

## **JAPAN PATENT ATTORNEYS ASSOCIATION**

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U.S.A.

November 19, 2020

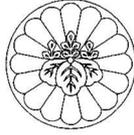
Subject: Docket No. PTO-C-2020-0055 Request for Comments on Discretion To Institute Trials Before the Patent Trial and Appeal Board.

Dear Sir or Madam,

The Japan Patent Attorney Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has more than 11,600 members practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including patent, design and trademark law as well as copyright and unfair competition law.

The JPAA appreciates the USPTO's efforts for clarifying rules on instituting AIA trials and providing an opportunity to submit comments on discretion on institution of trials. We would like to submit our comments as follows, and we would be happy to answer any questions regarding these comments.

First of all, we would like to emphasize the importance of international harmonization not only for worldwide users of the US patent system but also for US citizens. In this regard, the invalidation action system before the Japan Patent Office employs (i) consolidation of multiple invalidation actions, (ii) parallel examination of multiple invalidation actions with hearings and decisions on the same day, and (iii) prioritized examination of one action while suspending the other actions and examining invalidity grounds raised in the other actions in the prioritized action. This system is very effective to guarantee every petitioner's opportunity to invalidate a patent, which is very



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important under the circumstances where AIA trials are utilized for speedy and cost-effective resolution of disputes, while facilitating efficiency in examination before the Office. We hope that our introduction of the Japanese system will be helpful to you in rulemaking.

Based on this standpoint, we would like to provide our comments on each item.

### Serial Petitions

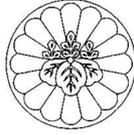
*1. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in General Plastic, Valve I, Valve II and their progeny, for deciding whether to institute a petition on claims that have previously been challenged in another petition?*

We would suggest that the USPTO should promulgate a rule with a case-specific analysis. We are afraid that it would cause confusion for not only Patentees, but also Petitioners, if there are no rules for deciding whether to institute a petition on claims that have previously been challenged in another petition.

*2. Alternatively, in deciding whether to institute a petition, should the Office (a) altogether disregard whether the claims have previously been challenged in another petition, or (b) altogether decline to institute if the claims have previously been challenged in another petition?*

We would suggest that the decision to decline institution by the USPTO should be based on the promulgated rule for deciding whether to institute a petition on claims. In addition, it is desirable that the petition of interest be instituted, when the petitioner differs from the previous petitioner or the reason of invalidity argued in the current petition differs from the reason of invalidity argued in the previous petition (except for those that could have been reasonably raised during the previous petition), in order to guarantee an opportunity to engage in a proceeding.

### Parallel Petitions



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*3. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in the Consolidated Trial Practice Guide, for deciding whether to institute more than one petition filed at or about the same time on the same patent?*

We would suggest that the USPTO should promulgate a rule with a case-specific analysis for deciding whether to institute more than one petition filed at or about at the same time on the same patent, if the USPTO is going to make such a decision. A guideline is needed not only for Patentees, but also for Petitioners.

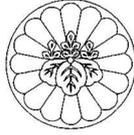
*4. Alternatively, in deciding whether to institute more than one petition filed at or about the same time on the same patent, should the Office (a) altogether disregard the number of petitions filed, or (b) altogether decline to institute on more than one petition?*

We would suggest that it depends on whether the present petitioner is the same as the previous petitioner. More than one petition should be declined due to judicial economy if the petitions are filed by the same petitioner at or about at the same time on the same patent based on the same reason. However, if either the petitioner or the reason is not the same or the reason is not one that could have been raised during the previous petitions, we would suggest that the petitions should not be declined in order to guarantee an opportunity to file a petition.

In Japan, there is a practice that plural petitions can be consolidated in proceedings, when either or both the Patentee and the Petitioner are the same in the petitions (Japanese Patent Act Article 154(1)). This system is efficient in preventing overlapping wasteful petitions, making proceedings efficient, and preventing conflicts among decisions from being made.

#### *Proceedings in Other Tribunals*

*5. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in *Fintiv* and its progeny, for deciding whether to institute a petition on a patent that is or has been subject to other proceedings in a U.S. district court or the ITC?*



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We would suggest that the USPTO should promulgate the rule, if the USPTO makes such decision. However, it is more desirable to avoid making the decision depending on the reasons for the previous petitions, as discussed in our answer to the 6<sup>th</sup> inquiry.

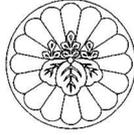
*6. Alternatively, in deciding whether to institute a petition on a patent that is or has been subject to other proceedings in district court or the ITC, should the Office (a) altogether disregard such other proceedings, or (b) altogether decline to institute if the patent that is or has been subject to such other proceedings, unless the district court or the ITC has indicated that it will stay the action?*

We would suggest that the USPTO should not make a decision to decline/disregard the petition based on the existence of other proceedings in a district court or the ITC, whenever the request for the petition is appropriate under law. We submit that the decision by administrative patent judges who are “persons of competent legal knowledge and scientific ability” is valuable, while each office might have its own decision which differs from others.

It is similar in Japan, and we highly evaluate a decision on an invalidation petition by the Appeal Board of the JPO which has competent legal knowledge and scientific ability. This is one of the reasons that the JPO can hear invalidation arguments in addition to a court.

On the other hand, it is wasteful and a heavy burden to institute a petition with respect to such a claim on any ground that the petitioner raised or reasonably could have raised during other proceedings in a U.S. district court or the ITC. Therefore, it is desirable that, for example, an inter partes review may not be instituted if the petition requesting the proceeding in the ITC is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent, in a similar manner of the district court case.

*Other Considerations*



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*7. Whether or not the Office promulgates rules on these issues, are there any other modifications the Office should make in its approach to serial and parallel AIA petitions, proceedings in other tribunals, or other use of discretion in deciding whether to institute an AIA trial?*

N/A

Sincerely,

A handwritten signature in black ink, reading "Y. Shimizu". The signature is written in a cursive, flowing style.

Yoshihiro SHIMIZU  
President, JPAA