

2018年12月14日
JEITA 特許専門委員会

AIA レビューにおける補正手続き改正案に対する意見

AIA レビューにおける補正手続き改正案に意見する機会を頂戴し、感謝致します。

JEITA は、IT/エレクトロニクス産業を中核にしたステークホルダーが所属する、日本最大級の業界団体です。その特許専門委員会は、会員企業21社を擁し、米国特許取得件数上位50社のうち、13社が、これらの企業に含まれています。

これらの企業は、日本は勿論、米国をはじめとする世界中で事業を展開しており、特許権者であるだけでなく、実施者でもあります。

このような、特許権者であり、かつ実施者でもある、という特質から、JEITA は、特許政策に関し、バランスの取れた見識を備えていると自負しております。かかる見識が、この度の補正手続き改正に役立つことを願い、以下、意見を申し上げます。

1. 問題の所在

本来特許が付与されるべき範囲を超えて与えられた特許は、第三者に不測の損害や不利益を与える恐れがあるため無効にされるべきです。同時に、本来特許が付与されるべき範囲の特許まで無効にされてしまうのは発明の適正な保護に欠けるため避けなければなりません。

この度の改正案は、AIA レビューにおいて補正の申請手続きの90%が認められていないというUSPTOにおける調査結果を踏まえ、AIA レビューをどのように制度設計すれば、本来特許が付与されるべき範囲の特許まで無効にされてしまうのを避けることができるか、という問題意識から生じたものと思料致します。

2. 解決アプローチ

本来特許が付与されるべき範囲の特許まで無効にされるのを避けるためには、改正案のように、特許権者に対してクレームの補正機会をより充実させるというアプローチがあると考えます。しかし、クレームの補正機会を過度に認めることは、当事者である申請人が不測の不利益を被る恐れもあります。

また、AIA レビューは、有効性が疑わしい特許を再考する低廉な手段を提供することで、無用な訴訟を減らすことを目的に導入されました。どのようなアプローチが適しているかを検討するにあたっては、このようなAIA レビューの導入経緯も忘れてはなりません。つまり、本来無効にされるべき特許が無効にされなくなってしまう事態は避けなければなりません。

こうしたことを踏まえ、AIA レビューにおける補正手続きの改正及びパイロットプログラムの施行にあたっては、全ての当事者（parties）及び利害関係人（stakeholders）にとっ

て公平でバランスのとれた制度になるよう慎重に検討すべきと考えます。

以下では、USPTO 資料 (Docket No.PTO-P-2018-0062) の P23-27 記載の質問のうち、特に気になったもの (concern) について回答致します。

3. 質問に対する回答

3-1. Q3. “the timeline in Appendix A1” に関して

Appendix A1 の Timeline では、各応答期間が 1 ヶ月または 1.5 ヶ月で、Petitioner、Patent Owner にとって十分な検討期間や無効資料の調査期間が与えられず、また Deposition や Declaration 等の手続きおよび書面も煩雑化し、PTAB への負荷も大きくなる懸念があります。今回の手続き変更の目的は、特許権者に十分な補正機会を与えることと考えますので、解決策の一例として、現行の手続きのスケジュールは変更せず、Motion to amend で、欧州特許制度のように特許権者が補正案を同時に 2 つ(Main request、Auxiliary request)提出できるようにするという方策もあります。この案によれば、Preliminary decision を省略でき、PTAB の負荷も軽減できると考えます。

3-2. Q5. “Preliminary decision” に関して

Preliminary decision は、Non-binding ではあるものの、特許権者での更なるクレーム補正の検討や両当事者での reply の内容検討の助けになります。それだけでなく、当事者間で和解を進めるのかなど、紛争解決にも寄与する可能性があります。現状の USPTO 資料によれば、Preliminary decision には、(1)Motion to amend が要件を満たしている立証に特許権者が優勢であること、(2)代替クレームの非特許性の立証に申請人が優勢であることが含まれるようです。しかし、単純にどちらが優勢かの判断だけでなく、その理由・根拠、更には地裁基準に基づいてどのようなクレーム解釈が行われたか等についても出来る限り含めることが、両当事者に有益であると考えます。

3-3. Q6. “Revised motion to amend” に関して

仮に 2 回目の補正を 1 回目と同様の補正要件 (新規事項追加/拡張でない、明細書と基礎出願にサポートあり) で認め、申請人が提出した Opposition、PTAB が出した Preliminary decision と関係ない内容で補正することが許容されると仮定します。そうすると、Opposition、Preliminary decision は無駄になってしまい、申請人にとって公平ではなくなり、審判官および申請人の負担が増え、迅速な審理に支障をきたすおそれがあります。従って、2 回目の補正では、1 回目の補正に対して new issue の追加を禁止すること、構成要件の外的付加を認めないこと等の何らかの内容的制限を設けるべきであると考えます。

