

**From:** Piroozi, Hamid  
**Sent:** Monday, November 05, 2012 5:24 PM  
**To:** fitf\_guidance  
**Cc:** fitf\_rules  
**Subject:** Comments from Purdue Research Foundation on Proposed Examination Guidelines on First Inventor to File Provisions

Please find attached comments from Purdue Research Foundation on Proposed Examination Guidelines on First Inventor to File Provisions.

\*\*\*\*\*  
\*  
\*\*\*\*\*  
\*

Hamid R. Piroozi, JD  
Legal IP Manager  
Purdue Research Foundation  
Office of Technology Commercialization  
1281 Win Hentschel Blvd.  
West Lafayette, Indiana 47906  
Office Telephone Number: 765-588-3504  
Cellular Telephone Number: 317-332-4720  
Email: [hrpiroozi@prf.org](mailto:hrpiroozi@prf.org)



CONFIDENTIALITY NOTICE: This email and any attachments are for the exclusive and confidential use of the intended recipient. If you are not the intended recipient, please do not read, distribute or take action in reliance upon this message. If you have received this in error, please notify us immediately by return email and promptly delete this message and its attachments from your computer system. Nothing in this communication should be considered as legal advice, legal counsel, or legal representation of any sort.

From: Elizabeth Hart-Wells, Ph.D.

Sent: Monday, November 05, 2012

To: [fitf\\_guidance@uspto.gov](mailto:fitf_guidance@uspto.gov)

Cc: [fitf\\_rules@uspto.gov](mailto:fitf_rules@uspto.gov)

Subject: Proposed Examination Guidelines on First Inventor to File Provisions

Purdue Research Foundation (“PRF”), a statutory body corporate formed and existing under the Indiana Foundation or Holding Companies Act of 1921, and the designee of Purdue University (“University”) to manage and license University-generated intellectual property, hereby provides support for the comments provided by the Higher Education Associations which cited organizational relationships to The Association of American Universities, The American Council on Education, The Association of Public and Land-grant Universities, The Association of University Technology Managers, and The Council on Governmental Relations, which comments were submitted on October 05, 2012 in response to the Federal Register notice on the USPTO proposed Examination Guidelines on First Inventor to File Provisions. In addition, PRF respectfully submits that the proposed rules (1) fail to preserve the subject matter of a publisher’s work for a later-filed patent application, based on the long-held dictum that a patent applicant’s specification must reasonably convey to those skilled in the art that the patent applicant was in possession of the claimed invention; and (2) fail to prevent an unfair wind-fall for a second publisher(s) or a patent applicant(s) whose work is based on the first publisher’s inventive work, as the second publisher or patent applicant could, under the guidelines as proposed, carve out problematic subject matter that the Office would deem as “mere insubstantial changes, or only trivial or obvious variations” from the claimed invention of the first publisher’s later filed application for patent. Accordingly, PRF proposes amending the proposed examination guidelines to provide that the exception under 35 U.S.C. § 102(b)(2)(B) and also under 35 U.S.C. § 102 (b)(1)(B) are inapplicable if a demonstration cannot be made that a patent applicant’s disclosure prior to a prior art disclosure that is relied upon under 35 U.S.C. § 102(a) reasonably conveys to one skilled in the art that the patent applicant was in possession of the claimed invention of a later-filed patent application at the time of the patent applicant’s disclosure. Such language provides harmony with the settled practice of grace period under the U.S. patent law.

Elizabeth Hart-Wells, Ph.D.  
Assistant Vice-President and Director  
Office of Technology Commercialization  
Purdue Research Foundation