

From:

Sent: Wednesday, May 12, 2010 2:17 PM

To: extended_missing_parts

Cc: Armstrong, Joel S.

Subject: Request for Comments on Proposed Change to Missing Parts Practice

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MESSAGE:

Re: Request for Comments on Proposed Change to Missing Parts Practice

Attention Eugenia A. Jones

Dear Ms. Jones:

Please see the attached comments.

Best regards.

William P. Berridge

<<5.12.10 Letter.pdf>>

OLIFF & BERRIDGE, PLC

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May 12, 2010

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By Email

Attention: Eugenia A. Jones

Re: Request for Comments on Proposed Change to Missing Parts Practice

Dear sir:

Oliff & Berridge PLC is a private intellectual property law firm that files and prosecutes several thousand patent applications per year on behalf of a wide range of U.S. and foreign applicants, including independent inventors, small businesses, universities and major U.S. and foreign corporations. As a Member of the firm, I am providing the following comments that represent the views of the firm. However, these comments are not intended to represent the views of any specific client or clients of the firm.

First, we would like to commend the USPTO on its recent efforts to enhance quality and efficiency in its operations. While change is often difficult to all involved, it is clear that change is needed, and we are very pleased that the USPTO has again begun to move forward in a spirit of communication and cooperation with the applicant community to achieve necessary and appropriate changes that "promote the progress of science and useful arts."

1. Relationship to Provisional Applications

As an initial matter, we recommend eliminating any suggestion from the USPTO's website and the commentary associated with the proposed changes that they "would effectively provide a 12-month extension to the 12-month provisional application period (creating a net 24-month period)." In fact, no such effect would arise from the proposed changes. The proposed changes in no way modify the statutory requirement for filing a nonprovisional application, in which new matter could not subsequently be added, within the statutory 12 month period. In fact, as accurately reflected in the title of the Request for Comments, the proposals are merely to change Missing Parts practice. They in no way change the timing or content requirements for filing a nonprovisional patent application, whether or not that nonprovisional patent application claims benefit of a prior provisional application.

2. Applicability to All Patent Applications

We believe that the proposed changes should not be restricted to applicability to nonprovisional patent applications that claim benefit of the filing date of a prior provisional patent application. Such a restriction creates arbitrary differences between nonprovisional patent applications that do not reflect any different needs or benefits among nonprovisional patent applications or the U.S. national phases of international (PCT) patent applications.

The rationale for the proposed changes presented in the Request for Comments applies equally to patent applications that claim foreign priority benefits, U.S. national phase patent applications, and patent applications that claim no prior filing date benefits at all. The same timing and cost issues apply equally across all such patent applications, and the proposed changes should thus be equally applicable across all such applications if they are implemented.

For example, at 75 Fed. Reg. 16751, the Request for Comments cites three benefits of the proposed changes. The first benefit is increased use of the 18-month publication system, providing more technical information to the public. The second benefit is adding flexibility for applicants who may otherwise be forced to expend resources completing nonprovisional applications that might subsequently be withdrawn, and allowing applicants to remove unnecessary workload from the USPTO. The third benefit is better targeting of applicant resources to allow applicants to focus on more commercially significant patenting activities and better tailoring the timing of patenting activities to commercial realities.

The first cited benefit focuses on the fact that more applications would be filed and published that would not have otherwise been filed without the ability to have 12 months to complete payment of the filing fees. This reduction of expense applies equally to applicants who bypass the expense of filing a provisional application in favor of filing a single nonprovisional application with no priority claim. More importantly, it encourages foreign applicants, whose priority applications or international applications were filed in a foreign language, to file in the United States or enter the U.S. national phase, resulting in English-language publication in the United States of patent applications that might not otherwise have been filed, and thus otherwise may have remained published only abroad and in a foreign language. This has the additional benefit of expanding U.S. citizens' access to substantial amounts of foreign technology that would otherwise have remained substantially inaccessible.

The second cited benefit focuses on the longer time period for applicants to ascertain the value of their inventions and decide whether to incur the additional costs associated with pursuing patent rights, thus (1) allowing applicants to avoid expenses with no-longer-relevant patent applications and (2) benefiting the USPTO and other users of the patent system by removing unnecessary workload from the agency. Again, these benefits apply at least equally to applicants who forgo the additional expense of filing a provisional application in favor of first

filing a nonprovisional application. They also apply to applicants who claim foreign priority benefits.

