

June 10, 2013

The Honorable Teresa Stanek Rea
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
600 Dulany Street
Alexandria, VA 22314

Via email: AC85.comments@uspto.gov

**Re: Response to Notice on “Changes To Implement the Patent Law Treaty”
78 Fed. Reg. 21788 (April 11, 2013)**

Dear Acting Under Secretary Rea:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (“Office”) Notice entitled “Changes To Implement the Patent Law Treaty” as published in the April 11, 2013, issue of the *Federal Register*, 78 Fed. Reg. 21788 (“Notice”).

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. 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. Our members represent both owners and users of intellectual property.

AIPLA generally supports the changes provided for in the Notice, which stem from the “Patent Law Treaty Implementation Act of 2012” (“PLTIA”; 126 Stat. 1527), which implements the Patent Law Treaty (“PLT”) of 2000. Additionally, AIPLA offers the following comments on specific aspects of the Notice.

Unity of Invention

In the process of ratifying the PLT, the U.S. Senate adopted a reservation with respect to Article 6 of the PLT. Specifically, the U.S. reserved that PLT Article 6(1) “not apply to any requirement relating to unity of invention applicable under the Patent Cooperation Treaty to an international application.”¹ In addressing this reservation in the Notice, the Office states:

¹ 78 Fed. Reg. 21788, 21790.

The Office appreciates that patent stakeholders prefer that the Office move from the “independent and distinct” restriction standard of 35 U.S.C. 121 to the “unity of invention” standard of PCT Rule 13. The Office is in the process of studying the changes to the patent statute, regulations, examination practices, and filings fees that would be necessary to move from the “independent and distinct” restriction standard of 35 U.S.C. 121 to the “unity of invention” standard of PCT Rule 13 in a practical manner.²

AIPLA has long supported the adoption of the unity of invention standard in the United States. AIPLA encourages the Office’s continued study of changes regarding the current “independent and distinct” restriction standard under 35 U.S.C. §121. AIPLA reiterates its commitment to work with the Office in addressing §121 and the use of a unity of invention standard.

35 U.S.C. §111(c) and 37 CFR §1.57(a)(3)

35 U.S.C. §111 has been amended to provide for a “reference filing” of a patent application, namely the filing of an application number only, with the actual application to be submitted later. Section 111(c) provides for the submission of the copy of the earlier filed referenced application (i.e., the “reference filing”). For cases where the copy of the specification and any drawings of the previously filed application are not submitted, §111(c) states that the application shall be considered as abandoned, and treated as “never been filed” unless revived and the appropriate copies of previously filed applications perfected. Rule 37 CFR §1.57(a)(3) is proposed to implement this revival of a reference filing.

AIPLA is concerned about the effect of the terms “never been filed,” in particular on the ability to claim priority to a reference filing that is deemed to have “never been filed.” AIPLA requests clarification that this is permitted under the new rules.

35 U.S.C. §41

Section 201(b) of the PLTIA prescribes that an abandoned application may be revived by petition if the application was unintentionally abandoned. This modifies the existing law which provides for two grounds for revival, namely, unintentional and unavoidable. Many countries around the world require a “due care” standard for revival of an abandoned application, which in the past was often fulfilled by a granted U.S. petition for revival on the grounds of “unavoidable” abandonment. The new standard of unintentional-only removes from applicants the ability to point to the granting of a U.S. petition on the grounds of unavoidable abandonment, and thus may make it harder for them to revive related applications in other offices.

² 78 Fed. Reg. 21788, 21790.

AIPLA notes that Section 202(b)(1)(A) of the PLTIA amends 35 U.S.C. §41(a)(7) to provide, in part, that the Director may refund any part of the fee specified in this paragraph, in exceptional circumstances as determined by the Director. Given that the PLTIA eliminates the unavoidable abandonment standard, AIPLA looks to this section as a possible remedy for the situation mentioned.

It remains unclear what “exceptional circumstances” means, and how the Director will make determinations of exceptional circumstances, as neither the proposed Rules, nor the discussion in the Notice, provide a definition or examples for “exceptional circumstances.” Nevertheless, AIPLA believes that giving the Director the ability to refund the fee “in exceptional circumstances” would allow the Office to effectively reverse the process with respect to an applicant believing he can meet the old “unavoidable” standard.

In other words, instead of submitting a request for unavoidable abandonment and paying a low fee (the old law), the Office is empowered to allow an applicant to request revival and make payment for unintentional delay (\$1700), and then to request a refund based upon exceptional circumstances. The PLTIA has thus replaced the “unavoidable” standard with an “exceptional circumstances” standard, which could include a showing of the exercise of “due care,” similar to the old unavoidable standard. In that way, perhaps applicants could make use of the Office to achieve a “due care” standard that might be used for other patent office determinations.

