

**From:** Brad Pedersen  
**Sent:** Friday, October 05, 2012 4:32 PM  
**To:** fitf\_rules  
**Cc:** Brian Batzli  
**Subject:** MIPLA FITF NPR Rules Comments

Attached please find the comments on the First-Inventor-to-File Notice of Proposed Rule Marking for the Proposed Rules that are being submitted on behalf of the Minnesota Intellectual Property Lawyers Association (MIPLA).

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October 5, 2012

Email – fitf\_rules@uspto.gov

MAIL STOP – Comments-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTENTION – Susy Tsang-Foster, Legal Advisor

Re: Comments on Proposed Rules for:  
Changes to Implement the First Inventor to File Provisions  
of the Leahy-Smith America Invents Act  
77 Fed. Reg. 43742 et seq., July 26, 2012

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Notice of Proposed Rulemaking (NPR) entitled “Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act,” 77 Fed. Reg. 43742 et seq., July 26, 2012.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients.

### **Overall Comments/Suggestions**

1. Support for Overall Framework of the Rule Changes – At a general and overall level, the rule changes proposed in the NPR implementing the first-inventor-to-file (FITF) provisions of the America Invents Act (AIA) are viewed by MIPLA as consistent with the AIA and with the history of that legislation leading up to its enactment in 2011.
2. As indicated in testimony by the undersigned at the Roundtable on these proposed rules held at the USPTO on September 6, 2012, MIPLA believes that the proposed rules “get it right” in terms of (i) balancing the *prima facie* burden which the Office has by statute with incentives for having applicants provide early identification of assertions of priority and exception for prior art as part of

the application process, and (ii) the assumption of symmetry between what will be considered to be “publicly available” for purposes of prior art under AIA Section 102(a)(1) and what will be considered a triggering disclosure for purposes of asserting the exceptions for prior art under AIA Section 102(b). However, MIPLA believes that the proposed Examination Guidelines “get it wrong” in terms of the standards proposed to be used for evaluating the scope of the exceptions created by a triggering disclosure for purposes asserting the exceptions for prior art under AIA Section 102(b). As discussed more fully in the Comments on the proposed Examination Guidelines, MIPLA opposes what is generally referred to as the “narrow” construction for the AIA Sections 102(b)(1/2)(B) first-to-publish (FTP) grace period exceptions.

### **Specific Comments/Suggestions**

- A. Clarification of “claim” in a priority/benefit context vs. “claim” in a claimed invention context – MIPLA suggests that the proposed rules could be clarified if the Office would consistently use throughout the proposed rules the terms “benefit claim” or “priority claim” when using the term “claim” in the context of an applicant asserting the benefit of an earlier priority date for a given claimed invention. In most cases, the context of how the term “claim” is being used in the proposed rules is apparent from a careful reading, but the use of the exact same term for two different purposes can be confusing on a quick read of the rules.
- B. Clarification on the “four months” deadlines for proposed Rules 1.55(a)(2)/(4), 1.78(a)(3)/(4), 1.78(c)(2)/(3) – MIPLA generally approves of these proposed rules and the various “four month after US filing” timelines as the best way of balancing the *prima facie* obligation of the Office to examiner applications and the need to have applicants provide information in a timely manner to facilitate efficient examination of applications about priority claims or a triggering disclosure for purposes asserting the exceptions for prior art under AIA Section 102(b). However, MIPLA would like the Office to clarify how these deadlines would be handled in view of the opportunity for applicants to extend the deadlines for filing missing parts for up to five months after receipt of a Notice of Missing Parts. It would appear that the better approach would be to have these various deadline occur on the longer of four months from the relevant US filing date or the completion of a response to a Notice of Missing Part.
- C. Proposed Rules 1.55(a)(4) and 1.78(c)(2): *Claiming Priority in an AIA case to a pre-AIA case* – MIPLA suggests that the Office should clarify the language in the rule that read: “or the date that a first claim to a claimed invention having an effective filing date on or after March 16, 2012 is presented in the application.” It is assumed that the first presentation of a claim having an earlier priority date can include the presentation of that claim by virtue of an amendment of an original or previously amended claim filed well into the prosecution of the application. MIPLA suggests that the proposed rules would be clearer if the timing requirements for a pre-AIA priority claim in a case filed after March 16,

2012 in the case of first presentation of a claim by way of an amendment or response after the filing date were made as a separate sentence in the rules that includes a specific requirement that the indication of a pre-AIA priority claim should be made as part of any amendment or response first presenting such a claim. A preliminary amendment filed with an application with first presentation of a pre-AIA claim should still be governed by the four month timing deadlines, but first presentation of a pre-AIA claim by way of amendment or response during prosecution should have the identification of the first presentation of a pre-AIA claim be made as part of the amendment or response.

