

**From:** Winkler, Michael [redacted]  
**Sent:** Tuesday, May 17, 2011 10:33 AM  
**To:** AC56.comments  
**Subject:** Comments from the ABA Section of Intellectual Property Law on Patent Term Extension and Adjustment Provisions

Please find attached comments from the ABA Section of Intellectual Property Law on "*Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements*" 76 Fed. Reg. 18990 (April 6, 2011). We realized these comments are being submitted past the stated deadline in the Federal Register. We submit them in any event, for the record, and hope they will be useful to you.

Thank you.

**Mike Winkler**

Director, Section of Intellectual Property Law  
American Bar Association  
321 North Clark Street  
Chicago, IL 60654  
T: (312) 988-5639  
F: (312) 988-6800

\*\*\*Note new email address:

[redacted]

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**AMERICAN BAR ASSOCIATION**

**Section of Intellectual Property Law**

321 North Clark Street  
Chicago, IL 60654-7598

(312) 988-5598

FAX: (312) 988-6800

E-mail: [iplaw@abanet.org](mailto:iplaw@abanet.org)

[www.abanet.org/intelprop](http://www.abanet.org/intelprop)

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Amy Mandel  
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Hayden W. Gregory  
Legislative Consultant  
Washington, DC  
[gregoryh@staff.abanet.org](mailto:gregoryh@staff.abanet.org)

May 17, 2011

via electronic mail to  
[AC56.comments@uspto.gov](mailto:AC56.comments@uspto.gov)

The Honorable David Kappos  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
Mail Stop Comments – Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Kery A. Fries, Senior Legal Advisor

Re: Comments on *Revision of Patent Term Extension and Adjustment  
Provisions Relating to Appellate Review and Information Disclosure  
Statements*, 76 Fed. Reg. 18990 (April 6, 2011)

Dear Under Secretary Kappos:

On behalf of the American Bar Association Section of Intellectual Property Law (the “Section”), I am writing to offer comments regarding the rules proposed by the United States Patent and Trademark Office (the “Office”) published in the Federal Register on April 6, 2011 (PTO-P-2011-0014) entitled, *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements* (the “Notice”). These comments have not been approved by the American Bar Association House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The proposed rules would ameliorate an inadvertent, yet inequitable gap that currently exists in the regulations for determination of patent term adjustment. In particular, under the current rules, when the Office reopens prosecution after a timely notice of appeal has been filed and issues an Office Action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 before a final decision is rendered by the Board of Patent Appeals and Interferences in favor of the applicant, the applicant is not entitled to recover this delay for patent term adjustment (“PTA”) purposes. This could be a significant amount of potential positive PTA that the applicant will surrender through no delay or fault on its part. In contrast, had the applicant’s appeal gone to completion and resulted in a reversal of the Office by the Board of Patent Appeals and Interferences, then 35 U.S.C. § 154(b)(1)(C) (so called, c-delay) would have accrued for PTA purposes. Thus, the Section supports the Office’s application of the patent term adjustment provisions to eliminate this gap to provide positive PTA for the applicant under 35 U.S.C § 154(b). The Section takes no position as to whether the Office has the authority to amend 37 C.F.R. § 1.701(a)(3) to effectuate this change.

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The Section further supports application of the PTA provisions to provide that submission of an information disclosure statement after a notice of allowance will not result in reduction of patent term adjustment if the information is first cited in a communication from a counterpart international application or from the Office in another application after the mailing of the notice of allowance. The Section notes that it is not uncommon for references to be cited, communications to be received from the Office in another application or communications to be received from a foreign patent office in a counterpart foreign application, for example, after the mailing of a notice of allowance. Under the proposed rule, applicants will not be penalized through reduction of PTA for submission of such information to the Office after the mailing of a notice of allowance. This will encourage submission of material information to the Office, thus resulting in more thorough examinations of applications, and ultimately patents of higher quality.

The Section appreciates the Office asking for input in response to the Notice and if you have any questions or require further explanation concerning any of our comments, please do not hesitate to contact me. Either I or another member of the leadership of the Section would be pleased to respond to your inquiries.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Marylee Jenkins', written over a horizontal line.

Marylee Jenkins  
Section Chairperson  
American Bar Association  
Section of Intellectual Property Law