From: Mark Nowotarski
Sent: Thursday, October 04, 2012 10:55 AM
To: fitf_guidance
Subject: USPTO is making an unreasonably narrow interpretation the exception under 35 U.S.C. 102(b)(1)(B)

Dear Ms. Till,

I believe that the USPTO is making an unreasonably narrow interpretation of the exception in 35 U.S.C. 102(b)(1)(B) of the Leahy-Smith America Invents Act. This provision of the law protects inventors whose inventions are copied after the inventions are made public. No one will ever be able to qualify for this exception under the USPTO's proposed examination guidelines. This will disproportionately hurt independent inventors. It will also hurt the USPTO.

The proposed guidelines state:

> *Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure* ***are mere insubstantial changes, or only trivial or obvious variations****, the exception under 35 U.S.C. 102(b)(1)(B) does not apply. (emphasis added)*

I cannot imagine any realistic scenario under the proposed guidelines where an inventor who has had his/her invention copied from a publication will be able to qualify for the exception under 35 U.S.C. 102(b)(1)(B). There will always be at least one insubstantial change or trivial or obvious variation between what an inventor publishes what a copier produces. This unreasonable standard will prompt patent practitioners such as myself to appeal examiner decisions that are based on these guidelines. This will needlessly consume USPTO resources.

Reasonable Alternative

A more reasonable alternative for applying the exception under 35 U.S.C. 102(b)(1)(B) would be to apply the same standards of disclosure to a prior publication as the office already applies to a provisional patent application. If the limitations in a claim are supported by a prior publication by the inventor, then an examiner cannot cite an intervening publication as "prior art" for the same limitations. The "subject matter" of a publication, therefore, would be defined by the limitations of the claim under examination. This approach would maintain greater continuity with the current examination standards, greater acceptance by applicants and greater conformity with the letter and spirit of the America Invents Acts. Other well respected patent attorneys have made similar suggestions to the USPTO at the recent First-Inventor-to-File roundtable held on September 6. I am joining my voice to theirs.

The USPTO's mission is to foster innovation, competitiveness and economic growth. The proposed examination guidelines undermine that mission. The office needs to adapt a more realistic definition of "subject matter" so that inventors can be protected against the copying of their inventions.

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