

July 30, 2012

Via Electronic Mail: micro_entity@uspto.gov

Mail Stop Comments—Patents
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: James Engel
Senior Legal Advisor
Office of the Deputy Commissioner for Patent Examination Policy

Re: Comments on Notice of Proposed Rulemaking Entitled “Changes to Implement Micro Entity Status for Paying Patent Fees,” 77 Fed. Reg. 104 (May 30, 2012)

Dear Mr. Engel:

The Minnesota Intellectual Property Law Association (“MIPLA”)¹ is grateful for the opportunity to comment on the Notice of Proposed Rulemaking entitled “Changes to Implement Micro Entity Status for Paying Patent Fees,” 77 Fed. Reg. 104 (May 30, 2012) (the “Micro Entity Rules”).

In general, MIPLA believes that the proposed Micro Entity Rules will benefit the independent inventor community and institutions of higher education by providing improved access to the U.S. patent system by reducing fees. This in turn will benefit society by increasing innovation and the sharing of knowledge. The Rules may also serve as a model for the International Bureau of WIPO as it strives to put into place a system of micro-entity fees for the PCT. MIPLA is grateful to the Office for their action in this area.

The comments submitted herewith reflect submitted herewith reflect the view of MIPLA as a whole, and do not necessarily reflect the view or opinions of either MIPLA or any of the individual members or firms, or any of their clients.

Sincerely,

/s/ Brad Pedersen

Brad Pedersen

¹ The MIPLA is an independent organization with nearly 700 members representing all aspects of private and corporate intellectual property practice, as well as the academic community, in and around the state of Minnesota.

1. Change some instances of “applicant” to “inventor” in § 1.29.

The potential benefits of 35 U.S.C. § 118 should be available to all inventors and applicants and should not exclude micro entities. At the same time, inventors not otherwise qualifying as micro entities should not receive the 75% reduction in fees simply by using an applicant qualifying as a micro entity.

Therefore, the final rules should replace some instances of “applicant” with “inventor” in § 1.29:

1. Change the second instance of “applicant” to “inventor” in § 1.29(a); and
2. Change all instances of “applicant” and “applicant’s” to “inventor” and “inventor’s,” respectively, in § 1.29(b), 1.29(c), 1.29(d)(1), 1.29(d)(2)(i) and 1.29(d)(2)(ii).

In the same vein, the final rules should clarify, amend or remove the following statement in § 1.29(h) to the extent that “parties” could include an applicant under 35 U.S.C. § 118 not qualifying as a micro entity but filing an application on behalf of an inventor qualifying as a micro entity:

It should be determined that all parties holding rights in the invention qualify for micro entity status.

One suggestion is simply to replace “parties” with “inventors.”

2. Add provisions to enable electronic filing of documents in a patent application with submission by mail of associated micro entity fees.

Micro entities will want to take advantage of the numerous benefits of electronic filing. These same entities, however, likely will not have access to deposit accounts at the U.S. Patent and Trademark Office (USPTO) and also may not have sufficient access to or comfort with credit to enable payment of fees by credit card. Absent these options, electronic filing is unavailable to micro entities.

Many patent practitioners in Minnesota have seen this first-hand through their participation in the LegalCORPS Inventor Assistance Program (“IAP”), the pilot patent law pro bono program in the country developed with the support of the USPTO. The inventors qualifying for free legal assistance through the IAP are micro entities at least based on the income cap imposed by the IAP, which substantially mirrors the definition in § 1.29(a)(3). While many IAP volunteer attorneys are associated with law firms having appropriate trust and deposit accounts to enable handling of client funds, other IAP volunteer attorneys are employed in-house for corporations where they are not able to handle client funds.

The final rules could address this issue by providing rules for electronic filing of documents along with a written certification by the applicant or inventor that any fees associated with that

filing are being submitted by check deposited in the U.S. mail on even date with the filing in applications in which micro entity status is being certified.