

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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October 16, 2015

The Honorable Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Alexandria, Virginia

Re: JIPA Comments on "Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board"

Dear Under Secretary Lee:

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 940 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned that the "Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.80, No.161, on August 20, 2015. We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

JIPA again thanks the USPTO for this opportunity to provide these comments and welcomes any questions on them.

Sincerely, yours,

Katsutoshi TERAI  
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**JIPA Comments on the “Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board”**

As many of JIPA members engage in filing US patent applications, JIPA has closely and carefully examined the proposed amendments, publicized in the Federal Register (FR) issued by the United States Patent and Trademark Office (USPTO) as of August 20, 2015, under the title of “Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board”. JIPA hereby presents its comments on the proposed amendments.

1. FR50724 Column 2 contains the Office’s Response to Comment 6<sup>1)</sup> regarding a patent owner’s motion to amend.

Under 37 CFR 42.121(a) and 42.122(a), a patent owner is required to hold a conference call with the Office before filing a motion to amend. During such a call, the judges will provide technical guidance to the patent owner and petitioner regarding the motion. In its Response mentioned above, the Office mentioned four precedent cases in which it has issued as further guidance.<sup>2)</sup>

[JIPA’s comments] The four precedent cases cited in the Response would be insufficient to enable a patent owner to identify the scope of “prior art known to the patent owner.” The Office should provide a more concrete explanation in its technical guidance (e.g. by clearly suggesting the method and scope of the prior art search, and advising that the patent owner specify the most relevant prior art in an affidavit).

- 1) *Comment 6* : Several commenters suggested that the Office provide additional guidance in conferences regarding motion to amend practice, including guidance on what prior art the patent owner needs to distinguish in a motion to amend.
- 2) *MasterImage*, slip op. at 1–3); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012–00027 (PTAB June 11, 2013) (Paper 26) (informative); *Int’l Flavors & Fragrances Inc. v. United States of America*, Case IPR2013–00124 (PTAB May 20, 2014) (Paper 12) (informative); *Corning Optical Comms. RF, LLC v. PPC Broadband, Inc.*, Case IPR2014–00441 (PTAB Oct. 30, 2014) (Paper 19); *Riverbed Tech., Inc. v. Silver Peak Systems, Inc.*, Case IPR2013–00403 (PTAB Dec. 30, 2014) (Paper 33); *Reg Synthetic Fuels LLC v. Neste Oil OYJ*, Case IPR2014–00192 (PTAB June 5, 2015) (Paper 48)

2. FR50726 Column 1 contains the Office’s Response to Comment 2<sup>3)</sup> regarding a patent owner’s preliminary response.

In its Response, the Office states the following: “The Office proposes to change the rules to provide expressly that a petitioner may seek leave to file a reply to a preliminary response including new testimonial evidence, so that the Office may allow a reply when the circumstances so warrant.”

[JIPA’s comments] “When the circumstances so warrant” is not sufficiently clear. The Office should clearly demonstrate in which cases and under which conditions a petitioner will be allowed to file a reply brief to the patent owner’s preliminary response, and clarify the procedure for filing such a reply brief.

- 3) *Comment 2* : The Office received several comments suggesting that the Board provide for the submission of a petitioner reply to the patent owner preliminary response, particularly if the Board were to amend the rule for the patent owner preliminary response to allow new testimonial evidence.

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