

# 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 "Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees"

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 the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.16, on January 25, 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  
President  
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JAPAN

## **JIPA Comments on the "Supplemental Examination 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 25, 2012, under the title of "Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. JIPA understands that the Supplemental Examination, introduced under 35U.S.C.257, is designed as a system for eliminating the situation where the patent owner cannot exercise his/her right due to inequitable conduct. In this respect, JIPA favorably evaluates the Supplemental Examination as a useful tool for fair patent owners who demand improved stability of patent rights, and also expects this new system to enable them to reduce litigation costs by solving the issue of inequitable conduct before filing suits.

2. At the same time, §1.20(k) in the Proposed Amendment provides for a fee required for the Supplemental Examination, which consists of (1) \$5,180 for the initial fee and (2) \$16,120 for the ex-parte fee. In total, the patent owner will have to pay \$21,300 as a fee when requesting the Supplemental Examination. JIPA supposes that the expensive fee is for suppression of the easy request for Supplemental Examination by users with inequitable conduct. However, JIPA would like to say that it is still expensive for fair and diligent patent owners, even taking into consideration that the Supplemental Examination is conducive to reducing litigation costs.

3. As a background for usage of the Supplemental Examination, the IDS procedure is still heavy burden for all users. We hope that the USPTO will consider further alleviating the burden of the IDS procedure on users. For instance, if the USPTO can get documents by itself such as through CCD (Common Citation Document) which was launched by collaborated trilateral offices, we expect the USPTO does not demand users to submit the same documents as an IDS procedure. Therefore, JIPA would strongly request that the total fee should be reconsidered to a reasonable level for fair and diligent patent owners, as long as the heavy burden of the IDS procedure exists for the users.

4. 37CFR1.610(b)(10) in the Proposed Amendment states, "A copy of each item of information listed in paragraph (b)(3) of this section." JIPA considers that "paragraph (b)(3)" might be a typographical error and should be corrected as "paragraph (b)(4)."

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