

From: Bousquet, Jeffrey R.
Sent: Friday, October 05, 2012 8:21 PM
To: fitf_rules
Cc: Berridge, William P.
Subject: FITF Comments

Re: Comments Regarding Proposed Changes to Implement the First-
Inventor-to-File Provisions of the Leahy-Smith America Invents Act

Dear Ms. Tsang-Foster:

Please see the attached comments.

Best regards.

William P. Berridge

<<O&B FITF Comments.pdf>>

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ATTORNEYS AT LAW

October 5, 2012

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By Email

Attention: Susy Tsang-Foster
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Re: Comments Regarding Proposed Changes to Implement the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act

Dear Ms. Tsang-Foster:

Set forth below are our comments regarding the proposed rule changes to implement the first-inventor-to-file (FITF) provisions of the America Invents Act (AIA).

Oloff & Berridge, PLC is a nationwide law firm specializing in intellectual property matters. Our patent practice serves corporations, universities, and individuals worldwide. We have filed and prosecuted thousands of matters before the United States Patent and Trademark Office (USPTO). Our practice before the USPTO provides a perspective and depth of experience necessary to provide the following comments regarding the proposed rule changes to implement the FITF provisions of the AIA. We appreciate the opportunity to have our positions considered by the USPTO.

I. Proposed Certified Copy Requirements

The USPTO proposes to require that a certified copy of a foreign priority application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. *See* proposed Rules 1.55(a)(2) and 1.55(a)(3). The USPTO further proposes that if an applicant requests that the USPTO obtain a copy of the foreign application under the priority document exchange program (PDEP), the copy of the foreign application must be received by the USPTO within this time period or by such later time as may be set by the USPTO. *See* proposed Rule 1.55(d)(1)(iii). Proposed Rule 1.55(f) indicates that these time periods are not extendible.

A. Unspecified Consequence for Failing to Timely File a Certified Copy

Proposed Rule 1.55(c) provides that a claim for priority will be considered to have been waived if not presented in an application data sheet (ADS) within the time period provided in proposed Rule 1.55(a)(2), unless a petition for a delayed claim of priority is accepted by the USPTO. However, there does not appear to be a defined consequence for when an applicant timely presents the foreign priority claim but fails to file a certified copy of the foreign priority application within the prescribed time period, or a provision for a petition for a delayed filing of the certified copy of the foreign priority document. Thus, clarification is respectfully requested as to what consequences, if any, will there be for timely filing the foreign priority claim but not timely filing the certified copy, and whether there will be any procedure for the late filing of the certified copy. Similar clarification is also requested for the situation in which an applicant timely files a foreign priority claim along with a PDEP request, but the USPTO does not timely receive the copy of the foreign priority application.

B. Applicants that Timely File a PDEP Request Should Not Be Penalized for the USPTO's Late Receipt of the Certified Copy

Proposed Rule 1.55(d)(1)(iii) requires that when an applicant files a PDEP request, the USPTO must receive the copy of the foreign application within the time period set forth in proposed Rule 1.55(a) or by such later time as may be set by the USPTO. This requirement is unreasonable. Applicants that take advantage of the PDEP have no control over when the USPTO will receive the copy of the foreign priority application after a PDEP request is filed. Applicants cannot control how long it takes the USPTO to act upon the request once it is filed, or how long it takes the foreign intellectual property office to act upon the request once it is received from the USPTO. Applicants can only control when the request is filed. Even if the PDEP request is filed with the application, as is often the case, there is no guarantee that the USPTO will receive the certified copy within the time period required by proposed Rule 1.55(a).

Thus, compliance with this proposed rule will create additional burdens to applicants and their representatives, as well as to the USPTO and foreign intellectual property offices participating in the PDEP.

