

October 5, 2001

Commissioner for Patents  
Box Comments – Patents  
Washington D.C. 20231

Attn: Robert A. Clarke

RE: Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications 66 Fed. Reg. 46409 (September 5, 2001)

Dear Mr. Clarke:

The following is offered in response to the call for comments regarding the requirements for claiming the benefit of a prior-filed application under the new 18-month publication of patent application provision of the American Inventors Protection Act of 1999 (AIPA).

The Office has proposed revisions to the rules of practice to accommodate changes made by AIPA. AIPA provides for, among other things, publication at 18 months from the priority date claimed by plant and utility applications filed on or after November 29, 2000. Specifically, AIPA § 4503(b) amends priority language of 35 U.S.C. § 119(e) and § 120 to provide that no patent application shall be entitled to the benefit of a prior-filed patent application unless an amendment containing the specific reference to the prior-filed patent application is submitted at such time during the pendency of the patent application as required by the Office. Prior to the enactment of AIPA there was no strict time limit for claiming priority. But with the enactment of AIPA and its requirements for publication at 18 months, it is now necessary for applicants to establish priority within the first 18 months of pendency. The amendments necessary to inform the applicants of these new practices are put forth in title 37 CFR § 1.78 (a)(1)-(6). It is for these changes that the Office seeks public comments.

The proposed changes include 1) defining the time period for claiming benefit of a prior-filed application in an application filed under the Patent Cooperation Treaty; 2) defining the time period to file English language translation of a non-English language provisional application, and 3) other technical corrections.

### **Claiming benefit of prior-filed applications**

Clearly defined claims of priority will be critical to the new 18-month publication requirement set forth in AIPA. Since the language of 35 U.S.C. § 119 and § 120 allow time limits to be established for filing priority claims, the proposed amendments to § 1.78(a)(1) establishing such time limits are within the scope of the Office's authority.

The proposed amendments to § 1.78(a)(2) set forth time limits for making a claim for priority for international applications designating the US. In my opinion, these requirements place no burden on the applicant as this information is readily available to them. The applicant must eventually provide this information if a claim of priority from prior filed applications is desired. This amendment merely requires that the applicant establish a priority claim within a shorter time following filing, but places no new burden on the applicant. If the applicant were to file in the PCT they would face this same requirement for providing priority claims at or near the time of filing.

The right to claim priority may be waived if a timely claim for priority is not made. I feel that these provisions protect the applicant and alleviate fears that the shortened time to claim priority will not result in loss of priority due to inadvertent error. For those cases where applicant can demonstrate that the delay in claiming priority was unintentional, amendments to § 1.78(a)(3) and § 1.78(a)(6) provide for petitioning for extensions of time to claim priority under 35 USC 120 or 119(e) if no designation is made in the application. If a priority claim is made in the application in a not set out in this section, but recognizable to the USPTO, then no petition is required.

### **Time limit to provide English language translation**

In exchange for the earlier disclosure of the invention through the 18-month publication, the AIPA provides a compensation right, (the right to obtain a reasonable royalty), beginning on the publication date, or if the priority publication is in a language other than English, then beginning on the date that the USPTO receives a translation of an international application in the English language.

The proposed amendments to § 1.78(a)(5) provides the applicant the option to postpone submitting an English translation until the later of 4 months from the filing date of the nonprovisional application that claims benefit of the non-English provisional

application, or 16 months from the date of the provisional application. It is my opinion that this option carries a positive benefit to the applicant in that the costs of translation can be great and delaying the translation expense until absolutely necessary could be financially desirable to some inventors or assignees.

**Other technical changes**

Proposed changes to § 1.78(a)(2) eliminate the need for any indication as to whether the application was filed in English. This indication is not necessary if an English version of the application is published.

Other changes clarify the requirement for identifying all applications by application number, that fall under the meaning of references required under 35 USC 120. This change is made specifically applicable to continuing prosecution applications (CPA), which carry the application number of the parent application making it impossible to distinguish from the parent based on application number alone. Such an amendment is necessary to fully document the application history.

In my opinion, the revisions to § 1.78 support the changes to 35 U.S.C. § 119(e) and § 120 made by AIPA § 4503(b) by providing guidance to the applicant for claiming the benefit of a prior-filed patent under the new 18-month publication requirement.

The comments do not necessarily reflect the opinions of my employers past or present.

Thank you for considering these comments.