



**AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION**

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March 21, 2007

The Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Comments on the Final Rule entitled "Changes to Implement Priority  
Document Exchange Between Intellectual Property Offices"  
72 Federal Register 1664 (January 16, 2007)

Dear Under Secretary Dudas:

The American Intellectual Property Law Association (AIPLA) wishes to express its support for the initiative of the United States Patent and Trademark Office (USPTO) in revising the rules of practice to provide for the electronic transfer of certified copies of applications for which priority is claimed under the Paris Convention from other intellectual property offices with which the Office has negotiated priority document exchange agreements. Electronic exchanges of priority documents provide a real service to applicants, eliminating a time consuming and costly paper-based procedure in favor of an efficient, no-cost electronic one. We strongly support this initiative, and urge that the Office build upon the start it has made with the EPO by also making the exchange process fully electronic and by negotiating similar exchange agreements with other offices including, in particular, WIPO.

AIPLA is a national bar association of more than 17,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a 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. Our members represent both owners and users of intellectual property.

This Rule clearly facilitates the goal of the USPTO's 21st Century Strategic Plan to support the electronic exchange of information and documents between intellectual property offices. It will benefit applicants by reducing the cost of ordering, processing, and mailing paper certified copies of priority documents for filing in other intellectual property offices. In addition, it will benefit participating offices by reducing the administrative costs associated with handling paper copies of priority applications.

Under the current paper-based system, to obtain the benefit of an earlier filing date applicants are generally required to file certified paper copies of priority documents in each later filed office. This requires an applicant to place an order with the first filed office for a certified paper copy of the priority application. In response, that office must print, assemble, and certify the paper copy, then physically deliver it to the applicant. The applicant must then arrange for delivery of the physical copy to the later filed office, which frequently re-processes the paper copy into electronic form. The direct electronic transfer of priority documents between the offices eliminates such cumbersome, time consuming, and expensive processing.

This Rule makes the benefits of electronic priority document exchange available to applicants needing to communicate such documents between the USPTO and the EPO. The Notice also states that the USPTO is developing a similar arrangement with the JPO. AIPLA applauds these initiatives by the Office, and believes that similar arrangements should be made wherever possible and, in particular, between the USPTO and the International Bureau of WIPO. Such an arrangement with WIPO would facilitate the provision of electronic certified copies of U.S. priority filings for the benefit of PCT applications filed in the International Bureau as Receiving Office.

We also note that, at present, applicants are required to use two paper forms to initiate electronic document exchanges. A first paper form, PTO/SB/38, is used to request that the USPTO obtain a certified copy of a particular priority application from a non-U.S. office to perfect a priority claim in the United States. A second paper form, PTO/SB/39, is used to authorize the USPTO to transmit an electronic certified copy of a particular U.S. patent application to a non-U.S. office. We propose that the Office eliminate the use of paper forms in this otherwise electronic process, and instead implement a fully electronic request and authorization mechanism.

Again, we congratulate the Office for this initiative and the adoption of this applicant-friendly Rule. We encourage the Office to continue to extend this initiative by providing fully electronic priority document exchanges with WIPO and other technologically capable offices.

Sincerely,

A handwritten signature in cursive script, reading "Michael K. Kirk".

Michael K. Kirk  
Executive Director