

(1) IN GENERAL.— Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time —

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA §3(n).

In some cases, it is very clear which of pre-AIA prior art and AIA prior art applies to a patent application.

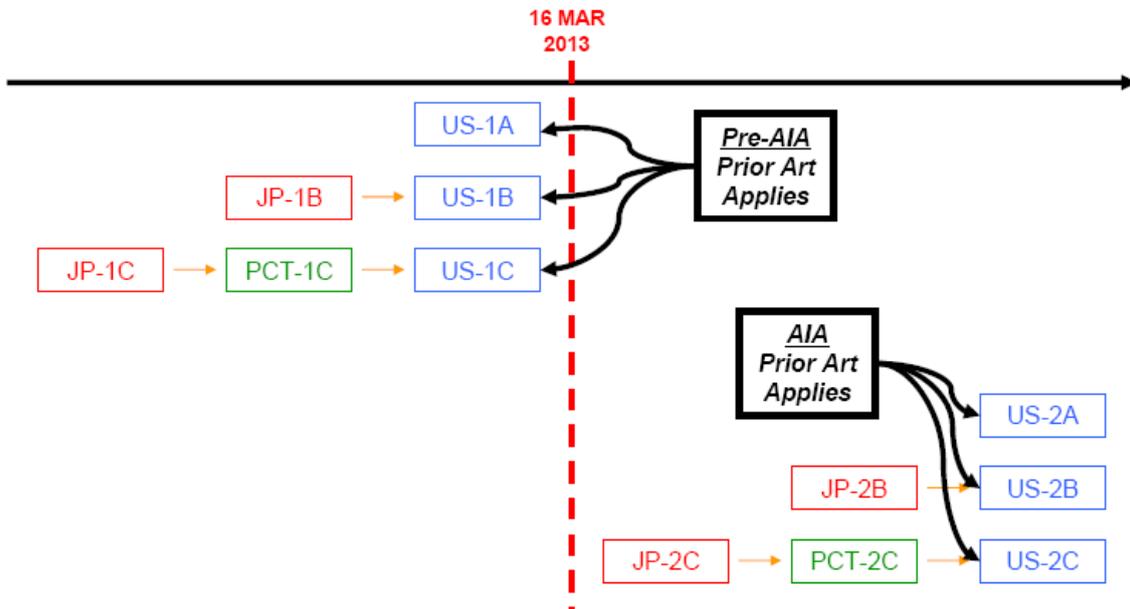


Fig. 1 shows the applicable prior art in exemplary US patent applications arranged along a timeline by actual filing date. US-1B and US-2B are US patent applications claiming priority benefit of JP patent applications, and US-1C and US-2C are US national stage PCT patent applications.

As shown in Fig. 1, any US patent application that is actually filed in the US before March 16, 2013 is subject to pre-AIA prior art. On the other hand, any US patent application that has an effective filing date (filing date of earliest foreign or domestic patent application of which priority benefit is claimed) on or after March 16, 2013 is subject to AIA prior art.

The situation becomes more complex in US patent applications that are/were actually filed in the US on or after March 16, 2013, but claim priority benefit of

a foreign or domestic patent application that was filed before March 16, 2013. Depending on the priority benefit claim and the subject matter of the claims of such US patent applications, pre-AIA prior art or AIA prior art may apply. (As will be apparent in the discussion below, if a single claim in an application necessitates application of AIA prior art, AIA prior art will apply to all claims in that application and all subsequent applications claiming priority benefit thereof).

