

From: Timothy Tardibono

Sent: Monday, November 05, 2012 11:57 PM

To: fitf_guidance; fitf_rules

Cc: Theresa Andrews

Subject: Comments by CONNECT (San Diego) re: FITF proposed rules and guidelines Docket Nos. PTO-P-2012-0015 and 0024

Hello.

Please see attached our comments in regard to Docket Nos. PTO-P-2012-0015 and 0024.

If you have any trouble opening the PDF document, please don't hesitate to contact me.

Sincerely,

Timothy Tardibono

CONNECT

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Comments by CONNECT

**Submitted to the United States Patent and Trademark Office
related to the Notice of Proposed Rulemaking on
Changes to Implement the First Inventor to File Provisions of the
America Invents Act**

Docket No. PTO-P-2012-0015

Docket No. PTO-P-2012-0024

November 5, 2012

Summary:

CONNECT's mission is to propel creative ideas and emerging technologies to the marketplace by connecting entrepreneurs with the comprehensive resources they need to sustain viability and business vibrancy. That mission will be significantly impacted as the United States Patent and Trademark Office (USPTO) considers changes to the rules for patent application filing and the American grace period under the America Invents Act.

It is imperative that the Office cautiously consider the impact of proposed rules on the U.S. innovation ecosystem because a strong patent portfolio is a critical factor in an emerging company's ability to successfully break into a market. CONNECT echoes the strong concerns expressed by our colleagues in the university community regarding the need for USPTO regulations to strengthen, not weaken, the American grace period.

Introduction:

CONNECT is a nonprofit organization dedicated to creating and sustaining the growth of innovative technology and related businesses. Since 1985, CONNECT has assisted in the formation and development of over 3,000 companies across a broad spectrum of technologies and is widely recognized as one of the world's most successful regional programs linking investors and entrepreneurs with the resources they need for success. As a leading voice in the innovation community, CONNECT



believes it is compelled to add its unique perspective to the voices being heard by the USPTO.

CONNECT has been hosting a series of AIA Regulatory Review Meetings where IP counsels and other IP experts in San Diego's innovation community have an opportunity to learn more about AIA Regulations and how they will impact start-up/emerging companies.

CONNECT and San Diego's innovation community greatly appreciates the USPTO's assistance in providing key USPTO leaders to participate in AIA Regulatory Review Meetings. Additionally, we'd like to extend our gratitude to the Small Business Administration's Office of Advocacy for their assertive effort to assist our Review Meetings to garner a greater appreciation of the startup concerns with the proposed First Inventor to File Rules. These comments and suggestions were developed in partnership with the aforementioned San Diego based IP experts present at CONNECT's AIA Regulatory Review Meetings.

CONNECT heartily commends the USPTO for its proactive steps to reach out to the patent community to explain the proposed rules and provide various forums for discussion. Clearly the USPTO is showing that it seriously wants stakeholder input and is providing transparency and accountability in its efforts. It is refreshing to see such public service from a federal agency. Thus we hope that the comments herein submitted will be received by the USPTO in a purely constructive manner and should not be seen as a pejorative commentary on the USPTO, its leadership, or staff. As always, CONNECT stands ready and willing to further assist the USPTO as it moves forward past the comment deadline.

The rules as proposed do not provide an American Grace Period reflective of the statutory text and would seriously alter and redefine the innovation ecosystem in university and research sectors that are an integral part of the American startup landscape.



USPTO has received a host of comments expressing grave concern that the proposed rules and guidelines materially alter the existing American grace period in contravention of the statutory text. CONNECT fully concurs with those warnings especially the comments made by our colleagues at the University of California and other major university and research stakeholders.

CONNECT implores the USPTO to consider and adopt the suggested revisions or in the alternative, again engage the university and research communities to find language that is true to the statutory text and can be implemented through more workable regulations.

Although uniformity in patent processes and the patent system are desirable, there is great diversity of users of the patent system. In reconsidering the proposed rules and guidelines, the USPTO should not overlook the fact that there are different business models, different technology timelines, and different innovation processes that all benefit the American economy and are deserving of intellectual property protection under the U.S. Constitution.

In our efforts working with the university research community in recent years, it is becoming abundantly apparent that there has never been a greater emphasis on commercialization than the present. Furthermore, innovation in commercialization approaches is spreading in the university community evidenced by the reallocation of resources universities and research centers are placing in their commercialization efforts. Thus, what has been a hallmark of the American innovation economy since the passage of the Bayh-Dole Act, university and research-based innovation, is on the cusp of a new vitality in effectiveness and results that will produce more game-changing technologies, more startups, and more jobs.

However, if the proposed narrow approach to the patent application filing process and Grace Period prevails, such vitality will be severely hindered and will create barriers to the symbiotic and successful relationship between universities/research centers and



startup/emerging companies. With the economy continuing to sputter, the American recovery can ill afford to have massive uncertainty injected into the efforts of startup and emerging companies as they work to improve lives while creating jobs.

Conclusion:

In summary, the USPTO should closely review the aforementioned rules and guidelines and modify them to more accurately reflect the statutory text which preserves the American Grace Period. Such modifications are necessary in order to ensure that start-up and emerging innovators can continue to successfully commercialize intellectual property, providing the backbone of America's global innovation advantage.

Respectfully submitted,

CONNECT, by:

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