



American Intellectual Property Law Association

June 23, 2017

Mr. Nicolas Oettinger,
Senior Counsel for Regulatory and Legislative Affairs
Office of General Counsel
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: RegulatoryReformGroup@uspto.gov

Re: Suggestions of the AIPLA for Consideration by the Working Group on Regulatory Reforms in Relation to Executive Order 13771 (“Presidential Executive Order on Reducing and Controlling Regulatory Costs”) and Executive Order 13777 (“Presidential Executive Order on Enforcing the Regulatory Reform Agenda”)

Dear Mr. Oettinger:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to provide suggestions regarding Executive Orders 13771 and 13777 for the Office’s Working Group on Regulatory Reforms.

AIPLA is a national bar association of approximately 14,000 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

COMMENTS

We commend the Office for establishing a working group on regulatory reforms in order to address Executive Orders 13711 and 13777. We believe having subject matter experts who are familiar with the Office’s regulations should greatly facilitate the Office’s compliance with the Executive Orders.

In order to aid the Working Group, we suggest the regulations indicated below for possible elimination or streamlining in accordance with Executive Orders 13711 and 13777. For the reasons discussed below, we believe that these regulations are unnecessary and often overly burdensome on the Office’s customers.

1. **The requirement under 37 CFR § 1.55 of a certified copy of a foreign patent application to which priority is claimed under 35 U.S.C. § 119.** Notably, § 119 does not require a certified copy of a foreign priority application in every application, but rather permits the Director to require a certified copy. Further, the certified copy of the foreign priority is unnecessary for examination of the vast majority of patent applications. Indeed, the Office's policy is to not consider the claim for foreign priority unless a reference is found with an effective date between the date of foreign filing and the date of filing in the United States. MPEP § 216. Thus, the portions of Rule 1.55 requiring a certified copy of a foreign priority application in every instance could be eliminated, while maintaining a requirement for a copy of the foreign priority application in instances where examination of the foreign priority application is necessary.
2. **The requirements under 37 CFR § 1.55 for a petition, fee, and statement in cases of a delayed claim for foreign priority.** The petition and fee for a delayed foreign priority claim can be onerous on applicants. Moreover, the petition, fee, and statement appear unnecessary inasmuch as an applicant has little, if any, incentive to intentionally delay a foreign priority claim (*e.g.*, patent term is not affected by the presence or absence of a foreign priority claim). A delayed claim for foreign priority could therefore be allowed with a simple filing and a much smaller fee, rather than a petition and significant fee. Notably, if the requirements for a petition, fee, and statement are eliminated for a delayed priority claim, then other regulations or Office policy could be modified to account for instances where the delayed priority claim becomes a burden on the Office. For example, if an applicant does not claim foreign priority until after receiving an Office Action where a claim is rejected on the basis of a reference with an effective date between the date of foreign filing and the date of filing in the United States, then the Office could make clear that a subsequent Office Action can be made final under 37 CFR 1.113 where the Examiner makes a new rejection of the claim based on a new reference.
3. **The requirement under 37 CFR § 1.83 that a drawing must show every feature of the claimed invention.** Under 35 U.S.C. § 113, an applicant is only required to furnish a drawing where necessary for understanding of the subject matter sought to be patented. Rule 1.83 therefore requires more drawings (showing "every feature") than what is required by statute ("necessary for understanding"). And it is our experience that Examiners will often apply Rule 1.83 very strictly by requiring drawings showing features of the claimed invention even where drawings showing such features are not, in fact, necessary to understand the claimed invention. Thus, Rule 1.83 could be streamlined to only require a drawing in cases where a drawing is necessary to understand the claimed invention.
4. **The requirement under 37 CFR § 1.98 for copies of foreign patent documents cited in an Information Disclosure Statement.** The Office long ago acknowledged that Examiners can easily access U.S. patent documents, and therefore eliminated the requirement that copies of cited U.S. patent documents be filed with an IDS. Today, almost all foreign patent documents can also be easily accessed using electronic databases. Hence, the requirement for copies of foreign patent documents for every IDS could be eliminated. To address cases where a foreign patent document cited in an

IDS cannot be easily accessed, the Office could still have a rule requiring a copy of foreign patent documents as needed.

5. **Practice Before the Patent Trial and Appeal Board in 37 CFR §§ 41 and 42.** Although these sections are designed to cover different aspects of the practice before the Patent Trial and Appeal Board (PTAB), there is some duplication in these sections which could be eliminated so the rules are simplified into a single comprehensive section covering all aspects. In addition, some of the rules in section 42 merely parrot the statute and, thus, should be eliminated.
6. **Requirements for Information Under 37 CFR § 1.105.** This rule *as applied* can be particularly burdensome on patent applicants. It is appreciated that this rule represents a codification of an already existing, but quite sparingly utilized, authority by the USPTO to ask questions of patent applicants during prosecution. In theory therefore, the rule has some appropriate uses. However, it has been the experience of a number of our members that the rule is inappropriately wielded in situations to request information that appears to be outside of the rule as written. In some instances, this results in the creation of a record in the file wrapper history that places applicant in a quandary about how to proceed. Applicants always try to comply and abide by the rules but some examiners ask for information either not known to applicant or that tries to shift the burden of examination to applicant. In several extreme cases, applicants have had to request expungement of the record because of prejudice to applicant stemming from the remarks of the examiner. We ask that this issue be highlighted and that more training be provided to examiners on the appropriate and inappropriate use of this rule.

CONCLUSION

AIPLA believes that Office should strongly consider elimination or streamlining of the regulations discussed herein as part of its efforts to comply with Executive Orders 13771 and 13777. We will continue to review the regulations and may provide any additional comments and recommendations.

Thank you for considering the AIPLA's suggestions.

Sincerely,



Mark L. Whitaker

President

American Intellectual Property Law Association