

From:
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Subject: WARF Provisional Comments USPTO

**Before the
United States Patent and Trademark Office
U.S. Department of Commerce
Washington, DC**

In the Matter of)

REQUEST FOR COMMENTS)
ON PROPOSED CHANGE TO)
MISSING PARTS PRACTICE)

Docket No.: PTO-P-2010-0029

COMMENTS OF WISCONSIN ALUMNI RESEARCH FOUNDATION

On March 29, 2010, the United States Patent and Trademark Office, U.S. Department of Commerce (“USPTO”), through a Federal Register notice, issued a Request for Comments (“RFC”) seeking public comments on a change to the Missing Parts Practice that would effectively provide an extended 12-month period to pay examination and search fees for non-provisional applications that meet certain criteria. 75 Fed. Reg. 16750 (April 2, 2010). The Wisconsin Alumni Research Foundation (“WARF”) hereby avails itself of the opportunity to submit comments.

I. About WARF

Created in 1925, WARF was the first university patent licensing organization in the world. Dr. Harry Steenbock, a UW-Madison scientist who discovered a cure for rickets, obtained a patent and licensed it broadly to the private sector. This partnership eradicated rickets not only in this country but worldwide. This early success, replicated many times, is based upon a strong patent system that provides incentives for innovation. The formula of moving ideas from the lab bench to the private sector for development creates jobs, benefits the American economy and contributes to the health and welfare of the world. Today, WARF has almost 85

years of marketplace experience in commercializing the fruits of university research, including the commercialization of early-stage technologies.

II. Comments

WARF sincerely appreciates the USPTO's ongoing efforts to improve the efficiency and effectiveness of the patent application process. As a successful university technology transfer organization, WARF appreciates that one of the goals of the proposed changes to the Missing Parts Practice is to enable applicants to spend up to an additional 12 months exploring the commercial viability of their technologies. Certainly it would be helpful, in some cases, to be able to delay paying approximately 80% of the filing fees for up to a year (without costly monthly extension fees) to facilitate a more detailed economic analysis, if the applicant can accept the accompanying loss of Patent Term Adjustment ("PTA"). It also seems likely that the USPTO could benefit both financially, through upfront-paid basic filing fees for each non-provisional application filed in the program, and in terms of workload reduction as a result of the removal from the examination queue of applications that applicants are no longer interested in pursuing.

A primary drawback to the current proposal is the applicants' loss of up to 9 months of PTA; this trade-off would be difficult to justify for many technologies and applicants. The proposal would be better, and benefit applicants far more, if PTA were not lost during the extensions for submitting the remaining filing fees. Because the rule change is designed to allow publication to proceed as usual, the delay in paying fees will rarely, if ever, delay the progress of the application through the USPTO for the relevant patent applications.

WARF would also welcome the option of requesting an international-style search report during the 12-month extended missing parts period. Please note, however, that it would be

critical for technology transfer organizations that utilize federal funding to receive the search report well in advance of the 60-day notice (prior to abandonment) that applicants must give federal funding agencies, should the applicant choose not to pursue patent protection. Therefore, receiving the search report within 7-9 months of filing the non-provisional application is critical, in order for applicants to utilize the enhanced feedback.

A common misunderstanding may exist in the field about the nature of this rule change, based on the Federal Register statement that the changes “would effectively provide a 12-month extension to the 12-month provisional application period (creating a net 24-month period)” (75 Fed. Reg. at 16750) with the result that some have described this as a “2-year provisional”. In fact, it would be better if the rule changes instituted a true 2-year provisional application process. While applicants would still need to act within 12 months for purposes of international filings, the opportunity to wait an additional year before filing a U.S. non-provisional application would be extremely valuable for applicants, as the additional time could advance the developmental stage of inventions appearing in the application (thereby advancing the value of the full disclosure and its public benefit), and ultimately improve the quality of both the applications and the resulting patents.

In summary, the proposed changes represent a potential benefit to applicants that may prove useful for specific cases in which the economic viability of the technology is uncertain and the applicant is willing and able to accept the accompanying loss of PTA. However, the benefit would be greatly increased if rules were further changed so that the fee extension would not cost applicants PTA, and if a true “2-year provisional application” was available.

CONCLUSION

In closing, WARF commends the USPTO for its leadership on a somewhat arcane, but nonetheless important, subject. WARF is very interested in and supportive of the proposed changes to Missing Parts Practice. In this regard, WARF looks forward to working with the USPTO on the resolution of issues identified in this matter.

Respectfully yours,



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