

From: Arjun [e-mail address redacted]
Sent: Monday, March 05, 2012 3:35 PM
To: preissuance_submissions
Subject: Comments/suggestions concerning Pre-issuance submission

The following comments/suggestions pertain to the contents of the USPTO AIA implementation roadshow slideset (http://www.uspto.gov/aia_implementation/120224-aia_roadshow_sunnyvale_ca.pdf):

1)

Per slide # 29 , titled "Preissuance Submissions Statutory Time Periods (cont.)",

* [Submission is filed as of its date of receipt by the Office](#)"

* [Cannot use certificate of mailing or transmission:](#)

[–Reduce rework by examiners/applicants due to papers crossing in the mail § 1.290\(i\)](#)

Comment: The suggested rule text states that a Preissuance Submission is considered as being filed as of the date of its receipt by the Office, and that the Certificate of mailing or transmission cannot be used.

Since most submissions to the U.S.P.T.O allow for the use of 37 CFR 1.8 (the exceptions, primarily, are the submission of patent applications for which the filing date is accorded based on the actual date of receipt of the application by the office) it appears reasonable to allow it, i.e. Certificate of mailing or transmission, to be used for Preissuance submissions as well.

Further, the date of deposit of a Preissuance submission by Express Mail is stated as being acceptable. However, such a submission via Express Mail does not achieve the stated objective, i.e. to reduce rework by examiners/applicants due to papers crossing in the mail. This is because the date of deposit of such a submission with the USPS may be many days prior to its receipt by the USPTO/examiner. In short, the use of Express Mail USPS service does not appear to eliminate the problem of papers crossing in the mail.

Suggestion: Therefore, eliminating the availability of Certificate of mailing or transmission for Preissuance submissions, adds unnecessary additional complexity to the rules. In conclusion, for at least the aforementioned reasons, the Patent office is requested to consider changing the proposed rule text to include the use of Certificate of mailing or transmission for Preissuance submissions.

2)

Slide # 26, titled "Preissuance Submissions Timing Example #1", states that the Preissuance submission must be filed before 14 mos (the Notice of Allowance date).

Comment: The Preissuance submission time limits are statutory time limits per AIA. However, the example cited on slide #26 of the slideset appears to raise questions concerning how could a 3rd party make a Preissuance submission by the 14 mo date, when the very existence of the application, and its contents, is only available to that 3rd party after 18 mo Publication date?

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