

From: Helfgott, Samson
Sent: Tuesday, July 29, 2014 1:34 PM
To: AC95.comments
Subject:

Please see attached.

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July 29, 2014

Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy
United States Patent Office
Attention: Susy Tsang-Foster, Senior Legal Advisor
Joseph F. Weiss, Senior Legal Advisor

**Re: Change to Facilitate Applicant's Authorization of Access to Unpublished U.S. Patent Applications by Foreign Intellectual Property Offices
Notice of Proposed Rulemaking Fed. Register/Vol. 79, No. 133**

Last year all three national Bar Association, AIPLA, IPO, and ABA-IPL Section recommended to the USPTO to change the ADS Form to include not only the ability for authorizing the USPTO to send out copies of priority applications (pre-publication) when an application is foreign filed, but also to authorize the USPTO to send out information (pre-publication searches and examinations) to foreign patent offices requiring such information. They further requested that the current "Opt-In" authorization box on the ADS be changed to an Opt-Out" box.

The Proposed Federal Register Notice proposes rules to implement such recommendations, and from my view point, I think the USPTO did an excellent job in implementing the Bar's request.

While the initial request for this change was triggered by the European Patent Office's Rule requiring applicants filing in the EPO to submit copies of any prior search and examination, including pre-publication documents, I believe that since that time further global developments have increased the importance of having these Proposed Rules implemented. Specifically, the fast paced developments of the Global Dossier by the IP5 will need the implementation of these proposed rule changes.

The Global Dossier will require each of the IP5 Patent Offices to make available the full file histories of all applications in their data base so that from one portal in each country, it will be possible to access the full file histories of applications contained in the data bases of the other of the IP5 countries, translated into the local language through a machine translations. Initially this information will include only post publication information. However, as this information will be used by patent examiners in each of these five countries, and as examinations are taking place earlier and earlier, pre-publication information, especially from the priority country, will be very useful to patent examiners in other countries for work sharing benefits. Likewise, the applicant himself should be able to use this as an international "Private Pair", permitting him to access his worldwide file histories from a single portal, and fully translated.

July 29, 2014
Page 2

With the GD in mind we must be sure that these proposed rules will adequately permit the USPTO to be able to make the pre-publication information available for the GD as the US develops the IT needed to implement the GD.

Although when preparing these proposed rules I am not sure the USPTO took into consideration the need for making pre-publication information available for the GD, I do believe that these rules generally do adequately provide the USPTO with the necessary authorizations to fulfill its obligations on making available pre published information for the GD system. However, I note a few areas of some concern, which the USPTO may want to address before finalizing these Proposed Rules:

1. In Proposed Rule Section 1.14(h)(2), in addressing access to the file contents, at the end of the paragraph they indicate they will be able to send the information to Foreign Intellectual Property Offices “ indicated in the written authority”. This seems to infer that the applicant will have to specifically indicate to which Patent Offices they will permit pre-publication information to be sent and indicate where they do not provide such authorization. I think this may cause a problem fulfilling our requirements for the GD System.

I believe that once an applicant foreign files his application in a foreign country, he inherently agrees to the rules and requirements of that foreign country, and to the extent that a foreign country requests that USPTO provide this information for the GD, I do not believe that the applicant should be required to specifically select to which foreign countries he will permit his information to be sent. By foreign filing in a country I believe he already agrees to follow the requirements of that country. I also note that this same specific language was excluded from Section (h)(1) relating to access to the priority document.

My recommendation therefore, is that this language “indicated in the written authority” likewise be removed from subparagraph (h)(2).

2. The Proposed Rules require that there be respective bilateral or multi-lateral agreements in place between the US and the foreign countries requesting the particular information. I don't think this is a major concern, but it will require all of the IP5 Patent Offices to have mutual agreements with each other in order for implementing the GD to cover pre-publication information. I would suggest the USPTO review this requirement in light of the GD development.
3. I would also want to see the proposed new ADS Form before actual implementation of these Rules to be sure that the language in the ADS conforms to what is needed for users and in conformance with user's requests.

July 29, 2014

Page 3

The Proposed Rules are all based upon the assumption that a specific authority is required from an applicant in order to send out pre-publication information to a foreign country in which that applicant has filed his application. It is believed that this assumption should be re-visited. As indicated above, it is believe that once an applicant foreign files his application in a foreign country he inherently agrees to the rules and requirement of that foreign country. Accordingly, it is believed that no separate authorization is needed to either send a priority document or pre-publication information, to the extent those are required by the foreign country. Accordingly, before implementing these rules, the USPTIO should reconsider the entire need for such authorization and should it be found there is no basis for such authorization, then the entire section from the ADS be removed and the simple foreign filing of an application by an applicant be used as his authorization for sending such priority documents and pre-publication information to the foreign country.

Sincerely,

A handwritten signature in cursive script, appearing to read "Samson Helfgott". The signature is written in black ink and is positioned below the word "Sincerely,".

Samson Helfgott

SH:nh