

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

October 5, 2001

Mr. Nicholas Godici
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Box Comments
Washington, D.C. 20231

Re.: AIPLA Comments on the Notice of Proposed Rulemaking Entitled "Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications" 66 Fed. Reg. 46409 (September 5, 2001)

Dear Acting Under Secretary Godici:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the Notice of Proposed Rulemaking entitled "Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications", published in the *Federal Register* on September 5, 2001.

The AIPLA is a national bar association of more than 13,000 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.

The AIPLA recognizes that this proposal is intended to clarify the practice for claiming benefit under 35 U.S.C. §§ 119(e) and 120 as amended by § 4503(b) of the American Inventors Protection Act of 1999 (AIPA). However, AIPLA believes that several points should be addressed in the final rule package.

At the outset, we would note that the requirements for claiming benefit within the 4/16 month limits are for implementing the 18-month publication requirements of AIPA. Therefore, those limits should only apply to applications filed on or after November 29, 2000. However, proposed § 1.78(a)(2)(ii) would apply to applications filed prior to November 29, 2000. Accordingly, it is suggested that proposed § 1.78(a)(2)(ii) be amended to make it clear that there is no waiver of benefit for failure to comply with the 4/16 month reference requirements of § 1.78(a)(2)(ii) in cases filed prior to November 29, 2000.

In the commentary on proposed § 1.78(a)(3) in the section of the Notice entitled “Discussion of Specific Rules” (in the paragraph bridging columns 1 and 2 of page 46411) it is stated that if the USPTO recognizes a claim for benefit “elsewhere in the application ... not in the manner specified in § 1.78(a)(2)(i) ... [but] within the time period set forth in § 1.78(a)(2)(ii)”, no petition to correct the claim will be required. AIPLA endorses this concept and suggests that proposed § 1.78(a)(2)(ii) be amended to clarify that if the benefit claim is recognized by the USPTO and appears in the published patent application, then the requirements of §§ 1.78(a)(2)(i) and (ii) have been satisfied and benefit is not waived.

AIPLA also believes that it is in the public interest to have a reference to any benefit claim included in the first paragraph of the published patent application. Therefore, the USPTO should take all steps necessary to ensure that, if an applicant has complied with the requirements of proposed § 1.78(a)(2)(iii), the reference will be included in the first paragraph of the published patent application. In this regard, if the reference is properly submitted, but is not included in the published patent application, or if a petition to correct a claim under § 1.78(a)(3) is granted, the USPTO should provide some mechanism to associate this benefit claim with the published patent application so that one can become aware of the claim without the need to inspect the application file.

Because the consequences of an applicant’s uncorrectable failure to comply with proposed § 1.78 could be the loss of valuable rights, AIPLA believes it is imperative that the rule provide applicants with great flexibility for claiming the benefit of an earlier filing date. Accordingly, AIPLA believes § 1.78(a)(2)(iii) should further be amended to permit the reference required by § 1.78(a)(2)(ii) to be included in the declaration. USPTO employees are familiar with checking the declaration for formal requirements and having them check for a priority claim in that document would not be a significant burden for the USPTO. Moreover, AIPLA believes that it should be clearly set forth in the rule that, if the requirements of proposed § 1.78(a)(2)(iii) amended as suggested have been met, the applicant would not be considered to have waived the benefit irrespective of whether the reference is included in the published patent application.

With respect to the mechanism in proposed § 1.78(a)(3) for correcting an error in claiming benefit, we would like to suggest that the USPTO also consider expanding this mechanism to correct a defective priority claim in a PCT application. We have in mind a PCT application designating the United States that is permitted to go abandoned before it enters the U.S. national stage in favor of a continuing application. If, for example, an applicant filed a provisional application, then a PCT application in which reference to the provisional application was inadvertently omitted, and then allowed the PCT application to go abandoned after filing a continuing application, consideration should be given to some mechanism that would allow applicants to restore priority. This consideration should cover both the situation where the PCT application is filed in the U.S Receiving Office and where it is filed in a non-U.S. receiving office.

Finally, AIPLA appreciates the USPTO's proposal to eliminate the requirement that an English language translation of a provisional application, filed in a language other than English, be filed within the 4/16 month time period in order to avoid waiver of a § 119(e) benefit claim for a provisional application. However, in doing so, if the USPTO fails to issue a notice requiring an English translation, voluntary submission is unlikely since it is not required. In such case, the public will be disadvantaged when the patent application publication is cited as § 102(e) prior art. In the absence of a USPTO notice, such a change would transfer the burden to obtain a translation from the applicant claiming benefit to the applicant against whom the patent application publication is cited. AIPLA believes that the burden of providing the translation should remain with the party making the claim for benefit.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk
Executive Director