

May 22, 2000

Mr. Kenneth M. Schor  
Box Comments-Patents  
Assistant Commissioner for Patents  
Washington, D.C. 20231  
United States of America

Re. Changes To Implement Eighteen Month Publication of Patent Applications

Dear Mr. Schor,

On behalf of Japan Intellectual Property Association, a non-profit IP organization in Japan with over 800 corporate membership, allow me to provide you with some comments on the subject matter, as described hereinafter.

1) §1.907(b) - *Inter partes* reexamination prohibited

According to this section, any party may not request *inter partes* reexamination on the basis of issues, which such party raised or could have raised in the civil action.

The term of “or could have raised” should be deleted from this section, if it will be determined case by case whether the issue could have raised in the civil action or not.

2) §1.915(b)(8) – Content of request for *inter partes* reexamination

It provides that any person who will request *inter partes* reexamination under this section should specify “the real party in interest” in the statement.

Therefore, is it correct to understand that according to the section §1.915(c) any attorney itself may not request *inter partes* reexamination? If correct, it is unclear what kind of person “the real party in interest” will mean.

3) – Selection/number of the examiner

One of the big problems in examination is that the examination criteria of each examiners will be different. It should be necessary to examine carefully the patentability of a patent against which *inter partes* reexamination will be requested, because any disputes in relation to such patent raise actually or will raise with high possibility.

Therefore, in order to solve these problems, it should be ruled that *inter partes* reexamination should be conducted by a council system comprising the experienced examiners.

4) §1.947 – Comments by third-party requester to patent owner’s response in *inter partes* reexamination

It provides that a third-party requester may file written comments within a period of 30 days from the date of service of the patent owner’s response and such time may not be extended.

It is hard for a foreign person to file written comments within such period. Therefore, it should be ruled that a third-party requester who lives in foreign

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country will be given at least 30 days to file a response or may file written comments within 60 days from the date of service of the patent owner's response.

5) §1.991 – Merger of concurrent reissue application and *inter partes* reexamination proceeding

According to this article, if a reissue application and an *inter partes* reexamination are pending concurrently on a patent, a decision may be made to merge the two proceedings.

If it will be permissible for a patent owner to request interviews with examiner in case of merger of the reissue proceeding and *inter partes* reexamination proceeding, it should be permissible for a third-party requester to do so equally as well.

It would be highly appreciated if you will consider the above comments.

Yours very truly,

Kunio Obara  
President  
Japan Intellectual Property Association