

**From:****Sent:** Thursday, April 08, 2010 1:57 PM**To:** extended\_missing\_parts**Subject:** Comment on proposed rulemaking

Honorable Commissioner,

This is a comment on behalf of myself and Miller Patent Services on the proposed rulemaking to extend the period for response to missing parts in order to effectively give applicants additional time to explore the possibility of exploiting their inventions.

I have only minor objections to the proposal and do not object to it in principle. However, there are some issues that should be addressed.

I strongly object to the requirement for publication at 18 months. While I understand that the publication of the application will build on the body of prior art available to the office, this is done potentially to the Applicant's detriment and without the Applicant receiving the quid pro quo of patent protection at this point. The invention is effectively disclosed to the public, perhaps before the inventor has a chance to perfect its real world embodiment. If the application would not otherwise be required to be published (i.e., if the applicant filed a request for non-publication) I see no reason to depart from honoring that request until a patent issues if this rulemaking is adopted. In many instances an independent inventor may still be developing prototypes and the like at this stage and publication would be potentially detrimental.

While this is not an objection to the rulemaking, per se, I strongly object to the references in the Federal Register notice that suggest that a provisional patent application is a "low cost" patent application. The register states, for example "The proposal would benefit applicants by permitting additional time to determine if patent protection should be sought at a relatively low cost and by permitting applicants to focus efforts on commercialization during this period." While the cost in government fees is certainly lower than a non-provisional application, the government fees are relatively small compared to the cost of professional services. I have found a growing belief that provisionals are cheap and easy, while seeing many that are not worth the paper they are written on.

I wish to respectfully submit to the Office that a provisional patent application is not (nor do I believe it was ever intended to be) a low cost alternative way to file a patent application. If memory serves me, it was intended to equalize the expiration date for domestic inventors with the expiration date of U.S. applications first filed in another country. A properly prepared provisional patent application should cost the inventor approximately the same in attorney/agent fees as a regular non-provisional patent application. Why? Because, although a claim is not required, the provisional application must support all claims to be presented in the future in the non-provisional application to be effective as a priority document. How does a practitioner assure this will happen? While it is impossible to fully predict what future claims might be presented in some cases, the best way to try to assure proper support in the provisional is to actually write the claims and assure they are supported in the provisional patent application. Hence, the effort required on the part of a practitioner is usually nearly the same as preparation of a regular patent application and therefore the practitioner fees should be similar.

Suggestions that perpetrate the myth that one must simply add one claim and file the provisional application again as a non-provisional do many inventors a disservice (e.g., "the applicant would need

to: (1) Draft at least one claim and file the nonprovisional application using essentially a copy of the provisional application papers (e.g., specification and drawings), with minor revisions to add the claim(s) at the end of the specification and the reference to the prior-filed provisional application in the first sentence of the specification”). This will no doubt be quoted as what the USPTO recommends one do. In many cases, it will result in a pro se or poorly advised inventor adding a clearly defective claim to a clearly defective provisional application. In the case where this process is followed and the inventor begins marketing his invention shortly after filing the provisional, the failure to at least perfect the application with a quality non-provisional application prior to the one year grace period will essentially rob the inventor of his domestic and possibly foreign patent rights. A statement that adding a claim is a minor addition may be a very very bad assumption. I suggest that the Office examine a sample of the provisional applications filed and determine for itself if they are up to the quality standards that would suggest that adding a claim is only a minor thing. My experience has been that those looking for a low cost provisional application rarely give any thought at all to the claims that must be supported.

I have found that there are many inventors who have been led down the path of believing that their inventions are protected by a shoddy provisional (perhaps prepared pro se) only to find that the invention has evolved into something that differs dramatically from the disclosure of the provisional, or that the provisional was poorly prepared. Further, the “low cost” provisional application has been used as a lure to attract inventors to unscrupulous invention marketing firms, or may have led the inventor to feel secure in marketing his invention during the one year provisional period while having an inadequate basis for a solid priority claim. If the provisional application is poorly prepared or defective, simply adding a claim and a priority statement will not save the inventor’s patent rights. It is often only the efforts of a competent practitioner rescuing the application at the time of filing a non-provisional application prior to the one year date that salvages U.S. protection for the inventor. If this effort is delayed until two years or beyond, the inventor may lose his patent protection forever. This will no doubt happen if this rule is adopted.

Educational efforts need to be undertaken to help minimize the number of inventors that are led down the path of believing they have protection from a shoddy provisional application and I fear that permitting such an application to last for two years will serve to aid in robbing many inventors of patent protection by virtue of one of the above described events. I ask that you take these potential consequences into consideration when making the proposed rules. It would be useful for the Office to assume that the provisional is defective and explore various possible scenarios in which an inventor can be harmed. I am confident that carrying out such an exercise will reveal many potential problems that should be addressed in any rulemaking.

Perhaps a better way to save money for the inventor is to defer the requirement for search and examination fees until a search or examination is about to be conducted.

I hope these remarks are constructive.

Sincerely,  
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