

To: Director of the United States Patent and Trademark Office
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From:
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RE: Comments in response to the Notice of Proposed Rule Making entitled "January 2004 Revision of Patent Cooperation Treaty Application" 68 FR 32441 (May 30 2003).

Sir:

The changes to the PCT and your corresponding proposed changes to 37 Code of Federal Regulations governing procedural aspects of the PCT in the United States Patent and Trademark Office represent a significant step forward in eliminating useless procedural aspects of PCT practice and corresponding potential loss of rights that were unrelated to patentability. However, the proposed rules leave certain room for improvement, which I note below.

Proposed 37 CFR 1.14(i)(1)(ii) precludes members of the public from obtaining a copy of the written opinion (now referred to in the PCT as an IPRP instead of an IPER) until 30 months after the priority date. The revised PCT provides for generation of an IPRP as part of a search report in PCT Chapter I. A search report must, by terms of the PCT, be established within a few months of the filing of a PCT application. Under the proposed rule, the public is deprived from the benefit of the IPER for years after it is established. Not allowing the public to prompt access to the IPER is contrary to public policy of the patent system of the United States as defined in the our constitution of promoting the useful arts. This is because the lack of knowledge by other than the applicant of the likelihood of the applicant obtaining patent protection causes business uncertainty as to what technologies will patents ultimately issued from national stage proceedings of the PCT application. This uncertainty results in business decision makers sometimes decide to develop technology that, years later, becomes subject to another's exclusive patent right. This uncertainty also results in business decision makers sometimes deciding not to develop technology that ultimately does not become subject to another's exclusive patent right. Both of the foregoing fact patterns are anathema to the concept of promoting the useful arts.

Moreover, proposed rule 37 CFR 1.14(i)(1)(ii) limits the availability of the public to monitor the status of pending patent applications to a much greater extent than corresponding rules of practice for most United States applications filed under 35 USC 111. Applications files under 35 USC 111(a) are generally published after 18 months at which time the list of papers in their files are freely available to the public (via the USPTO's Web based PAIR system) and the actual papers can be purchased online from the USPTO for a nominal fee. In contrast, 37 CFR 1.14(i)(1)(ii) prevents the public from obtaining access to the only relevant prosecution document in PCT applications for 30 months. When Congress enacted the American Inventors Protection Act (AIPA) in 1999, it expressly provided for early publication of United States patent applications. That shows a Congressional recognition that publication promotes the useful arts as required by the Constitution. In addition, the AIPA provided legal consequences to the publication of PCT application including (1) the 35 USC 102(e) prior art effect for the disclosure of the PCT application as of it's filing date and (2) the 35 USC 135(b)(2) claim bar to claims defining substantially the same subject matter as the claims published in the PCT application. What is stated in an IPRP regarding the prior art necessarily includes, either expressly or inherently, construction of the meaning of the specification of the PCT application and construction of the scope of the claims in the PCT application. Therefore, the IPRP contains information material to wether claims in another application, whether a 35 USC 111(a) application or a United States national stage of a PCT application, should be rejected under 35 USC 102(e) or 35 USC 135(b)(2) based upon the published PCT application. Accordingly, preventing the public, and impliedly preventing examiners of other applications, access to the IPRP of a PCT application, reduces the effectiveness of the USPTO's examination process issuing valid patents.

For the foregoing reasons, proposed 37 CFR 1.14(i)(1)(ii) should be revised to provide for prompt access to IPRPs. To the extent that such a rule change is inconsistent with United States' PCT treaty obligations, the Director should forcefully argue in the PCT to allow early publication of IPRPs.

Respectfully submitted

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