

From:

Sent: Tuesday, June 01, 2010 3:33 PM

To: extended_missing_parts

Subject: Comments on Proposed Change to Missing Parts Practice

Dear Ms. Jones,

On behalf of The Boston Patent Law Association, I submit herewith the Association's Comments in response to the Request for Comments published at 75 Fed. Reg. 16750 (April 2, 2010). We thank the Office for this opportunity to provide our thoughts.

Sincerely,

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June 1, 2010

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Re: Proposed Change to Missing Parts Practice, in Response to
Request for Comments at 75 Fed. Reg. 16750 (April 2, 2010)

Dear Ms. Jones:

The Boston Patent Law Association (BPLA) thanks the U.S. Patent and Trademark Office (USPTO) for the opportunity to comment on the USPTO's Proposed Change to Missing Parts Practice (hereinafter "the Proposal").

The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws in the Boston area. These comments were prepared with the assistance of the Patent Office Practice Committee of the BPLA. These comments are submitted solely by the BPLA as its consensus view. The stated arguments, contentions, or positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member.

We appreciate the USPTO's efforts in developing the Proposal, and we support the Proposal's objectives of giving applicants additional time at a relatively low cost to determine if patent protection should be sought, and removing from the USPTO's workload those applications that will not be pursued. We offer the following comments, falling into three general categories: (a) clarifying the effects of the Proposal; (b) expanding the Proposal to apply to additional applications; and (c) providing suggestions on implementation.

I. Public Communications Clarifying the Proposal's Effects

The BPLA appreciates the Proposal's goal of giving applicants more flexibility by extending the time period to complete a utility application. However, the BPLA suggests that efforts should be taken to ensure that the patenting public fully understands the effects of the proposed procedure if and when it is implemented. The Federal Register notice announcing the Proposal states that "[it] would effectively provide a 12-month extension to the 12-month provisional application period (creating a net 24-month period)." 75 Fed. Reg. 16750. This statement might be misunderstood as meaning that provisional applications are effective for more than 12 months, that a nonprovisional application could be filed more than one year after the filing date of the provisional application, or that a nonprovisional application filed at 12 months need only satisfy the requirements for a provisional application. Reports of the Proposal in the patent press similarly suggest an extended provisional application program. For example, the blog Patent Docs discussed the Proposal under the title, "USPTO Seeks to Effectively Double Provisional Application Period." The IPO Daily News reported, "USPTO Publishes Proposal To In Effect Extend 12-Month Provisional Patent Application Period." These headlines might lead readers to misinterpret the Proposal as allowing more than one year to file a nonprovisional application following the filing of a provisional application.

The BPLA suggests that, should the Proposal be implemented, the USPTO undertake publicity efforts to ensure that the Proposal is properly understood according to its title and effect, namely, a Change to Missing Parts practice. The USPTO should emphasize that a nonprovisional application still must be filed within 12 months after the provisional application, that all potential claims must be supported by the specification at the time the nonprovisional application is filed, and that new matter cannot be added following the filing date of the nonprovisional application. The BPLA suggests that the USPTO stress that the Proposal does not alter or defer these important requirements.

II. Expanding the Proposal to Apply to Additional Applications

The BPLA believes the goals of the Proposal would be best served if a maximum number of applicants takes advantage of the new program. As such, the BPLA suggests reducing the program requirements as follows.

A. Applications That Do Not Claim Priority to a Provisional Application

The Proposal requires that a nonprovisional application claim the benefit of a provisional application to qualify for the extended missing parts program. The BPLA suggests that the Proposal should apply to all applications regardless of priority. All applications, including continuing applications, should be able to benefit from a 12-month extended missing parts period. This would further the goals of providing applicants additional flexibility in determining whether to pursue an application, and removing those applications that will not be pursued from the USPTO's workload.

