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Sent: Friday, October 05, 2012 12:01 PM
To: fitf_rules
Cc: JEAN NGUIMBUS
Subject: First-Inventor-to-File (Response to Proposed Rules)

The Honorable David Kappos
U.S. Patent and Trademark Office
Mail Stop **Comments—Patents**
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 5, 2012

RE: Comments on Proposed Rules: “First-Inventor-To-File” (Federal Register Vol. 77, No. 144)

Greenblum & Bernstein, P.L.C., the undersigned, is a law firm located in Reston, Virginia, that specializes in all aspects of intellectual property law. The firm currently employs over 30 registered patent attorneys and agents that engage in prosecuting and litigating in various areas of intellectual property. The firm also files over 1000 new applications for patents each year. Thus, the firm has an avid interest in the proposed rules implementing the First-Inventor-To-File system.

Priority

The USPTO has proposed modification of 37 C.F.R. § 1.55 to include provisions relating to the requirement for filing a certified copy of a foreign priority application within certain time periods. We understand the USPTO has agreements with foreign patent offices for the exchange of priority documents. We are concerned about the tracking of compliance, and are unclear about the ramifications for failing to comply.

For example, will the USPTO check to ensure that the certified copy has been filed, or has been transferred from a foreign patent office? Are Applicants responsible for periodically checking the USPTO’s electronic files to ensure a copy has been forwarded from a foreign patent office? If a foreign patent office has been requested to forward the document, whose responsibility is it to ensure that the foreign patent office does so? Will the USPTO mail a notice setting a due date for compliance?

If Applicant fails to comply by the time periods initially set, or set by notice mailed from the USPTO, what are the ramifications?

We would suggest requiring Applicants to provide either a certified copy, or to file a written request for transfer of the certified copy, prior to the due date. If, at the time of allowance, a certified copy has not been transferred to the USPTO, Applicant should be given notice and an opportunity to remedy the deficiency. Otherwise, if Applicants are required to repeatedly check on the status, there would be a significant burden on Applicants.

Application of “Old” Law versus “New” Law

To assist in determining whether the application is subject to 35 U.S.C. § 102/103 as amended by the AIA or 35 U.S.C. § 102/103 in effect on March 15, 2013, the USPTO proposed modification of 37 C.F.R. § 1.55 to require an Applicant to state, e.g., that “upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013” or that “upon reasonable belief, this application contains subject matter not also disclosed in the foreign application.” The USPTO’s comments on the proposed rules note that no statement is required if the nonprovisional application discloses only subject matter also disclosed in a foreign application filed prior to March 16, 2013.

Regarding the proposed rules, what forms the basis of “reasonable belief”? For example, is our firm entitled to rely on an assertion by Applicant that the nonprovisional application discloses only subject matter also disclosed in a foreign application filed prior to March 16, 2013. Please note that it would result in considerable costs to Applicants if U.S. counsel were required to verify the accuracy of such assertions. Verification would require translation of the foreign application, or knowledge of the foreign language, which can result in a significant expense and time/delay.

As a separate issue, what effect will the statement “upon reasonable belief, this application contains subject matter not also disclosed in the foreign application” have on the USPTO’s decision on which law to apply? The proposed rules seem to suggest that the sample statements regarding a) at least one claim having an effective date, or b) application containing subject matter not also disclosed, are mutually exclusive. In other words, if Applicant asserts that “upon reasonable belief, this application contains subject matter not also disclosed in the foreign application,” then it seems clear that Applicant has not also submitted a claim entitled to an effective date on or after March 16, 2013. As the rules would seem to specifically require that Applicant inform the USPTO when such a *claim* has been presented, it is unclear how the USPTO will use the statement (“upon reasonable belief, this application

contains subject matter not also disclosed in the foreign application”) to make any determination about which law to apply.

Office’s Decision on Which Law to Apply

The rules provide for situations in which an Applicant fails to make a timely statement (as discussed above), and then later makes such a statement, and when an Applicant makes a statement, but then retracts the statement. In both situations, the USPTO may make a requirement for information under 37 C.F.R. § 1.105.

However, the comments and rules do not seem to address the situation in which Applicants do not believe that a new claim has an effective filing date on or after March 16, 2013 (i.e., Applicants believe the claim is entitled to an earlier date), but an examiner asserts the claim is only entitled to a filing date on or after March 16, 2013. Consider, for example, the situation in which Applicants add new claims by preliminary amendment filed with an application: Applicants believe the claims are fully supported by the earlier application, but the examiner disagrees.

In this situation, is the examiner allowed to apply the new law, where Applicants have not made one of the required statements? If so, and again noting that it was not Applicants’ *intention* to add a claim having an effective filing date on or after March 16, 2013, may Applicants cancel such claim so as to avoid having the new law applied? If not, we are very concerned about possible negative impact on Applicants’ rights.

Given the severe impact on Applicants’ rights an examiner’s conclusion that a claim contains “new matter” would have, we suggest that any such decision only be made in conjunction with a Group Director (GD) or Quality Assurance Specialist (QAS), as well as a Supervisory Primary Examiner. Thus, the mailing of any Action in which an examiner asserts that new matter exists (relative to an application filed prior to March 16, 2013) would require signatures by the examiner, a SPE, and GD/QAS.

The undersigned appreciates the opportunity to submit these comments and questions, and would be pleased to work with officials at the U.S. Patent and Trademark Office to achieve the goals of reducing the burden on examiners to examine patent applications.

Sincerely,

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the law firm of Greenblum & Bernstein, P.L.C.

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