

From: Steven M. Hoffberg

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To: fitf_rules

Subject: Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2012-0015]

RIN 0651-AC77

Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act

Dear Sir:

I provide these comments as a brief overview and observations, and by no means a comprehensive analysis of the proposed rules.

The rules should be amended to make clear that the phrase “contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013”, only refers to claims present when an application is filed, and does not at all relate to claim amendments during prosecution, especially which have not been allowed. A claim can only have an effective filing date if it is present in an application when filed. Thus, the effective date must refer to the claim, and not to the “claimed invention”. This will avoid misinterpretation by examiners who might assert that any pre-AIA application magically becomes a post-AIA application because a rejection under 35 USC 112 renders the claim unsupported by the specification as of its effective filing date.

The word “must”, with various sanctions associated with violation of the action clause relating to providing disclosures relevant to whether the AIA applies or not is presented in the proposed rules, as well as a newly required Petition (and fee) in the event that an Applicant fails to comply with the rules. In fact, the rule(s) should be very simple: The ADS should include non-prejudicial checkboxes, indicating “post AIA subject matter included in claims”, “post AIA subject matter included in specification”, and “unknown”. The ADS may be delayed until required by a Notice to File Missing Parts, with no penalty for failure to provide this information until examination has commenced. Thereafter, applicant would various remedies, such as filing an RCE. There seems no need for the USPTO to require this information immediately later filing, where administratively, it might not matter for 3-5 years, when the examiner finally picks of the application. While the USPTO is clearly working to reduce its backlog, except in cases where expedited examination is provided, such time periods do not serve a compelling state interest.

Ultimately, it must be the Examiner’s burden to determine whether the claims have a pre-AIA filing date or a post-AIA one, and the USPTO should not abdicate that responsibility by seeking to shift the burden, with great prejudice, to applicants.

There may, in some presumably rare cases, arise a situation where applicant does not know whether the AIA is applicable or not, and a request for admission (with sanctions for failure to be accurate) by the USPTO is inappropriate. For example, in some cases, a claim is identical to the text of a pre-AIA claim, but the specification is amended. In this case, the application arguably is not one which “contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013”. On the other hand, the Courts have not spoken, and therefore this may be a gray area for some time. An administrative solution to this problem is inappropriate, since forcing an applicant to accept AIA coverage, or risk sanctions for falsely claiming pre-AIA coverage, are not the only choices available.

Very truly yours,

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