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Subject: Supplemental Comments in Response to 26 July 2012 FR 43759 Proposal on Guidelines

Attached are my supplemental comments in PDF.

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Supplemental Comments on Rules & Examination Guidelines Proposals of 26 July 2012 to Implement
First Inventor to File Provisions of the AIA, FR 43742 & 43759

INTRODUCTION

I provide the following comments as an active patent practitioner since 1973 and an active member of national intellectual property law associations for most of my career, having served on numerous committees charged with developing comments to USPTO rules proposals as well as having provided my personal comments to the USPTO on numerous rules proposals. While these comments are mine alone, they do reflect in depth discussions I have had with colleagues and others seriously concerned with the current proposals.

I also provide the following comments with recognition of the outstanding job the USPTO has done to date, in implementing the provisions of the AIA which have already become effective and in taking due account of the comments provided in response to earlier AIA related rules proposals. In this regard, in my view, the rationale provided in response to comments can be as valuable as any modifications of the proposed guidelines and rules themselves.

COMMENTS ON THE PROPOSED EXAMINATION GUIDELINES

The proposed Guidelines' approach to the disqualification of intervening public disclosures is **not** consistent with treating the earlier public disclosure as if it were a patent application. It is very well established patent law that a patent application will support post filing claims which have trivial variations from the precise disclosure of the application. In addition it is very well established patent law that a broad disclosure will support claims to a broad invention even if a public disclosure is discovered with a teaching within the broad invention which does not appear in the application at issue. For instance, if a patent application properly teaches a chemical genus, a later public disclosure of a species will not defeat the patentability of the genus claim even if that particular species is disclosed in the patent application.

Thus regardless of whether such a virtual patent application filing is appropriate such an approach does not justify the trivial variations approach.