

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
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Commissioner for Patents
Box Comments - Patents
Washington, D.C. 20231

April 24, 2003

Notice of Proposed Rulemaking
Changes to Implement Electronic Maintenance
of Official Patent Application Records
68 Fed. Reg. 14365 (March 25, 2003)

Dear Mr. Commissioner:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the rule and practice changes proposed by the United States Patent and Trademark Office (PTO) in the subject Notice.

The AIPLA is a national bar association whose more than 14,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

We support and encourage the PTO to move promptly, but effectively, to a system permitting beginning-to-end electronic processing of applications. We are

pleased to provide comments on the subject notice, and stand ready to assist and consult with the PTO in structuring an effective and efficient electronic system free of unnecessary complexities.

Please consider the following comments and suggestions on the proposed rule changes and practices described in the Notice:

37 C.F.R. § 1.3:

As we understand the proposed change in this section and the associated practices, the PTO will not enter, and will not consider as a bona fide reply under 37 C.F.R. § 1.135(c), a paper (1) presented in violation of the decorum and courtesy requirement or (2) submitted in violation of 37 C.F.R. § 10.10(b) [former patent examiner assisting with an application within his/her bar]. While we agree that the PTO should have procedures to address these rare transgressions of acceptable practice, the proposals appear incomplete, unworkable at a practice level, and unfair to an innocent applicant.

First, the proposed section, unlike the existing section, contains no provision for notice to the applicant (such as by return of papers) that the PTO has made a decision not to enter a paper. Whether a particular paper violates the decorum and courtesy requirement or is in violation of § 10.10(b) will often require some judgment and possibly even an investigation of the facts. It may well be, particularly in the case of a violation of § 10.10(b), that the person submitting the paper has no idea a violation has occurred.

Accordingly, if and when the PTO takes an action not to enter a paper because of a violation of § 1.3, the applicant should be promptly notified of this determination and that requirement should be made explicit in § 1.3.

Secondly, the proposed change to this section is not workable at a practical level unless it is the intent of the PTO to retroactively declare applications abandoned or patents lapsed because of a belated and possibly retroactive non-entry of a paper. The PTO should recognize that even in the rare instance when a paper is submitted lacking decorum and courtesy, it is not likely to be read by anyone in the PTO until after the statutory period has expired. Similarly, a violation of § 10.10(b) may not be detected/uncovered until years after a patent has been granted. We believe that both of these situations are more properly addressed by the Office of Enrollment and Discipline for registered practitioners, and as a possible issue of inequitable conduct in the particular application/paper—recognizing that the PTO neither addresses nor investigates an inequitable conduct issue outside of an interference proceeding. Finally, if this policy and practice of non-entry of papers is to be applied to papers submitted in violation of § 10.10(b), that practice should be explicitly recited in § 1.3, not buried in text of a proposed rulemaking notice.

Third, the proposed practice of not entering papers may be unfair to an innocent applicant, both from the standpoint of receiving timely notice that a paper has not been entered, and perhaps adding an unnecessary burden of reviving an application from abandonment or a patent from a lapsed status, in addition to potential unenforceability

problems. We would encourage the PTO to provide notice to the applicant when a first violation is determined with a fair warning that future violations will result in the non-entry of any paper submitted in violation of this section. At the least, we would support a revision to this section to provide: "Papers presented in violation of this requirement will be submitted to the Commissioner for Patents and may not be entered upon notice to applicants and any registered practitioner." Note that this proposed revision would require that the Commissioner of Patents make a decision to authorize the PTO to deny entry to a paper only after adequate notice, and that this notice be provided to both applicants and any registered practitioner prosecuting the application/reexamination proceeding.

37 C.F.R. § 1.14:

AIPLA generally supports the reorganization of this section and the proposed changes. However, AIPLA would encourage the PTO to make additional changes consistent with the general policy and practice of making patent prosecution transparent to the public after 18 months from original filing and in other special circumstances.