また、特許権者が 2 回目の補正を提出する場合は、特許権者が 1 回目の補正を取り下げたと扱われることを明確にすべきと考えます。

3-4. Q10.“Contingent or non-contingent” に関して

現行の提案である"contingent" (対応オリジナルクレームが unpatentable である場合に限り補正クレームの特許性の最終決定を提供)の方が適切であると考えます。ユースケースとしては、侵害訴訟の提訴を受けた後に被疑侵害者側が申請人として、AIA trial proceeding の申請をするのが一般的だと考えます。侵害訴訟では、オリジナルクレームで審理が進むと思いますので、被疑侵害者(申請人)は、少なくともオリジナルクレームが有効かどうかを PTAB で判断してもらいたいと考えるためです。

"non-contingent"であった場合は、オリジナルクレームの特許性の決定に代えて補正クレームの特許性の最終決定が提供されます。つまり、侵害訴訟で審理対象となっているオリジナルクレームの特許性について、PTAB から何の判断も示されなくなってしまう。被疑侵害者(申請人)が PTAB からオリジナルクレームの特許性の判断を得る機会を実質的に奪われることは、公平ではありません。

3-5. Q13.“Proposed Pilot Program”の適用対象に関して

USPTO 資料 P21 の最終パラグラフによれば、パイロットプログラムが開始された後、“審査開始決定”がされたすべての AIA trial proceeding にパイロットプログラムを適用するとなっています。つまり、パイロットプログラムは、パイロットプログラム開始以前に申請された AIA trial proceeding に遡及適用されます。申請人は、現行のルールを前提に IPR 等の AIA trial proceeding を申請していますので、申請後のルール変更は公平ではないと思います。したがって、パイロットプログラムの適用対象は、パイロットプログラムが施行された後、AIA trial proceeding が“審査開始決定”がされた件ではなく、AIA trial proceeding が“申請”された件に限定した方が妥当であると考えます。

3-6. Q14.“Proposed Pilot Program”の opt-out に関して

両当事者が opt-out に合意する条件で本パイロットプログラムをその件に適用しないということは、両当事者に公平でバランスがとれております。従って、そのようにすべきであると考えます。

以上



PTO-P-2018-0062

December 14, 2018

Andrei Iancu
Director
United States Patent and Trademark Office,
Department of Commerce
P.O. Box 1450, Alexandria, VA 22313-1450

Re: Submission Concerning the Proposed Amendment Process in Trial Proceedings under the America Invents Act Before the Patent Trial and Appeal Board

Dear Mr. Director:

First of all, allow us to express our gratitude for your providing us with an opportunity to submit our comments for the public consultation on the proposed amendment process in AIA trial proceedings, that is, trial proceedings under the America Invents Act (“AIA”) before the Patent Trial and Appeal Board (the “PTAB”).

We are the Japan Electronics and Information Technology Industries Association (“JEITA”), one of Japan’s largest industry organizations, primarily constituted by stakeholders including electronics and information technology (IT) businesses. Our Patent Committee has 21 member companies, of which 13 members are among the top 50 companies in terms of the number of patents granted in the U.S.

These companies, being patent owners and at the same time manufacturers, have active worldwide presences, including in Japan and the U.S.

We believe that our unique position as being representative of both patent owners and manufacturers allows us to gain insight on patent policy measures from a well-balanced point of view. Based on this insight, we would like to make a submission hoping to be of assistance to your making an informed decision on revising the amendment process.

1. Fundamental Point of Issue

A patent should be invalidated if the scope of protection granted is found to be broader than as otherwise should have been granted, because such patent has a risk of causing unexpected damage or disadvantage to a third party. At the same time, it is necessary to prevent an invalidation of a patent which would otherwise have been patented, because this would be against proper protection of inventions.

We understand that the proposed amendment process takes into account the study conducted by the USPTO, which shows that the motion to amend has been denied in 90% of AIA trials, and seeks to develop a proper amendment process that can avoid the invalidation of patents which would otherwise have been patented.

2. Approaches to Solution

One possible approach for preventing an invalidation of patents which would otherwise have been patented may be to provide a patent owner with greater opportunity to amend claims. However, if the patent owner is given excessive opportunity to amend claims in AIA trial proceedings, this could cause unexpected disadvantage to the other party to the trial (the AIA trial petitioner).

Meanwhile, the AIA trial proceedings have been introduced to reduce unnecessary litigations by providing inexpensive means to review patents with the potential of being invalidated. For delving into the best approaches to be taken, this background and goal of introducing the AIA trial proceeding system must be also taken into account so as to ensure that patents containing grounds of invalidity will not survive.

Against this backdrop, we believe that the USPTO should carefully consider a well-balanced system that is fair to all parties and stakeholders in the course of revising the amendment process in AIA trial proceedings and implementing a pilot program.

In the section below, we submit our comments regarding some of the questions presented on pages 23 to 27 of the USPTO' notice (Docket No. PTO-P-2018-0062) which we have particular concerns about.

