

From: Blanco White, Henry [e-mail address redacted]
Sent: Thursday, September 29, 2011 3:31 PM
To: ai_a_implementation
Subject: Suggested rulemaking - new 35 USC 102

Suggested rule:

That any applicant wishing to benefit from a date of public disclosure for the purposes of 35 USC SS. 102(b)(1)(B) and 102(b)(2)(B) should be required to file a claim to benefit of that date, similar to that required under 35 USC 119 and 37 CFR 1.55. The timing should follow existing Rule 1.55. The content should include a copy of the applicant's prior public disclosure or, where that disclosure was not in an easily copyable format, a clear account of its substance with supporting materials following existing practice under Rule 1.131. The format can follow existing practice under Rule 1.131.

Reason:

Industry needs, and constitutional due process requires, certainty as to the validity of patents. Industry therefore needs to know whether a seeming piece of prior art is prior art or not. So industry needs to know what critical date the patentee can rely on to defeat alleged prior art. That is why Rule 1.55 requires foreign priority claims to be supported by a certificate of the priority date and a copy of the prior application, and that is why provisional applications are laid open to public inspection when the subsequent complete application is published. The same reasoning applies to any public disclosure that gives the applicant a defensive date against third party prior art under new 35 USC SS. 102(b)(1)(B) and 102(b)(2)(B), and the same level of documentation and public notice should be required.

The opinions expressed in this e-mail are my personal opinions, and do not necessarily represent the opinions of any law firm with which I may be associated, or of any of its or my clients.

Henry N. Blanco White
Drinker Biddle & Reath LLP
1 Logan Square, Ste. 2000
Philadelphia, PA 19103-6996
U. S. A.
Tel: [redacted]
Fax: [redacted]
E-mail: [redacted]