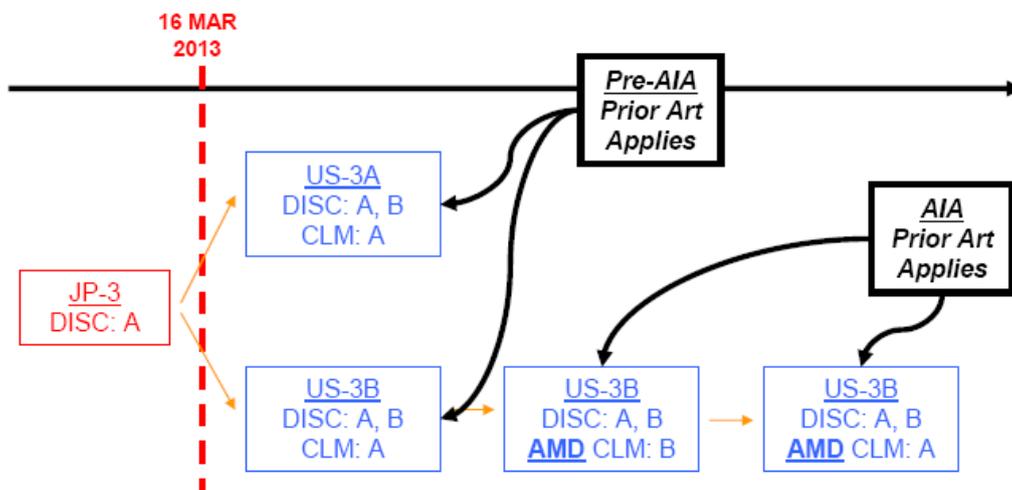


Fig. 2 shows the applicable prior art in exemplary US patent applications arranged along a timeline by actual filing date. The disclosed subject matter of the JP patent application is indicated, and the disclosed subject matter and claimed subject matter of each US patent application are indicated. US-3A and US-3B are US patent applications claiming priority benefit of the JP patent application. Moving from left-to-right, the second and third boxes for US-3B indicate amendments to the claims.

As shown in Fig. 2, if certain claim amendments are made in a transitional patent application that is subject to pre-AIA prior art (i.e., if claim amendments result in claims that are not supported by a foreign or domestic patent application filed before March 16, 2013 of which priority benefit is claimed), the patent application will then become subject to

AIA prior art. Further, as shown with respect to US patent application US-3B, this change is not reversible. While a patent application subject to pre-AIA prior art may be converted into a patent application subject AIA prior art, once a patent application is subject to AIA prior art, it can never again be subject to pre-AIA prior art.

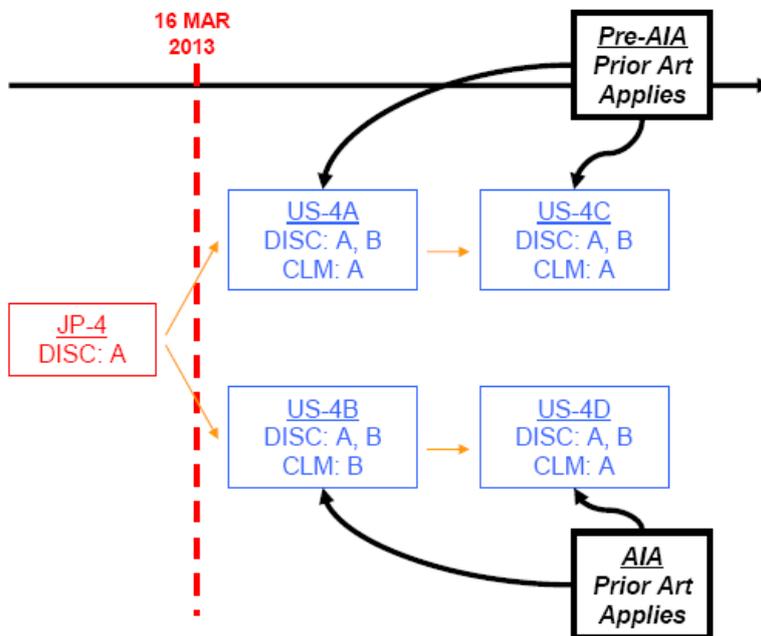


Fig. 3 shows the applicable prior art in exemplary US patent applications arranged along a timeline by actual filing date. The disclosed subject matter of the JP patent application is indicated, and the disclosed subject matter and claimed subject matter of each US patent application are indicated. US-4A and US-4B are US patent applications claiming priority benefit of the JP patent application. US-4C is a continuation of US-4A, and US-4D is a continuation of US-4B.

