

June 24, 2013

Mail Stop Comments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By Email

Attention: Robert W. Bahr, Senior Patent Counsel, Office of Patent Examination Policy

Re: Request for Comments on Changes to Implement the Patent Law Treaty

Dear Mr. Bahr:

Oloff & Berridge PLC is a private intellectual property law firm that files and prosecutes several thousand patent applications per year on behalf of a wide range of applicants, including independent inventors, small businesses, universities, and major U.S. and international corporations. As a Member of the firm, I am providing the following comments that represent the views of the firm. However, these comments are not intended to represent the views of any specific client or clients of the firm.

First, we would like to commend the USPTO on its efforts to enhance quality and efficiency in its operations, and to implement the new law changes. While change is often difficult, the subject proposed rulemaking is very well thought-out and clearly presented in almost all respects. We just have a few proposed changes, most but not all editorial, as set out below.

Section 1.16(f)

Due to its grammatical construction, this section appears to impose the surcharge only for certain patent applications, and is unclear as to whether a separate surcharge is applicable for each deficiency in a single application. We suggest that it be revised to read as follows (additions underlined, deletions bracketed):

(f) A single surcharge [Surcharge] for filing ... later than the filing date of the application, for filing an application that does not contain at least one claim on the filing date of the application, [and] and/or for filing an application [filed] by reference ...

Section 1.53(b) and (c)

The phrase "with or without claims" should be set off by commas at both ends -- e.g., "...specification, with or without claims, is received ..."

Section 1.53(f)

Similarly, to make clear that the surcharge is not only applicable in certain circumstances in which it is required to avoid abandonment, the clause "and pay the surcharge if required by §1.16(f)" should be set off by commas at both ends -- e.g., "examination fee, and pay the surcharge if required by §1.16(f), to avoid abandonment."

Sections 1.53(f)(ii) and 1.495(c)(3)(ii)

The phrase "for the patent" should read "for the application" or be deleted in both occurrences.

Sections 1.55(b)(2) and 1.78(a)(1)(ii)

The phrase "or upon petition" should close with a comma -- e.g., "or upon petition, if the delay ..." -- to make clear that the following requirement regarding the delay being unintentional does not apply only to the circumstance in which a petition is required.

Sections 1.57(a) and 1.76(b)(3)

The word "replaced" is confusing in this context, as it suggests that some other specification and drawings are or need to be present to be replaced. We suggest instead using the word "provided" (for clarity) or "constituted" (to match the statute).

Section 1.57(a)(4)

The requirement that the certified copy be "received by the Office from a foreign intellectual property office participating in a priority document exchange agreement" within the specified time limits imposes unnecessary burdens and costs on the Office, as was recognized in the Office's revision of such a requirement that had been included in the proposed changes to sections 1.55(h) and (i). We recommend that the requirement be similarly revised here to correspond with final sections 1.55(h) and (i).

Section 1.57(g)

The references in this section to other subparagraphs of section 1.57 need to be updated in view of the addition of new subsection (a).

Sections 1.78(a)(4) and (c)(3)

The word "also" (two occurrences in each section) is confusing and redundant; we recommend that it be deleted.

Section 1.378(d)

The final sentence of this rule is inconsistent with the deletion of the corresponding fee from section 1.17(f), and thus should be deleted.

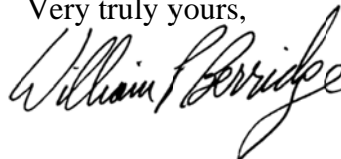
Section 1.704(f)

The phrase "in compliance with" in connection with the application papers, drawings, translations, and sequence listings could result in serious inequities and confusion as to the proper term of a patent. In many cases, "compliance" with the requirements is sufficient for an application to move past OIPE to the Examiner. However, the Examiner may require minor corrections to ensure such compliance after examination has begun.

Literally construed, this rule could wipe out all patent term extension arising from PTO delays in an application after it has passed through OIPE and is simply in the queue to await examination. It would also cause applicants to strongly contest Office Actions that raise such minor issues that could otherwise be addressed with simple, inexpensive changes to application papers, drawings, translations or sequence listings in response to a first Office Action. The result would be that patent examination would become more complicated and expensive to both applicants and the Office, and could even involve patent term extension litigation in the District Court.

Thus, we recommend substituting a phrase such as "satisfying the Office's pre-examination requirements under" for the phrase "in compliance with."

Very truly yours,



William P. Berridge

WPB/hs