Under current practice, an Examiner's failure to acknowledge receipt of a certified copy of the priority document on the Office Action Summary (PTOL-326) of the first action on the merits (or a similar indication in a first-action Notice of Allowance or an Ex Parte Quayle Action) serves as a notice to applicants and their representatives to take further action with respect to the certified copy. This notice provides at least three months for applicants to prompt action on a PDEP request or obtain a paper certified copy. Under the proposed rule, because a first action on the merits is rarely received within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, additional efforts will be needed to ensure that the USPTO timely receives the certified copy pursuant to a PDEP request. Applicants and their representatives will need to monitor whether

the USPTO receives the certified copy requested under the PDEP well in advance of the proposed due date, and to take additional action if the USPTO does not receive the certified copy sufficiently early. This will entail docketing applicable call-up and due dates, accompanied by checking of the USPTO's PALM system and/or making status inquiries by telephone or in writing to determine whether the USPTO has received the certified copy. If the USPTO does not receive the certified copy requested under the PDEP well in advance of the proposed due date, applicants will then need to start the burdensome and time-consuming process to obtain the certified copy on their own and timely file it with the USPTO. Under such a scenario, the foreign intellectual property office will need to process and respond to two separate requests for the certified copy, and the USPTO will need to likewise process two separate receipts of the certified copy for the same application, mooting the benefits of the PDEP system and turning it into a detriment.

Thus, applicants and their representatives will need to take additional actions with respect to current practice to ensure that the USPTO timely receives certified copies requested under the PDEP. This, in turn, will require the USPTO to expend additional resources to handle certified copy status inquiries from applicants. Furthermore, the USPTO and foreign intellectual property offices participating in the PDEP will need to expend additional resources to handle duplicative certified copy requests.

Proposed Rule 1.55(d)(1)(iii) should not be adopted by the USPTO because it places on applicants that file a PDEP request requirements that are beyond applicants' control and unduly burdens applicants, the USPTO, and foreign intellectual property offices participating in the PDEP. The USPTO should instead require that if an applicant desires to take advantage of the PDEP, a PDEP request must be filed within a specified time period. The USPTO should evaluate and revise, if necessary, its internal procedures for acting on a PDEP request to ensure that it will receive the certified copy within the time period desired by the USPTO.

C. The Proposed Certified Copy Requirements Should be Narrowed to Correspond to the USPTO's Actual Need to Rely on a Foreign Priority Application to Establish an Effective Prior Art Date Under AIA 35 U.S.C. §102(d)

The USPTO asserts, "Since patent application publications will have a prior art effect as of the earliest priority date (for subject matter disclosed in the priority application) with respect to applications subject to 35 U.S.C. 102, as amended by the AIA, the Office needs to ensure that it has a copy of the priority application by the time of publication."

It appears that the USPTO is arguing that it needs a copy of the priority application by the time of publication to determine the effective prior art date under AIA 35 U.S.C §102(d) of the subject matter disclosed in the U.S. patent application publication or U.S. patent. According to AIA 35 U.S.C §102(d), the subject matter must be described in the priority application for that subject matter to have an effective prior art date as of the filing date of the priority application.

The USPTO overstates its need. In actuality, the USPTO's need for a copy of the priority application for the purposes of AIA 35 U.S.C §102(d) is limited to those instances in which the priority application is being relied upon to establish an earlier effective prior art date of subject matter of a published U.S. patent application or U.S. patent claiming priority to that foreign application. At the very least, this need cannot exist before the U.S. publication date. Consequently, requiring that the certified copy be received by the USPTO two months or more prior to the U.S. publication date is not necessary.

Furthermore, if the foreign priority application is in a foreign language, having a copy of the priority application prior to the time of publication would be of little use to the USPTO without an accurate English-language translation. It would be costly for the USPTO to translate every foreign-language priority document it receives. A more cost-effective approach would be to translate a foreign-language priority document only when an actual need to do so arises, such as when it is being relied upon to establish an earlier effective prior art date to reject a claim in a U.S. application. Under this approach, requiring that the certified copy be received by the USPTO prior to the U.S. publication date would not be necessary.

Moreover, in the limited circumstances where the USPTO will need a copy of the foreign priority application to establish an effective prior art date under AIA 35 U.S.C. §102(d), by the time the need arises, the vast majority of foreign priority applications will have been published by the foreign intellectual property office in which they were filed, and would be readily available on the internet. Although this would not be a certified copy, the need for a certified copy of a priority document has long been obsolete, as reflected by the fact that 35 U.S.C. §119(b) was amended in 1999 to no longer require the filing of a certified copy of the foreign priority application and to instead provide that the Director "may require" a certified copy of the foreign priority application.

