

From: John Haran
Sent: Friday, October 05, 2012 7:14 PM
To: fitf_guidance
Cc: John Covert
Subject: SKGF Comments on Examiner Guidelines

Dear Ms. Till:

In reply to the examination guidelines for implementing the first inventor to file provisions of the AIA published on July 26, 2012 at 77 Fed. Reg. 43759, we respectfully submit the attached comments.

Best regards,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

Docket No. PTO-P-2012-0024

For: **Proposed Examination Guidelines
for Implementing the First-Inventor-
to-File Provisions of the Leahy-Smith
America Invents Act**

**77 Fed. Reg. 43759
(July 26, 2012)**

**Comments in Reply to the Proposed Guidelines Entitled "Examination
Guidelines for Implementing the First-Inventor-to-File Provisions of the
Leahy-Smith America Invents Act"**

Via Internet to: fitf_guidance@uspto.gov

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

Due: October 5, 2012

Attention: Ms. Mary C. Till, Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

Dear Ms. Till:

In reply to the Proposed Guidelines published July 26, 2012, at 77 Fed. Reg. 43759, the PTO Practice Committee at STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. submits the following comments.

1. In the Proposed Guidelines, the Office asked for comments on "the extent to which public availability plays a role in 'on sale' prior art as defined in 35 U.S.C. 102(a)(1)." Having attended the First-Inventor-to-File Roundtable on September 6, 2012, we are aware that others have studied this issue in depth and are submitting comments more detailed than our own in support of public availability playing a role in "on sale" prior art. We agree that public availability should play a role in "on sale" prior art for at least the reasons discussed below.

35 U.S.C. § 102(a)(1) precludes a patent if "the claimed invention was patented, described in a printed publication, **or in public use, on sale, or otherwise available to the public** before the effective filing date of the claimed invention." (Emphasis added.) We

respectfully submit that the bolded section is a single phrase and that the "or otherwise available to the public" clause modifies the "on sale" clause to imply that the sale be public. Any interpretation that "on sale" can include a secret sale not known to the public goes against the spirit of 35 U.S.C. § 102(a) that prior art be publicly available.

2. The Office at two locations in the Proposed Guidelines states that 35 U.S.C. § 101 can be employed to reject (or invalidate) a claim to an invention when it is clear that the application names a person that is not a true inventor. The Office relies upon the language of the statute and Commentary of P.J. Federico to support this assertion. While the undersigned share the Office's concern that an application for patent should name the correct inventor, we respectfully urge caution in expanding the scope of rejections that are made under 35 U.S.C. § 101. Experience has shown that § 101 jurisprudence is not straight-forward. Expanding this jurisprudence is not in the public interest.

3. The Proposed Guidelines at p. 43764 make a distinction between the written description required to support a claim under 35 U.S.C. § 112(a) and what constitutes a prior art disclosure that describes a claimed invention. The Office indicates that there is a "how to make requirement [that] is judged from the viewpoint of a person of ordinary skill in the art, and thus does not require the document explicitly disclose information within the knowledge of such a person." The Office cites *In re Donohue*. Importantly, but overlooked in the Office's summary, *Donohue* also recognizes a line of cases where the elements of a claimed invention were described in a prior art publication, but the publication indicated that the authors were not successful in obtaining the invention. In such a fact situation, the claimed invention was not placed into possession of the public, and the reference was not found to have described the claimed invention, regardless of additional information within the knowledge of a person of ordinary skill in the art.

4. The Proposed Guidelines at p. 43765 state that the Office will continue to treat admissions of prior art in the same manner. We respectfully request the Office to treat admissions, at least during the transitional period between old § 102 and new § 102 on a case-by-case basis. There is a high probability of mistakenly applying the wrong § 102 in a particular application both by applicants and the Office for the foreseeable future.

5. The Office recognizes at p. 43762 of the Proposed Guidelines that the temporal focus for an obviousness inquiry has been shifted to before the effective filing date of the claimed invention. At p. 43772 of the Proposed Guidelines, the Office states that AIA § 102(a) defines prior art for both novelty and obviousness. The Office relies upon *Hazeltine v. Brenner* as authority. We note that the rationale and logic of *Hazeltine v. Brenner* are undermined by the new definition of prior art under § 102(a)(2). The rationale of *Hazeltine v. Brenner* will apply to a subset of § 102(a)(2) patents and published applications – only those applications that were first filed as a U.S. non-provisional patent application. A supremely efficient USPTO can issue an application with a foreign priority date no sooner than twelve months from effective filing date; and with PCT applications no sooner than thirty months from effective filing date. The percentage of applications falling into this

category is high enough that there is direct conflict with the clear words of the statute: "the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art."

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

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

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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.