

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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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 "Miscellaneous Post Patent Provision" of the Leahy-Smith
America Invents Act

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 "Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.3, on January 5, 2012. 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,

Kenji Koumoto
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JIPA Comments on the “Miscellaneous Post Patent Provisions”

JIPA has closely and carefully examined the proposed amendment to 37CFR, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of January 5, 2012, under the title of "Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. §1.501(a)(2) of the Proposed Amendment provides as follows:

(a) *Information content of submission:*

At any time during the period of enforceability of a patent, any person may file a written submission with the Office under this section, which is directed to the following information:

...

(2) Statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of the patent. ...

This new rule enables the applicant [patent owner] to submit his/her statement on claim interpretation through proceedings for re-examination, inter-partes review (IPR), and post-grant review (PGR). If the applicant submits such statement upon filing, we hope that proceedings can be conducted more smoothly based on appropriate claim interpretation from the beginning, which will contribute to increasing efficiency and reducing the processing time in the proceedings, as well as mitigating the applicant's burden to respond. JIPA believe that this amendment should be beneficial to both the USPTO and patent users. In connection with this, the statement under the new rule (§1.501(a)(2)) and the statement under the existing rule (§1.530(b)) would be treated in different ways in the proceedings, so JIPA would request that the USPTO clarify the distinction in the treatment of these statements under MPEP or otherwise from this point of view.

2. §1.501(b)(7) of the Proposed Amendment provides as follows:

(b)(7) A statement identifying the real party(ies) in interest to the extent necessary to determine whether any *inter partes* review or post grant review filed subsequent to an *ex parte* reexamination bars a pending *ex parte* reexamination filed by the real party(ies) in interest or its privy from being maintained.

JIPA agrees that in relation to the provisions on estoppel in the IPR and PGR, newly introduced under 35USC.315(e)(1) and 325(e)(1), the USPTO will need information identifying the party to the extent that it can determine whether any IPR or PGR filed subsequent to an *ex parte* reexamination interferes with the maintenance of a pending *ex*

parte examination. This provision also offers an option for the party who submits such information to remain anonymous. JIPA considers that patent users will welcome the new rule that maintains anonymity, which has been the advantage of the ex parte reexamination under the previous rules.

(EOD)