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米国特許商標庁(USPTO の IPR 制度変更意見募集への意見提出	米国特許商標庁	2025 年 12 月

The Japan Automobile Manufacturers Association (JAMA) respectfully submits this comment in response to the Notice of Proposed Rulemaking (NPRM - 2025-19580) issued by the United States Patent and Trademark Office (“USPTO”). JAMA appreciates the opportunity to provide input on the proposed amendments to the rules governing proceedings before the Patent Trial and Appeal Board (“PTAB”).

This comment introduces JAMA as an organization, outlines general observations and concerns regarding the proposed rule, and offers specific suggestions to ensure that the final rule supports innovation, procedural fairness, and global industry competitiveness.

I. Introduction

JAMA is a nonprofit industry association representing 14 manufacturers passenger car, truck, bus, and motorcycle manufacturers of Japan . JAMA is headquartered in Tokyo and has a branch office in Washington D.C. JAMA’s objective is to promote the sound development of the motor vehicle industry and support its members’ efforts to serve consumers, contribute to economic and social prosperity, and address safety and environmental challenges in those communities around the world in which they build and sell their products.

JAMA members have been integral to the U.S. auto industry and the broader American economy for decades. With cumulative manufacturing investment since 1982 now reaching over \$66.4 billion, JAMA members have 25 U.S. production facilities, 43 research and development (R&D) and design centers and 70 distribution centers across 27 states. Approximately one third of all vehicles produced in the U.S. are made by Japanese-brand automakers.

Japanese-brand automakers are interwoven with communities throughout the U.S. who count on them not only for employment but also for improved access to workforce development and education, philanthropic support, and environmental stewardship. JAMA’s members provide over 110,000 direct U.S. jobs and support more than 2.2 million jobs across the country.

In light of JAMA’s strong economic footprint in the United States, JAMA and its members have a particular interest in NPRM - 2025-19580, issued by the United States Patent and Trademark Office (USPTO). JAMA supports efforts to enhance transparency, fairness, and predictability in proceedings before the Patent Trial and Appeal Board (PTAB), as such improvements are essential to promoting innovation and maintaining global industrial competitiveness.

II. Treating IPRs as a “complete substitute for at least some phase of the litigation” for Invalidity Challenges in District Court Is Inconsistent with the Statutory Structure

The proposed rule (§ 42.108(d)) would allow the USPTO to limit the institution of IPR proceedings when invalidity challenges for the same patent are

raised in district court or the ITC, on the premise that “IPRs should generally serve as a complete substitute for at least some phase of the litigation.” That rationale cannot be squared with the statutory scheme established by the America Invents Act (AIA). Under 35 U.S.C. § 311(b), the grounds for invalidity that can be considered in IPR and in district court litigation differ, meaning the two are not a “complete substitute.”

Section 311(b) explicitly limits the grounds that can be raised in an IPR as follows:

“A petitioner in an inter partes review may request to cancel as unpatentable one or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”

In other words, the only permissible invalidity grounds in IPR are novelty (§ 102) and non-obviousness (§ 103), and the prior art for those challenges is restricted to patents and printed publications.

This limitation reflects the legislative policy behind the AIA, which designed IPRs as a swift procedure providing review based on documentary prior art.

In contrast, invalidity challenges in district court litigation under 35 U.S.C. § 282(b)(2) may be based not only on patents and publications but also on non-documentary art such as products, public use, sales, or prior practice.

Therefore, IPR and district court proceedings are complements, not substitutes. In drafting the AIA, Congress could have chosen to design IPRs to resolve challenges based on the full gamut of art that is available to a challenger in district court. It chose not to do so. Treating IPRs as a “complete substitute” for one or more phases of the litigation would be inconsistent with Congress’s judgment.

III. Prohibiting IPRs on Patents Previously Deemed Valid Conflicts with the AIA’s Intent and Unfairly Disadvantages Later-Sued Defendants

Congress also considered and made statutory provision for the interaction between district court litigation and parallel IPR proceedings. The proposed rule would upset the balance Congress struck. In particular, proposed § 42.108(e) states that if a patent claim has ever been held valid by a district court, the ITC, the PTAB, or in reexamination, subsequent IPR petitions should generally not be permitted. But Congress chose to provide for a more limited estoppel, reflecting its judgment that the “one and done” rule reflected in the proposed rule would be undesirable and unfair.

(1) Congress Considered and Provided for a Careful Balance Between IPRs and District Court Litigation

In enacting the AIA, Congress considered and made provision for the fact that the same patent might be subject to validity challenges through both the IPR process and district court litigation, including from different challengers. It enacted provisions to protect patent owners from the unfairness of multiple “bites at the apple” by the same challenger, without providing that IPRs would be completely barred in the event of an unsuccessful challenge by a single challenger.

