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Sent: Monday, November 07, 2011 5:30 PM
To: aia_implementation
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Subject: Derivation proceedings

MIPLA Suggestions for Group 2 Rulemakings:
Subgroup 10 – Derivation Proceeding Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings – Subgroup 10 – Derivation Proceeding Rules.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 10 – Derivation Proceeding Rules, MIPLA has the following suggestions:

10.1 Timing to Initiate a Derivation

We suggest that the Office should interpret the language in new Section 135(a) to apply to the first publication of a “derived” claim, regardless of whether that happens in a published application or patent, and regardless of whether the first publication is on a case filed by the alleged deriver or the party alleging derivation.

10.2 Obviousness-type Standard for Derivation

We suggest that the Office should promulgate regulations that use an “obviousness” type derivation standard as set forth in New England Braiding v. Chesteron 970 F.2d 878 (Fed. Cir. 1992), DeGroff v. Roth, 412 F.2d 1401 (CCPA 1969), Agawam v. Jordon, 74 US 583 (1868).

10.3 Reissue Available for a Derivation

We suggest that the Office should permit cases to be used to petition for an initiation of a derivation proceeding.

10.4 Derivation Petition Considered Only After Claims Otherwise Allowable

We suggest that the Office should not consider a derivation until such time as the claims are otherwise in condition for allowance.

10.5 Split Resolutions in a Derivation

We suggest that the Office should permit split resolutions as part of a derivation proceeding.

10.6 Claim Amendments in a Derivation

We suggest that the Office should permit claim amendments as part of a derivation proceeding.

10.7 Validity Challenges in a Derivation

We suggest that the Office should permit challenges to the validity of a claim at issues as part of a derivation proceeding.

10.8 Transfer Derivations to PGR

We suggest that the Office should transfer interferences to review proceedings as soon as issues related to inventorship are resolved, and, the party alleging derivation should be required to pay the fees for PGR proceeding should be waived for such a transfer.

Submitted on behalf of MIPLA.

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