

May 30, 2000

Honorable Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Dear Commissioner:

This communication is in response to the Patent and Trademark Office's request for comments relating to proposed changes in the rules of practice in patent cases to implement certain provisions of the "American Inventors Protection Act of 1999" to provide patent term adjustments that compensate patentees for certain delays in the application examination process.

We, the undersigned patent attorneys and agent, request consideration of the following comments:

37 CFR § 1.703(f)

Proposed Rule 1.703(f) states that "the date indicated on any Certificate of Mailing or transmission under § 1.8 shall not be taken into account in" calculating the term adjustment. Thus, although timeliness of a response is determined relative to the date indicated on a Certificate of Mailing or a Certificate of Transmission, the period for determining whether an applicant has engaged in reasonable efforts to conclude prosecution of the application will be determined with reference to the date that the Patent Office places their stamp on the response indicating receipt in the Patent Office. Thus, the proposed procedure creates an inconsistency, wherein an applicant is deemed to have failed to engage in reasonable efforts to conclude prosecution of the application, although the applicant has submitted a timely response. This inconsistency appears to be arbitrary on its face, and unfair in view of the fact that delays in the Patent Office are determined with reference to the mailing date on the correspondence from the Patent Office, not the date that the correspondence is received by the applicant. This means that all delays in the mail, whether from the Patent Office to the applicant or from the applicant to the Patent Office, can potentially accrue against the applicant. The proposed rule suggests that use of first class mail delivery service by an applicant may constitute a failure to engage in reasonable efforts to conclude prosecution, whereas use of first class mail delivery service by the Patent Office would never constitute an examination delay attributable to the Patent Office.

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The time between the date appearing on a Certificate of Mailing and the date of actual receipt in the Patent Office should not be regarded as time during which the applicant has failed to engage in reasonable efforts to prosecute the application. To do so unreasonably charges the applicant with responsibility for ensuring prompt mail delivery or utilizing the express mail provisions of 37 CFR § 1.10. An applicant cannot engage in any meaningful activity that will encourage or ensure prompt first class mail delivery service. Further, an applicant does not have any reasonable basis, especially early in the prosecution, for predicting whether the application will result in the issuance of a patent having a term adjustment. Under the proposed rules, in order to ensure that a reduction in the term adjustment is avoided, the applicant must file all responses (including timely responses) under the express mail provisions of 37 CFR § 1.10. This is so even though it is likely that most patents will issue without a term adjustment, i.e., will be issued within three years of the actual filing date, and will not be subject to other examination delays. In addition to being unable, in most circumstances, to determine whether the added expense of filing a response using express mail delivery service is justified, it is impossible to predict the mail delivery time of any particular response. Although most communications sent by first class mail will arrive in the Patent Office within about a week, longer periods (e.g., 15 days) do not appear to be uncommon. Further, the undersigned attorneys and agent are aware of instances in which communications have been lost in the mail or delayed for an excessive period of time. In such cases, any period of adjustment would be reduced by the period of time in excess of three months from the mailing date on the correspondence from the Patent Office that elapses before a response is delivered, even if a response was mailed to the Patent Office on the same day that the Office Action or notice was received by the applicant.

An applicant should not be burdened with the responsibility of ensuring that the U.S. Post Office delivers first class mail in a timely manner, the responsibility of determining how much time should be allowed to ensure timely delivery, or the risk that the U.S. Post Office will lose the response or deliver the response only after an excessively long period of time has elapsed. Assigning such risks and responsibility to the applicant is especially unfair in view of the fact that it will generally be impossible during the early stages of prosecution to predict whether an application will issue as a patent with a term adjustment, whether any such adjustment will be of significant value, and whether a slow mail delivery will reduce the term adjustment.

A peculiar consequence of the proposed procedure in which the Certificate of Mailing is not honored for purposes of determining whether an applicant has engaged in reasonable efforts to prosecute the application, is that any delay in the mail will delay issuance of the patent, and any response from an applicant that is delayed in the mail could potentially reduce a patent term adjustment. Thus, delays in the mail could delay issuance and reduce the patent term adjustment, penalizing an applicant twice for a delay that is neither predictable nor under applicant's control.

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For the reasons set forth above, the undersigned attorneys and agent respectfully request that the Patent Office reconsider the proposed rule, and replace it with a rule that would accord an applicant's Certificate of Mailing the same deference and treatment as the mailing date on an Office Action or other notice from the Patent and Trademark Office. A timely response, as determined by the date indicated on a Certificate of Mailing should be the date used to determine whether an applicant has failed to engage in reasonable efforts to conclude prosecution of the application.

37 CFR § 1.704(c)(10)

Under the proposed rules, submission of a Preliminary Amendment or other preliminary paper less than one month before the mailing date of an Office Action or Notice of Allowance will constitute a failure of the applicant to engage in reasonable efforts to conclude prosecution of the application. The proposed rule requires that any term adjustment be reduced by the number of days beginning on the mailing date of the original Office Action or Notice of Allowance and ending on the mailing date of the Supplemental Office Action or Supplemental Notice of Allowance.

A peculiar aspect of this proposed rule is that a Preliminary Amendment or other preliminary paper is typically submitted to expedite prosecution, not to delay prosecution. However, a more peculiar aspect of the proposed rule is that the period of the reduction is entirely within the control of the examiner. No matter how long the examiner takes to mail a Supplemental Office Action or Supplemental Notice of Allowance, any such time will be regarded as time in which the applicant failed to engage in reasonable efforts to conclude prosecution, even though the applicant has no control over how quickly the examiner mails a Supplemental Office Action or Supplemental Notice of Allowance. Thus, an applicant can be penalized for any period of time, without limit, for delays caused by the examiner.