Specifically, under § 1.14(a)(1)(iv) an unpublished abandoned application that is referenced in certain prescribed documents is open to the public upon request. The AIPLA encourages the PTO to similarly make unpublished pending applications that are referenced in certain documents available to the public upon request where those pending applications are either incorporated by reference in the certain documents or where the pending application is relied upon under 35 U.S.C. §§ 119(e), 120, 121 or

365 by an application that has issued as a U.S. patent or in an application that has published as an SIR, or with effect as a U.S. application. Where almost 90% of pending U.S. applications that are now published are available to the public, there is no sound public policy or unusual PTO burden that should prevent public access to these unpublished pending applications. These unpublished pending applications can be an essential source of prosecution history that is necessary, for example, to interpreting the scope of claims in a patent that relies on the unpublished pending application for filing date benefit.

The Office should clarify, either in the regulation itself or in additional information provided in the Manual of Patent Examining Procedure on this section, what it means when it indicates an application is “referenced” in another document. Does this reference mean that an application is simply identified in the specification of another document? Must this “reference” constitute an incorporation-by-reference of the application? Must the reference actually appear in the patent or patent application publication, or could it appear in the prosecution history of such a patent or application such as in an information disclosure statement submitted by the applicant during the prosecution of the patent or application?

Finally, under 37 C.F.R. § 1.14(f)(2), the AIPLA would encourage the PTO to make any action or decision that involves an interpretation of patent laws and regulations that would be of important precedential value available to the public regardless of whether the decision discloses a trade secret or other confidential

information. The great majority of applications will be available to the public by virtue of a publication of most applications 18 months after first filing. Clearly this policy and practice represents the rule rather than the exception. In the unique circumstances where an action or decision is considered to have important precedential value, the general rule of transparency to the public should prevail over the interests of confidentiality of an individual application that is not even available to most applicants.

37 C.F.R. § 1.52:

Both the present provisions of 37 C.F.R. § 1.52, and proposed §§ 1.52(a)(5) and (7), provide that when the papers are submitted that do not comply with provisions of this section, applicants will be notified and given a period of time within which to provide substitute papers. Unfortunately, it is not an uncommon occurrence that applicants are notified that the papers are not in compliance, but there is no identification of which provision or provisions have not been complied with in the papers filed. If it is not the policy of the PTO to identify specific areas or paragraphs of noncompliance, it should be the policy and practice to assist applicants in submitting papers that comply with all applicable regulations. If it is the policy of the PTO to identify specific errors, then the provisions of the proposed paragraphs of § 1.52 should be amended to indicate that specific errors will be identified in the notice.

37 C.F.R. § 1.72(b):

AIPLA agrees that this particular section should be amended to reflect current Federal Circuit case law. However, in view of the fact that the Federal Circuit, other

courts and the Board of Patent Appeals and Interferences will now use the abstract in interpreting the claims, it would be appropriate to revise PTO practice and amend MPEP § 608.01(b) to prohibit examiners from amending or revising the abstract of the disclosure except to correct the types of errors identified in MPEP 1302.04. In other words, examiners should not be authorized to make amendments to the abstract in the absence of express approval from the applicant unless those errors are of the type of misspelled words or obvious, minor grammatical errors. While it is recognized that an applicant may file comments or propose an amendment under 37 C.F.R. § 1.312 for an amendment made by an examiner with a notice of allowability, this procedure does not provide applicants with the measure of protection necessary to ensure that any revision to the abstract does not alter the interpretation of the claims in an application. As a practical matter, the application file leaves the Office soon after mailing of a notice of allowance and the ability of an applicant to get an examiner to consider any paper after the notice of allowance has been mailed is very problematic.

37 C.F.R. § 1.97:

The proposed revision of this section is based on an inaccurate assumption and will not promote the desired benefit of efficient processing and use of the benefits of PAIR. The proposed changes to §§ 1.97(b) and (c) would make the deadlines for filing an IDS the day before an Office Action is mailed. The PTO explanation for this change in the “mailing rule” is that unless “applicants are required to submit an IDS before Office Actions are mailed, applicants may unfairly delay prosecution to meet their short-

term needs by mailing an IDS on the same day as Office Actions are mailed upon seeing that a mailing occurred through PAIR.”

