

From: Brooke Schumm [e-mail address redacted]
Sent: Monday, October 24, 2011 11:14 AM
To: Gongola, Janet
Subject: Comment on 18-month first to file and effective filing date

Janet:

As always, it was nice to see you. I hope you can deposit this comment where it belongs.

As I read the AIA, for applications with an effective filing date after 18 months, March 16, 2013, I believe, the first to file rule will generally prevail.

One peculiarity, which I am not sure the Office can circumvent by rule or regulation, but which is certainly a trap for the unwary, is that if you enter the national stage on a PCT application and say forget the oath, you do not receive a U.S. filing date until the application is complete. You don't lose your claim of priority, it just has a later effective filing date.

I am sure you can see where this is going. For applicants who say had a priority date of September 1, 2010, citing to a provisional of that date, and who timely filed their PCT application on September 1, 2011, properly claiming benefit and did not have an oath (not required for PCT), and then entered the U.S. National on a timely basis at 30 months on March 1, 2013, but failed to file an oath contemporaneously, or had an error in it (a missing electronic signature slash for instance), they who thought they could get the benefit of a U.S. first to conceive regime will probably only find out after March 16, 2013 (by notice of missing parts) that in fact they have an effective filing date post-March 16 when they get their package with oath completed. Thus, they accidentally dropped themselves into a first to file regime. They keep their priority dates, but cannot claim a first-to-conceive priority in an interference.

Thanks for our conversation. See you at the Inn next month I hope.

Brooke.

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