

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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September 16, 2014

The Honorable Michelle K. Lee  
Deputy Under Secretary of Commerce for Intellectual Property and  
Deputy Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Alexandria, Virginia

Re: JIPA Comments on "Trial Proceedings Under the AIA Before the Board"

Dear Deputy Under Secretary Lee:

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 930 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned that the "Trial Proceedings Under the AIA Before the Board", published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.79, No.124, on June 27, 2014. We would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

JIPA again thanks the USPTO for this opportunity to provide these comments and welcomes any questions on them.

Sincerely, yours,



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## **JIPA Comments on the “Trial Proceedings Under the AIA Before the Board”**

As many of JIPA members engage in filing US patent applications, JIPA has closely and carefully examined the Request for Comments, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of June 27, 2014, under the title of “Request for Comments on Trial Proceedings Under the AIA Before the Board”. JIPA hereby presents its comments on this Request for Comments.

1. FR36476 Column 3 provides with respect to Motion to Amend as follows:

Motion To Amend

2. What modifications, if any, should be made to the Board’s practice regarding motions to amend?

The current AIA trial proceedings regarding motions to amend impose a page limit of 15 pages. Under the current practice, the claim listing is included in the 15 pages. Under such a practice, if the claims to be amended are originally lengthy or the number thereof is large, the number of pages required for describing the amended claim listing increases in the Motion to Amend. Accordingly, the number of pages which can be used for proving the patentability etc. is limited and thus the contents thereof should be abbreviated in comparison with the case where the claims are short or the number of the claims is small. It is allowed to exceed the page limit under the provision if a Motion to waive page limits which shows the interests of justice (for exceeding the page limit) is granted in advance (37 CFR 42.24(a)(2))<sup>1</sup>. However, there has been no precedent where such a motion was granted as far as we know.

JIPA hopes that it is no longer necessary to describe the amended claim listing in the Motion and may be attached separately. This modification is intended to allow a sufficiently detailed argument to be developed for proving the patentability etc. equally regardless of the length and the number of the claims to be amended.

As regards the amendment, the Board imposes the Patent Owner the burden of proof for the patentability of the amended claims as one of the requirements for accepting the Motion to Amend. It is demanded that this patentability should be demonstrated over the prior art

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<sup>1</sup> Case IPR2012-00006 The interests of justice should be indicated, if the reason is that the number of pages is not sufficient due to the length and number of the claims. “Thus Illumina asserts, without supporting evidence or explanation,(...) and that length and number of the claims challenged would prohibit it from addressing patentability sufficiently within the sixty pages allowed by Rule42(a)(1)(I). (...) It is not the Board’s role to compare the Illumina petition with its proposed petition and attempt to figure out if the Illumina request for waiver of the page limit is in the interests of justice.

in general.<sup>2</sup> JIPA believes, however, that this burden of proof for the patentability over the prior art in general is too strict for the Patent Owner considering that the time is limited and the number of pages is limited to 15 pages or less.

Therefore, JIPA hopes that as regards the proof of patentability imposed on the Patent Owner, the prior art to be compared should be within the documents cited in the examination procedure and the Petition of IPR.

2. FR36477 column 1 provides with respect to Extension of 1 Year Period To Issue Final Determination as follows:

Extension of 1 Year Period To Issue Final Determination

14. What circumstances should constitute a finding of good cause to extend the 1-year period for the Board to issue a final determination in an AIA trial?

There are cases where a test should be carried out for the comparison of the claimed invention with the prior art. Depending on the field of the invention and circumstances of the patent claims, such a comparison test takes a long term. JIPA believes that if an extension of term is allowed in such a circumstance, the Patent Owner or the Petitioner can conduct a comparison test sufficiently. JIPA concerns that insufficient test might bring unfair result. JIPA hopes that a case where a comparative test(s) are deemed necessary is allowed as a circumstance which constitutes a finding of good cause to extend the 1-year period for the Board to issue a final determination. This is because the Patent Owner or Petitioner should be able to carry out the comparative test fairly and sufficiently.

3. FR36477 Columns provide as General as follows:

General

17. What other changes can and should be made in AIA trial proceedings? For example, should changes be made to the Board's approach to instituting petitions, page limits, or request for rehearing practice?

The current AIA trial proceedings regarding the Petition impose a page limit of 60 pages. If the claims to be challenged are originally lengthy or the number thereof is large, the number of pages required for describing the claim chart increases in the Petition. Accordingly, the number of pages which can be used for the explanation is limited and thus the contents thereof should be abbreviated in comparison with the case where the claims are short or the number of the claims is small.

It is allowed to exceed the page limit under the provision if a Motion to waive page limits is filed simultaneously with the Petition and is granted as showing the interests of justice (for

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<sup>2</sup> Case IPR2012-00005 Paper 68 at 55

exceeding the page limits) (37 CFR 42.24(a)(2)). However, there has been no precedent where such a motion was granted as far as we know.

JIPA hopes that it is no longer necessary to describe the claim chart in the Petition and may be attached separately. This modification is intended to allow a sufficiently detailed argument to be developed for giving explanation equally regardless of the length and the number of the claims to be challenged.

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