

September 8, 2014

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: AC95.comments@uspto.gov

**Re: Response to the Notice of Proposed Rulemaking Entitled
“Changes to Facilitate Applicant’s Authorization of Access to
Unpublished U.S. Patent Applications by Foreign Intellectual
Property Offices” 79 Fed. Reg. 40035 (July 11, 2014)**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views on the United States Patent and Trademark Office (“Office”) Notice of Proposed Rulemaking entitled “Changes to Facilitate Applicant’s Authorization of Access to Unpublished U.S. Patent Applications by Foreign Intellectual Property Offices” as published in the July 11, 2014 issue of the Federal Register, 79 Fed. Reg. 40035 (“Notice”).

AIPLA is a U.S.-based national bar association comprising approximately 15,000 members that are primarily lawyers in private practice and corporate practice, government service, and the academic community. AIPLA members represent a diverse spectrum of individuals, companies, and institutions, and are involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property, in the United States and in jurisdictions throughout the world.

The Notice proposes changes to the rules governing the confidential nature of patent applications to include a specific provision by which an applicant can authorize the Office to give a foreign IP office access to all or part of the file contents of an unpublished U.S. patent application in order to satisfy a requirement for information imposed on a counterpart application filed with the foreign intellectual property office.

Currently, two different sections of 37 C.F.R govern the ability of a foreign IP office to electronically access a certified copy of a priority application (37 C.F.R. § 1.14(h)) and to access the search results and bibliographic information about the priority application (37 C.F.R. §

1.14(c)). The former rule is invoked using a check-box on the Application Data Sheet (ADS) while the latter rule requires the filing of a separate document (PTO/SB/69 - Authorize EPO Access to Search Results). The proposed changes to the rules will consolidate these provisions into a single rule (1.14(h)) that allows applicants to give the Office authority to provide a foreign IP office with access to an application in order to satisfy an information requirement of the foreign IP office. The proposed rulemaking also addresses changes to the application data sheet (ADS) form that will simplify the process by which applicants provide the Office with the required authorization. This will reduce the resources applicants must expend to comply with these foreign IP office requirements, and enhance the quality of patent examination.

In a letter to The Honorable Teresa Stanek Rea, dated May 22, 2013, AIPLA recommended a similar change to the rules of practice. We gratefully acknowledge the consideration given to our recommendation, and because the proposed amendment closely tracks our recommendations, we whole-heartedly support the proposed amendment.

The impetus for the PTO form SB/69 was Rules 141 EPC and 70b EPC which entered into force on January 1, 2011 and which apply to European patent applications and International Applications filed on or after that date. These provisions require applicants who claim foreign priority when filing a European Patent Application to submit to the European Patent Office (EPO) a copy of the results of any novelty search carried out by the office of first filing. If no search results are available when the European application is filed, the applicant must provide the search results as soon as they are made available to the applicant.

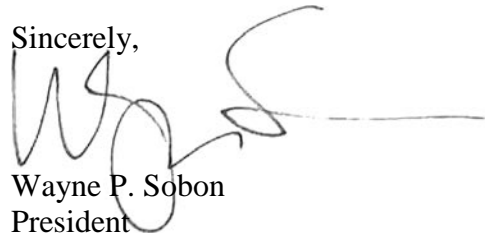
In order to alleviate the burden on the applicant, the EPO negotiated with various offices, including the USPTO, and agreed to provide an exemption to applicants. According to the agreed-upon exemption, U.S. applicants do not need to individually file the search results based on the understanding that the USPTO will automatically send those results as soon as the U.S. examiner completes the search. In order to comply with the duty to keep the contents of unpublished applications confidential, the USPTO provided form PTO/SB/69, allowing applicants to authorize access to the results of searches in unpublished applications to satisfy the requirements of Rules 141 EPC and 70b EPC. The proposed amendment obviates the need for form PTO/SB/69 by combining the authorization under Rule 1.14(c) to provide the search result with the authorization, under Rule 1.14(h) to provide foreign offices with a certified of the application.

While the existing procedures address a specific requirement by the EPO, we note that recent developments in agreements for cooperation among IP offices increase the importance of this rule change. In particular, the rapid development of the Global Dossier will need this rule for full implementation. In view of this, AIPLA is gratified to note that the proposed rule change is not limited to the search results required by the EPO but applies to information required by any foreign intellectual property office according to a bilateral or multilateral agreement to provide the required information to that office.

Although the proposed amendment to 37 C.F.R. 1.14(h) closely tracks our recommendations, we note that a minor change may be needed in the proposed text. As proposed, the new Rule 14(h)(2) recites “written authority under this paragraph (h)(2) will be treated as authorizing the Office to provide to all foreign intellectual property offices indicated in the written authority.” (emphasis added). We note that this statement may be inconsistent with the statement in the Notice of Proposed Rulemaking that the written authority to provide access to this information will be provided on an “opt out” basis on the ADS. Any such provision on the ADS would not include a list of foreign intellectual property offices. We further note that the underlined language does not appear in Rule 14(h)(1). Accordingly, we recommend that the language “indicated in the written authority” be stricken from Rule 14(h)(2).

AIPLA appreciates the opportunity to comment on the Proposed Rulemaking regarding Changes to Patent Term Adjustment calculations. AIPLA looks forward to further dialog with the Office with regard to the issues raised above.

Sincerely,

A handwritten signature in black ink, appearing to read 'Wayne P. Sobon', with a long horizontal line extending to the right.

Wayne P. Sobon
President

American Intellectual Property Law Association