The USPTO's proposed certified copy requirements are not tailored to address the USPTO's actual need to establish an effective prior art date under AIA 35 U.S.C. §102(d) without unduly burdening applicants. To more narrowly tailor the certified copy requirements to correspond to the USPTO's actual need, the USPTO should waive the certified copy requirements for foreign priority applications that are filed in foreign intellectual property offices that publish applications that correspond to the originally filed application within eighteen months of publication and make these publications readily available on the internet. Such a publication could be relied upon to establish a prima facie effective prior art date. If an applicant facing a rejection relying on such a reference decides to challenge the reliability of the publication, the applicant can do so. This would be far less burdensome than a requirement that every applicant relying on foreign priority meet strict deadlines that burden the applicants, the USPTO, and the foreign intellectual property offices and renders the PDEP system counterproductive.

II. Required Statements of Proposed Rules 1.55(a)(4), 1.78(a)(3), 1.78(c)(2)**A. Summary of USPTO's Proposal**

The USPTO proposes that certain statements be made under certain circumstances in nonprovisional applications filed on or after March 16, 2013, that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013. In particular, if such a nonprovisional application:

(1) contains at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of:

- four months from the actual filing date of the later-filed application,
- four months from the date of entry into the national stage in an international application,
- sixteen months from the filing date of the prior-filed application, or
- the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application; or

(2) does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement that the application includes subject matter not disclosed in the foreign, provisional, or nonprovisional application within the later of:

- four months from the actual filing date of the later-filed application,
- four months from the date of entry into the national stage in an international application, or
- sixteen months from the filing date of the prior-filed application.

B. Complying with the Proposed Required Statements will be a Significant Economic Burden for Foreign Applicants

The USPTO asserts that this information is needed to assist the USPTO in determining whether the application is subject to pre- or post-AIA 35 U.S.C. §102 and §103, because examination costs will significantly increase if the USPTO must determine on its own the effective filing date of every claim ever presented in an application filed on or after March 16,

2013, that claims priority to or the benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013.¹

The USPTO argues that its proposed requirements will not have a significant economic impact on applicants. In support of this conclusion, the USPTO provides the following two arguments:

1. The USPTO's experience is that the majority of nonprovisional applications that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application do not disclose or claim subject matter not also disclosed in the foreign, provisional, or nonprovisional application.
2. USPTO staff with experience and expertise in a wide range of patent prosecution matters as patent practitioners estimate that this will require, on average, an additional two hours for a practitioner who drafted the later-filed application (including the claims) and is familiar with the prior foreign, provisional, or nonprovisional application.

Both arguments are flawed and do not support the USPTO's conclusion.

The first argument is flawed on two grounds.

First, no basis is provided for the statement of the USPTO's alleged experience concerning the majority of nonprovisional applications that claim benefit. As acknowledged by the USPTO, it generally makes such determinations only when necessary. In fact, the vast majority of foreign priority documents are never translated in the USPTO and thus it cannot know what they do or do not support. The ones that are translated are only translated because they support the claims in issue. For example, of the several thousand foreign-priority-based applications that our firm files each year, translations of the foreign priority documents are filed in at most a few dozen applications each year. Such translations are not prepared if they will not support the claims in issue.

Second, the proportion of previously filed applications that do not disclose or claim subject matter not disclosed in a priority document has no bearing on whether a given application discloses or claims subject matter not disclosed in a priority document. This determination would have to be made independently for every application filed on or after March 16, 2013, that claims priority to or the benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, under the proposed rules. Under the alternative we propose herein, such a

¹ There would be no such requirement in any case – the presence of a single post-March 16, 2013 claim establishes that post-AIA §§102 and 103 apply. Thus, the analysis may stop when a single such claim is detected.

determination would only be necessary if the difference in applicable law affects the outcome of examination.

The second argument is flawed because it does not take into consideration that: (a) the U.S. practitioner filing the later-filed application is not always the individual who drafted the later-filed application, and is almost never the individual who drafted the foreign priority application(s); and (b) the U.S. practitioner filing the later-filed application often is not familiar with the prior provisional or nonprovisional application, and seldom is familiar with the details of a foreign priority application.

