

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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To: United States Patent and Trademark Office  
[PTABNPRM2020@uspto.gov](mailto:PTABNPRM2020@uspto.gov)

Public Comments on PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence

Dear Director of the United States Patent and Trademark Office:

We, the Japan Intellectual Property Association (JIPA), are one of the world's largest organizations of IP users with a membership of 1,324 companies (as of June 10, 2020), most of which are Japanese companies. In light of the fact that our member companies file numerous U.S. patent applications, JIPA has carefully considered "PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence" published by the United States Patent and Trademark Office (USPTO) in the Federal Register of May 27, 2020. We, JIPA, respectfully submit our comments on USPTO's proposed revisions to the rules, as below. USPTO is kindly requested to take our comments into consideration when deciding on the revisions to the rules.

(1) Revisions to the Rules on Institution of IPR, PGR, or CBM Review (37 CFR 42.108(a), 42.208(a))

JIPA welcome these proposed revisions to the rules because these are consistent with the SAS decision.

(2) Revisions to the Rules on Filing of Responses (37 CFR 42.23, 42.24, 42.120, 42.220)

JIPA welcome these proposed revisions to the rules because these are consistent with the Office Patent Trial Practice Guide, August 2018 Update.

(3) Revisions to the Rules on Presumption of Testimonial Evidence Submitted by the Patent Owner (37 CFR 42.108(c), 42.208(c))

JIPA request that these proposed revisions to the rules be changed. Specifically, USPTO is kindly requested to delete "Any such request must make a showing of good cause." from the proposed rules, or to change the proposed rules such that it makes possible for the petitioner to surely file a reply to the preliminary response when a genuine issue of material fact has been created by

testimonial evidence submitted by the patent owner. This is because under conditions where the presumption is eliminated by these proposed revisions to the rules, if it is impossible for the petitioner to rebut the testimonial evidence submitted by the patent owner, the petitioner will be in an unfavorable position. Based on only the "good cause" in the current rules, it is unclear whether the petitioner has the opportunity to file a reply. Therefore, we would appreciate it if USPTO could make it possible for the petitioner to surely file a reply at least when a genuine issue of material fact has been created by such testimonial evidence. Even if this change is added to the revisions, we think that such a change would not affect the elimination of confusion as to the presumption and discouragement to submit testimonial evidence that concern USPTO.

In addition, JIPA request that when the period of time between the date of the decision on these revisions to the rules and the effective date is less than six months, the revised rules be applied to the proceedings petitioned on or after the effective date. This is because a new confusion would be created if these revisions to the rules are applied even to the pending proceedings petitioned based on the premise that there is a presumption. In particular, we have concerns that with regard to the proceedings immediately before the institution decision, the presumption will be eliminated without giving the petitioner the opportunity to rebut. USPTO is kindly requested to apply the revised rules to the proceedings petitioned on or after the effective date in order to clear up any confusions, which is the purpose of these revisions to the rules.

Yours faithfully



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Managing Directors  
Japan Intellectual Property Association