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From: David Ream

Sent: Tuesday, April 19, 2005 11:55 AM

To: AB85 Comments

Subject: Re proposed changes to 37 CFR 1.78(a)(5)

I agree that filing an English language translation in the provisional application is a good idea.

However, I suggest that the Applicant should be allowed to file the translation in the provisional *after* a nonprovisional application is filed, for example more than one year from the filing date of the provisional application, perhaps 15 months from the provisional filing date. There is no need to file the translation during the pendency of the provisional application (i.e. within one year of the provisional filing date), because the non-provisional application would be not be available to the public until at least 18 months from the provisional filing date. In addition, filing a translation of the provisional prior to or with the nonprovisional can be a significant burden to the Applicant. For example, in a situation where the US PTO requires a translation before the Applicant has decided whether the invention is commercially viable and/or worth pursuing with a nonprovisional application, the Applicant must incur the often substantial expense of translation. There can also be significant burden to the Applicant in a situation where the Applicant reaches a decision to pursue a non-provisional application shortly before the anniversary of the provisional filing date, and obtaining a translation is extremely expensive or impossible because there is too little time. In addition, there will be increased burden to the US PTO. For example, in a situation where the US PTO requires an English translation of the provisional application and the applicant later decides to not to file a nonprovisional application, the US PTO's efforts in processing, scanning and archiving the English translation are for naught.

In addition, I suggest that there *not* be a requirement for the Applicant to file a statement in each nonprovisional, that a (verified) English language translation of the provisional application has been filed in the provisional application. The Federal Register notice asserts that one object of the proposed rule change is to reduce the burden on the Applicant, so the Applicant will not "incur substantial expense for having to file a copy in each nonprovisional application". However, the burden on the Applicant to file the statement in each nonprovisional application, will not be significantly different from the burden of filing an English language translation of the provisional in each nonprovisional application. I think the best way to deal with this

is to send a notice in the provisional application (e.g., near 14 months from the provisional filing date) that a verified English language translation is required if the Applicant intends to rely on the provisional application and the translation has not already been filed. The priority claim information in the nonprovisional application to the provisional application will provide sufficient notice to both the public and the Examiner where to look for an English translation of the provisional application (i.e., in IFW under the provisional application number).

Thank you for considering my remarks.

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