In cases where the U.S. practitioner did not draft the later-filed application and is not familiar with the details of the prior foreign, provisional, or nonprovisional application, determining whether the later-filed application discloses or claims subject matter not disclosed in a priority document will be difficult and costly, even if the priority document is in English. If the priority document is not in English, additional costs will be required to obtain an accurate translation necessary for the analysis. This problem is exacerbated when multiple foreign priority applications are combined to generate a U.S. application. This often inadvertently creates new combinations of information that affect the effective date of disclosures and/or claims. Foreign applicants will need to expend an incredible amount of resources to comply with these proposed requirements in every case they file that has dates bridging March 16, 2013.

For example, consider the following cost of analysis for a foreign origin application, based on the following parameters:

Translation costs:	≥ \$75 per page of translation
Attorney time:	1 hour for every 5 pages of specification being compared to translation of foreign priority application 1 hour for every 10 claims being compared to translation of foreign priority application
Attorney rate:	\$350/hr (USPTO's estimate)

An average 20-page application with 20 claims would incur costs of at least \$3,500 for the translation and analysis, assuming only one priority application is involved.² Multiplying this by the 135,633 foreign priority and PCT National Stage applications filed each year (per the USPTO's FY2011 statistics at 77 Fed. Reg. 43752), the aggregate burden of this single aspect of the proposed rules is about \$474,715,500 per year (over \$82,706,000 for the 22,974 small entities the USPTO has counted among such applications). This clearly makes the rulemaking economically significant, and causes it to have a significant economic impact on a substantial number of small entities. The benefits do not justify the costs of the rules, because the same

² The cost would be substantially higher if more than one priority document must be considered, or if larger applications and/or priority documents are involved.

benefits can be obtained by targeting the requirements only on applications in which the pre- or post-AIA determination is relevant to patentability, as will be discussed in more detail below.

Additionally, the proposed required statements unnecessarily place on the U.S. practitioner filing the application the burden of determining whether the application should be subject to AIA 35 U.S.C. §102 and §103 and, thus, the consequences if the determination is incorrectly made. This could potentially lead to allegations of inequitable conduct and/or practitioner negligence for not getting it right, regardless of whether the determination has any effect whatsoever on the USPTO's examination of the application.

C. The Proposed Requirement for Information if an Applicant Fails to Timely Provide the Required Statements is Punitive, Arbitrary, and Capricious

The USPTO indicates that if an applicant fails to timely provide such a statement and then later indicates that the nonprovisional application contains (a) a claim having an effective filing date on or after March 16, 2013, or (b) subject matter not also disclosed in the priority application, the USPTO may issue a requirement for information under Rule 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. §112(a) in the priority application for the remaining claims in the nonprovisional application.

Issuing a requirement for information under Rule 1.105 under this scenario would serve no purpose in helping the USPTO determine whether the application is subject to pre- or post-AIA 35 U.S.C. §102 and §103. Once it is established that any single claim is subject to AIA 35 U.S.C. §102 and §103, the status of the remaining claims is irrelevant to that determination. The requirement thus would be punitive, arbitrary, and capricious. Thus, the requirement should only be to identify any one pending or canceled claim that is not supported in a pre-March 16, 2013 application.

D. An Alternative Solution

Determining whether claims presented in every application filed on or after March 16, 2013, that claims priority to or the benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013 are subject to pre- or post-AIA 35 U.S.C. §102 and §103 would be a significant economic burden to the party responsible for making this determination, whether it be the USPTO or its stakeholders.

An alternative solution is that the USPTO apply a rebuttable presumption that all applications filed on or after March 16, 2013 USPTO are subject to AIA 35 U.S.C. §102 and §103. Applicants may rebut this assumption by providing a statement to the effect that the claims are not subject to AIA 35 U.S.C. §102 and §103 within the later of:

- four months from the actual filing date of the later-filed application,
- four months from the date of entry into the national stage in an international application, or
- sixteen months from the filing date of the prior-filed application.

If such a statement is not timely made, the claims would be examined under AIA 35 U.S.C. §102/§103. If a reference applied in a §102 or §103 rejection would not be prior art under pre-AIA §102/§103, the applicant may disqualify the reference by submitting sufficient proof that the claims are entitled to pre-AIA §102/§103.

