

PTO Proposed Rules on Application Publications

Vol. 65, Federal Register, No. 66, April 5, 2000, pp.. 17946-17971

Notice of proposed rulemaking entitled: "**Changes to Implement Eighteen-Month Publication of Patent Applications**"

Comment deadline: May 22, 2000 - no public hearing.

The Office indicated that prefers to receive comments on this set of proposed rules via the Internet addressed to: pregrantpub.comments@uspto.gov.

N.B. This is a very lengthy set of proposed rules and accompanying PTO comments. Only a few comments will be made here. These comments are in Rule order, not in order of importance. These comments also includes some general observations which are not necessarily either suggestions or criticisms.

First, although it had been hoped that the files of all published applications would be "open to the public", as in most other countries, amended Sections 1.11 and 1.14 will provide that only for *abandoned* published applications. However, **Section 1.14(c)(2)** indicates that "A copy of the specification, drawings and all papers relating to the file of an abandoned OR PENDING PUBLISHED application may be provided to any person upon written request, including the fee . ." HOWEVER, it is not clear to me whether this is limited by the immediately previous main subparagraph (c) language that the copies will only? be "A copy of an application-as-filed, OR a file wrapper and contents MAY, . . be supplied . ." Is this discretionary, and does it modify or restrict 1.14(c)(2)? Will "all papers relating to the file" in **1.14(c)(2)** include all the subsequent amendments that are made? I.e., it is suggested that the drafting of this subparagraph (c) and (c)(2) of Section 1.14 could be improved, or broken up to cover the two different situations of the two different subparagraphs (c)(1) and (c)(2), and to make it completely clear that subparagraph (c) is not intended to be optional at the discretion of the PTO.

A very major practice change is the proposed *elimination of examination* (**Section 1.85(a), etc.**), and delay in publication, of applications that are not “completed”. That is, in particular, patent applications with “*informal drawings*” will no longer be examined. They will “NOT be placed on [sic] the files for examination until objections to the drawings have been corrected.” “Objections to the drawings in the Utility or Plant application will NOT be held in abeyance,..” This major practice change will, of course, impose substantial time pressure burdens on Applicants and patent illustrators, and increased “up-front” costs of patent applications. [Very many patent applications are now filed with informal drawings, on the assumption that there is ample time to file formal drawings while the application is pending. Many formal drawings are now not filed until after a notice of allowance.] Delaying application filings by waiting for formal drawing preparations could also delay the filing dates of many U.S. patent applications [unless provisional filings are used?]. If foreign countries allow filings with informal drawings by their citizens, and we do not, they will have a significant competitive advantage. The “first to file” wins the patent rights in almost all cases.

It is appreciated that the Patent Office does not want to publish applications with informal drawings. However, the full international economic and political consequences must be carefully considered for such a major patent practice change.

“Section 1.99: Third party submission in published application”.

This rule will establish a limited, restricted, ability of the public to submit patents or publications (only) to a pending published application file, with a fee, service, etc.. Under 1.99(e), it “must be filed within two months of the publication.”

However, there is another even more significant and seriously deleterious restraint in Section 1.99(d). “A submission under this section may *not* include *any explanation* of the patents, publications, or any other information.”

In many cases the will make any attempted prior art submission completely ineffective. We all know that an Examiner is simply not going to wade through an entire lengthy submitted publication to find some minor portion thereof that is relevant to the claimed subject matter, “looking for a needle in a haystack”, “without a clue”. This prohibition against providing any guidance whatsoever to the Examiner of where to look in the cited art for the relevant

disclosures makes no sense from the standpoint of PTO efficiency, the vital public interest in valid patents, and the PTO's statutory duty to examine patent applications and not issue invalid patents. At the very least, the rule should allow the submitter to mark, with a yellow high-liner or the like, or insert "Post-it"® tabs at, the relevant sections of lengthy patents or other publications being submitted, providing that identically marked copies are served upon the Applicant in accordance with Section 1.99(c).

Section 1.130. The proposed amendment of Section 1.130 is not understood by this commentator. There is no reference here, or addressing of, the new statutory amendment of 35 USC §103 which has automatically removed, from any application since 11/29/99, references which would have been §102(e)/103 references but were commonly owned at the time of the invention. That statute has only been addressed by the PTO in part of an OG Notice of April 11, 2000, 1233 OG 54, with no public input, and not by a proposed rule. That OG notice itself at 1233 OG 56 has unnecessarily onerous requirements to prove common ownership at the time of the respective dates of invention. [Since a date of an invention is legally presumed to be its filing date unless and until proven otherwise under 102(g), a normal assignment executed concurrently with the application should be sufficient prima facie evidence of ownership at the time of the invention without requiring another oath by the patent owner.] Yet this proposed rule Section 1.130 is broadly entitled "Affidavit or declaration to disqualify commonly owned patent or published application as prior art". At the very least that is confusing to the public. Furthermore, this proposed rule will require BOTH a Terminal Disclaimer AND "An oath or declaration stating that the application or patent under reexamination and patent or published application [sic - confusingly written] are CURRENTLY owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 USC §104." It is also not clear by whom this required Oath or Declaration must be made, especially as to the current common ownership, and why that is not already fully, and more properly, taken care of by the statement of common ownership already provided in the executed terminal disclaimer, and/or the assignments?