- D. Proposed Rule 1.55(c)(4): *Requirements of Petition for Late Presented Priority Claim* – MIPLA asks the Office to provide a rationale or statutory basis for the proposed requirement of a “statement that the entire delay between the date the claim was due under paragraph (a) and the date the claim was filed was unintentional.” The requirement of proof of the subjective intent of the applicants appears to run counter to the many statutory changes in the AIA that remove the subjective requirements for proof of applicant or patentee intent. One potential alternative to dissuade applicants from intentionally delaying presentation of a priority claim would be to insure that the entire length of delay in presenting a priority claim by petition is counted against any patent term adjustment calculated for the application.
- E. Proposed Rule 1.55(e)(4): *Requirements for filing an English translation of Foreign Priority Application* – MIPLA suggests that the Office specifically reference the preceding rule 1.55(e)(3) to clarify when an English translation is required under proposed Rule 1.55(e)(4), and also provide clarification in the rule on the timing of any deadlines for filing an English translation in response to proposed Rule 1.55(e)(3)(ii)-(iii). It is assumed that if an Office Action contains either a rejection based on prior art that has dates intervening between the US filing dates and the foreign priority claim dates or a specific request by an Examiner, then the deadline for filing the English translation would be consistent with the deadlines for responding to the Office Action, including any extensions of time that may be permitted for a response. It would be helpful if the rules expressly confirmed that filing of the English translation in response to an Office Action can take advantage of any extensions of time for filing that Office Action, particularly given proposed Rule 1.55(f) which indicates that time periods under this section are not extendable.
- F. Proposed Rule 1.77(b): *Arrangement of Application Elements* – MIPLA suggests that the Office should take this opportunity to revamp Rule 1.77(b) and separate out those items of information currently required under separate headings in a patent application in Rule 1.77(b) that are now going to be tracked by the Office in the Application Data Sheet pursuant to new Rule 1.76. Specifically, current subsections 1.77(b)(1)-(4), other than the actual title of the invention, and proposed Rule 1.77(b)(6), each reference information that is being provided and managed in an electronic manner via the Application Data Sheet (name,

citizenship and residence of applicant, related applications, federally sponsored joint research, joint research agreements and the proposed rule for prior disclosures by or for an inventor). Current subsections 1.77(b)(1)-(2) include a parenthetical that makes these subsections optional if the information is included on the application data sheet. Given that the timelines for filing the information required by proposed Rule 1.77(b)(6) are not coextensive with the filing of application, and given that subsequent presentation or amendment of the claims could significantly impact the issue of whether or not a prior disclosure is or is not being used to trigger an exception to prior art under Section 102(b), the requirement to include this section in the patent application seems out of place and more likely to result in confusion to the public when reviewing either patents or published applications. Keeping all of this kind of information tracked and published as part of the Application Data Sheet available on PAIR, or as part of the cover page of a patent or published application, seems like a better way to keep the public informed and allows applicants to provide these kinds of information in a more efficient manner and in accordance with the timelines and procedures set forth under the remainder of the proposed Rules.

- G. Proposed Rule 1.78(e): *Applications Containing Conflicting Claims* – MIPLA suggests that the Office should take this opportunity to clarify the intended scope of what is meant by “conflicting claims” in proposed Rule 1.78(e) that represents a re-promulgation of current Rule 1.78(b). Given the adoption of other new rules regarding claims that are “substantially similar” or “patentably indistinct,” in the context of the new derivation proceedings, for example, there is a possibility for confusion in how the term “conflicting claims” in proposed Rule 1.78(e) should be understood in reference these other new rules.
  
- H. Proposed Rule 1.130: *“Subject Matter of the Disclosure”* – MIPLA is concerned that the proposed Rule 1.130 introduces a new concept into the rules that is not recited in the statute or defined by the proposed Rule. As discussed more fully in the Comments on the Proposed Examination Guidelines, the statutory phrase “subject matter disclosed” is unique to new AIA Sections 102(b) and 102(c) and must be interpreted and applied consistently by the Office in promulgating rules relating to these statutory provisions. The phrase used in proposed Rule 1.130 “subject matter of the disclosure” is not found in the statute or defined in the NPR. The usage of this phrase in proposed Rule 1.130(b), (d), (e) does not appear to be consistent and is used in some places to refer to the content of the prior art disclosure and in other places to refer to the content of the disclosure made by or from the inventor that is being relied upon to trigger an exception under AIA Sections 102(b) or 102(c). More problematic is that the phrase is also used in some places to reference the content of a rejection, instead of the content of either a prior art or inventor-based disclosure. The Office is urged to reconsider and revise the usage of the terminology in the final rules to make the rules clear and consistent with respect to the meaning and application of the statutory language “subject matter disclosed.”

- I. Proposed Rule 1.130(c) and (e): *Declaration Invoking 3<sup>rd</sup> Party FTP Grace Period for 102(a)(1) Prior Art* – MIPLA suggests that the Office amend the last sentences of proposed Rule 1.130(c) and (e) be changed to read: “If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the disclosure with sufficient detail and particularity to provide a satisfactory showing that the disclosure is a public disclosure of the subject matter of the earlier disclosure.” The suggested changes would make the standard for evaluating both non-publications and publications the same, and eliminate the potentially confusing reference to the language “the subject matter on which the rejection is based.” The proposed rule provides no basis or rationale for evaluating the two kinds of public disclosures based on different standards. MIPLA urges the Office to adopt an approach for all of the various exceptions to prior art under AIA Section 102(b) or 102(c) that is symmetric in its application.

Submitted on behalf of MIPLA by:

/s/

Brad Pedersen  
Chair, MIPLA IP Law Revision Committee