

September 27, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: fitf_rules@uspto.gov
fitf_guidance@uspto.gov

Re: Re: Comments on:

“Changes to Implement the First Inventor to File
Provisions of the Leahy-Smith America Invents Act”
77 Fed. Reg. 43742 (July 26, 2012)

“Examination Guidelines for Implementing the First Inventor to File
Provisions of the Leahy-Smith America Invents Act”
77 Fed. Reg. 43759 (July 26, 2012)

Dear Under Secretary Kappos:

First let me express my extreme pleasure in being able to address Rules to Implement a First Inventor to File System in the USPTO. As you may be aware, I recall when the term “harmonization” was first being introduced and I recall having discussions at WIPO over 40 years ago on this subject. It is amazing to see that the United States has finally moved to a First Inventor to File System, harmonizing our system with the rest of the world.

As both the pre AIA rules together with the AIA rules will coexist for quite a number of years, it is critical to understand which laws apply. In that regard, the proposed rules and guidelines have set two criteria to determine which statute apply. The first criteria is whether the application contains or contained at any time a “claimed invention” having an effective filing date on or after March 16, 2013. The other criteria relates to disclosing subject matter in an application filed on or after March 15, 2013 which was not contained in a previous application whose priority might have been claimed.

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With respect to the later criteria, my understanding is that if someone were to add additional subject matter, that would of necessity define the new application as being a continuation-in-part application. I fail to understand how someone could file a continuation or divisional application and add new subject matter. I think this criteria needs clarification.

However, of what concerns me even more is the first criteria. I fail to comprehend the practical situation of filing a "claimed invention" after March 16th based on an application filed before March 16th. My understanding is that a "claimed invention" must be supported by the disclosure. If the disclosure was filed before March 16th and a claimed invention has an effective filing date on or after March 16th, that means that new matter must have been added after March 16th. If that new matter was added in the specification, then that is covered by the second criteria where there is additional subject matter being added.

On the other hand, if no new subject matter was added, but simply a claim is submitted after March 16th that is not supported by the original disclosure, that should be rejected under 35 USC 112 ¶1 as claiming new matter. This has always been improper and should continue to be rejected. That claim should never be entered and a rejection issued by the examiner as is done at present. To the examiner to immediately "flip" all of the claims so that they are prosecuted under AIA appears incongruous when a claim that adds new matter should not even be entered.

Additionally, from a practical viewpoint, practitioners do not "purposefully" file claims that are unsupported by a specification as they know full well they will get a new matter rejection. In most cases, when such a claim might be submitted, there might be a difference of opinion between the examiner and the practitioner. The practitioner may have arguments why he believes it is support and ultimately, the examiner may agree or disagree. However, the proposed rules do not permit any dialog to discuss this situation. It is a unilateral decision by the examiner if he believes a claim has been submitted on new matter, he immediately "flips" the case to AIA without any opportunity for any dialog.

It is suggested that this approach is both improper, and punitive. At best, if an examiner believes a claim is not supported, it should not be entered, and the practitioner be given an opportunity to either explain why he believes the claim is supported or an opportunity to cancel before the automatic "flipping" of all the claims to the AIA occurs.

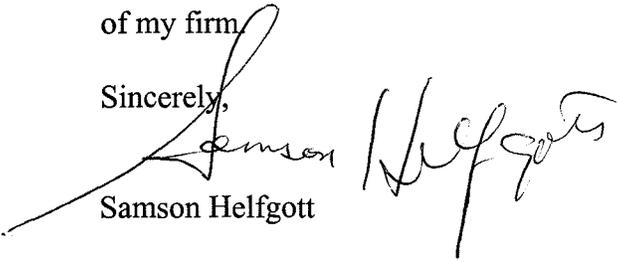
It is hoped that this issue will be reviewed and the final rules will appropriately address this situation in a more practical and realistic manner.

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Please note that the comments submitted above are my own, and do not necessarily reflect those of my firm.

Sincerely,


Samson Helfgott