

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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April 9, 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 "Practice Guide for Proposed Trial Rules"

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 "Practice Guide for Proposed Trial Rules", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.27, on February 9, 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,

Yoichi Okumura

President

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## **JIPA Comments on the "Practice Guide for Proposed Trial Rules"**

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 February 9, 2012, under the title of "Practice Guide for Proposed Trial Rules" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. The Proposed Rule of Practice for Trials before the PTAB (77 Fed. Reg. 6879, Feb. 9, 2012) establishes the rules to govern the "Practice for Trial" in proceedings such as inter partes review (IPR), post-grant review (PGR), and a covered business method patent (CBM) review. JIPA appreciates this achievement because the standardization of procedural rules common to these proceedings that have different purposes, as umbrella rules, will be highly beneficial to patent users. JIPA would like to express its gratitude for the USPTO's consideration for having published the Practice Guide, even though it refers to the trial proceedings at district courts. The practice guide limits the scope of subjects of the discovery process —JIPA members have been concerned about engaging in this process because it is time-consuming and costly—, so as to make it speedy and inexpensive.

2. The Proposed Rule recommends a party to hold an initial conference with a judge during trial proceedings. JIPA understands that this will be an important conference that could greatly affect the course of the trial. The conference is to be held within one month from the date of institution of proceedings (77 Fed. Reg. 6874 Col. 2, Feb. 9, 2012).

JIPA considers that from the standpoint of the patent owners, especially those outside the United States, who have been attacked by the sudden institution of IPR or other proceedings, the one-month period is too short to decide everything in response to the motion or discovery. JIPA would strongly request that this period be extended to two months or that flexible arrangements be made for parties outside the United States.

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