Furthermore, the fee set for revival for unintentional abandonment is \$1700/\$850. This is a decrease from the previous fees for unintentional abandonment. As the petition for revival (unintentional) is now applied to the payment of maintenance fees after the grace period, the rules point out correctly, that since they no longer require the payment of both the petition fee and the surcharge fee, revival of maintenance payments after the 6 month grace period is cheaper under the new rules than under the old rules.

However, the Office fails to point out that now a failure to provide claims for priority (as well as certified copy) by the 4/16 month deadline is considered abandonment and a revival fee of \$1700/\$850 is required. This compares to the fees previously set forth in section 37 CFR §1.17(t) of \$1420/\$710. This is a considerable fee increase and AIPLA requests that the amount be reconsidered.

35 USC §261 and 37 CFR §3.11

The PLTIA amends 35 U.S.C. §261 to provide for a “register of interests in applications for patents and patents.” The Notice proposes 37 CFR §3.11 be modified to provide for recordation of “other documents relating to interests in patent application and patents...” The PLTIA, however, does not specify the scope of an “interest.” Because the statute indicates that an “interest that constitutes an assignment, grant, or conveyance shall be void...” unless it is recorded in the Office, AIPLA requests that the Office provide guidance regarding the scope of these interests as well as what is necessary to have these interests recorded.

37 CFR §§1.55, 1.57

Proposed 37 CFR §1.55 requires that certified copies of foreign applications be “filed within four months from the date of entry into the national stage...or sixteen months from the filing date of the prior-filed foreign application, and [further that if] the exceptions in paragraphs (h) and (i) are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in §1.17(g).” Proposed 37 CFR §1.55 increases the standard for priority relative to current Rule 1.55 that only requires a claim to priority within a four or sixteen month time limit.

The PLT is intended to reduce administrative burdens whereas the proposed rule increases applicant administrative burdens. Proposed 37 CFR §1.55 would institute more stringent requirements for filing of a certified copy of a foreign application, and is therefore inconsistent with burden-reduction goals. The Office is urged to reconsider the proposed time frames and fees. Also, foreign countries must provide certified copies and obtaining them within the mandated time frame is often beyond applicants’ control. Current rules only require submission of certified copies prior to payment of an issue fee. AIPLA requests that the current standard be maintained.

Similar time frames for 37 CFR §1.57(a)(4) are proposed and AIPLA similarly requests that more latitude be permitted for applicants.

Certified Copies and Patent Term Adjustment

Proposed Rule 1.704 requires that an application be in condition for examination within 8 months of the filing, or commencement of the national stage for PCT applications. Proposed Rule 1.704(f) specifies the submission of “any certified copy of the previously filed application required by §1.57(a).” As noted above, obtaining a certified copy can be difficult and beyond an applicant’s control. While eight months *might* be sufficient, loss of patent term adjustment time in situations beyond applicant’s control is unfair.

AIPLA therefore suggests that the requirement for the submission of the certified copy within eight months be entirely removed, or at the minimum, an “interim copy” procedure be introduced. The “interim copy” procedure should also permit the applicant to file a temporary paper copy of the foreign application without certification, so long as he provides the certified copy by the issue date. If the strict time frames are maintained, it is requested that procedures be put in place to provide exceptions for situations where it can be shown that applicants have made good faith efforts to comply with requirements.

Applications not in English

The Notice does not include a proposed change to 37 CFR §1.412(c)(6)(ii) to allow the RO/US to accept international applications that are not filed in English. The PLTIA amends 35 U.S.C. §361(c) to read “International applications filed in the Patent and Trademark Office shall be filed in the English language, or an English translation shall be filed within such later time as may be

fixed by the Director.” The PCT rules have particulars for filing a translation where the international application is not in a language of publication or in a language accepted by the ISA (PCT Rule 12). Currently a non-English language international application is forwarded by RO/US to the IB under PCT Rule 19.4(a)(ii) upon payment of a fee equivalent to the transmittal fee (\$240).

Since 37 CFR §1.52(d)(1) sets forth the conditions for filing of an English translation for a nonprovisional application that was not filed in English, AIPLA would propose that the Office amend the rules to extend this same ‘courtesy’ for an international application, now that the statute permits it.

Oath/Declaration

The Technical Correction Bill of the Leahy-Smith America Invents Act (AIA) corrected the AIA so that now the Oath/Declaration is to be submitted before payment of the issue fee. As a result, there is no longer the extra needed Notice of Allowability since the applicant can now receive the Notice of Allowance and thereafter submit the Oath/Declaration before paying the issue fee.

Proposed Rule 1.495 addresses this issue. We believe the proposed modification is acceptable and we appreciate the Office taking the necessary steps to correct this matter.

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Thank you for allowing AIPLA the opportunity to provide comments on this important initiative. AIPLA looks forward to further dialogues with the Office in finding solutions and defining programs to maintain and enhance the Office’s mission.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive, flowing style.

Jeffrey I.D. Lewis
President
American Intellectual Property Law Association