The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
        and Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Kery A. Fries
                Senior Legal Advisor, Office of Patent Legal Administration,
                Office of the Associate Commissioner for Patent Examination Policy

Dear Under Secretary Kappos,

The attached Comments by Intellectual Ventures, LLC are submitted in response to the Request for Comments relating to *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements* published at 76 Fed. Reg. No. 66 (pp. 18990-18995) on April 6, 2011.

Very truly yours,

--Matt Rainey

Vice President, Chief IP Policy Counsel
Intellectual Ventures, LLC
3150 139th Ave SE
Bellevue, Washington 98005
Tel.: (425) 467-2300

May 6, 2011

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
        and Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Kery A. Fries
        Senior Legal Advisor, Office of Patent Legal Administration,
        Office of the Associate Commissioner for Patent Examination Policy
By email to: AC56.comments@uspto.gov

<u>Re</u>: Comments on "Revision of Patent Term Extension and Adjustment Provisions Relating to
    Appellate Review and Information Disclosure Statements"
    76 Federal Register No. 66 (pp. 18990-18995; April 6, 2011)

Dear Under Secretary Kappos:

In reply to the Notice of Proposed Rulemaking (the "Notice") relating to Revision of Patent
Term Extension and Adjustment Provisions Relating to Appellate Review and Information
Disclosure Statements, Intellectual Ventures, LLC submits the following comments.

Intellectual Ventures both creates and invests in inventions spanning a broad range of
technologies. Through our own original filings as well as applications relating to invention
portfolios that we have acquired, Intellectual Ventures files hundreds of new patent applications
each year, and prosecutes a large portfolio of pending U.S. patents. Accordingly, requirements
relating to submission of information pursuant to USPTO disclosure requirements have a
significant effect on (a) the efforts that IV undertakes to comply with USPTO rules and (b) the
expenses related to those efforts.

We believe that the rules proposed in the Notice will be beneficial to USPTO practices, and
accordingly support them, with the exception that we believe the thirty-day time period specified
in subsections 1.704(d)(1)(i)-(iii) for submission of information disclosure statements should be
increased.

This thirty-day time period will in practice often simply be too short; a three-month time period
is more consistent with the realities of international prosecution. There are often delays in
delivery of documents, so that information does not reach an applicant in sufficient time to
review new references, correlate relevant information, and then prepare and file information
disclosure statements in all pertinent applications. Further, if one or more references are not in
English, additional time may be needed to prepare translations.

Accordingly, it is likely that many companies with large portfolios of pending U.S. applications
will need a longer period than the proposed thirty days. We believe that it is not beneficial to the
U.S. patent system to impose unduly short time limits on applicants, particularly where such time

periods are more restrictive than existing standards. Such short deadlines can lead to errors due to hasty preparation of disclosure statements and, worse, subsequent charges of inequitable conduct regardless of the innocence of the errors. The submission of relevant references is an important process, and sufficient time should be allowed for applicants to do so carefully. It is in the best interests of the U.S. patent system, the Patent Office and applicants if disclosure statements are thorough and accurate, with translations where appropriate.

We note that 37 CFR Section 1.97(e) provides a three-month time period for complying with Section 1.56 in situations in which certain late-cited references or communications may arise. It seems inconsistent and unnecessary that an applicant's behavior would be considered timely under Section 1.97(e), but tardy for purposes of term extension under proposed Section 1.704(d). Specifically, we believe that a submission that is timely under Section 1.97(e) should not cause an applicant to lose patent term adjustment.

Accordingly, we urge that the thirty-day period identified in subsections 1.704(d)(1)(i)-(iii) be redefined to track Section 1.97(e). However, since Section 1.97(e) and proposed Section 1.704(d) trigger from different dates (e.g. issuance of an foreign office action vis-à-vis receipt of information by an applicant), to avoid ambiguity or conflict between the sections, we recommend defining the Section 7.04(d) time periods as the longer of:

(a) the three-month time period as defined in Section 1.97(e); and
(b) the 30-day period as already defined in proposed subsections 1.704(d)(1)(i)-(iii).

As always, we appreciate the opportunity to comment.

Respectfully submitted,
Intellectual Ventures, LLC

Matthew Rainey, Esq.
Vice President, Chief IP Policy Counsel
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