A prior art search conducted under AIA §102 /§103 is broader than a search conducted under pre-AIA §102/§103, and would encompass substantially all prior art under pre-AIA §102/§103, with two possible limited exceptions. Commonly owned or joint research agreement patents and patent application publications that would not qualify as prior art under AIA §102/§103 may qualify as prior art under pre-AIA §102. Also, "grace period" disclosures in applications claiming foreign priority that would not qualify as prior art under AIA §102/§103 may qualify as prior art under pre-AIA §102 or §103. Nevertheless, the AIA prior art search would most likely flag these references. Currently, commonly owned or joint research agreement patents and patent application publications are often applied in §103 rejections, and the applicant is tasked with establishing that the reference is disqualified under 35 U.S.C §103(c). As to grace period disclosures, the USPTO's proposed Examination Guidelines indicate that Examiners will apply grace period disclosures as prior art unless it is apparent from the disclosure that it is by the inventor or a joint inventor, placing the burden on the applicant to submit sufficient evidence to disqualify the disclosure. *See* Federal Register 77(144): 43766. Accordingly, a search conducted under AIA §102/§103 should identify every potential prior art reference that would be identified in a pre-AIA search. If a potential prior art reference falls into either of the above two categories, the Examiner should apply the reference in a rejection and leave it to the applicant to disqualify it.

Applicants that certify that an application is subject to pre-AIA §§102 and 103 and subsequently present a claim having an effective filing date on or after March 16, 2013, should be required to contemporaneously notify the USPTO of that fact.

Under this proposed alternative, neither the USPTO nor applicants would be required to determine whether each application filed on or after March 16, 2013, that claims priority to or the benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013 is subject to pre- or post-AIA §102/§103, thus eliminating the significant economic burden that would be incurred by having to do so. This would avoid anyone being subject to the burdensome analysis in the most usual case that the applied references are prior art under both versions of the statute or when no relevant references are uncovered.

Although rebutting the AIA presumption would require the same amount of analysis that would be required under the USPTO's proposal, applicants would be able to decide on a case-by-case basis whether to expend the resources necessary to make such a determination. As noted above, such a decision would not be needed in every case that bridges March 16, 2013, but instead would only be needed where a reference applied in a rejection could be disqualified under pre-AIA §102/§103. Even then, applicants would have other options for overcoming the rejection. This would not be much different from current practice when a reference is applied that falls between an applicant's earliest effective U.S. filing date and the claimed priority date of a non-English-language foreign application. The applicant may disqualify the reference by filing an accurate translation of a certified copy of the priority document and establishing that the claim is sufficiently supported by the priority document. However, if the applicant does not wish to incur the expense of translation and analysis to disqualify the reference, the applicant has other options for responding to the rejection, including cancelling or amending claims to overcome the rejection.

In addition, this approach minimizes the training burden on USPTO examiners and the confusion that will arise if searches are conducted under different standards for different applications. Examiners can be trained to perform searches according to a single set of standards. Every search they conduct will conform with those standards. Thus, training time and confusion can be minimized over the many years that both sets of laws will apply.

Also, the pre-AIA or post-AIA law determination need not be made at all in many cases (e.g., "old" prior art or no relevant prior art). Thus, as the number of pre-AIA cases diminishes, not all examiners need be trained at all in the nuances of pre-AIA law. Technical Center experts can be appointed to address the determination of whether a reference is prior art in the few cases where the determination is pertinent, while all examiners can proceed with searches, thus further lowering the USPTO's training burdens.

III. Other Comments

As a general comment, the USPTO should avoid using old rule numbers for new rules. Both sets of rules will need to be used for years to come and it is very confusing when the USPTO uses the same old rule numbers for the new rules. The USPTO should instead use new rule numbers for new rules so that it is clear what rules apply and a single set of rules can be used for all applications.

A. Ambiguities in Proposed Rule 1.130

Paragraphs (a)–(e) of proposed Rule 1.130 are cumbersome and difficult to navigate. This may be improved by the use of further subnumbering in subparagraphs (a)(1) and (a)(2), or by individually numbering the six scenarios listed in these subparagraphs as (a)(1)–(a)(6), respectively. The USPTO should also consider incorporating the various requirements of paragraphs (b)–(e) into paragraph (a) closest to the scenario to which they respectively apply.

