

From: Weidner, Timothy [e-mail address redacted]
Sent: Friday, September 09, 2011 3:23 PM
To: ai_a_implementation
Subject: Patents Issue I. A. i - Foreign-based Prior Art Under 102(d)(2)

Attn: Hiram Bernstein
Senior Legal Advisor, Office of Patent Legal Administration

A change in the law: Examiners will be able to refer to a foreign filing priority date (119) as a prior art date under 102(d)(2) when rejecting claims with a reference under 102 or 103. Is a translation necessary? Whose burden should the translation be?

Other than the translation part, it's similar to the facts of *In re Giacomi* (Fed. Cir. 2010) regarding section 119 provisional application filing dates as prior art dates. Who is responsible for checking that a provisional provides support? It should fall on the examiner first since the examiner has the burden of proof, then it should fall on the applicant second to confirm or dispute it. Likewise, I imagine foreign support will be the responsibility of the examiner first, and applicant second.

Simply assuming that things are supported in priority documents could be problematic.

So here's a proposal: When an examiner is citing prior art which relies upon a foreign filing date as an effective date, the examiner should check for support in, and provide in the file, a machine translation of the foreign priority document. Please feel free to contact me with any questions or comments.

Thanks,

Tim
Timothy Weidner