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To: AB71 Comments
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Stoll, Robert
Subject: PTO 12/4/03 Requested Comments on Patent Term Rules 701 & 2

I would like to add my "second" to the prior-submitted public comment of my esteemed outside counsel reproduced below.

I would also like to note by way of legislative history activity personal knowledge that the present (unfortunately complex) patent term provisions were a necessary legislative compromise for obtaining passage of the 1999 AIPA legislation. Especially, obtaining support for that legislation from a certain previously-opposing California Congressman and his staff who were legitimately concerned that patent owners not be punished by patent term loss for any PTO application prosecution delays by patent terms running 20 years from original filing dates (including the then-lengthy Board delays). They wanted absolute assurance that the public would obtain not less than the previous (17 years from issue) patent term under ANY circumstances. The latter is clearly part of the legislative history.

Substantially reducing a patent term under the AIPA by depriving applicants of any term extension protection from an ENTIRE Board review period, when there has been a de facto applicant claim allowance success on appeal, merely due to necessary further prompt Rule 56 disclosure, or formalities corrections by applicants, which are not allowed during appeals, and/or which were not even known to be needed before the appeal was remanded, would appear to be clearly contrary to the intent of the patent term statute, and could lead to unnecessary litigation.

Thus, I respectfully suggest consideration of proposed rules 701(a)(3) and 702(e) being slightly revised to change "other action by the applicant," in each said rule to:

--other action by the applicant, other than the filing, within 30 days after a Board remand, of a supplemental Information Disclosure Statement in compliance with Section 1.97 and/or an amendment correction of formalities necessitated or suggested by the Board remand decision itself--.

Thank you,

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