

From: IP-LAW
Sent: Wednesday, October 31, 2012 10:51 AM
To: fitf_rules
Subject: Position paper of UNION-IP on Rule 1.78(a)(5)

Dear Under Secretary Kappos:

please find attached a Position Paper of UNION-IP on Rule 1.78(a)(5). We would appreciate it very much, if this paper would be considered in connection with the proposed "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act" published July 26, 2012 in the Federal Register.

With kind regards,

On Behalf of the UNION ExCo
The Patents Commission of UNION
The President
Jochen Kilchert

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The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments—Patents
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Via Electronic Mail (only) to: fiff_rules@uspto.gov

Dear Under Secretary Kappos:

The Union of European Practitioners in Intellectual Property expresses gratitude for the public invitation to provide comments to the United States Patent and Trademark Office to assist USPTO efforts to effectively implement the first-to-file provisions of the Leahy-Smith America Invents Act (“AIA”).

UNION is an association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related questions and who carry on their profession independently or as employees. UNION is a private, free, international Association which is not dependent on any National or International Authority: it approves its own members, in accordance with its Statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European Practitioners in the Intellectual Property field in different countries and different branches of the profession.

In the years after its foundation in 1961, UNION was one of the organisations which participated most actively in the preparations for the European Patent System. Since that time it has continuously pursued its activities in the Patent field, particularly in arranging Round-Table discussions on current Patent problems. It has contributed prominently to the debate on the application of the Patent System to Biotechnological Inventions. In addition it has dedicated its activities to other areas of Intellectual

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Property in Europe, especially the harmonisation of Trade Mark and Design Laws as well as the Community Trade Mark and Community Design. It has taken the initiative in bringing forward discussions of the existing and newly created Utility Model or Short Term Patent Laws in numerous European countries and raising the question whether these laws should be harmonised or whether a European Utility Model should be created.

UNION maintains close contacts with International Authorities such as WIPO (The World Industrial Property Organisation) and the Commission of the European Union, and it is invited to their consultations and discussions. It participates regularly as a non-governmental organisation with observer status at International Conferences.

It has come to the attention of UNION's governance that key provisions of the AIA coming into effect from March 16, 2013 provide prior art effect to U.S. patent applications as of their foreign priority dates, eliminate existing statute section 35 U.S.C. 102(e), and eliminate the Hilmer doctrine, for U.S. applications filed after March 16, 2013.¹ Practically, this means that a great number of European patent applications written by members of the UNION shall eventually serve as the basis for "effective filing date,"² as referred to in the AIA, for corresponding U.S. applications claiming priority to these European patent applications that are filed after March 15, 2013. Accordingly, UNION's members have a vital interest in supporting the United States Patent Office's effective implementation of these complex and sweeping changes to U.S. patent law. We believe that our members' extensive experience within European first-to-file patent systems may be of assistance to the USPTO's efforts.

We focus this letter on some perceived discrepancy between the actual effect or intent of the statutory changes of March 16, 2013, and the proposed "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act" published July 26, 2012 in the Federal Register with an invitation to comment by October 5, 2012.³ We first note that proposed Rules 37 CFR 1.55(c)(3) & (4) effectively continue the current USPTO practice of not requiring an English translation of any non-English language European-origin foreign priority application, except in the limited circumstances specified. This general principle was also adopted in the recent revision of European Patent Convention Article 88(1) (EPC 2000), where the requirement for a translation of a priority document filed in a language other than an official language of the EPO was eliminated in favor of a translation submission regime similar to that of USPTO Rule 1.55(e)(3) & (4).⁵ It appears

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however that proposed Rule 37 CFR 1.78(a)(5)6 as promulgated in the July 26, 2012 proposed Rules package was inadvertently overlooked in USPTO efforts to effectively update the Rules for post-March 15, 2013 practice.

This organization stands in support of the complete abolition of effect of Rule 37 CFR 1.78(a)(5) for all United States provisional applications filed after March 15, 2013, so as to eliminate the mandatory requirement to submit certified English translations of provisional applications filed in languages other than English after this date. USPTO requirements for submission of certified English translations of non-English language U.S. provisionals filed after March 15, 2013 should be harmonized or equivalent to the USPTO requirements imposed upon foreign priority documents existing in non-English language, so as not to disadvantage the usage of U.S. provisionals relative to other priority systems.

Our reasoning for recommending this change to you relies on our perceptions upon relevant review of the AIA-induced changes, on the perceived interests of domestic U.S. inventors and industry, on perceived efficiencies for the USPTO, on the direct experience of our members, and also on policy considerations consistent with AIA implementation.

Our perception of the AIA-implemented changes leads us to primarily conclude that after March 15, 2013, relative distinctions between foreign priority filings and U.S. provisional priority filings are essentially removed or minimized, and that these two types of filings may thereafter be considered as essentially legally equated as to future effect within substantive future statute sections 102, 103, and 119. First-to-file implementation largely abolishes the potential 35 U.S.C. 102(e) effect⁷ of provisionals filed after March 15, 2013 because section 35 U.S.C. 102(e) itself is eliminated after this date. Simultaneously, the AIA essentially equates foreign filings and provisional filings in the role of priority documents by permitting both to equally serve as the basis for the “effective filing date”. The AIA changes of March 16, 2013 also eliminate current statute section 35 U.S.C. 102(g) and thus the future possibility to “swear back” of certain references up to one year prior to an effective U.S. filing date.⁸ While such an “effective U.S. filing date” may at present time be established only by a U.S. provisional but not by a foreign priority document, this present distinction shall entirely cease to exist for U.S. provisionals filed after March 15, 2013. After March 15, 2013, all priority documents apparently shall equivalently establish an “effective filing date” under the AIA. In this view, there seems little reason to then additionally burden or disfavor the usage of the U.S. provisional as a

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priority document by additionally subjecting it to the further requirements and costs to uniformly submit an English translation, when no such burden is placed on the foreign priority documents. Thus, Rule 37 CFR 1.78(a)(5) appears as a burdensome, unnecessary, legacy or remnant rule, when considering the situation of U.S. provisionals filed after March 15, 2013.

