From:
Sent: Tuesday, June 01, 2010 4:33 PM
To: extended_missing_parts
Subject: United Inventors Association Government Committee's comments re Missing Parts Change

Dear Eugenia A. Jones,

Please see the attached comments to the Missing Parts Change. Please feel free to contact me if you would like to discuss anything further.

Respectfully,
Bambi F. Walters
Chair – UIA Government Committee
United Inventors Association
bambi@bfwpc.com

UNITED INVENTORS ASSOCIATION
www.uiausa.org

Since 1990, the UIA has been the national 501(c)3 non-profit dedicated to inventor education and support. Our Mission is to provide reliable information to inventors, as well as Certification to inventor groups and inventor-friendly firms who agree to comply with rigorous professional and ethical standards.

June 1, 2010

VIA Electronic Mail
extended_missing_parts@uspto.gov

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

Attention: Eugenia A. Jones

UIA Comments in response to "Request for Comments on Proposed Change to Missing Parts Practice" 75 Fed. Reg. 16750 (April 2, 2010)

Dear Under Secretary Kappos:

The United Inventors Association (UIA) appreciates the opportunity to offer comments in response to the Notice of Request for Comments on Proposed Change to Missing Parts Practice. Comments are provided below on the Categories identified in the Notice and the areas of particular U.S. Patent and Trademark Office ("PTO") interest also addressed in the Notice.

Since 1990, the UIA has been the national 501(c)(3) non-profit dedicated to inventor education and support. Our Mission is to provide reliable information to inventors, as well as Certification to groups and inventor-friendly firms who agree to comply with rigorous professional and ethical standards. Our industry newsletter is estimated to reach over 10,000 independent inventors and at least 70 inventor groups nationwide. For more information, please see our website, www.uiausa.org.

The UIA appreciates USPTO Director Kappos' support of the independent inventor community and his dedication to beneficial patent reform. One instance of such reform is the topic of these comments: changing the non-provisional missing parts practice to achieve some of the advantages of an extended provisional pendency period. As the PTO observed, changing the statutory term of the provisional period from twelve to twenty-four months would likely raise myriad problems. Nonetheless, the additional time would undoubtedly benefit inventors small and large. The UIA cautions that the advantages gained by the proposed changes are coupled with vast opportunities for confusion among independent inventors. Without sufficient education, the proposed rule could do more harm than good. The UIA applauds the PTO for its dedication to address inventor concerns and its creative solution for reducing the costs due twelve months after filing a provisional patent application.

Notwithstanding the UIA's esteem for both the PTO and the proposed changes, we have some minor reservations. First, the UIA is concerned with the labeling of the proposed

changes. Several popular secondary sources within the patent industry fallaciously describe a proposed twenty-four month provisional application period.[1] However, the UIA urges the PTO to be wary of endorsing such a characterization. We fear that inventors may come to assume that the changes proposed are simpler than they are in reality.

A so-called twenty-four month provisional infers that inventors have a full two years to file a non-provisional application. A significant number of provisional applications are written *pro se* or with the, arguably nominal, help of an invention promotion company. Such applicants may believe that they can delay approaching a registered practitioner for an extra year, under the proposed changes. From this delay precipitates issues worthy of consideration.

A provisional patent application is valuable primarily if it enables an applicant to claim an earlier date of priority in a corresponding non-provisional application. For such a claim to be valid, the provisional application must be enabling at the time it was filed. Yet, a significant number of inventors each year file provisional patent applications with disclosure falling short of enabling. Fortunately, those who wish to continue to pursue patent protection usually come to a registered practitioner, within the twelve-month pendency of the provisional application. Even if a priority claim cannot properly be made, not all is lost: the practitioner can still file a proper non-provisional application with a new filing date, because the provisional application was never published. The inventor may lose a year of priority rights, but not his or her patentability rights.

The proposed changes benefit most the applicant attempting to delay costs. If one is delaying PTO costs, one is likely delaying other costs as well. Instead of approaching a practitioner before the twelve-month mark, an inventor misled into believing he has a twenty-four month provisional may not do so until between twelve and twenty-four months. The inventor thus would not learn of his provisional application's deficiency until up to two years after filing it. Though the applicant may then file a full and enabling non-provisional, his or her reluctance to incur costs results in up to two years of priority time lost. During these two years, developments in the art capable of defeating patentability given the new, later, priority date could very well occur.

Second, the UIA urges the PTO to couple these changes with an increased promotion of inventor education. It is important for applicants to know the significance of filing provisional patent applications. This knowledge is common among those inventors who consult with a registered practitioner, but not necessarily among those filing a provisional *pro se*.

Included in this education should be the observation that <u>delaying</u> costs by taking advantage of the altered missing parts practice does not <u>reduce</u> costs. Quite the contrary: the inventor must also pay a $63 surcharge by twenty-four months. Yet this surcharge would be dwarfed by the additional registered practitioner's fees the inventor will likely

[1] *See, e.g.*, "USPTO Proposes 24 Month Provisional Application Pendency," Gene Quinn, IPWatchdog, http://www.ipwatchdog.com/2010/04/01/uspto-proposes-24-month-provisional-application-pendency (last visited June 1, 2010).

incur between twelve and twenty-four months. Instead of a single set of fees to file a non-provisional, the inventor may need to pay one round of fees for the filings for the twelve-month mark and a second round of fees for the twenty-four month mark. Though the first round should be lower than the cost of a full patent, the sum of the fees from both rounds will exceed the costs of a single filing. It is true that the extra year of commercialization may furnish a superior opportunity to fund these costs, even if the sum is higher than before, and the changes are surely an improvement. Nonetheless, inventors should be made aware of the thorns on this rose.

The UIA appreciates the opportunity to provide these comments on the extension of the provisional patent process and would be pleased to answer any questions that our comments may raise. We look forward to participation in the continuing development of practices and procedures affecting independent inventors.

Meanwhile, the UIA's focus remains on providing independent inventors with what they really need to succeed: reliable information supported by careful studies, certification to inventor-friendly resources and practical educational tools to see ideas become inventions, real wealth, and real jobs. Together, we strive to keep inventing safe, rewarding, and fun!

Sincerely,

Bambi Faivre Walters

Bambi F. Walters
Chair – UIA Government Committee
United Inventors Association
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