

From: John Haran
Sent: Friday, October 05, 2012 5:51 PM
To: fitf_rules
Cc: John Covert
Subject: SKGF Comments on FITF Rulemaking

Dear Ms. Tsang-Foster:

In reply to the Notice of Proposed Rulemaking addressing changes to implement the first inventor to file provisions of the AIA published on July 26, 2012 at 77 Fed. Reg. 43742, we respectfully submit the attached comments.

Best regards,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AC77

For: **Notice of Proposed Rulemaking:
Changes to Implement the First
Inventor to File Provisions of the
Leahy-Smith America Invents Act**

**77 Fed. Reg. 43742
(July 26, 2012)**

**Comments in Reply to the Notice of Proposed Rulemaking Entitled
"Changes to Implement the First Inventor to File Provisions of the Leahy-
Smith America Invents Act"**

Via Internet to: fitf_rules@uspto.gov

Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Due: October 5, 2012

Attention: Ms. Susy Tsang-Foster, Legal Advisor
Office of Patent Legal Administration

Dear Ms. Tsang-Foster:

In reply to the Notice of Proposed Rulemaking published July 26, 2012, at 77 Fed. Reg. 43742, the PTO Practice Committee at STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. submits the following comments.

1. 37 C.F.R. §1.55(a)(2)

The Office proposes to amend 37 C.F.R. §1.55(a)(2) to require that in an original application filed under 35 U.S.C. 111(a), the claim for foreign priority, as well as a certified copy of the foreign application, must both be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.

Currently, the requirement for submitting a copy of the foreign application is met if it was submitted in a parent U.S. application. Will the requirement for the certified copy of the foreign application of proposed §1.55(a)(2) be met if a certified copy of the foreign application is submitted in a parent US application within the time period specified in

proposed §1.55(a)(2)? If so, will it be necessary for the applicant to indicate that the certified copy of the foreign application was submitted in the parent U.S. application?

2. 37 C.F.R. §1.55(d)(1)

The Office proposes to amend 37 C.F.R. §1.55(d)(1) to specify that the requirement for the certified copy of a foreign priority document will be satisfied if (i) the applicant files a request, in a separate document, that the Office obtain a copy of the foreign application from a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement; (ii) the foreign application is identified in an application data sheet; and (iii) the copy of the foreign application is received by the Office within the period set forth in paragraph (a) or by such later time as may be set by the Office.

(a) Currently, the Office automatically retrieves such documents from foreign intellectual property offices having a bilateral or multilateral priority document exchange agreement with the Office. Will this practice continue or must the applicant file a request in a separate document (for example, Form PTO/SB/38)? If the Office continues the practice of automatically retrieving such documents, what will happen if the Office does not retrieve the priority document in the prescribed time period? Does the Office recommend that a request be made rather than relying on the Office to automatically retrieve the priority document?

(b) If the applicant files a request for the Office to obtain a certified copy of the priority document, what will happen if the Office does not retrieve the priority document in the prescribed time period? Is the applicant's duty to submit the priority document within the prescribed time period met by filing such a request even if the Office does not retrieve the priority document within the prescribed time period? Is it necessary for the applicant to continuously check to make sure the priority document was retrieved by the Office? At what point should the applicant submit a certified copy of the priority document if the Office does not appear to have retrieved the copy?

3. 37 C.F.R. §§1.55(a)(4), 1.78(a)(3), and 1.78(c)(2)

The Office proposes to amend 37 C.F.R. §§1.55(a)(4) and 1.78(a)(3), and add new 37 C.F.R. §1.78(c)(2) to require that when an application claims priority to, or the benefit of, an application filed before March 16, 2013, the applicant must state if the later-filed application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. Also, these sections require that when an application claims priority to, or the benefit of, an application filed before March 16, 2013 and the application does not contain a claim to a claimed invention that has an effective

filing date on or after March 16, 2013, the applicant must state if the later-filed application contains subject matter not also disclosed in the prior-filed application.

(a) We respectfully submit that these required statements create an unfair and unnecessary burden on applicants.

Why is it necessary for the applicant to make a determination if either of these statements should be made? In most instances, the Office should be able to determine whether or not the claims of the application have support in the priority and/or benefit documents without the need for the applicant to state such. In instances where (1) the Office cannot make a determination if there is support for the claims in a priority document, such as if the priority document is not in English, and (2) there is a rejection that can only be made under the first-inventor-to-file provisions, why can't the Office make the rejection and then place the burden on the applicant to demonstrate that the rejection is not proper because the claims have support in the priority document? This is similar to the current practice wherein the Office makes a rejection that is only possible if there is no support for the claims in a non-English language priority document. When making the rejection, the Office notes that in order to rely on the foreign priority document to overcome the rejection, the applicant must (1) provide an English translation of the priority document and (2) specify the support for the claims in the English translation in order to overcome the rejection.

(b) In addition, these requirements will be especially confusing for foreign applicants as it may be difficult to determine if new matter has been added to the application filed in the U.S.

For example, when we file a U.S. application claiming priority to a non-English language foreign application, we often read through the English translation before filing the application to correct any grammatical issues. Would making grammatical changes to the translation be considered adding new matter, and therefore require that the applicable statement be made?

What if during our review, we realize that the foreign application referred to an element by the incorrect figure reference number? Would correcting this when filing the U.S. application be considered new matter, thereby requiring that a statement be made that the application contains subject matter not also disclosed in the prior-filed application?

(c) The requirement to make these statements also increases the likelihood that inequitable conduct could become an issue in litigations involving patents issuing from applications claiming priority to, or the benefit of, an application filed before March 16, 2013. Any time a defendant in a litigation believes one of these statements should have been made by the applicant during prosecution, but was not, the defendant will assert that by not making the statement, the applicant intentionally made a material misrepresentation to

the Office. This could cause applicants to err on the side of caution and unnecessarily make these statements in order to avoid a charge of inequitable conduct.

We respectfully request that the Office reconsider requiring that these statements be made.

4. 37 C.F.R. §1.130

The Office proposes to amend 37 C.F.R. §1.130 to provide a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art in accordance with 35 U.S.C. §102(b) as amended by the AIA. Certainly, evidence will frequently need to be proffered by a patent applicant seeking to invoke the various exceptions of 35 U.S.C. §102(b) as amended by the AIA. It is our opinion that the Office should consider employing a more general approach such as embodied in current 37 C.F.R. §1.131(b) and 37 C.F.R. §1.132. Each of these rules provides for submission of evidence to either antedate or overcome a rejection, while leaving much of the details regarding the sufficiency of the evidence to development on a case-by-case basis. The supplementary information to the rules refers to a number of court decisions that have shaped and informed current declaration practice under current 37 C.F.R. §1.132. Nuances in the facts of the cases influenced the type of showing required to disqualify alleged prior art in each of these cases. While common fact patterns can be envisioned at this stage, there will undoubtedly be a number of unique fact patterns that will be encountered. It is our opinion that a rule that does not deviate from the words of the statute would allow for a reasoned and proper development of declaration practice dealing with the new exceptions of 35 U.S.C. §102(b) as amended by the AIA.

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/John T. Haran/

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And

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The views expressed herein are our own and are not to be attributed to any other person or entity including STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C., or any client of the firm.