As shown in Fig. 3, if a patent application claims priority benefit of an earlier patent application that is subject to AIA prior art (e.g., because the earlier patent application includes at least one claim that is not supported by a foreign or domestic patent application filed before March 16, 2013 of which priority benefit is claimed), the continuing patent application is subject to AIA prior art. Further, as shown with respect to US patent application US-4D, this is true even if the particular patent application would otherwise be subject to pre-AIA prior art (e.g., because all claims are supported by a foreign or domestic patent application filed before March 16, 2013 of which priority benefit is claimed). If an

earlier patent application in a chain of priority is subject to AIA prior art, all subsequent patent applications in the chain will be subject to AIA prior art.

### 3. Taking Advantage of the Applicability Provisions

While the previous section illustrates how a patent application subject to pre-AIA prior art may irreversibly become a patent application subject to AIA prior art, there are ways to prevent the applicability of AIA prior art. Further, there are ways to trigger applicability of AIA prior art when desired.

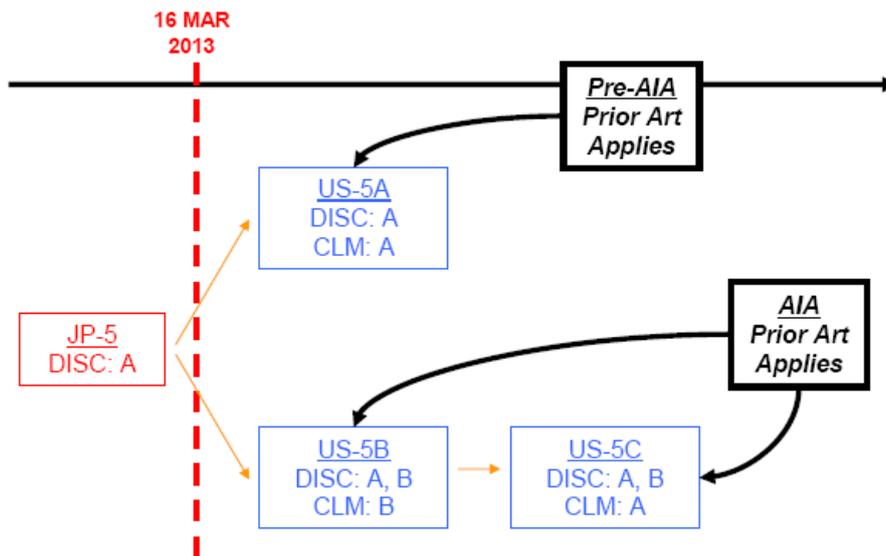


Fig. 4(a) shows the applicable prior art in exemplary US patent applications arranged along a timeline by actual filing date. The disclosed subject matter of the JP patent application is indicated, and the disclosed subject matter and claimed subject matter of each US patent application are indicated. US-5A and US-5B are US patent applications claiming priority benefit of the JP patent application. US-5C is a continuation of US-5B.

As shown in Fig. 4(a), it is possible to maintain two separate chains of US patent applications filed on or after March 16, 2013, which claim priority benefit of the same foreign (or domestic) patent application filed before March 16, 2013. In the particular example in Fig. 4(a), US-5A is subject to pre-AIA prior art because: (i) US-5A claims only subject matter that is supported by JP-5, which was filed before March 16, 2013; and (ii) US-5A does not claim priority benefit of a patent application that is subject to AIA prior art. By contrast, US-5B is subject to AIA prior art because it claims subject matter that is not supported by a prior patent application, which was filed before March 16, 2013, and US-5C is subject to AIA prior art because it

claims priority benefit of a patent application that is subject to AIA prior art (US-5B). Because US-5A does not claim priority benefit of US-5B, US-5A is unaffected by US-5B's status as a patent application subject to AIA prior art.

Thus, by maintaining separate chains of patent applications, it is possible for an applicant to choose which of pre-AIA prior art and AIA prior art will apply to particular claimed subject matter -- in this case by choosing to pursue one or the other of US-5A and US-5C. Further, this choice need not be made immediately, but instead can be made later in the course of prosecution of US-5A or US-5C (or child, grandchild, etc., patent applications thereof).

