

May 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  
"Changes to Implement 18-Month Publication of Patent Applications"  
65 Fed. Reg. 17946 (April 5, 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 "Changes to Implement Eighteen-Month Publication of Patent Applications," published in the *Federal Register* on April 5, 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.

Overall, the United States Patent and Trademark Office (USPTO) has done an excellent job in proposing regulations for this significant change in patent practice in the United States. The proposed regulations rely to a significant extent on the implementation of an electronic filing system in the USPTO. Applicants who desire to voluntarily publish applications pending on or after May 29, 2000, and those who want to publish or republish an amended application or publish an application earlier than 18 months from filing are required to submit the application via the electronic filing system to take advantage of these opportunities. The AIPLA is concerned that these opportunities for publication of patent applications be available to the entire spectrum of the inventor and patent community. The current state of development of the USPTO's electronic filing system and the heavy reliance placed on this system for a variety of optional procedures jeopardizes, at this time, prompt access to these opportunities for a significant population of customers without the resources to participate. The AIPLA believes that the Office should provide an option, at least in the initial years of implementation of its electronic filing system, to obtain these optional publication opportunities by filing a paper copy in a format designated by the USPTO together with a fee sufficient to cover the expenses of converting the paper copy to an electronic form suitable for publication. The requirement to submit an application for voluntary publication only by the electronic filing

system should not be made mandatory until the Office has demonstrated that its electronic filing system is fully functional.

In this regard, the AIPLA encourages the USPTO to involve a wide spectrum of the user community in developing an appropriate electronic filing system. The electronic filing system should rely, to the maximum extent possible, on standard, off-the-shelf tools and systems that will be readily available and usable by the entire inventor and patent community. The AIPLA is willing to assist the USPTO in developing a user friendly system that will make the patent application publication opportunities accessible to all who want to take advantage of the new procedures.

The following comments are offered on specific rules proposed by the PTO:

In proposed Rules 1.14(c)(1) and (2) and (e), it should be made clear that an application incorporated into, or referred to by an application that is published in accordance with 35 U.S.C. 122(b) "will be" available to the public in accordance with the procedures adopted by the USPTO. Similarly, the Rules should provide that the file wrapper of such an application "will be" provided under such procedures as well. It is not clear why these proposed rules state that such applications and file wrappers "may be" provided, when it does not appear that access is discretionary when the appropriate conditions are met. Compare the language in Rules 1.13(a) and 1.13(i) that provides that copies "will be" furnished.

The proposed changes to Rules 1.52(d) and 1.78(a)(5) are a very positive development. These will permit an applicant who has filed a provisional application in a language other than English to postpone submitting a translation in the English language until the later of 4 months from the filing date of a nonprovisional application (that claims the benefit of the provisional application) or 16 months from the date of the provisional application. These changes will permit some applicants to postpone the costs of translation of provisional applications that are relied on for an earlier filing date in a nonprovisional application. The USPTO should clarify, however, whether the translation should be directed to the provisional application file or the nonprovisional application(s) claiming benefit of the provisional application.

Proposed Rules 1.55 and 1.78 provide that claims for the benefit of an earlier foreign or domestic filing date must be made in an application within the later of four months from the actual filing date of the later application or sixteen months from the filing date of the earlier application, or the claim will be considered waived. While we note that a deadline is necessary to ensure publication in eighteen months, the PTO has indicated that the publication cycle for applications is currently 14 weeks. 65 Fed. Reg. at 17950. This means that the public cannot rely on an application being published earlier than 20 months from the priority date - 16 months to claim the benefit and about 4 months for the publication process. We believe that all applications that are going to be published in the United States should generally be published at 18 months in order to reliably inform the public as to the status of potential patent claims of US applications having foreign counterparts which the public may have seen published abroad. While we

believe that a publication cycle of four months is entirely too long and would urge the USPTO to shorten it as soon as possible, we also believe that the deadline for claiming priority should reflect that reality so that applications are generally published at 18 months.

In proposed Rule 1.72(a), the USPTO indicates that the title can only include characters capable of being created by a keyboard. If the Office has a particular keyboard or character set in mind, it should be identified in the rule. Otherwise, the meaning of the requirement is unclear.