Turning now to **Section 1.215** - "Patent Application Publication," there are some serious concerns with some of these provisions. First, Section 1.215(b) states that if the Applicant

wants the application publication to include assignee information, the Applicant must include a SEPARATE PAPER indicating that such information is being provided for inclusion in the application. It is respectfully submitted that this is defeating one of the major intended purposes of the patent application publication system. Obviously, a principal intended public benefit of published applications is to see what applications are being filed by competitors, especially foreign competitors. This will be effectively defeated if there is no assignee identification on the publication. Otherwise, the public will be subjected to a great deal of extra work to try to independently determine the assignee information for the more than two hundred thousand applications expected to be published each year, to be done by each reader of the publications. This is highly undesirable. Why can't this information be automatically generated by the Patent Office from its computerized assignment records? Especially since the PTO is only going to publish the application as filed, and most assignments are filed concurrently with, or shortly after the filing of the application.

Furthermore, why should an additional, separate, duplicative, paper be required just for this duplicative assignment information? Even if the PTO cannot effectively write software to provide assignment information on the publication automatically, why can't the applicant be allowed to simply name the assignee in a box on the regular application papers, instead of adding more paperwork?

Now turning to something very serious, there are very serious proposed restraints on "Patent application publication", to the point of effective disablement, in **Sections 1.215 through 1.219**.

Section 1.215(c) says that "At applicant's option" the publication will be based on a copy of the application AS AMENDED, PROVIDED that the Applicant supplies "such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application." Effectively, making it impossible to do so for most applicants even if this electronic filing system was available in time, unless all amendments were made within one month.

The new Statute, at 35 USC 122(b)(2)(B)(v), expressly provides for 18 month U.S. publication of optionally redacted copies of U.S. applications with the non-foreign-published material removed. Yet, the PTO proposed implementing rule in **Section 1.217(b)** would effectively preclude this statutory right to have only a redacted copy of the application published in many circumstances for many, if not most, applicants, by requiring that "The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements." [or it will be published WITHOUT any redactions.]

Of the greatest concern of all in this respect is **Section 1.221** - "Voluntary Publication or republication of Patent Application Publication. [? - sic]":

The new *statute* this Rule 1.221 is *supposed* to be implementing *specifically allows* ANY utility application pending on November 29, 2000 to be published upon request, *and* provides very important new statutory advantages for doing so. Especially, the immediate retroactive creation of 102(e) prior art, from the filing date of the published application (even if a patent never issues). This new statutory right to a 102(e) prior art defense against later filed applications simply by publication will be very valuable to many applicants, if not frustrated by PTO implementation rules. As one example, otherwise costly and lengthy interference proceedings, including now pending interferences, may be avoided or won by a senior applicant's use of these new statutory provisions. As another example, competitor patents on obvious minor "improvements" can be prevented from inadvertently issuing while one's pioneer patent application with broad claims is long-pending on an appeal.

However, this proposed PTO Rule **1.221(a)** would *effectively sabotage* this very important provision of the new statute, by stating that any such request for publication "must include a copy of the application in compliance with the Office *electronic filing system requirements*."! As the PTO's own comments accompanying these rules indicate*, this electronic filing system is at best only a trial system which may not even be generally available or fully operative by November 29, 2000! Furthermore, how can a demand for electronic filing be *retroactively* imposed on *previously filed non-electronic* applications? This rule provision would deprive any and all pending applicants of their important new statutory rights unless they

can somehow acquire the equipment and software and spend the funds necessary to *retype* and/or *reformat* hundreds of thousands of pending applications into some kind of rule-undefined, and probably unavailable, “electronic filing” format. Obviously, most “small inventors”, and many other applicants, will not be able to acquire or obtain such software and the compatible technology and secretarial training and support to use it, even if it is even actually available on 11/29/00. Yet this proposed rule expressly states that "if...the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application." !

It is submitted that the adoption of a PTO rule which would effectively *de facto* deprive much of the public of an important statutory right is *prima facie ultra vires*.

*The PTO’s comments on its electronic filing system (EFS) appear on page 17949 of the FR.

These purely personal comments are respectfully submitted by:

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