

From: Brad Pedersen [e-mail address redacted]
Sent: Monday, March 05, 2012 5:39 PM
To: post_patent_provisions
Subject: Comments on Changes to Implement Miscellaneous Post Patent Provisions

March 5, 2012

MAIL STOP – Comments Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION – Kenneth Schor
Senior Legal Advisor, OPLA

Re: Comments on Miscellaneous Post Patent Provision Proposed Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Notice of Proposed Rulemaking (NPR) entitled “Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act” – Vol. 77, No. 3, January 5, 2012, pp. 442-448.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to fee setting.

In general, MIPLA supports the opportunity for third parties to submit relevant prior art references during patent prosecution so long as the submissions are legitimate and the rules for the submission process protect patent applicants from frivolous or harassing uses of the process.

MIPLA has the following overall comments/suggestions.

1. *Consistency between Proposed Rule 1.501 and Proposed Rule 1.290* - MIPLA suggests that the USPTO consider these two proposed rules together for purposes of consistency between these two rules relating to pre-issuance and post-issuance submissions made to the

Office. In particular, the Office has not identified why there should be a difference in the requirements for comments on the relevance of a submission between a third party pre-issuance submission under Rule 1.290 and a post-issuance submission under Rule 1.501.

MIPLA has the follow specific comments/suggestions:

A. Proposed Rule 1.501(a)(2) – MIPLA recommends that the USPTO clarify whether statements about the scope of a claim in continuing application could be submitted under this Rule as a statement of a patent owner made in a parent patent, even though the statement was not about a claim in that parent patent.

Submitted on behalf of MIPLA by:

Brad Pedersen
Patent Practice Chair

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