

From: [CHISHIMA Hideaki](#)
To: [TrialRFC2018Amendments](#)
Cc: [千島\(JBMIA\)](#)
Subject: Submissions from JBMIA on [Docket No. PTO-P-2018-0062] by USPTO
Date: Thursday, December 13, 2018 3:10:19 AM
Attachments: [SUBMISSION TO USPTO \(Docket No. PTO-P-2018-0062\).pdf](#)

Dear Sir,

This mail is for Japan Business Machine and Information System Industries Association (JBMIA) to submit its comments in response to solicitation of public comments by USPTO as announced in Federal Register / Vol. 83, No. 209 / October 29, 2018 / DEPARTMENT OF COMMERCE Patent and Trademark Office / Docket No. PTO-P-2018-0062.

The comments are attached hereto.

JBMIA is a Japanese incorporated association which was renamed in 2002 from Japan Business Machine Makers Association established originally in 1960. JBMIA consists of forty (39) member companies engaged in business machine and information system and five (5) supporting companies. Almost all of the member companies have actively filed patent applications in the USA.

Sincerely,
Hideaki Chishima(Mr)
Intellectual Property Committee Secretariat

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**DEPARTMENT OF COMMERCE
Patent and Trademark Office
Docket No. PTO-P-2018-0062**

**Request for Comments on Motion to Amend Practice and Procedures in Trial Proceeding
under the America Invents Act before the Patent Trial and Appeal Board**

Agencies: Patent and Trademark Office

Comments Close: 12/14/2018

**Association Submitting: Japan Business Machine and Information System Industries
Association (JBMIA)**

Submitter: Hideki Sanatake

Chairman of JBMIA IP Committee

Japan Business Machine and Information System Industries Association
LILA HIJIRIZAKA, 3-4-10 Mita, Minato-ku, Tokyo, 108-0073 JAPAN

Submission Date: 12/13/2018

DESCRIPTION OF JBMIA

Japan Business Machine and Information System Industries Association (JBMIA) is the industry organization which aims to contribute the development of the Japanese economy and the improvement of the office environment through the comprehensive development of the Japanese business machine and information system industries and rationalization thereof.

<http://www.jbmia.or.jp/english/index.php>

Regular Members	Associate Members
IRISOHYAMA INC. NEC Display Solutions, Ltd. Oki Electric Industry Co., Ltd. CASIO COMPUTER CO., LTD. Canon Inc. KYOCERA Document Solutions Inc. KONICA MINOLTA, INC. SHARP CORPORATION Seiko Epson Corporation Sony Imaging Products & Solutions Inc. DUPLO CORPORATION TOSHIBA TEC CORPORATION Panasonic Corporation Fuji Xerox Co., Ltd. Fujitsu Limited FUJIFILM Corporation BROTHER INDUSTRIES, LTD. Maxell, Ltd. MIMAKI ENGINEERING CO., LTD. MURATA MACHINERY, LTD. MEIKO SHOKAI CO., LTD. RICOH COMPANY, LTD. RISO KAGAKU CORPORATION	ACCO BRANDS JAPAN K. K. AMANO Secure Japan Corporation NEC Platforms, Ltd. OKAMURA CORPORATION GRAPE SYSTEMS INC. Cosmos Corporation SATO HOLDINGS CORPORATION Sky Co., LTD. TÜV Rheinland Japan Ltd. TOYO Corporation HP Japan Inc. NIPPON EXPRESS CO., LTD. Japan Quality Assurance Organization Fellowes Japan K.K. Microwave Factory Co.,Ltd. UL japan,Ink.
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	IT-it CO.,LTD E Ink Japan Inc. KYOCERA CORPORATION Hitachi-Omron Terminal Solutions, Corp. Fujikura Kasei Co., Ltd.

SUMMARY OF SUBMITTED COMMENTS

1. As to the Proposal of “Preliminary Decision by the Board on a Motion to Amend and an Opportunity to Revise that Motion”

We basically disagree with the proposal because it will create additional tasks within short time periods given to respond and thus will increase burdens on both parties. Especially, there will be a serious impact on foreign parties.

2. As to the Proposed Pilot Program

When the Office implements the pilot program, we request that the new amendment procedure not apply to AIA trial proceedings involving a motion to amend, that are filed before the implementation date of the program, but are decided to institute by the Board after the implementation date. Otherwise, it will hurt interests of those who file an AIA trial proceeding, but do not know the new amendment procedure.

REQUEST OF CHANGES IN CASE OF IMPLEMENTATION

While basically disagreeing with the proposed change, we request the points below even in case of implementing the new amendment procedure.

1. Extension of Time Period Given to Respond

The time period given to respond in the current proposal is too short, so we request changes from 1.5 to at least 2 months, and from 1 to at least 1.5 months. Especially for foreign parties (either patent owner or petitioner) that reside in foreign countries, the time period should be longer or extendible.

2. Limitation on amendment

With respect to the claim amendment in the motion to amend, we request that only amendment narrowing the claim scope of the claim proposed in the originally-filed motion to amend, be allowed. Otherwise, it will be difficult to settle claim scope through the procedure.

3. Meaning of Motion to Amend

In case of filing a motion to amend, we request that invalidity of the claims to be amended be assumed to be admitted by the patent owner. Accordingly, as for Question No. 10 in the document of USPTO proposal, the idea of “contingent” should be taken. In this way, the patent owner will be more careful in filing a motion to amend, which leads to decrease frivolous motions and secure smooth flow of the procedures.