

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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5th July, 2018

To: The Honorable Andrei Iancu, Director
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 Changes to the Claim Construction
Standard for Interpreting Claims in Trial Proceedings Before the
Patent Trial and Appeal Board**

Dear USPTO Director Andrei Iancu,

1. Considering that JIPA member companies file a large number of United States patent applications, JIPA has closely and carefully examined Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board (PTAB), published by the USPTO in the Federal Register (hereinafter FR) dated May 9, 2018. JIPA hereby presents its comments on the Changes.

2. JIPA makes the following remarks on the changes in the Claim Construction Standard before PTAB. We would like the Commissioner to take them into consideration when determining the changes in the standard.

(1) Merit of the broadest reasonable interpretation (BRI) standard

We respectfully request you to consider that construing a patent claim using the BRI standard helps to protect the public. This is as stated in the Supreme Court decision: *Cuozzo Speed Technologies, LLC v. LEE* 579 U.S. ___ (2016) (slip op., at 17).

That is, claims examined using the BRI standard before PTAB can be easily understood by public as the legitimate scope

of the right, and public can obtain useful information from disclosed inventions.

(2) The revision policy of AIA (Leahy-Smith America Invents Act)

The Congress enacted the AIA and created the reexamination mechanism for issued patents for the following purposes. That is, it is intended to expand the procedure by the USPTO to perform "reexamination (review)" of patents issued by the prior administrative proceedings to improve patent quality. Moreover, it is intended that the improvement in patent quality helps to secure the validity of a patent in district-court litigation and solve disputes between the parties, and furthermore it is intended to protect the public's paramount interest in seeing the patent monopolies: H.R. Rep. No. 98 Pt. 1, 112th Cong., and 1st. Sess. 48 (2011) (House Report). This is also as stated in the above-mentioned Supreme Court decision (slip op., at 16).

In other words, considering that the reexamination before PTAB in the AIA is a procedure to "review" issued patents examined using the BRI standard in administrative proceedings by the USPTO, we believe that it is a rational and efficient to use the same claim interpretation standard in a reexamination, which leads to the above-mentioned public interest, as used in prior USPTO's examinations.

(3) Roll of examination before PTAB

The effects by the present changes are described in FR21222 Column 3.

Minimizing differences between claim construction standards used in the various fora could lead to greater uniformity and predictability of the patent grant. In addition, using the same standard in the various fora could help increase judicial efficiency overall.

However, it is legally clear that there is a difference in the burden of proof by the challenger between a district court litigation and a reexamination before PTAB. That is, in district

court litigation, a patent is presumed to be valid unless clear and convincing evidence is presented, and thus the challenger must prove invalidity of the patent by presenting the above-mentioned evidence. On the other hand, in a reexamination before PTAB, a patent is not presumed to be valid, and the challenger only establish unpatentability by presenting preponderance evidence, and thus in reality, there is the difference in the burden of proof.

We are concerned that the above-mentioned effects asserted by the USPTO obtained by adopting the same claim interpretation standard in a district court litigation and a reexamination, which are different in the burden of proof, may be merely limited.

In view of the above three points, JIPA respectfully argues the merits of using the BRI standard in examination before PTAB as before.

Yours faithfully



Minoru Kato
Managing Director
Japan Intellectual Property Association