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February 11, 2016

U.S. Patent and Trademark Office  
401 Dulany Street  
Alexandria, VA 22314

Re: Topic for Submission for Case Studies Pilot Program

Dear Colleagues:

1. Statement of the quality-related issue:

If an applicant wants to wants to abandon a provisional application early in the year to start another Paris Convention year of priority, the new provisional cannot be filed until the applicant is sure the first provisional was abandoned, leaving no rights remaining. However, the PTO says that an application is not abandoned upon the filing of an express abandonment, but only when the PTO acknowledges that request for express abandonment by issuance of a notice of abandonment. This can often take a substantial amount of time, much to the stakeholder's chagrin. We have had cases take between 2 and 3 (or more) weeks. This can cause problems particularly given the first to file provisions of the AIA. Not only does the review take time, but it is a waste of PTO resources to review the express abandonment requests by hand.

2. Proposal for PTO study:

A review of the filings of express abandonments of provisional applications, and the time it takes for the PTO to process the abandonment, and issue the notice, would include not only the numbers of such requests, but the time from filing to notice, the amount of personnel involved in the review, and the costs of such requests.

3. Outcome of study as it relates to patent-quality improvement:

We believe that the PTO will find a significant backlog in the rulings on express abandonment requests, along with an expensive cost to the PTO to personally review the requests. Such costs are unnecessary under the following proposal to revise the express abandonment procedure. Given that electronic filings make receipt at the PTO of the express abandonment instantaneous and provable by instantaneous return receipt of the electronic PTO issued receipt, the PTO's refusal to consider an application abandoned upon filing a notice of express abandonment, is an outmoded and antiquated practice.

We propose that an express abandonment should be made subject of an EFSWeb automatic petition. This automatic procedure would result in a system that benefits the stakeholders of the PTO because they will know immediately that their abandonment has been effective, it will reduce costs to them by eliminating periodic checks required to make sure the abandonment goes through, and it will allow them to immediately refile the application the next day so as to be able to benefit from the earliest filing date possible.

One might argue that such an automatic filing is not appropriate because the PTO must verify that the person filing the express abandonment has a power of attorney to do so.

However, given that the EFS Web system is quite capable of permitting applicant to file such automatic petitions only when the signor has a power of attorney (as it does with automatic approval of terminal disclaimers, for example), this is not a valid concern.

Sincerely,

BROWDY AND NEIMARK, PLLC

A handwritten signature in cursive script, appearing to read "Ronni S. Jillions".

Ronni S. Jillions  
Reg. No. 31,979