So understood, it unfavorably and unnecessarily burdens domestic U.S. applicants and industries. It should be noted, that while European applicants would be able to file non-English foreign priority documents to establish the post-March 15, 2013 “effective filing date,” domestic U.S. applicants and industries that similarly choose to place a non-English provisional priority document into the USPTO for the same purpose of establishing an “effective filing date” are also subject to the additional burden, paperwork, and attorney and translation fees associated with the unneeded requirements of legacy Rule 1.78(a)(5). For example, a U.S. domestic applicant from Florida who may choose to file his U.S. provisional application in Spanish language prior to filing a 111(a) application based upon it, is subjected to unnecessary paperwork and burden relative to one of our European clients residing in Spain who first files his foreign priority application in the Oficina Española de Patentes y Marcas (Spanish Patent Office) in Spanish prior to similarly filing a 111(a) application based upon it.

Maintaining Rule 1.78(a)(5) for U.S. provisionals filed after March 15, 2013 also reduces the flexibility and options that U.S. applicants and industries may seek in making early preparations to file abroad. For example, it is not uncommon for members of our organization to counsel domestic U.S. filers of European-area applications that certain modifications or amendments of their documents may better prepare their applications for filing abroad. As may be readily understood, after March 15, 2013, the ability to directly obtain priority dates for such modifications or amendments, as well as foreign filing licenses, without the unnecessary legacy burden of Rule 1.78(a)(5), via the U.S. provisional system directly within target foreign languages that reduce costs of and facilitate such modifications and amendments, should desirably be an available tool at the disposal of domestic U.S. applicants and industries.

Furthermore, we perceive that eliminating legacy Rule 1.78(a)(5) for U.S. provisionals filed after March 15, 2013 should lead to operational efficiencies for the USPTO staff and document handling systems. Our members’ experience indicates that such a change would eliminate the current USPTO mailing of a notice regarding papers filed in a non-English language. It would also entirely eliminate the submission processing required at the USPTO side when translation transmittal

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correspondence is submitted by applicants. Thus, elimination of Rule 1.78(a)(5) should eliminate all USPTO costs and efforts associated therewith.

Simultaneously, we do not perceive that elimination of Rule 1.78(a)(5) should have any significant effect on the status quo as regards USPTO security review processing and foreign filing license granting. Currently, USPTO staff typically grant a foreign filing license long before applicants are required by Rule 1.78(a)(5) to submit a certified translation. We would expect that this would continue to hold true for the vast majority of non-English provisionals filed. For those very few applications in which USPTO staff reach the opinion that they may need an accurate translation before granting foreign filing license, we suggest that our above proposal to use an analog to 37 CFR 1.55(e)(3)(iii) appears conclusive.

Considering our own members' perception of current USPTO practices in security review processing and foreign filing license granting within non-English provisionals, we respectfully submit that our members suggest that eliminating legacy Rule 1.78(a)(5) would seem to have absolutely no effect on the current USPTO handling of non-English provisionals. Thus our overall perception is that eliminating legacy Rule 1.78(a)(5) for all U.S. provisionals filed after March 15, 2013 achieves a net positive balance for USPTO operations.

Finally, we suggest that eliminating legacy Rule 1.78(a)(5) for U.S. provisionals filed after March 15, 2013 appears fully consistent with several of the important policy considerations weighed by the USPTO during its extensive rulemaking efforts associated with the AIA. The elimination of this unnecessary requirement tends to foster innovation by eliminating some of the complexities, costs, and paperwork associated with filings. This holds true both for U.S. domestic applicants as well as our European applicants. The elimination of this unnecessary requirement seems to facilitate the more effective administration of the U.S. patent system by eliminating unnecessary USPTO processing efforts and expenditures.

Abolition of Rule 1.78(a)(5) for filings made after March 15, 2013 appears to open paths to more patent prosecution options for all applicants, and particularly for applicants who are interested in filing with an international reach. Furthermore, elimination of this unnecessary requirement provides a small but consistent further step in the direction of harmonization.

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Thus, in response to the notice of proposed rulemaking published in the Federal Register on July 26, 2012, UNION recommends that the USPTO include within its final rules an effective abolition of Rule 37 CFR Rule 1.78(a)(5) for all U.S. provisionals filed after March 15, 2013.

On Behalf of the UNION ExCo

The Patents Commission of UNION

The President

Jochen Kilchert

Footnotes

1. *Public Law 112-29, Sept. 16, 2011, sec. 3; 125 STAT. 285-287.*

2. *Public Law 112-29, Sept. 16, 2011, sec. 3; 125 STAT. 285.*

3. *77 Fed. Reg. 43742-43759, July 26, 2012.*

4. *77 Fed. Reg. 43755, July 26, 2012.*

5. *EPC Rule 53(3); EPO Guidelines for Examination, F-VI,3.4.*

6. *77 Fed. Reg. 43756, July 26, 2012.*

7. *effect discussed in In re Giacomini, CAFC 2009-14 July 27, 2010 and in Ex Parte Yamaguchi, USPTO Appeal 2007-4412, August 29, 2008.*

8. *77 Fed. Reg. 43759, July 26, 2012.*

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