

Reitter, Breck

From: Millet, Marcus J <mmillet@ldlkm.com>
Sent: Tuesday, April 10, 2012 4:49 PM
To: Derivation
Subject: FW: Written Comments-Changes To Implement Derivation Proceedings-77 FR 7028

I respectfully submit the following comments with respect to the above-identified notice of proposed rulemaking. I am an attorney currently active in post-issuance proceedings in the PTO, including *ex parte* and *inter partes* reexaminations. My practice includes representation of both patent owners and parties challenging patents. Although I am a partner in the firm of Lerner, David, Littenberg, Krumholz and Mentlik, my comments are offered solely in my individual capacity and do not necessarily represent the views of the firm as a whole.

My comments are as follows:

Proposed Rule 42.407(b)

Under the statute, a petition to institute a derivation proceeding “may be filed only within the one-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier applications claimed to the invention. . . .” AIA, 35 U.S.C. 135(a). Under Proposed Rule 42.407(b), if the petition is in any way incomplete, even in some minor respect, no filing date is accorded to the petition. Thus, the one-year period continues to run. If a petitioner makes a minor error in the petition, such as an insufficient fee, it can be barred from filing any petition. The rule should be modified to provide that if a petition affords notice sufficient to identify the application with which a derivation proceeding is sought and sufficient to identify the petitioner’s application, the petition will be accorded a filing date which can be preserved by completing the remaining requirements within one month after notice of the defects is sent by the PTO, and upon payment of a surcharge. The surcharge should be substantial, to discourage use of this provision as a normal route to filing.

Proposed Rule 42.405

Under Proposed Rule 42.405, the petition itself must be supported by substantial evidence including at least one affidavit addressing communication of the derived invention and lack of authorization which, if left un rebutted, would support an inference of derivation. That requirement is enough to prevent institution of frivolous derivation proceedings. In addition, however, proposed Rule 42.405 provides that “the showing of communication must be corroborated.” Corroboration should not be required in the petition. In some meritorious cases, corroborating evidence may only be available through discovery during the case. Other proposed rules provide for discovery, including examination of the petitioner and the adverse inventor. By requiring corroboration in the petition itself, the rule as it now stands would unjustly prevent parties with meritorious cases from obtaining relief.

Respectfully submitted,

Marcus J. Millet

Reg. No. 28,241