The undersigned attorneys and agent request that the reduction in any term adjustment under § 1.704(c)(10) shall not exceed four months (a reasonable period for the Examiner to prepare a Supplemental Office Action or Notice of Allowance), and that any period in excess of four months from the date on which the Preliminary Amendment or other preliminary paper is received by the Patent Office to the date on which the Supplemental Office Action or Supplemental Notice of Allowance is mailed shall be regarded as an examination delay under § 1.703(a)(2) or (3).

37 CFR § 1.704(c)(13)

Under proposed rule 37 CFR § 1.704(c)(13), any time between the date on which a Notice of Appeal is filed, and on which an Appeal Brief is filed, will constitute a failure of the

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applicant to engage in reasonable efforts to conclude prosecution of an application, and will reduce any applicable patent term adjustment.

This reduction in the patent term adjustment is inappropriate. If an applicant prevails on Appeal, this means that the final rejection was inappropriate, and that the examiner should have issued a Notice of Allowance, not a final rejection. Accordingly, an applicant should not be further penalized for taking a reasonable amount of time to prepare an Appeal Brief. In many cases, an applicant will submit a response to a final rejection before filing an Appeal Brief. This provides the examiner with an opportunity to reconsider the final rejection and withdraw a faulty rejection before an Appeal Brief is submitted. It is not unreasonable for an applicant to wait for a reply (e.g., a Notice of Allowance or Advisory Action) from the examiner before preparing an Appeal Brief, so that any additional comment by the Examiner can be taken into consideration. Often it will be desirable to file a Notice of Appeal before receiving the examiner's response in order to reduce or eliminate fees associated with filing an extension of time. In such cases it would not be reasonable to regard all of the time from the filing of the Notice of Appeal to the filing of the Appeal Brief as a failure of applicant to engage in reasonable efforts to conclude prosecution, especially since efforts subsequent to a final rejection in an application in which the applicant prevails on Appeal are attributable to examiner error.

Because it is reasonable to take up to two months to prepare an Appeal Brief after a Notice of Appeal has been filed, and because time consumed by an Appeal in which the applicant prevails is attributable to examiner error, the undersigned attorneys and agent respectfully submit that use of the two month period allowed for filing an Appeal Brief (after a Notice of Appeal has been filed) should not constitute a failure to engage in reasonable efforts to conclude prosecution and should not be included as a reduction of any patent term adjustment.

37 CFR § 1.704(c)(14)

Under proposed rule 37 CFR § 1.704(c)(14) submission of an amendment or other paper after a decision by the Board of Patent Appeals and Interferences (subject to certain exclusions) that requires the mailing of a Supplemental Office Action or Supplement Notice of Allowance constitutes a failure of the applicant to engage in reasonable efforts to conclude prosecution of the application, and requires that any applicable patent term adjustment be reduced by the number of days beginning on the mailing date of the original Office Action or Notice of Allowance and ending on the mailing date of the Supplemental Office Action or Supplemental Notice of Allowance.

The proposed rule does not place any limits on the reduction of the patent term adjustment. Further, the applicant has no control over the period of the reduction. Instead, the reduction is completely under the control of the examiner. Thus, excessive delays by the

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examiner will, under this proposed rule, constitute a failure of the applicant to engage in reasonable efforts to conclude prosecution.

The undersigned attorneys and agent do not dispute whether the period of adjustment should be reduced by a period of time beginning on the mailing date of the original Office Action or Notice of Allowance, but submit that the ending date should be either the mailing date of the Supplemental Office Action or Notice of Allowance, or a date four months from the date on which the amendment or other paper is received by the Patent Office, whichever period is shorter, and that any period taken by the Patent Office in excess of four months from the date on which the amendment or other paper is received by the Patent Office to the date on which the Supplemental Office Action or Notice of Allowance is mailed shall be regarded as an examination delay under § 1.703(a)(2) or (3).

37 CFR § 1.704(c)(15)

Under proposed rule 37 CFR § 1.704(c)(15) submission of an amendment under § 1.312 or other paper after a Notice of Allowance has been mailed will result in a reduction of any patent term adjustment equal to the number of days beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office Action or Notice in response to the amendment, subject to a four month maximum.

The inclusion of the expression “or other paper” in this subsection is unfair to the applicant, and should be deleted. An applicant may file a paper after a Notice of Allowance has been mailed to request that the examiner acknowledge and enter into the record prior art references listed on a previously submitted Information Disclosure Statement or Form 1449. Other papers that may be filed after a Notice of Allowance has been mailed include requests to correct or overcome certain deficiencies in the Notice of Allowance, such as a request that the examiner acknowledge receipt of a certified copy of a previously submitted priority document, or a request that the examiner approve proposed drawing corrections previously submitted by the applicant. Such requests should not delay issuance of the patent, and any such delay should be attributed to the Patent Office, not to the applicant.

Further, it will not always be appropriate to reduce a term adjustment when an amendment under § 1.312 is filed. For example, an amendment under § 1.312 may be filed merely to update a claim to priority by inserting the patent number for a parent application for which a patent issued after, or immediately before, the Notice of Allowance was mailed. Such amendment should not delay issuance of the patent, and should not be regarded as a failure of the applicant to engage in reasonable efforts to conclude prosecution.

Accordingly, the undersigned attorneys and agent request that proposed rule 37 CFR § 1.704(c)(15) be revised to exclude papers other than an amendment under § 1.312,

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especially papers that are filed to correct an examiner omission or a deficiency in the Notice of Allowance. Further, the undersigned attorneys and agent request that proposed rule 37 CFR § 1.704(c)(15) be revised to exempt amendments under § 1.312 that are filed only for the purpose of updating a claim to priority.

Respectfully submitted,

By: PRICE, HENEVELD, COOPER,
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