

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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February 29, 2012

The Honorable David J. Kappos
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 the "Proposed Patent Fee Schedule" Under Section 10 of the American Invents Act (AIA)

Dear Under Secretary Kappos:

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 900 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 "Proposed Patent Fee Schedule", originally released on February 7, 2012 by the United States Patent and Trademark Office (USPTO), we would like to offer our opinions as follows. Among the all proposed fees schedules, we are concerned about the RCE, Post-Grant and Inter-Partes Review fees. They are also important process for users, and we believe that appropriate utilization of patent system should be based on the appropriate fee schedule for users. Your further 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,

Kenji Koumoto

President

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JAPAN

JIPA Comments on the “Proposed Patent Fee Schedule”

1. Request for Continuing Examination Fees

As several participants expressed at the public hearing on February 5, JIPA also believes that the RCE fee is too expensive. Considering that most of applications are matured into patents through the RCE process, almost all applicants would have to pay much more than now. Nevertheless, even if the RCE fee is raised, we believe that many applicants do not always withdraw their applications actively. Namely, raising the RCE fee does not work for reducing the backlog in the USPTO. Therefore, JIPA strongly requires the fee schedule including RCE be set on the appropriate level.

2 Post-Grant Review and Inter-Partes Review

JIPA is concerned about the expensive fees for Post-Grant Review and Inter-Partes Review. There seems to be a possibility that many users cannot use new introduced reviews because of the expensive fees.

In addition, JIPA believes that the substantial part of the petition fee for Post-Grant Review and Inter-Partes Review should be returned to the petitioner when Board decides not to institute the proceeding. In such case, time consuming Trial at Board will not be held, and such fee necessary to conduct Trial should be reimbursed to the petitioner, as long as the content of petition is not frivolous.

Furthermore, we believe that dependent claims should be excluded for the purpose of calculating the petition fee for Post Grant Review and Inter-Partes Review. Otherwise, it will not be possible for users to file a post grant review appropriately against patents with many claims.

(EOD)