

From: Rosenberg, William

Sent: Thursday, November 01, 2012 10:57 AM

To: fitf_guidance

Subject: Comments of the U.S. Patent and Trademark Office regarding "Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act

Dear Ms. Till:

In reply to the Request for Comments of the U.S. Patent and Trademark Office regarding "Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act," published on July 26, 2012 at 77 Fed. Reg. 43759, the University of Massachusetts respectfully submits the attached comments.

Bill Rosenberg

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UMass President's Office
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November 1, 2012

Via email: fitf_guidance@uspto.gov

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

Attn: Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Re: Docket No. PTO-P-2012-0024 (77 Fed. Reg. 43759)

The following comments are respectfully submitted by the University of Massachusetts to comment on U.S. Patent and Trademark Office's (USPTO) proposed implementation of the First Inventor to File Provisions of the America Invents Act (AIA). Our comments are directed primarily at the proposed Examination Guidelines referenced above.

The University of Massachusetts is a public research and land-grant university comprised of the Amherst, Boston, Dartmouth and Lowell campuses and Medical School located in Worcester. It is the largest public university in New England with research expenditures of \$586.7 million in fiscal year 2011. The University generated \$35 million in income from faculty-derived discoveries and products during fiscal year 2011. One of its principle missions is the open and free dissemination of knowledge for the public good. Its primary means for dissemination of research results is through the prolific volume of publications and conferences published by its faculty who, driven by their commitment to academic excellence, make early and broad disclosures of knowledge.

With regard to implementation of FITF under the AIA, the University of Massachusetts understands the benefits of harmonization with the patent laws of other countries and has accepted this change as good for the United States. However, throughout the many months during which the AIA was considered, universities indicated that FITF would be acceptable if three provisions were included or retained: a strong inventor oath, provisional patent applications and a one-year grace period. Because of the way universities work, in particular, the typical publication process used by our researchers, a

meaningful grace period is essential to protecting the missions of our land-grant institution.

Our concern is that the proposed Examination Guidelines contain an unreasonably limited interpretation of the AIA's grace period provision. Specifically, the Guidelines, as proposed, state:

“Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 USC 102(a) and the subject matter publicly disclosed by the inventor ... are mere insubstantial changes, or only trivial or obvious variations, the (grace period exception) does not apply.” (77 Fed. Reg. 43767 and 43769). If adopted, such language would essentially destroy meaningful grace period protection and invite third parties to produce a prior art reference by simply copying the work of the original inventor and introducing “insubstantial changes or trivial/obvious variations.” In our view, this language constitutes substantive rule-making and exceeds the authority of the USPTO.

We are aware of the October 5, 2012 letter to your office sent by AAU, ACE, AAMC, APLU, AUTM and COGR (the Associations) expressing in greater detail these and other concerns. The University of Massachusetts concurs with the Associations' letter and formally endorses it. We request that the USPTO eliminate the above-cited language and replace it with language which ensures a meaningful grace period for universities.

We regard the AIA as an important and beneficial advance in U.S. patent law. However, to be truly effective for organizations that develop the scientific and technical advances on which our country's competitive strength relies, e.g., universities, AIA must be implemented in an appropriate manner consistent with the language of the statute. Universities should not be penalized for advancing science through the early and broad dissemination of knowledge.

The University of Massachusetts respectfully requests the USPTO reconsider its narrow interpretation of the grace period under the AIA.

Sincerely,



William S. Rosenberg, Ph.D.
Executive Director
Commercial Ventures and Intellectual Property