



JAPAN PATENT ATTORNEYS ASSOCIATION

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Patent Board,
Director of the United States Patent and Trademark Office,
600 Dulany Street,
Alexandria, VA 22314
U.S.A.

July 9, 2018

Attention: Vice Chief Administrative Patent Judges Michael Tierney/ Jacqueline Wright Bonilla, PTAB Notice of Proposed Rulemaking 2018

Subject: Docket No. PTO-P-2018-0036 Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board

Dear Sir or Madam,

The Japan Patent Attorney Association (JPAA) was established in May, 1915 under the Patent Attorneys Act, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has more than 11,300 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.

The JPAA appreciates the opportunity to submit comments on the proposed rule. We would be happy to answer any questions regarding our comments below.

The JPAA generally supports the proposed rule: replacing the broadest reasonable interpretation (“BRI”) standard for construing unexpired patent claims in inter partes review (“IPR”), post-grant review (“PGR”), and the transitional program for covered business method patents (“CBM”) proceedings (“IPRs proceedings”) with an approach that follows the frame work set forth in *Phillips*.

The JPAA thinks that the range of the patent right should be completely in accord with the range of the exercise of the right. Although the Office currently uses the BRI standard as a claim construction standard, the BRI standard potentially reads on a broader universe of prior art than does the *Phillips* standard. Thus, a patent claim could be found unpatentable in an AIA trial on account of claim scope that the patent owner would not be able to assert in an infringement proceeding, as described on p. 21223, column 1, lines 29-36 of the Federal Register Vol. 83, No. 90.



The AIA trials are trial proceedings conducted at the Board to review the patentability of one or more claims in a patent and begun by a third party (a person who is not the owner of the patent and a possible suspect of an infringement). The review is often requested in response to receiving a warning letter or initiation of an infringement litigation, and is performed by quasi-judicial Patent Trial and Appeal Board constituted by experienced administrative judges, on behalf of the court. In view of such nature of the AIA trials, the JPAA assumes that the claim construction standard in IPRs proceedings should be the same as the standard applied in federal district courts and International Trade Commission (“ITC”) proceedings.

Therefore, the JPAA generally supports the proposed rule-making. However, the JPAA also respectfully requests to make an additional explanation for the proposed claim construction and re-consider a current practice for amendments to secure more predictable proceedings.

[Item 1: Claim Construction]

The JPAA respectfully requests to confirm the following matters while the proposed rule said “Any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission, that is timely made of record in the inter partes review proceeding will be considered.”:

(i) Does the proposed rule suggest that the Board’s claim construction be bound by the prior claim construction determination? Or, can the Board adopt other claim construction?

(ii) If the Board adopt other claim construction, can the Board make their own claim construction? Or, can the Board make a claim construction in accordance with only the assertion of the Patentee or the third party?

The JPAA respectfully believes that these are essential issues for the Patentee to prepare and make an assertion regarding the claim construction.

[Item 2: Opportunities for Amendments]

The JPAA respectfully requests to allow the Patentee to have at least one substantial opportunity to file an amendment as a rule in IPRs proceedings, i.e. to relax the requirements for the amendment. For example, in a trial for invalidation in Japan, the Patentee has a right to amend the claims for following reasons:

- (i) restriction of the scope of claims,
- (ii) correction of errors or incorrect translations; and
- (iii) clarification of an ambiguous description, regardless of whether the amended claim under the trials is patentable or not (Japanese Patent Act Article 134bis(1)).



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Now, there were few cases in which the Patentee could amend the claims in IPRs proceedings. The JPAA respectfully believes that it is desirable for the Patentee to have at least one substantial opportunity to file an amendment in the context of distinguishing the IPRs proceedings from the proceedings in federal district courts and/or ITC. Additionally, the JPAA also respectfully believes that having an opportunity to file an amendment in IPRs proceedings is effective for not only the US Patentee but also the Patentee in foreign countries in light of an international harmonization.

Thank you for the opportunity to comment on the proposed rule.

Sincerely,

A handwritten signature in black ink that reads "K. Watanabe". The signature is written in a cursive, flowing style.

Keisuke WATANABE
President
Japan Patent Attorneys Association