

From: Clarke, Penny (GE Global Research) [e-mail address redacted]
Sent: Monday, March 05, 2012 2:46 PM
To: preissuance_submissions
Subject: Response to Request for Comments -- Section 8 of America Invents Act

March 5, 2012

Nicole D. Haines

Legal Advisor

Office of Patent Legal Administration

Office of the Associate Commissioner for Patent Examination Policy

Dear Ms. Haines,

I am writing to express my general support for the regulatory implementation of Section 8 of the America Invents Act proposed by the US Patent and Trademark Office (USPTO) in the January 5, 2012 Notice of Public Rulemaking (NPRM) and to request reconsideration of the following aspects of the proposed procedures.

1. In the January 5, 2012 NPRM, the USPTO indicated, in the last four lines on 449 of the Federal Register, Vol. 77, No. 3, that the Office does not plan to require that the third party serve the applicant with a copy of the third-party's preissuance submission. I agree with the office's proposal, as the current process of requiring the third party to serve the applicant with the copy is burdensome, costly, ad-hoc, and paper-intensive. However, I take issue with the alternate plan proposed by the USPTO beginning on the last line of page 449 and continuing onto the third line of page 450 of the Federal Register, Vol. 77, No. 3, that the Office does not intend to directly notify the applicant upon entry of a third-party preissuance submission. I request that the USPTO reconsider and modify its proposed process to provide for email notification of EFS registered applicants upon entry of a third party preissuance submission into the IFW. This notification would be similar to the email notification that the USPTO already provides EFS registered Applicants for office actions and other papers issued by the USPTO.

Such notification would be helpful to applicants by providing early notice of the third party preissuance submission, thus affording applicants the maximum time to review the contents of the third-party preissuance submission and determine, where applicable, how and whether to modify an applicant's prosecution strategy in view of the submission.

Further, such notification would impose minimal burden to the USPTO by following the existing notification process for USPTO mailings, would be paperless, and would be

limited to EFS registered applicants. As such, I hope that the USPTO will provide this or a similar electronic notification means for third party preissuance submission.

2. In order to assess the effectiveness of third-party preissuance submissions, patent practitioners and their clients would benefit from the availability of data illustrating the impact of third-party preissuance submissions upon the Examination process. In particular, the publication of a metric, such as the frequency with which an Examiner made a rejection relying, at least in part, on a reference cited in a third-party preissuance submissions would help patent practitioners and their clients determine if third-party preissuance submissions would be cost-effective, in the aggregate. Accordingly, I hope that the USPTO consider making this metric or similar data available to the public after a meaningful number of third-party preissuance submissions have been received and considered by the USPTO.

3. As noted by the USPTO in the January 5, 2012 Notice of Proposed Rulemaking (on the last six lines of the middle column on page 453 of the Federal Register, Vol. 77, No. 3), requiring an explicit identification of the real party in interests might serve to discourage some third parties from making a preissuance submission. I support the USPTO's plan to not require an explicit identification of the real party in interest. However, the new third party preissuance submission process could be made more cost-effective and attractive for parties making the submissions, if the statements submitted under proposed rule 37 CFR 1.290(c)(5) (regarding no duty to disclose and compliance with the applicable Rules) were included in a separate page held in confidence by the USPTO, such that the signed statements were not uploaded into IFW and further were excluded from the file history for the respective patent application. Alternatively, the identity of the submitter could be held in confidence, for example by blacklining or otherwise redacting the name, signature and address of the submitter, such that the submitter is not identified in the IFW for the respective patent application.

This enhanced anonymity would serve at least two purposes and hence would increase the use of third party submissions. First, by enhancing the anonymity of the submission, third parties would not need to use a wide assortment of outside counsel to make the submissions to maintain anonymity but instead could rely on preferred providers or in-house counsel, which would lower the costs to those parties associated with the submissions. Second, by enhancing anonymity, parties that would otherwise decline to use the third-party preissuance submission process may engage in the process, further increasing the overall use of the new third-party submission process. As such, I hope that the USPTO will adopt this or a similar means (for example blacklining or otherwise redacting the name, signature, and address) to hold the identity of the submitter of the statements required under proposed rule 37 CFR 1.290(c)(5) (regarding no duty to disclose and compliance with the applicable Rules) in confidence and not identify the submitter in the file history for the respective patent applications.

Thank you for your consideration of these points.

Very truly yours,

Penny A. Clarke

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