



## **JAPAN PATENT ATTORNEYS ASSOCIATION**

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March 28, 2012

Judge. Michael Tierney,  
Lead Administrative Patent Judge,  
Board of Patent Appeals and Interferences  
USPTO

Re : JPAA Comments on “Practice Guide for Patent Proposed Trial Rules” and  
“Proposed Rules for Inter Partes Review”

The Japan Patent Attorneys Association (JPAA) is the professional association of more than 9,000 patent attorneys practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including copyright and unfair competition. Many are capable of representing clients before infringement lawsuits. The JPAA would like to submit our comments on the “Practice Guide for Patent Proposed Trial Rules” and “Proposed Rules for Inter Partes Review”.

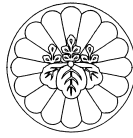
### “Practice Guide for Patent Proposed Trial Rules”

The "Practice Guide for Proposed Trial Rules" is well drafted and very helpful to understand the gist of the new proceedings of IPR, PGR, and CBM as well as the derivation proceeding. Each section is compact, and still sufficient for understanding the essence of the proceedings.

The JPAA wishes that the Practical Guide should be more specific for the conditions and timings where and when claim amendments are permitted during the proceedings. For example, "G. Amendments" on page 6874 of the Federal Register does not provide thorough information about the amendments. The conditions and timings for amendments are very important for not only patent owners but also petitioners and the conditions and timings for amendments should always be clear to the patent owners and petitioners.

### “Proposed Rules for Inter Partes Review”

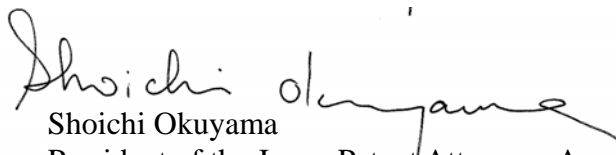
With regard to 35 USC 313, 37 CFR Section 42.107, we believe that it is reasonable that a patent owner is able to file a preliminary response to a petition before institution of inter partes review. Such preliminary response from the patent owner would help the Board make a quick-but-prudent decision on whether the review should proceed or not. With respect to a deadline for filing the preliminary response in the



USPTO, the JPAA wishes that the deadline may be extendable for patent owners residing outside the US.

With regard to 37 CFR Section 42.121(a), second sentence, we are afraid that the Board would be unwilling to authorize a patent owner to file additional motions because of the one-year requirement of 35 USC 316(11). The JPAA wishes that the Board would apply 37 CFR Section 42.121(a) in a flexible manner to give the patent owner sufficient chances for claim amendments because the patent owner has an absolute right to decide contents of his patent.

Sincerely yours,

  
Shoichi Okuyama  
President of the Japan Patent Attorneys Association