Under proposed Rule 1.78(a)(2), if an application claims the benefit of an international application, the first sentence of the application must include an indication of whether the international application was published in English. It is not clear from either the proposed rule or the commentary associated with the proposed rules whether this requirement is applicable to international applications filed before November 29, 2000. Clarification is requested.

The requirement in Rule 1.85 for drawings which comply with Rule 1.84 and the inability to request that drawing revisions be held in abeyance until allowable subject matter is indicated by the examiner will pose a significant burden on applicants and practitioners. The presentation of drawings which meet all of the requirements of Rule 1.84 takes time, and will raise the up-front costs of patent prosecution. Further, changes to the drawings may be required during the course of the examination process. The USPTO should be sensitive to these concerns and realities of patent prosecution and accept drawings that meet the minimum standards for publication.

Under proposed Rule 1.98(a)(2)(iii), the USPTO is requiring that a copy of each cited pending application be submitted with an information disclosure statement. The AIPLA continues to believe that a copy of a pending patent application should not be required as a component part of an information disclosure statement, particularly since the USPTO is now capturing in electronic form applications as filed and is moving in the direction of electronic filing. Applications will be readily available to examiners in electronic form in the near future, so the adoption of a requirement for a paper copy is a move in the wrong direction. The USPTO is requested to reconsider this proposal.

Under proposed Rule 1.99, the public is permitted to submit information that could be used during the examination of a patent application. We question whether this is consistent with new section 122 ( c ) which instructs the Director to ensure that no protest or opposition can be initiated after publication without the express written consent of the applicant. The AIPLA suggests that no communication to an examiner, written or oral, should be made by a third party between application publication and patent grant. If a third party knows or learns of relevant information following publication, there is no reason why they could not submit such information directly to the patent applicant for appropriate disposition consonant with applicant's duty of disclosure. Alternatively, after the patent is granted, the applicant could submit the information to the Office under Rule 1.501. Accordingly, we would delete proposed Rule 1.99.

It is not clear why the proposed change to Rule 1.132 is necessary or desirable. The amendment would provide that no oath or declaration could be submitted under Rule 1.132 to traverse a rejection if the rejection is based on a patent or application to another that claims the same patentable invention. Consider an applicant replying to a same-invention double patenting rejection applied to claims directed to an alloy. The alloy is defined in the patent and application in different terms. Why should the applicant be precluded from making a factual showing under Rule 1.132 that the claimed alloys are identical, even if the claims are directed to the same patentable invention? Consider further where an examiner makes an obviousness rejection over a patent to another, but owned by the same entity as the application. Applicants should be able to make a factual showing under Rule 1.132 to support a nonobviousness argument.

Under proposed Rule 1.215(a), the USPTO will publish an application based on the papers deposited on the filing date. This raises the question as to how a Continued Prosecution Application (CPA) filed under Rule 1.53(d) will be treated. We believe that the claims in the application as filed in a CPA and as they existed at the termination of prosecution could be provided by the applicant in a prescribed form and published by the Office. The more focused claims in an application at this stage of prosecution will make it much more likely that an applicant will be able to enjoy provisional rights under new section 154 (d).

In proposed Rule 1.221(a), the USPTO has proposed to refund the publication fee and not publish the application where a request for voluntary publication has been filed, but the request does not meet all the requirements. Rather than refunding the fee, the USPTO should consider sending a notice to the applicant who has requested voluntary publication, pointing out the defects in the request, and providing an opportunity for applicant to correct them.

Finally, in proposed Rule 1.417, submissions of an international publication or an English language translation of an international application to trigger the provisional rights provisions of 35 U.S.C. 154(d)(4) are to be sent to "Box PCT." The USPTO should consider setting up a separate box for these submissions to reduce the possibility that these papers will be commingled with other PCT papers. Further, the Office is requested to provide information on how these papers will be processed, and how a member of the public can confirm the date these papers were received.

The AIPLA appreciates the opportunity to provide comments on the specific proposals under consideration by the USPTO. We look forward to working with the Office to implement the 18-month publication provisions of the statute in ways that will benefit applicants and their representatives and not unnecessarily burden the Office.

Sincerely,

Michael K. Kirk  
Executive Director  
American Intellectual Property Law Association