



# **INSTITUTE OF INTELLECTUAL PROPERTY & SOCIAL JUSTICE, INC.**

*ADVANCING IDEAS  
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## **IIPSJ Comments on Proposed Change to Missing Parts Practice by the United States Patent and Trademark Office**

### **I. Commentator Information**

These comments are submitted by the Institute of Intellectual Property and Social Justice at the Howard University School of Law, by its Director, Prof. Lateef Mtima, and its Associate Director, Prof. Steven D. Jamar, in response to the Request of Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office David J. Kappos, for Public Comments Regarding the Proposed Change to Missing Parts Practice, as published in the Federal Register, 75 FR 16750-01, Monday, March 29, 2010 (FR Doc. 2010-7520).

The Institute of Intellectual Property and Social Justice (IIPSJ) was founded in 2002 to address the social justice implications of intellectual property law and practice, both domestically and globally. IIPSJ's work ranges broadly and includes scholarly examination of intellectual property law from the social justice perspective; advocacy for social-justice aware interpretation, application, and revision of intellectual property law; efforts to increase the diversity of the those who practice IP law; and programs to empower historically and currently disadvantaged and under-included groups to exploit IP effectively.

### **II. Summary of Comments**

In IIPSJ's view, the Proposed Change to Missing Parts Practice would benefit indigent and other patent applicants of limited means by permitting them additional time to develop commercialization support and other funding pertinent to successful completion of the patent application process. Under the Proposed Change, the period during which an applicant would be permitted to complete a nonprovisional application relating back to a provisional application would be effectively extended by 12 months. Such an extension could provide financially constrained applicants with additional time in which to secure the resources to complete their applications and eventually commercialize their inventions. This enlargement of the provisional application time period would make the process more attractive to financially constrained inventors and thereby lower the effective threshold to patent protection. This could also increase the number of ultimately successful applicants from historically underserved and disadvantaged groups, thereby rendering the patent application process more equitable and inclusive, and enhancing the ultimate societal benefits by diversifying the community of IP stakeholders and expanding the range of contributions to the national store of patented inventions.

### **III. The Proposed Change to Missing Parts Practice Would Aid Financially Constrained Inventors and Promote IP Social Justice**

The heightened importance of intellectual property to national economic and social welfare interests has increased the need for an intellectual property regime which reflects the full range of constituent interests in our society. Contribution and participation is required from all corners in order to ensure the broadest range of inventive endeavor and optimum ability to compete in the global IP community. An intellectual property system that encourages and enables the development and exploitation of intellectual property by people from all walks of life and communities increases the incentive to everyone to invest effort and resources toward the development of intellectual property, and enhances respect for the intellectual property regime as a whole. Indeed, facilitating the protection and exploitation of intellectual property in historically underserved communities expands their stake in an increasingly effective and empowering IP regime. Moreover, it broadens opportunities for individual and collective advancement, and thereby furthers the fundamental aims of intellectual property progress for society and the foundational democratic ideals of our nation.

The Proposed Change to Missing Parts Practice is consistent with these social utility objectives in a variety of ways. First and foremost, it would lower the effective threshold to patent protection. The patent application process can be prohibitively expensive for many inventors. Fees and legal costs can run up into the tens of thousands of dollars, and lacking sufficient investment capital and/or concrete commercialization prospects, many inventors are simply unable to even contemplate participation in the process, while many others cannot afford such substantial investment risks in the absence of concrete opportunities for an ultimate financial return.

Some financially constrained inventors navigate these obstacles by taking advantage of the provisional application process and engaging in capitalization and commercialization fundraising efforts during the pendency of the application. Provisional applications have a pendency of 12 months from the date of filing, during which the applicant must file a corresponding nonprovisional application. However, if the corresponding nonprovisional application is incomplete when filed, such as to prompt the Patent & Trademark Office to issue a Notice of Missing Parts, the applicant typically has two months in which to respond to the Notice. Obviously if applicants had a longer period of time in which to respond to the Notice and complete their attendant nonprovisional applications, it could support any ongoing efforts to obtain funding and commercialization support.

The Proposed Change to Missing Parts Practice to increase the period in which to respond to the Notice of Missing Parts to 12 months would support such efforts. The longer period would provide applicants more time to ascertain the value of their inventions, and to target their attention and resources toward further capitalization and commercialization activities. In many cases, this additional time could spell the difference between an ultimately successful nonprovisional application and a stillborn provisional application, abandoned solely due to financial constraints.

Moreover, the Proposed Change to Missing Parts Practice would result in a process more aligned with public expectations, and thereby increase public confidence in the patent system. Like corporate inventors and other applicants of means, indigent inventors aspire to participate in the system of patent protection - perhaps even more so. They typically appreciate the system's role in leveling the playing field and providing opportunities for socio-economic advancement. A socially responsive IP regime would meet these expectations.

Finally, broader and more diverse participation in the patent system is likely to lead to an increase in the number and range of patented inventions and public knowledge. Progressive IP policies anticipate and embrace strategic opportunities, and the Proposed Change to Missing Parts Practice portends the opportunity to infuse and enhance the national store of patented inventions and utilitarian knowledge with works that might otherwise remain unavailable to the public for years. Some inventors unable to afford the full price of admission to the patent protection process might attempt to exploit and protect their inventions as trade secrets. Others, frustrated and despondent over the lack of immediate commercialization prospects might abandon their work altogether, thereby depriving society of the fruits of their ingenuity until some later inventor makes the same discovery. Threshold entry policies to IP protection must be carefully crafted to eschew such results, and the concomitant frustration of the foundational and constitutionally mandated priorities of the intellectual property law, which hold societal progress paramount.

#### **IV. Conclusion**

The Proposed Change to Missing Parts Practice is one consistent with the social justice objectives which undergird American intellectual property law. Our intellectual property regime holds the promise for the democratization of access to knowledge and inclusive participation in the creative and inventive process for all. While a comprehensive in pauperism mechanism would ultimately address the problems faced by financially constrained inventors, the Proposed Change to Missing Parts Practice is an important step in the right direction. Expanding the community of participants in the IP system broadens the commonwealth of IP stakeholder interests and enhances opportunities for IP entrepreneurship and a more equitable distribution of the fruits of intellectual endeavor, to the collective benefit of society as a whole.

Respectfully Submitted,

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