



AIPPI • JAPAN

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International Association for the Protection of Intellectual Property of Japan

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December 12, 2018

The United States Patent and  
Trademark Office (USPTO)

Re: Comments on Motion to Amend Practice and Procedures in Trial  
Proceedings under the America Invents Act before the Patent Trial and  
Appeal Board

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding "Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board"

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

Our comments are attached hereto.

Very truly yours,

Kenichi NAGASAWA  
President  
AIPPI JAPAN

## Comments on Proposed Change to PTAB Rules (Procedure for Amending Claims during AIA trial proceedings)

### **Changed rule should not be applied retroactively in the name of a pilot program**

According to the Office's current proposal, the proposed pilot program will be implemented after the deadline for submission of comments on December 14, 2018, and the new procedure will be used in every AIA trial proceeding involving a motion to amend where the Board issues a decision to institute a trial after the implementation date of the pilot program. Consequently, the changed rule will also apply to those AIA trial proceedings where the petitioner had no way to know about this change at the time of filing the petition. This is, in effect, retroactive application of a changed rule and violates the principle of due process of law, unfairly harming the interests of the petitioner, in particular.

In the case of the change to the claim construction standard on which the Office solicited comments earlier this year, the new rule applies only to those AIA reviews that are requested on or after the effective date of that rule. This is because the Office finally decided not to retroactively apply the rule, despite the original proposal, in response to opposing opinions from the public.

If the Office adopts the new change as they propose, it will be indispensable at least to avoid the retroactive application as in the previous case to ensure a smooth transition.