

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: RIN 0651—AC67

For: **Notice of Proposed Rulemaking:
Changes to Implement the
Preissuance Submissions by Third
Parties Provision of the Leahy-
Smith America Invents Act**

**77 Fed. Reg. 448
(January 5, 2012)**

***Comments In Reply To the Notice of Proposed Rulemaking Entitled "Changes to
Implement the Preissuance Submissions by Third Parties Provision of the
Leahy-Smith America Invents Act "***

Via Internet to: preissuance_submissions@uspto.gov

Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Due: March 5, 2012

Attention: Nicole D. Haines
Legal Advisor, Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

Dear Ms. Haines,

In reply to the Notice of Proposed Rulemaking published January 5, 2012, at 77 Fed. Reg. 448, I respectfully submit the following comments.

1. Applicants should be notified of the entry of preissuance submissions

In the comments, the Office states that it does not intend to directly notify the applicant upon entry of a third-party preissuance submission (page 449, last line, continuing onto page

450). However, the art cited in a preissuance submission may be relevant not only to the instant application in which it is cited, but also to applications that are related to the instant application. By the Office alerting the applicants to the fact that a preissuance submission has been entered in case X, the applicants can make a more timely decision on whether or not such art should also be made of record in related cases Y and Z. This is especially important if the preissuance submission was made in the file wrapper of an application that has been abandoned in favor of a continuing application, as applicants may not be actively monitoring the image file wrapper of abandoned applications. Therefore, it benefits both the Office and the applicants if the Office notifies applications so that applicants learn of such art as soon as possible.

As the Office notes on page 450, middle column, it is advantageous for examiners to have the best art before them prior to issuing the first Office action on the merits. It would help the Office meet that goal if the Office notified applicants that a third party preissuance submission had been entered in any application as soon as possible.

2. Entry of preissuance submissions into the record of abandoned applications should not be permitted.

The entry of a third party preissuance submission into the record of an abandoned application should not be permitted. It wastes Office resources to take the time to decide if preissuance submissions into the record of an abandoned application are compliant with the rules for third party preissuance submissions, especially if no continuing applications have been filed.

It is also too much of a burden on applicants to monitor the record of every abandoned application, even if such monitoring is limited to active families, especially if the Office is not going to notify applicants that such a submission has been entered. If there is a pending application, then for the maximum efficiency of prosecution, the Office should require that the preissuance submission be made in the record of the pending application.

3. If preissuance submissions into the record of abandoned applications are permitted, such submissions should be permitted only under specific circumstances

If preissuance submissions into the record of an abandoned application are to be permitted, they should be permitted only when public PAIR indicates that a continuing application has been filed, or that a petition to revive has been filed. Whether or not a continuing application has been filed, and whether or not a petition to revive has been filed, can be determined from public PAIR. The burden should be on the third party to monitor PAIR in that regard, rather than on the applicants to monitor the record of every abandoned application.

4. Examiners should consider third party preissuance submissions that were made in abandoned parent applications

In the comments, the Office states that an examiner would not consider preissuance submissions in an abandoned application unless the abandoned application resumes a pending status (page 450, column 1). However, MPEP § 707.05 states that "In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art." Clarification is requested. Would an examiner who is reviewing an abandoned parent application for pertinent prior art also be required to consider any third party preissuance submission that was entered into the application after the parent application was abandoned?

5. Proposed 37 C.F.R. § 1.291(c)(1)

There is a typographical error in proposed 37 C.F.R. § 1.291(c)(1). Specifically, subpart (v) is missing. It is believed that subpart (vi) should be subpart (v).

6. Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

/Michele A. Cimbala/

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