

From: Sundby, Suzannah
Sent: Friday, October 05, 2012 3:52 PM
To: fitf_rules; fitf_guidance
Subject: First-to-File Comments to Proposed Rules and Examination Guidelines

Dear Office of Patent Legal Administration:

As properly noted by the USPTO in the comments related to the FITF examination guidelines, the AIA did not change the requirement that the USPTO bears the initial burden of explaining why the applicable statutory or regulatory requirements have not been met if a claim in a patent application is to be rejected. With this in mind, I respectfully submit that it is the USPTO's initial burden to determine whether the claims of a non-provisional application claiming the benefit of an earlier filing date that is before 16 March 2013 are sufficiently supported by the priority application and thereby receive the benefit of the earlier filing date and the first-to-invent rules.

Proposed Rules

The proposed rules shift the USPTO's initial burden of examination to Applicants by requiring Applicants to submit statements as to the applicability of the first-to-file provisions of the AIA and rules. Although the statements required, as proposed by the USPTO, appear simple and insignificant, a problem arises where an Applicant may have made an incorrect statement or may have not timely submitted the statement. Specifically, in either case, the Applicant may then be required to specifically identify parts of the specification of the priority document which provide support claims benefiting from pre-AIA, first-to-invent rules. Such statements and additional information required to correct an incorrect statement will most likely be detrimental and adverse to Applicants' interests. Under many state bar rules, attorneys must zealously represent their clients' interests and not act in a manner that is adverse to such interests. Thus, such USPTO rules put many patent attorneys in a difficult position - either violate state bar rules and ethics or violate USPTO rules of practice.

Thus, I propose that ALL applications filed on or after 16 March 2013 are initially considered and examined under the post-AIA, first-to-file rules. Then if during examination, Applicants wish to claim the benefit of a pre-AIA, first-to-invent rule, Applicants must then submit the arguments and evidence that a given claim is to receive the benefit of the earlier filing date in a manner similar to current practice for antedating a reference.

For considering the prior art effect of a US application (Prior Art Application) claiming the benefit of a foreign priority application, I propose that the USPTO simply assume that the disclosure of the Prior Art Application as filed with the USPTO is the same as that of the foreign priority application. Then, if during prosecution, the Prior Art Application is asserted as prior art against the claims of an application of a subsequent applicant, it is the subsequent applicant's burden to argue and provide evidence that the "at issue" disclosure in the Prior Art Application cannot be asserted as being prior art as

of the foreign priority date as the foreign priority application does not set forth the "at issue" disclosure.

This procedure would then alleviate the need for requiring Applicants to submit a certified copy of a foreign priority document within the later of four months from the actual filing date or sixteen months from the foreign priority filing date. This time requirement, which if not met results in the loss of foreign priority, is potentially problematic in that not all foreign countries participate in a document exchange program with the USPTO such that obtaining a certified copy of a foreign priority document and being able to timely submit such to the USPTO is largely dependent on how fast the foreign patent office will act once an Applicant requests a certified copy from the foreign patent office. Often Applicants do not decide to pursue patent protection until the last minute and will not order certified priority documents until the decision to file the patent application is made. In these situations, it is quite possible that the delay by a foreign patent office, which is out of the control of the Applicant, will result in the loss of priority.

I note that many may be interested in obtaining legal opinions, e.g. patentability, validity, and non-infringement opinions, which will require one to determine whether the claimed subject matter of falls within the post-AIA, FITF rules, or not, and thereby require one to review the priority document to consider issues such as written description support. As there may be situations where the U.S. application is published, but the priority document is not yet obtainable from the prosecution history PAIR records, I suggest that the USPTO enact a rule which mandates that the act of an Applicant claiming the benefit of a priority application, including foreign and domestic applications, is an automatic express consent by the Applicant conferring (anyone) the right to obtain a copy of the priority document from the applicable patent office upon providing a request to the applicable patent office which also provides evidence of the US application and the priority claim to the priority document at issue.

Proposed Examination Guidelines

With regard to whether public availability is a requirement for "on sale" activities under AIA 35 U.S.C. 102(a)(1), I respectfully submit that the such "on sale" activities should be only that which is publicly available. This interpretation is consistent with the intent of the AIA and the concession to have no geographical limitations, i.e. opening the applicable activities to include those outside of the United States. To include secret/confidential agreements would further erode the availability of patent protection in the United States and thereby further weaken our economic system.

With regard to the ability to avail oneself of the new grace period shielding disclosure under 35 U.S.C. 102(b)(1)(B), the USPTO proposes that the subject matter disclosed in the prior art being applied must be exactly the same as the subject matter publicly disclosed by the inventor. Thus, the USPTO indicates that the ability to claim the shielding effect of 35 U.S.C. 102(b)(1)(B) is available where there are only insubstantial

changes, or only trivial or obvious variations between that of the prior art and that publicly disclosed by the inventor.

This is one of the most troubling and problematic proposals by the USPTO. In particular, requiring that the shielding disclosure be exactly the same as the prior art disclosure in order to disqualify the prior art as prior art makes it such that the new grace period shielding disclosure under 35 U.S.C. 102(b)(1)(B) is completely worthless. Specifically, an inventor could have published an article and then another party could simply read about the inventor's invention in the article, write a second article which essentially copies text from the first article, but has insubstantial changes, or only trivial or obvious variations so as to not be accused of plagiarism and then the second article which merely summarizes the first article could be applied as prior art under 102(a), but the Inventor/Applicant would not be able to disqualify the second article under 35 U.S.C. 102(b)(1)(B) because of insubstantial changes, or trivial or obvious variations. Surely, the USPTO's interpretation that the shielding disclosure and the prior art disclosure must be exactly the same is not Congress' intent for the application and effect of 35 U.S.C. 102(b)(1)(B).

Thank you for this opportunity to comment on the proposed FITF rules and examination guidelines.

Best regards,
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