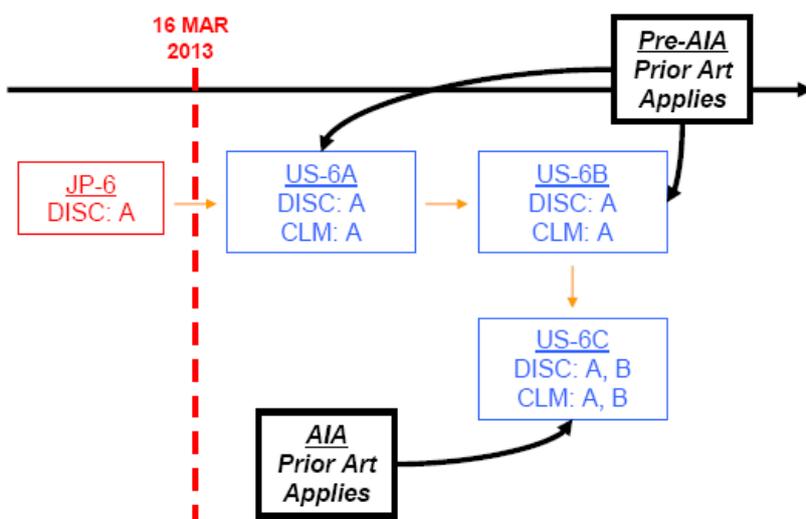


Fig. 4(b) shows the applicable prior art in exemplary US patent applications arranged along a timeline by actual filing date. The disclosed subject matter of the JP patent application is indicated, and the disclosed subject matter and claimed subject matter of each US patent application are indicated. US-6A is a US patent application claiming priority of the JP patent application. US-6B is a continuation of US-6A, and US-6C is a continuation-in-part of US-6B.

An alternative scenario is shown in Fig. 4(b). In the particular example in Fig. 4(b), US-6A and US-6B are subject to pre-AIA prior art because: (i) US-6A and US-6B claim only subject matter that is supported by JP-6, which was filed before March 16, 2013; and (ii) US-6A and US-6B do not claim priority benefit of a patent application that is subject to AIA prior art. By contrast, US-6C is subject to AIA prior art because it claims subject matter that is not supported by a prior patent application, which was filed before March 16, 2013.

In this case, a chain of patent applications subject to pre-AIA prior art (US-6A, US-6B) is maintained until, at some later time, it is deemed desirable to pursue a patent application subject to AIA prior art – then, a continuation-in-part patent application is filed (US-6C), which presents claims directed to subject matter not described in JP-6. However, again, the status of US-6A and US-6B as being subject to pre-AIA prior art is not affected by US-6C, because US-6A and US-6B do not claim priority benefit of US-6C (instead US-6C claims priority benefit of US-6A and US-6B – the claim of priority benefit goes backward, not forward). By maintaining a chain of patent applications subject to pre-AIA prior art, it remains possible to later to add a link to the chain (i.e., a further patent application) that is subject to AIA prior

art, without adversely affecting the prior art status of the earlier patent applications.

By maintaining patent applications on two separate paths (or at least maintaining a pre-AIA prior art path until such time that is necessary to open an AIA prior art path), it will become possible to later select, if necessary, the prior art law that will apply to the claims. This flexibility may prove valuable in important patent applications.

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As shown above, it is possible for applicants to control whether a transitional patent application will be subject to pre-AIA prior art or AIA prior art. In important patent applications, it may be desirable to preserve the ability to rely on each of pre-AIA prior art and AIA prior art, in the event that one of the prior art definitions becomes more advantageous during examination.

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Editors' Note

This issue includes a message from Mr. Katsumi Harashima, the president of the LES Japan, and an article on prior art(s) under the AIA from Mr. Jacob Doughty, a US patent attorney practicing in Japan. If you would like to refer to any back issues of our newsletters, you can access them via the following URL:

<http://www.lesj.org>

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