

August 23, 2000

The Honorable Q. Todd Dickinson
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Box Comments -- Patents
Washington, D.C. 20231

Attn: Robert W. Bahr

Re: AIPLA Comments on the Notice of Proposed Rulemaking Entitled
“Treatment of Unlocatable Application and Patent Files”
65 Fed. Reg. 42309 (July 10, 2000)

Dear Under Secretary Dickinson:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the notice of proposed rulemaking entitled “Treatment of Unlocatable Application and Patent Files,” published in the *Federal Register* on July 10, 2000.

The AIPLA is a national bar association of more than 10,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The proposed new § 1.251 deals with the United States Patent and Trademark Office (USPTO) obtaining from a patent applicant or patentee copies of papers from a patent application or patent file that the Office cannot locate. While this course of action is necessary sometimes, the AIPLA wants to assure that the USPTO recognizes that a requirement from the Office to provide copies of papers to replace a misplaced patent application or patent file can be a substantial burden on patent applicants or patentees. The proposed § 1.251(b) indicates that the burden will be placed on the patent applicant or patentee if the Office cannot locate the file “after a reasonable search.” The rulemaking does not state what would constitute a reasonable search, which causes concern that the USPTO might lessen its efforts to look for lost files, and to shift the burden to patent applicants and patentees through the requirement made under the proposed

rule. In addition, once a patent applicant or patentee has been required to provide a copy of a patent application or patent file, special care should be taken to ensure that a subsequent request will not need to be made with respect to that same file.

The burden is increased by the requirement in the proposed rule for a patent applicant or patentee to provide a list of all correspondence with the Office for the patent application, patent, or other proceeding. This proposed requirement seems unnecessary, especially since the USPTO's computerized patent application monitoring system (PALM) contains a list of the papers in the patent application or patent file wrapper. Rather than requiring patent applicants or patentees to prepare a list, the USPTO should include a printout of the record of the correspondence in PALM with any requirement under the proposed rule to provide copies of such correspondence. The PALM printout would be useful to patent applicants and patentees in searching their files for copies of correspondence. The printout would also be useful to patent applicants and patentees in deciding whether they can make the statement required by the proposed rule as to whether a complete copy of the correspondence is being submitted.

Section 1.251 (b)(1) of the proposed rule requires patent applicants or patentees to state that the copy they are providing is a "complete and accurate copy of the correspondence" between the Office and the patent applicant or patentee. They may not be able to make this statement with total assurance. This part of the proposed rule should be modified to accept a statement from patent applicants or patentees that the copy being provided is a complete and accurate copy of the correspondence "as contained in the file" of the patent applicant or the patentee.

Section 1.251 (b)(2) of the proposed rule requires patent applicants or patentees to make a similar statement that "the copy is a complete and accurate copy of the correspondence" when in fact what is being furnished to the Office is their "record" and not a copy. The copy is made by the Office. The analysis in the Discussion of the Specific Rule part of the notice more accurately reflects that the statement addresses the "papers" submitted. This part of the proposed rule should also be modified to accept a statement that what is being provided is the complete record of correspondence as contained in the file of the patent applicant or the patentee.

The proposed rule indicates that the USPTO will set a time period within which the applicant or patentee must comply with the requirement to provide copies of correspondence. The proposed rule does not specify what that time period might be, but it is hoped that the USPTO recognizes patent applicants and patentees will often need time to gather copies of the correspondence which the Office has misplaced. The USPTO should set a three-month period with the possibility of extensions of time with fee under 37 C.F.R. § 1.136(a). Many patent applicants and patentees will desire to respond in a shorter period of time, and they will do so. However, those patents applicants and patentees, who need more time to respond, should not be penalized or put to undue expense as a result of the USPTO's failure to keep track of its files.

We appreciate the opportunity to provide comments on the specific topics under consideration by the USPTO. We look forward to working with the Office as it implements the American Inventors Protection Act in ways that will best serve the patent system while minimizing the burdens on the USPTO as well as patent applicants, patentees, and their representatives.

Sincerely,

Michael K. Kirk
Executive Director