B. Applications Filed Without Oath or Declaration or Filing Fee

To qualify for the extended missing parts period under the Proposal, applicants must submit an executed oath or declaration, as well as the basic filing fee. The BPLA suggests that these

requirements may reduce the flexibility afforded to applicants by the Proposal and, as a result, decrease usage of the program. The BPLA suggests opening the program to all applications sufficient to secure a filing date. For example, upon receipt of any application, the USPTO could issue an initial notice to file missing parts, giving applicants two options for response. The first option could be the same as under the current system – pay all fees due and submit an executed oath or declaration. The second option could provide for deferring payment of the search and examination fees for up to 12 months, if the applicant pays the basic filing fee. The executed oath or declaration could be due with the filing fee, or when the search and examination fees are paid.

C. Applications Filed With Non-Publication Request

For an applicant to receive the 12-month extended missing parts period, the Proposal requires publication of the application. The BPLA suggests that the extended missing parts program should not include a publication requirement. While we acknowledge the USPTO's objective of adding publications to the body of prior art, nonpublication is a statutory right highly valued by some inventors. *See* 35 U.S.C. § 122(b)(2)(B)(i). An applicant who wishes to take advantage of the Proposal should be able to do so without being forced to publish the application. Requiring publication might deter certain applicants, such as individual inventors or small entities, from taking advantage of the Proposal. These applicants may be the same ones most likely to noticeably benefit from the deferred fee structure under the extended missing parts practice, yet they might be deterred from using the program where they find nonpublication important to their commercial success.

Moreover, certain aspects of the Proposal may adversely impact the public notice function of patent publication. The Proposal suggests that a nonprovisional application can be filed with only one claim, and a preliminary amendment adding claims can be filed with the response to notice of missing parts. However, the application would publish 18 months after the provisional filing date, *i.e.*, before the filing of the preliminary amendment. The Proposal thus could result in more applications publishing without full claim sets, requiring the public to take the additional step of consulting PAIR to later obtain a full claim set.

III. Suggestions on Implementation

A. International Style Search Report

The BPLA believes that the benefits of reducing USPTO workload and of giving applicants additional time to determine if patent protection should be sought would best be achieved by providing applicants with additional information regarding the patentability of their invention. To that end, the BPLA supports the USPTO's proposal to offer applicants an optional service of an international style search report. *See* 75 F.R. 16752. Such a search report would provide applicants an early indication of the patentability of their claims and would assist them in determining whether to proceed with examination. The preliminary search report would be most useful if it issues during the 12-month extended missing parts period. The value of the report would be diminished if it issued after the applicant was required to make a decision regarding payment of the search and examination fees, thereby placing the application in the examination queue. Thus, the BPLA urges that the preliminary search report issue well before the 12-month extended missing parts period expires. The BPLA

suggests that if the search report issues after the 12-month extended missing parts period has expired, the applicant should be allowed to request and obtain a refund of the search fee.

B. Patent Term Adjustment

The Proposal states that no change would be made to the patent term adjustment (PTA) regulations if the USPTO proceeds with implementing the changes to missing parts practice. As the Proposal points out, responding to a notice to file missing parts more than three months after mailing the notice counts as applicant delay under 37 C.F.R. §1.704(b). Thus, under the Proposal, if an applicant took advantage of the full 12-month period to respond to the missing parts notice, it appears that nine months would be counted as applicant delay under 37 C.F.R. §1.704(b). If this is the case, the BPLA is concerned that such a detrimental effect on PTA may deter many applicants from using the extended missing parts period. The BPLA suggests that the USPTO consider rulemaking to amend the PTA regulations for applicants who take advantage of the Proposal. In particular, responding to a notice to file missing parts up to the 12-month extension period should not be counted as applicant delay under 37 C.F.R. §1.704(b).

IV. Conclusion

The BPLA appreciates the opportunity to comment on the USPTO's proposed Change to Missing Parts Practice. Thank you for your consideration of our comments.

Sincerely,

Boston Patent Law Association

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