

May 24, 2000

Honorable Q. Todd Dickinson  
Under Secretary of Commerce for  
Intellectual Property and  
Director of the United States Patent  
and Trademark Office  
Box Comments - Patents  
Washington, D.C. 20231

Attn: Robert W. Bahr

Re: AIPLA Comments on the Notice of  
Interim Rulemaking Entitled  
“Changes to Application Examination  
and Provisional Application Practice”  
65 Fed. Reg. 14865 (March 20, 2000)

Dear Director Dickinson:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the notice of interim rulemaking entitled “Changes to Application Examination and Provisional Application Practice,” published in the *Federal Register* on March 20, 2000.

The AIPLA is a national bar association of more than 10,000 members engaged 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.

The following comments are offered on the interim rules.

Amended section 1.53(c)(3) states that a request to convert a provisional application to a nonprovisional application must be filed prior to the earlier of abandonment of the provisional

application or expiration of twelve months from the filing date of the provisional application. Thus, this rule appears to negate the effect of the statute and new section 1.7(b) which extends the pendency of a provisional application to the next business day if twelve months after its filing date falls on a Saturday, Sunday or Federal holiday. Even though the provisional application would be pending on that next business day (i.e., not abandoned), pursuant to section 1.53© a request to convert the provisional application to a nonprovisional application would be untimely on that next business day under subparagraph (ii). There is no reason why the rule should contain this restriction, which may well have been unintended since it is not discussed in the preamble.

Amended section 1.53(d) sets forth that a continued prosecution (continuation or divisional) application may only be filed based on a utility or plant application filed before May 29, 2000. On or after May 29, 2000, the provisions of new section 1.114 would be available for requesting continued examination for applications filed on or after June 8, 1995. However, in the Discussion of Specific Rules part of the Notice it is stated that an applicant may not obtain examination of different or nonelected invention (e.g., a divisional) via a request for continued examination under section 1.114. Thus, the public, and the USPTO, is losing the ability to have pertinent information from a parent application, which is to be abandoned, contained in a divisional application filewrapper. The continued prosecution application process should be retained for such divisional applications to avoid unnecessary work on everyone's part such as the need to refile an Information Disclosure Statement.

Amended section 1.78 requires that for a nonprovisional application to claim benefit of a prior filed provisional application, the provisional filing fee must be paid within the time period set forth in section 1.53(g) and have any required English-language translation filed within the time period set forth in section 1.52(d). Thus, an applicant who fails to file a timely and complete response to a notice to file missing parts of a provisional application will lose the ability to claim benefit of the provisional application filing date in a later nonprovisional application. The rules should state that a provisional application can be revived to permit the USPTO to accept the filing fee, surcharge, translation, or whatever may be missing from the provisional application.

Section 1.313 should be amended to specify in paragraph (a) that an application may be withdrawn from issue prior to payment of the issue fee for consideration of a submission pursuant to section 1.114. This ground is specified in paragraph © which governs once the issue fee is paid, but paragraph (a) only states that "a showing of good and sufficient reasons why withdrawal of the application is necessary" is required. An applicant needs assurance that the application will be withdrawn from issue for consideration of a submission pursuant to section 1.114 if a petition under section 1.313(a) is filed. Applicants should not be faced with deciding whether it is necessary to pay the issue fee to keep the application pending when no decision on a petition under section 1.313(a) has been received. If withdrawal from issue for consideration of a submission under section 1.114 is clearly stated in the rule to be an acceptable reason for withdrawal, applicants will have the assurance that their petition will be granted, and thus will not need to be concerned with payment of the issue fee solely to maintain pendency while a petition is being matched with the allowed file and decided.

We appreciate the opportunity to provide comments on the specific topics under consideration by the USPTO. We look forward to working with the USPTO to achieve its patent business goals in ways that will not unnecessarily burden applicants or their representatives.

Sincerely,

Michael K. Kirk  
Executive Director