With respect to the effect of district court challenges on IPRs, Congress provided that under 35 U.S.C. § 315(b) a party cannot file an IPR petition more than one year after “the petitioner is served with a complaint alleging infringement of the patent” at issue in the petition. Congress also provided that under 35 U.S.C. § 315(a)(1), a party cannot file an IPR petition if it first brought a declaratory-judgment action for invalidity in district

court on the same patent at issue in the petition.

With respect to the effect of an IPR proceeding on district court litigation or subsequent IPRs, 35 U.S.C. § 315(e) provided that “[a] petitioner … may not assert in another USPTO proceeding or in a civil action that a claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.”

Thus, while Congress took steps to make sure that a challenger would not be able to wastefully subject a patent owner to multiple duplicative challenges, it also chose not limit this estoppel effect only to the petitioner who filed the IPR and their privies. Other entities remain free to independently file IPR petitions based on new evidence or theories. Accordingly, proposed § 42.108(e) upsets the careful balance Congress struck.

(2) Practical Unfairness

Congress’s scheme makes sense. Proposed § 42.108(e) would result in undesirable consequences by allowing patent owners (including non-practicing entities, or “NPEs”) to strategically target small or resource-limited companies as initial defendants who are ill-equipped to mount the strongest possible invalidity challenge. If whatever patent challenge those small entities could muster proved unsuccessful, the patent owner could then prevent entities better equipped to identify invalidity problems from accessing the IPR mechanism for challenges.

As a result, low-quality patents would effectively gain de facto immunity. This structural design would foster the proliferation of poor-quality patents, undermining one of the AIA’s central objectives — eliminating such patents to support healthy technological competition.

(3) General Plastic case (General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha, IPR2016-01357)

To the extent the statutory scheme is not adequate, the PTAB has already created an adequate mechanism to deter abuse of serial petitions in the General Plastic decision.

Under General Plastic, the PTAB comprehensively considers various factors—such as the content and timing of the earlier petitions, the presence or absence of new evidence, the reasonableness of the petitioner’s conduct, and the impact on resources—to strike a balance between ensuring a petitioner’s legitimate opportunity to defend itself and preventing an excessive burden on patent owners or the wasting of resources. This flexible and well-established framework has already achieved both the prevention of abuse and fairness, and there is no reason to uproot it.

IV. The Premise of the Rule Does Not Take NPEs into Account

The justification for the proposed rule is that “[r]eliable patent rights encourage the inventor or others to invest in the patented technology by giving them confidence that they, not competitors, will reap the benefits of their efforts.” It states that “[w]ithout this additional investment, the invention may remain in the laboratory, never reaching the public as a commercial product or service.” The stated justification for the proposed rule is therefore to encourage investment in innovation.

However, this premise does not align with the current reality of litigation. Today, many patent infringement lawsuits are filed by NPEs that neither engage in research and development nor manufacture or sell products. These NPEs purchase patents that reflect the achievements of others and monetize them through license fee demands or litigation.

Therefore, protecting patents held by NPEs in the name of “reliable patent rights” does not promote innovation. On the contrary, it risks restraining the activities of companies that actually invest in R&D and commercialization, thereby harming U.S. technological competitiveness and the health of the market. The blanket nature of the proposed rule therefore threatens to undermine its very justification.

V. Conclusion

We agree with the USPTO’s goal of promoting “fairness, efficiency, and predictability.” However, the current proposal suffers from the following fundamental problems:

1. Under the statutory design of 35 U.S.C. §311(b), IPR and district court proceedings cover different grounds for invalidity; treating them as “complete substitutes” is incorrect.
2. Categorically barring IPRs based on prior validity proceedings—including those brought by other entities—grants immunity to low-quality patents and contradicts the purpose of the AIA.
3. The premise of the proposed rule—that it would promote innovation—does not apply to NPEs, and as currently drafted, the proposed rule would undermine its stated justification.

¹ JAMA's membership includes Daihatsu Motor Corporation, Hino Motors, Honda Motor Corporation, Isuzu Motors Limited, Kawasaki Motors, Mazda Motor Corporation, Mitsubishi Motors Corporation, Mitsubishi Fuso Truck and Bus Corporation, Nissan Motor Corporation, Subaru Corporation, Suzuki Motor Corporation, Toyota Motor Corporation, UD Trucks Corporation, and Yamaha Motor Corporation

² “The Contributions of Japanese-brand Automakers to the United States Economy,” Dr. Thomas Prusa (<https://www.jama.org/the-contribution-of-the-japanese-branded-automotive-industry-to-the-united-states-economy-may-2023/>) (May 16, 2023) (accessed October 10, 2025).