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To: AB71 Comments
Subject: Revision of Patent Term Extension etc.

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MESSAGE:

Attention: Kerry A. Fries
Legal Advisor
Office of Patent Legal Administration

Re: Comments on November 24, 2003 Notice of Proposed Rulemaking:
Revision of Patent Term Extension and Patent Term Adjustment Provisions Related to Decisions by the Board of Patent Appeals and Interferences

The proposed rulemaking is a good first step toward eliminating some of the inequities that arise under the PTE/PTA rules. However, I believe that in one aspect it needlessly creates a new inequity. To avoid this new inequity, I suggest that proposed rules 701(a)(3) and 702(e) be revised by changing "other action by the applicant," in each rule to --other action by the applicant other than the filing of an Information Disclosure Statement in compliance with section 1.97(d),--.

As correctly noted in the commentary of the proposed rulemaking, a remand is often the equivalent of a reversal. However, in the months (or sometimes years) that pass during the appeal process, other prior art that may be material often comes to the attention of applicants at a time that would have been post-issuance had the appeal not been needed to overcome an improper rejection. For example, foreign counterpart applications are often examined, and new references cited in foreign search reports, during the pendency of an appeal. If the subject patent had already issued, the patentee would not have had to take any action with respect to this new prior art. However, due to the delay inherent in the appeal, Rule 56 requires the applicant to cite the new prior art in an Information Disclosure Statement.

In such circumstances, the remand is still effectively a reversal. In substantially no case is an Information Disclosure Statement filed to overcome issues raised in a remand -- the Information Disclosure Statement is entirely independent of the appeal. There is no reason that applicants should be compelled to forfeit months or years of patent term extension merely because they must continue to comply with Rule 56 as a result of the Patent Office's delay.

In addition, as a matter of public policy, applicants should not be put into a position of being penalized for complying with Rule 56. Such imposition of a penalty, not caused by any delay by applicants or by issues left open because of remand, may cause applicants to try to more narrowly construe the Rule 56 duty to try to avoid that penalty, resulting in patents of more questionable validity and increased litigation of inequitable conduct issues. Patent Office rules should be promulgated to avoid, not engender, such problems.

The modification proposed above avoids these problems, while still being narrowly tailored by requiring compliance with Rule 97(d). Thus I respectfully request that it be seriously considered.

Respectfully submitted,

William P. Berridge
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