We believe that this assumption is both inaccurate and clearly inconsistent with the manner in which applicants use PAIR in filing an IDS. In our experience, no one is going to sit on IDS information while checking PAIR on a daily basis to determine when the last possible moment exists for filing an IDS. This is unrealistic. Rather, experience shows that when IDS information is obtained for filing, the IDS papers are prepared for filing by checking PAIR to determine the status of an application and the requirements that must be satisfied in order to submit the IDS in a timely and proper way. The proposed changes to § 1.97 will neither promote efficient processing nor provide for the benefits of PAIR. Consider the following typical preparation of an IDS: (1) an IDS is prepared in the morning; (2) PAIR is checked in the morning to determine whether a second or final Office Action has been issued in an application - PAIR reflects no action mailed; (3) the IDS is filed under § 1.97(c); (4) a final Office Action is mailed in the afternoon of the same day and the PAIR information is updated after the IDS has been mailed/delivered to the USPTO; (5) under the proposed rules, the IDS may be considered untimely or not in compliance with the provisions for an IDS filed after a final Office Action. How does this promote efficiency and legitimate use of PAIR?

Unfortunately, there are many instances when papers are going to be timely mailed or delivered to the PTO before an Office Action is mailed, yet will not be associated with the file for consideration before the Office Action is both prepared and

mailed. In some cases, it takes several weeks if not several months before the PTO properly associates papers with the correct file. In all of these cases where the papers are filed before the mailing date of the Office Action, the PTO will consider the information as being timely filed before the Office Action. The proposed change of one day is not going to alter the occurrence of the overwhelming majority of these situations. The proposed change will not promote efficient processing and in many cases will not permit applicants to rely upon a legitimate use of PAIR. Accordingly, the PTO is requested to reconsider the proposed changes to § 1.97 and withdraw the proposed changes.

37 C.F.R. § 1.121:

AIPLA supports efforts of the PTO to streamline the process of amending patent applications, but cautions against unnecessary complexities that benefit no part of the patent process. The proposed elimination of two or three sets of application claims in any one amendment is clearly a step forward. The proposed adoption of a requirement to place each claim ever presented in an application in one of 11 different categories identified by the PTO is clearly several steps in the wrong direction. Given the number of people in the PTO that must learn a new amendment system, and the 20,000 plus registered practitioners and their administrative assistants, paralegals, secretaries and other support staff that must adapt to a new system, the PTO simply must stop experimenting with such a vital part of the patent process and make a much better effort to simplify the process for all concerned.

The number of categories suggested by the PTO is unnecessarily complex, will clearly magnify the number of errors that occur in filing amendments, and may create unnecessary risks for patent owners who will be accused of misleading the Office if an inadvertent error is made in selecting the appropriate category. The AIPLA suggests that the number of categories could be easily reduced to five: (1) no characterization; (2) new claim; (3) amended claim - being amended in the paper filed; (4) withdrawn claim; and (5) canceled claim. The "no characterization" option would simply apply to any claim that did not fall into one of the other four categories.

In addition, the PTO should make clear the appropriate frame of reference for submitting an amendment with the new status indications. For example, in cases where multiple proposed amendments after final are submitted to the PTO, should the second or subsequent proposed amendment assume that the previous amendment will be entered? Will not be entered? Is not entered unless advised by the PTO? In addition, consider a circumstance where the PTO advises an applicant that an amendment after final will be entered upon the filing of a notice of appeal. However, instead of filing a notice of appeal, an applicant decides to take a different course of action by filing an RCE or a CPA. Should an amendment filed with the RCE or CPA assume that the amendment after final has been entered? Has not been entered? Will only be entered if an explicit request is made to enter that amendment?

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We appreciate the opportunity to provide comments on the Notice entitled "Changes to Implement Electronic Maintenance of Official Patent Application Records," and would be happy to assist in any way we can.

Sincerely,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive style with a large, prominent initial "M".

Michael K. Kirk
Executive Director