

From: Amanda.CarmanyRampey
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To: fitf_rules
Subject: WSPLA Comments on Changes to Implement First-Inventor-To-File

Attached are comments from the Washington State Patent Law Association on the Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR 43,742, published on July 26, 2012.

Thank you,
Amanda J. Carmany-Rampey

Amanda Carmany-Rampey Ph.D.

Associate

206-405-2007 Direct

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LAW

five decades. one focus.

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Amanda J. Carmany-Rampey, Ph.D.
Amanda.CarmanyRampey@knobbe.com

October 5, 2012

VIA EMAIL ONLY
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, Office of Patent Legal Administration, United States Patent and Trademark Office

Dear Under Secretary Kappos:

The Washington State Patent Law Association (“WSPLA”) appreciates the opportunity to provide comments on the “Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act” published on July 26, 2012 in the Federal Register (77 FR 43,742). WSPLA is the leading organization for patent attorneys and other patent professionals in the State of Washington, providing a forum for patent and other intellectual property law issues, and serving as a valuable resource for patent attorneys, agents, educators, students, and owners of intellectual property in our state. WSPLA offers the following comments and suggestions regarding the proposed changes to the rules of practice to implement a “first inventor to file” (FITF) system.

The FITF provisions of the America Invents Act (AIA) apply to any application for patent, and to any patent issuing thereon, which contains or contained at any time “a claim to a claimed invention” that has an effective filing date on or after March 16, 2013.¹ In order to assist the U.S.P.T.O. in determining whether an application is subject to examination under 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2012 (pre-AIA), the U.S.P.T.O. proposes amendments to 37 C.F.R. § 1.55(a)(4) and 37 C.F.R. § 1.77(a)(3) that will affect the prosecution of nonprovisional applications filed on or after March 16, 2013, which claims the benefit of a foreign (amendments to 37 C.F.R. § 1.55(a)(4)) or provisional (amendments to 37 C.F.R. § 1.77(a)(3)) applications filed prior to March 16, 2013. It is the opinion of WSPLA that the proposed changes to 37 C.F.R. § 1.55(a)(4) and 37 C.F.R. § 1.77(a)(3) place an undue burden on applicants and will be only marginally effective, at best, in assisting the U.S.P.T.O. in determining whether an application is subject to examination under AIA or pre-AIA rules.

The proposed amendments to 37 C.F.R. § 1.55(a)(4) and 37 C.F.R. § 1.77(a)(3) would require that if (1) an application claims the benefit of a foreign or provisional application filed prior to March 16, 2013 and (2)

¹ Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(n), 125 Stat. 284 (2011).

contains, or contained at any time, a claim to a claimed invention that has an effective filing date² on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed foreign or provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, for applications claiming the benefit of a foreign or provisional application filed prior to March 16, 2013 that *do not* contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but disclose subject matter not also disclosed in the pre-March 16, 2013 priority application, the proposed amendments would require the applicant to make a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed foreign or provisional application.³

As the FITF provisions of the America Invents Act (AIA) only apply to applications that contain or contained at any time “a claim to a claimed invention” that has an effective filing date on or after March 16, 2013, it must be presumed that the purpose the proposed amendments requiring the applicant to identify applications that *do not* contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but disclose subject matter not also disclosed in the pre-March 16, 2013 priority application, is to target these applications for further scrutiny into the effective filing date of the claims by the U.S.P.T.O. in order to determine whether an application is subject to examination under AIA or pre-AIA rules. Although this aspect of the proposed amendments may assist the U.S.P.T.O. in determining whether AIA or pre-AIA examination rules apply, further requiring an applicant to make an affirmative statement that an application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, places an undue burden on applicants and invites charges of inequitable conduct. Determining whether a patent claim is supported by a disclosure is often a fact-based inquiry, over which reasonable parties may disagree. However, by *requiring* an applicant to make an affirmative statement that an application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, when such a statement is not made the applicant is necessarily stating that all claims of an application have an effective filing date before March 16, 2013. WSPLA is therefore concerned that by making it a requirement for applicants to state that an application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the proposed amendments are opening the door for unnecessary litigation.

² “The term ‘effective filing date’ for a claimed invention in a patent or application for patent (other than a reissue application or a reissued patent) means the earliest of: (1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365.”

³ The applicant is not required to specify which claims have an effective filing date after March 16, 2013 or what subject matter was not disclosed in the pre-March 16, 2013 priority application. However, if the applicant fails to make a timely statement or seeks to retract a previous statement, the U.S.P.T.O. may require issue a requirement for information under § 1.105, requiring the applicant to specifically identify where there is written description support for the claims in the pre-March 16, 2013 priority application.

WSPLA therefore proposes that a statement that an application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 be optional. Making this statement optional would be unlikely to increase the burden on U.S.P.T.O. in determining whether an application is subject to examination under the AIA or pre-AIA rules, as the U.S.P.T.O. already makes this determination under the proposed amendments when the statement is not made and applicants would be motivated to identify an application for examination under the AIA rules, when appropriate, in order to avoid the time and expense of being required to identify written description support for the claims in the pre-March 16, 2013 priority application.

Thank you,



Amanda J. Carmany-Rampey
Chair, Patent Office Rules and Practices Committee
WSPLA