

COMMENTS OF THE SECTION OF INTELLECTUAL
PROPERTY LAW OF THE AMERICAN BAR ASSOCIATION ON
CHANGES TO IMPLEMENT EIGHTEEN-MONTH
PUBLICATION OF PATENT APPLICATIONS

1. Proposed ' 1.85 requires that a utility or plant application "not be placed on the files for examination until objections to the drawings have been corrected." The Office is reviving an old practice of having formal drawings in place prior to the examination of the application. The Section disagrees with this costly proposal, particularly in view of the unnecessary financial burden it places on individual inventors and small companies.

The Section opposes a strict formal drawing standard for publication purposes. Reasonably good quality drawings (with margins) to facilitate clear reproduction should be sufficient. There is a built-in incentive for applicants to provide formal drawings (or close to formal), since any problems with the published applications may impact on the applicant=s ability to obtain provisional rights.

The proposed rule appears to conflict with the PTO=s plan in the Proposed Rules to Implement the Patent Business Goals (see 64 Fed. Reg. 53772 (October 4, 1999)), which discussed limiting the requirements for formal drawings. The proposed rules at that time had suggested eliminating paragraphs (d), (h), (i), (j), (k)(1) and (3), (m), (n), (p), (r), (s) and (x) of Section 1.84, as Anot necessary for the reproduction of drawings.@ If the PTO now feels that Aformal drawings@ are necessary for the published applications, they should reduce the formal requirements of Section 1.84 as previously suggested.

In addition, since the drawings need not be in place until publication at 18 months, suitable drawings should not be required until, for example, 14 months from the earliest priority date claimed. Since the Office is using a copy of the application (including the drawings) from the PACR database to create the patent application publication, it is not clear why examination of the application cannot simultaneously proceed.

2. Proposed ' 1.85 also states that objections to the drawings in a utility or plant application "will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action." Proposed ' 1.85 also states, however, that the patent application publication will not include drawings filed after the application has been placed on the files for examination. Accordingly, it is not clear why drawing objections by the examiner need to be corrected immediately by the applicant. Awaiting receipt of the Notice of Allowance before preparing formal drawings saves time and money and should not delay issuance of the patent.
3. It is important for applicants to receive notification of the publication date of applications so that any necessary actions required to protect additional patent rights (e.g. foreign filings) can be completed prior to publication. In addition, it is important for applicants to receive confirmation of nonpublication of applications so that action can be taken, if necessary, to prevent inadvertent or

erroneous publication. In this regard, the Section strongly approves the Office's plans to indicate a projected publication date on the filing receipt and to provide a change notification indicating revised projected publication dates (See Federal Register, Vol. 65, No. 66, p. 17950, 3d col).

In furtherance of the Office's plans, the Section believes it is important to also include a confirmation of nonpublication on the filing receipt when the application is filed with a nonpublication request in compliance with proposed ' 1.213(a). In addition, change notifications of nonpublications should be issued in the event of express abandonment pursuant to proposed ' 1.138 or in the event of a determination that the application is no longer pending pursuant to proposed ' 1.211(a)(1). In addition, the Office states that "if events change the projected publication date by more than two weeks . . . the Office will issue a change notification indicating the revised projected publication date." The Section believes that if the publication date is changed at all, and especially if the publication date is earlier than initially projected, the applicant should be immediately notified of the new publication date.

4. Proposed ' 1.215(c) states that at applicant's option, the patent application publication will be based upon the copy of the application as amended during examination, provided that applicant supplies such a copy "in compliance with the Office electronic filing system requirements." The Section believes that the Office's requirement to use the Office's electronic filing system (EFS) in order to obtain publication of amendments is inappropriate and onerous. Indeed, the Office recognizes that its EFS pilot program may not be ready by November 29, 2000, the effective date of the patent application publication provisions. One firm currently using the pilot program has commented that it requires substantial effort by in-house IS department personnel as well as attorney time and effort. Another practitioner has commented that experience with the PTO=s new system for filing applications containing DNA/RNA sequences poses similar problems and did not provide a Achecker@ feature to allow one to ascertain if there was any problem with the sequence before it went to the PTO. These experiences teach that such programs should not be implemented on a widescale basis prematurely because they can lead to major problems which are ultimately paid for by the applicants.

Applicants should not be required to use the EFS software package until such time as EFS is fully capable and widely used. The Office is not paperless yet and it would be an unfair burden on many to only permit those who are EFS capable to benefit from ' 1.215(c). In the meantime, the Office should prepare a rule permitting submission by paper of copies of applications for applicants requesting: (1) a patent application publication reflecting amendments to the application; (2) voluntary publication of an application; (3) republication of a previously published application; or (4) publication of only a redacted copy of an application.

5. Proposed ' 1.217(e) provides that the certificate of mailing or transmission procedure set forth in provisions of ' 1.8 do not apply to the time period set forth in ' 1.217 regarding the publication of a redacted copy of an application. The Section is opposed to this limitation on an applicant's method of delivery of a redacted copy to the Office. Applicants should be given the benefit of the filing date as of the date of mailing by first class mail. Although the PTO=s receipt of the redacted copy will be delayed a day or two (compared to Express Mail), this does not warrant the limitation.

6. The Office states that the publication process involves producing weekly volumes of patent application publications on a variety of media: e.g., the Office's Examiner Automated Search Tool (EAST) and Web-based Examiner Search Tool (WEST) search systems, optical disc products for sale to the public, and exchange with the Office's intellectual property exchange partners. The Section urges the PTO to also place all such publications on the Office web site so that such publications will be as readily available as issued U.S. Patents.

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