In addition, foreign-origin applications make up a very substantial portion of total USPTO patent application filings. Thus, removing the unnecessary workload associated with applications that foreign applicants decide not to pursue would be of significant benefit to the USPTO. The potentially greatest benefit to the USPTO and other users of the U.S. patent system applies in connection with PCT national phase applications. Currently, nonprovisional applicants who determine that they will not pursue patenting before preparation of a first Office Action can abandon such an application and receive a refund of search fees and excess claim fees, thus providing them with incentive to remove those applications from the USPTO's workload. U.S. national phase applicants, on the other hand, do not have this option, and thus in our experience generally leave their unwanted patent applications in the USPTO workload to avoid incurring any expense associated with expressly abandoning those applications. Providing this new missing parts option to such applicants could provide them with a strong incentive to remove substantial unnecessary workload from the agency.

The third cited benefit is equally applicable on its face to all patent applicants. Particularly because the proposed changes make the timing of completion of filing requirements/satisfaction of missing parts up to the applicants, the proposed changes would equally permit all applicants to more closely target their resources to commercialization and patenting on a coordinated schedule.

In addition, substantially all applicants already have the opportunity to delay preparing full claim sets in their U.S. applications. As noted in the Request for Comments, some applicants take advantage of Missing Parts practice to file nonprovisional applications without complete claim sets by omitting an executed oath or declaration or declining to pay the search and examination fees up front. They then file Preliminary Amendments at the same time that they file the missing parts. This practice is in no way restricted to applicants who claim benefit to a previously filed provisional application. In fact, we have found such a strategy to be more common with foreign applicants who need to conform their claims to U.S. practice, often involving substantial amendments to the claims, for example, to eliminate improper multiple dependencies, "use" claims and the like that would otherwise make their claims potentially unexamined or subject to non-substantive rejections. Providing this additional low cost time would likely encourage such foreign applicants to use the time to improve their claims for U.S. examination, thus better targeting their own resources and permitting more efficient and purposeful engagement with the USPTO in the examination process, and thereby reducing overall pendency of all patent applications.

Thus, we recommend that the proposed changes be applicable to all nonprovisional and U.S. national phase patent applications, and not be restricted to nonprovisional applications that claim benefit of the filing date of a provisional application.

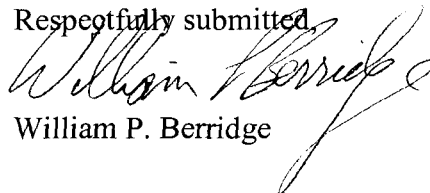
3. Mechanics of the Notice Process

The Request for Comments is somewhat ambiguous as to details of the proposed Notice to File Missing Parts. It may become unduly complicated if a single Notice to File Missing Parts sets both a two-month extendible deadline for some requirements (e.g., declaration, basic filing fee, translation) and a non-extendible 12-month deadline for other requirements (e.g., search fee, examination fee, excess claim fees) with separate fees payable for separate responsive filings. Consideration should be given to the realities of both the USPTO's and applicants' docketing capabilities relative to multiple active deadlines for a single USPTO notice. Similar realities apply to the involvement of multiple fees payable at different times for response to Notices to File Missing Parts -- a \$130 fee and extension fees for the 2-month deadline and a separate \$130 fee for the 12-month deadline.

We therefore recommend that a first Notice identify all missing parts and the option to supply them within a 2-month extendible time frame with a single \$130 fee (and additional \$130 fee where a translation of the nonprovisional or international application is required), followed by a second Notice regarding the 12-month time frame if applicants' response to the first Notice does not include 12-month items. In the event that an application is filed with only 12-month items missing, a single Notice, corresponding to the second Notice identified above, should be sufficient. In either case, we recommend that Notices include a courtesy warning as to the potential offsetting of any positive PTA.

In addition, the Notice also did not make clear which deadline would apply to application size fees, multiple dependent claim fees, sequence listing requirements, or submission of translations of foreign-language provisional applications. Sequence listings and translations of provisional applications may improve the informational content of publications. However, given the intent of the Request for Comments to avoid forcing applicants to incur the cost of substantive work such as preliminary amendment of claims, and given the fact that preparing sequence listings and translations also can involve much substantive work and cost, all three of these items may be better left for the 12-month deadline.

Respectfully submitted,



William P. Berridge