

COMMENTS TO PUBLICATION PROPOSED RULE CHANGES

REQUIREMENT TO USE ELECTRONIC FILING SYSTEM FOR CERTAIN APPLICATIONS

While it is a desirable goal to request that publication be conducted by EFS, the Patent Office itself is not willing to guarantee that this system will be fully operational in time for implementing the new publication of applications. Accordingly, to mandate its use only for re-publications, redacted publications and voluntary publications is particularly troubling. These three categories of publications are sure to be among the most difficult to obtain accurate computer database copies for smooth conversion under the EFS software for electronic submission. Many of the redacted applications will come from foreign priority applications, the majority of which will not be available to the U.S. practitioner in acceptable electronic format. To the extent compliance with EFS will require obtaining a computer readable file copy of an application which may no longer be available or which, if available is in a differing computer format, the conversion of such an application to EFS format is likely to work a significant prejudice upon foreign applicants seeking to take advantage of redacted publication. There is no justification for accepting original filings of applications in scannable format for standard publication and requiring EFS initially for redacted publications.

Further, the same applies for voluntary publication. Many original and pending applications including those which may have been derived from patent applications written in prior years on earlier versions of most computer software, are unlikely to be easily convertible to current available software for use in preparation of an EFS-ready copy. Since statutory rights are at issue (both with respect to the ability under the new statutes to file redacted applications and the ability to seek provisional rights based on voluntarily published applications), the burden on applicants to use EFS for voluntary publications is not justified. Further, it is very likely that converted applications (from prior software versions to current software versions) which are then translated into EFS format will be subject to a high risk of software translation error in comparison with merely scanning the applications in the same manner as the PTO will be scanning originally filed applications.

Since each of the types of applications for which EFS will be required is statutorily provided for, the PTO should not be able to require an additional burden for redacted, voluntarily published and re-published applications which is not also required of other originally filed applications that will simply be imaged. Provided the paper, margin and drawing requirements are met, republications, redacted publications and voluntary publications should be subject to the same requirements as original publications, i.e., electronic scanning of the paper copy, until EFS is running successfully and in use for all applications. This is particularly true where the PTO has not yet guaranteed that EFS will be available.

USE OF REVIVAL PROVISIONS FOR PRIORITY CLAIM TIME LIMIT

There is a strong interest in having the priority claim available as well as having the application in printable format for publication purposes. However, the penalty attached for late submission of a priority claim (including filing of a certified copy of a foreign application which is many times at the hands of the efficiency of a foreign Patent Office) is far too onerous. The statute provides that a priority claim may be made at any time while an application is pending and that the Director may set time limits. However, while putting a time limit on the filing of the claim is a laudable goal for informing the public, the penalty fee of \$1210.00 is totally unnecessary and works a hardship on small entities. If drawings or other paper requirements are late, the publication is merely delayed with the attendant ramifications associated with late publication with respect to public notice and provisional rights. However, the late submission of priority information initiates a \$1210.00 penalty, which is wholly inconsistent.

Less onerous late penalties are easily available as alternatives. For example, the PTO could charge a late submission fee (in the manner of a late-filed IDS) or to require republication of the application with the correct priority information at the expense of the applicant (that is, a further \$300.00 publication fee). In addition, a further alternative would be a provision for publication of only bibliographic information including the new priority claim (if filed late) with a lesser publication fee and/or a late priority submission fee and then attachment of publication of the bibliographic information to the electronic file of the earlier published application document in the manner that European applications are published with the attached Search Report. Finally, the same option available for late drawings is available for a late priority claim -- refusal to publish until the priority claim is submitted.

Since there are other alternatives (such as those mentioned above) for encouraging timely submission of a priority claim, the penalty currently proposed is unduly and unjustifiably not commensurate in scope with the late submission of a priority claim. Further, since other requirements necessary to publication (such as drawings and the like) may be merely submitted late with a delayed publication, the large fee and/or waiver of the priority claim works a significant disadvantage to individuals and small entities in view of the large nature of the fee required to reinstate the priority claim.

MARTIN G. BELISARIO

Registration No. 32,886

PATENT DEPARTMENT HEAD

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103

Telephone: (215) 965-1200 **Direct: (215) 965-1303**

Facsimile: (215) 965-1210

E-mail: mbelisario@akingump.com