3. Comments

3-1. Regarding Q3. "the timeline" in Appendix A1

We are concerned about the proposed timeline in Appendix A1 wherein the petitioner and patent owner would have only 1 to 1.5 months to reply, which is insufficient for them to consider the case or investigate evidence of invalidity. This proposed timeline could also make proceedings and documents for making depositions or declarations more complicated, imposing a greater burden on the PTAB. The purpose of this proposed procedural change is to provide a patent owner with sufficient opportunity to amend, and as one possible approach to achieve this, we would suggest allowing a patent owner to introduce two amendment options in accordance with the current patent owner's response time and without changing the current timeline. This means that patent owners are able to simultaneously submit (i) a main request and (ii) an auxiliary request by filing only one Motion to amend at the current patent owner's response time, and those can be considered in parallel per the current timeline and rules. Auxiliary claim set requests have been used successfully in European Patent Office examination and opposition proceedings for years. This approach would enable the PTAB to omit making a preliminary decision, which could reduce its burden.

3-2. Regarding Q5. "Preliminary decision"

A preliminary decision, although it is non-binding, can assist the patent owner in considering

whether or not to further amend the claims and also assist the parties in elaborating their replies. In addition, it can also contribute to solving the dispute by encouraging the parties to discuss a settlement. According to the USPTO' notice explaining the current status, a preliminary decision indicates (1) whether the patent owner would prevail in establishing that the motion to amend meets statutory and regulatory requirements, and/or (2) whether the petitioner would prevail in establishing the unpatentability of any proposed substitute claims. However, a preliminary decision would be more useful to both parties if it further provides to the extent possible the reasons why the PTAB has judged the patent owner or petitioner to be prevailing in either case or the claim construction that the PTAB has reached based on the federal district court's standard.

3-3. Regarding Q6. "Revised motion to amend"

Suppose a case in which the PTAB would accept a patent owner's revised motion to amend, whose content is irrelevant to an opposition filed by the petitioner or a preliminary decision made by the PTAB, under the same requirements as those applied to the original motion to amend (i.e., not introducing a new matter to the original claims or expanding the scope of claims; being supported by the specification and the original application). In that case, the petitioner's opposition and the PTAB's preliminary decision would go to waste, which would be unfair to the petitioner and would increase the burdens on the examiner and the petitioner, posing an obstacle to speedy proceedings. To avoid such situation, we would propose some restrictions on the content of the revised motion to amend, such as to prohibit the revised motion from introducing a new issue or adding a new element to the claim rather than narrowing the scope of elements of the claim.

In addition, the USPTO should make it clear that if a patent owner files a revised motion to amend, the original motion would be treated as being withdrawn.

3-4. Regarding Q10. "Contingent or non-contingent"

We consider that a motion to amend should be "contingent" (meaning that the PTAB will provide a final decision on the patentability of a proposed substitute claim only if it determines that a corresponding original claim is unpatentable), as currently proposed. In common practice, a party that has been sued for infringement would file a petition for AIA trial proceedings. In infringement litigation, proceedings would be conducted based on the original claims, so the allegedly infringing party (the AIA trial petitioner) would desire the PTAB to determine at least whether the original claims are patentable.

If a motion to amend is "non-contingent," the PTAB will provide a final decision on the patentability of substitute claims in place of determining the patentability of corresponding

original claims. This means that the PTAB would make no ruling on the patentability of the original claims that are being examined in the infringement litigation. It would be unfair that the allegedly infringing party (the AIA trial petitioner) would be deprived of the substantial opportunity to obtain the PTAB's decision on the patentability of the original claims.

3-5. Regarding Q13. "Proposed Pilot Program" (scope of implementation)

The last paragraph on page 21 of the USPTO's notice states that the USPTO may implement the pilot program for every AIA trial proceeding involving a motion to amend "where the PTAB issues a decision to institute a trial" after the implementation date of the pilot program. This means that the pilot program will be implemented retrospectively with regard to all AIA trial proceedings for which a petition for trial has been filed before the implementation date of the pilot program. Such a rule change after the filing of petitions for AIA trial proceedings would be unfair to the petitioners because they file petitions on the basis of the rules that are in effect as of the time of the filing. Therefore, we consider that the pilot program should be implemented only with regard to AIA trial proceedings for which a "petition for trial is filed" after the implementation date of the pilot program, rather than those for which the "PTAB issues a decision to institute a trial" after that date.

3-6. Regarding Q14. "Proposed Pilot Program" (opt-out)

The approach of not implementing the pilot program in AIA trial proceedings if both parties agree to opt out of the program would be fair and well-balanced. We consider that the USPTO should adopt this approach.

Respectfully Submitted,

Japan Electronics and Information Technology Industries Association
1-1-3, Otemachi, Chiyoda-ku, Tokyo 100-0004, Japan