

**From:** Anne Brown  
**Sent:** Friday, October 05, 2012 3:36 PM  
**To:** fitf\_rules  
**Subject:** first to file Comments

- (1) Section 155(a)(4) requires that, if an application filed after 3/16 that discloses “subject matter” not disclosed in the prior (pre-3/16 application), the applicant must provide a statement to that effect. But it is not clear at all what would constitute “subject matter”. Is it any textual addition? Is it only subject matter that would support a claim? Is it only subject matter that would support a claim that would not have been supported in the prior application?
  
- (2) Section 155(a)(4) requires that, if an application filed after 3/16 has a claim that is not in the prior (pre-3/16 application), the applicant must provide a statement to that effect. Would that also apply to a claim that was fully supported by the prior disclosure or only to a claim that was not supported by the prior disclosure?
  
- (3) Same questions for 178(a)(3) and 178(c)(2).
  
- (4) It’s very clear that if a US application is first filed after 3/16 then the effective prior art date for a foreign application (for examination purposes) is the earliest foreign priority date. But what is not clear is the following: If an applicant has an application where any of the above sections apply, can the expanded prior art be used to search ALL of the claims (ie, the pre-3/16 claims as well as the post 3/16 claims) or only those claims that do not have support in the prior application?

Example of issue: There is a US application (parent) filed pre 3/16. There is a continuation (not RCE) or divisional of that parent filed after 3/16. The continuation (or divisional) contains a new claim that was fully supported by the parent spec. As to that claim, could a foreign application be cited as prior art against that claim based on its earliest foreign priority date or only based on its publication date?

I would also recommend the following

1. The USPTO has the burden to examine applications and Applicants should not be required to make such statements, especially where they can be adverse to clients' interests... and with many state bar rules, attorneys are prohibited from actions which are adverse to client's interests.
  
2. Because of the issues with such statements, we propose that the USPTO initially examine all applications as if they are post-AIA, i.e. under the post-AIA laws. Then should Applicant

choose, Applicant can argue and submit evidence that the application should benefit from pre-AIA First Inventor rules... similar to 131 swearing behind practice.

3. The requirement to provide a certified copy of a priority document within 4/16 mos or else one loses their priority claim is a BIG problem as sometimes clients don't decide whether to pursue an application until the last minute. Obtaining a priority document timely is completely dependent on how fast the patent office of the priority document acts. Some take their own sweet time. #2 above will also result in this "timing" requirement being unnecessary.

Anne Brown, Ph.D.

Tarolli, Sundheim, Covell & Tummino LLP

1300 East Ninth Street, Suite 1700

Cleveland, Ohio 44114

Phone: 216-621-2234 Ext. 146

Fax: 216-621-4072

[abrown@tarolli.com](mailto:abrown@tarolli.com)