

AMERICAN BAR ASSOCIATION
SECTION OF INTELLECTUAL PROPERTY LAW
Comments on Proposed Rule Regarding the Treatment of Unlocatable
Application and Patent Files
Federal Register Notice Monday, July 10, 2000
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1. The Notice of Proposed Rulemaking states that when an application or patent file cannot be located after a reasonable search and the application or patent file is necessary to conduct business before the Office, the Office will reconstruct the application or patent file. Reconstruction, however, is important for reasons other than business before the Office. Third parties require access to application files to conduct a proper claim construction analysis for an infringement or validity study. Lost files frustrate the public notice function provided by the patent and its prosecution history. Accordingly, the Section supports the Office's efforts to promptly reconstruct lost files.
2. The proposed Rule does not set a time limit within which the applicant is to comply with the request to reconstruct the file. Nor does the proposed Rule indicate whether the time period may be extended. The Section recommends that the request to reconstruct be treated the same as an Office action, i.e., three months should be given to respond to the request and fee extensions of up to three additional months should be permitted. In addition, a provision should be added to permit revival of an application for unintentional abandonment at no cost to applicant, as the cost should be absorbed by the Office.
3. The proposed Rule requires an applicant or patentee to provide a copy (or produce its own record for the Office to copy) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding. This Rule should be clarified, however, to limit the correspondence to only those papers available to the public if the patent had issued, i.e., all formal correspondence with the Office. Thus, proposed claim amendments which were sent to the Examiner for consideration on an informal basis need not be provided. In addition, for an information disclosure statement, it should not be necessary to produce copies of patents or patent publications from the U.S. or foreign offices since these are readily available from other sources.
4. The proposed Rule requires the patentee or applicant to provide a statement that the copy provided is complete and accurate. The Rule should permit, however, the patentee or applicant to state that the copy provided is complete and accurate to the best of that individual's knowledge and belief, upon reasonable investigation.
5. For purposes of patent term adjustment, all of the time to reconstruct the file should be charged against the Office.

6. The Notice states that attempts to reconstruct will be conducted after the Office makes a Reasonable search. In order to promptly begin reconstructing the file, a time limit should be established for the reasonable search, e.g., three months.