Alternatively, paragraphs (b)–(e) should begin with a subheading or clause clearly identifying the scenario(s) of paragraph (a) to which they apply. For example, subparagraph (c) as proposed begins, "If the disclosure on which the rejection is based is not by the inventor or a joint inventor." This would include (i) disclosures by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, as well as (ii) disclosures by a party who did not obtain the subject matter disclosed directly or indirectly from the inventor or a joint inventor, wherein the party is also not the inventor or a joint inventor. Similarly, subparagraph (e) as proposed begins, "If the disclosure on which the rejection is based is not by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor." This would include (i) disclosures by the inventor or a joint inventor, and (ii) disclosures by a party who did not obtain the subject matter disclosed directly or indirectly from the inventor or a joint inventor, wherein the party is also not the inventor or a joint inventor. Thus, it is confusing as to when an (a)(1) declaration and an (a)(2) declaration may or may not be used, and the requirements for such declarations, under the different circumstances.

B. Proof of Communication of a Disclosure Should Not Require that the Communicated Disclosure Be More Extensive than the Reference Disclosure

The USPTO indicates in its commentary that proposed Rule 1.130(d) requires proof of an enabling disclosure from the inventor or a joint inventor to the disclosing party. *See* Federal Register, 77(144):43750. All that should be required is a showing that the disclosure from the inventor or a joint inventor to the disclosing party was enabling at least to the same extent as the disclosing party's disclosure. Furthermore, any such express requirement should be stated in the relevant rules, and not buried in commentary.

C. Applicants Should Not be Required to File Derivation Petitions

Proposed Rule 1.130(f) indicates that the USPTO may require an applicant to file a petition for a derivation proceeding. However, filing a derivation petition is sometimes prohibited, and it should always be optional. There is no basis for requiring the filing of a derivation petition when an applicant may avoid a rejection in another way (e.g., by amending claims).

D. A Clear Definition of "Divisional Application" is Needed

Proposed Rule 1.78(c)(2) requires identifying whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application or international application. Rule 1.9 should be amended to include a clear definition of what constitutes a divisional application. For example, do divisional applications encompass so-called "voluntary" divisional applications, where the claims were not presented in the parent application, but could have been subjected to a restriction requirement had they been presented in the parent application?

E. Inconsistencies Between Rules 1.78(c)(5) and 1.55(a)(2)

Proposed Rule 1.78(c)(5) provides that cross references to applications for which a benefit is not claimed must not be included in an application data sheet. This appears to conflict with proposed Rule 1.55(a)(2), which provides in part (emphasis added):

The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)). The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing.

Proposed Rule 1.78(c)(5) should be revised to eliminate this conflict – e.g., by adding "other than the reference required by 37 C.F.R. §1.55(a)(2)."

F. Completion of Rule 1.110

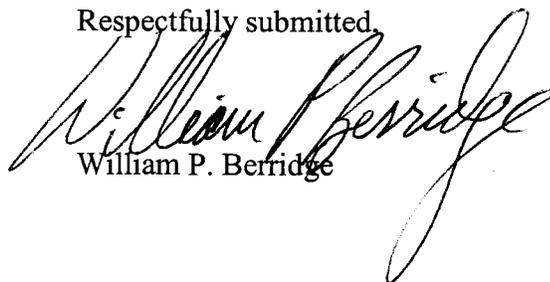
Proposed Rule 1.110 does not reflect the full scope of the reason for the existence of that rule (e.g., to address issues that may arise under pre-AIA §103(c) or post-AIA §102(b)(2)(C) and (c)). Thus, proposed Rule 1.110 should be further amended as follows:

§ 1.110 Inventorship and ownership of the subject matter of individual claims. When more than one inventor is named in an application or patent, the Office may require an applicant or patentee to identify the inventor, and ownership or obligation to assign ownership on the effective filing date, of each claimed invention in the application or patent, when necessary for purposes of an Office proceeding.

* * * *

We appreciate the USPTO's careful consideration of our comments and proposals set forth above.

Respectfully submitted,



William P. Berridge