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November 18, 2011

Hon. David J. Kappos  
Under Secretary of Commerce for Intellectual Property  
And Director of the U.S. Patent and Trademark Office  
600 Dulany Street  
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Alexandria, VA 22313

Submitted via: [aia\\_implementation@uspto.gov](mailto:aia_implementation@uspto.gov)

**Re: Group 2 Rulemakings**

Section 4—Inventor's Oath or Declaration and Assignee Filing  
Section 6—§ 301 Citation of Prior Art and Written Statements  
Section 8—Preissuance Submissions by Third Parties

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide preliminary comments to the U.S. Patent and Trademark Office (USPTO) concerning the rules packages that are under development in connection with provisions of the America Invents Act (AIA). These preliminary comments do not necessarily represent the final views of IPO regarding the subject matter discussed herein. Time did not permit review by the full Board of Directors. IPO will be submitting official comments in response to the USPTO's Notices of Proposed Rulemaking.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members.

IPO's preliminary comments below are directed to three subjects of the Group 2 Rulemakings:

1. Inventor's Oath or Declaration and Assignee Filing pursuant to AIA Section 4;
2. Citation of Prior Art and Written Statements in a Patent File pursuant to AIA Section 6; and
3. Preissuance Submissions by Third Parties pursuant to AIA Section 8.

We are submitting a separate letter with preliminary comments on Post Grant Review and *Inter Partes* Review.

**1. Inventor's Oath or Declaration and Assignee Filing pursuant to AIA Section 4**

a. Inventor's oath or declaration

In accordance with the changes made to 35 U.S.C. §§ 115 and 118 in Section 4 of the AIA, we support drafting rules that will streamline and simplify the patent process. Such rules will allow rightful intellectual property owners to avoid unnecessary filing costs and delays and prevent a loss of rights in their inventions.

b. Time for filing an oath or declaration, substitute statement, or assignment declaration

The AIA amends 35 U.S.C. § 115 to allow a notice of allowance to issue only if an appropriate oath or corresponding document (applicant statement) has been filed. While the applicant statement remains an element of a complete application under § 111, the amendments to § 115 make clear that the applicant statement need not be submitted at initial filing of the patent application. Accordingly, we suggest that the USPTO develop rules that confirm examination will not be halted until an applicant statement is filed.

According to the legislative history, the purpose of the AIA Section 4 amendments is to streamline the oath and declaration process and to make it easier to file applications. In keeping with this objective, there is no reason for the applicant statement to impede examination. Indeed, we ask that the proposed rules confirm that the USPTO will not issue a notice of missing parts in the absence of the applicant statement. Examination should proceed, and a notice of allowance should issue if an application is otherwise allowable and complete but for the filing of the applicant statement.

These changes will facilitate faster and simpler filings, reduce costs associated with responding to notices of missing parts, and reduce overall prosecution time.

c. Streamlining documents and procedure

35 U.S.C. § 115(e) allows for the required statements of an oath or declaration to be included in an assignment executed by an inventor (combined assignment). Under current practice at the USPTO, two separate submissions are necessary: (1) filing of an oath or declaration; and (2) recordation of an assignment. We suggest that the USPTO develop rules that allow for a single submission of the combined assignment. This will facilitate faster and simpler filings, reduce costs associated with duplicative submissions, and reduce overall prosecution time.

35 U.S.C. § 115(g)(2) allows for the Director to require a copy of an executed oath or declaration from a parent application to be included in a later-filed application. We suggest that the USPTO waive this latent requirement for continuation and divisional applications, and instead develop rules that allow for an incorporation-by-reference of the oath or declaration of the parent application in the later-filed continuation or divisional application. This will facilitate faster and simpler filings, reduce costs associated with duplicative submissions, and reduce overall prosecution time.

d. Right to file an application

The AIA also amends 35 U.S.C. § 118 to allow persons other than the inventor to file an application for a patent. The amendments to § 118 not only broaden the filing authority for persons to whom the inventor has assigned or is under obligation to assign beyond the traditional circumstances where an inventor cannot be found or reached after diligent effort, but also extend filing authority to persons who otherwise show “sufficient proprietary interest in the matter” upon “proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.” The AIA does not clarify the type of “proprietary interest” showing required but rather leaves such determinations to the USPTO.

We suggest that the USPTO develop rules that confirm an affidavit or declaration is sufficient to meet the proprietary interest showing requirement of amended § 118. The submitted affidavit or declaration should contain both the facts and circumstances demonstrating an applicant's good faith understanding of its proprietary interest and the traditional requirements for affidavits (statements must be made under oath before a notary public, magistrate, or officer authorized to administer oaths) or declarations (acknowledgement by the declarant that willful false statements may be punishable by law and may jeopardize the validity of the application or any patent that issues therefrom). We believe these requirements will sufficiently limit improper filings while ensuring that parties having rights in an invention can act to protect the invention without undue delays and the associated loss of rights risk.

## **2. Citation of Prior Art and Written Statements in a Patent File Pursuant to Section 6**

IPO encourages the USPTO to adopt regulations for compliance with § 301 of the AIA that facilitate consistency in the claim interpretations adopted in proceedings before the federal courts and the USPTO, but discourage abusive delay tactics such as the submission of large volumes or numerous submissions of erroneous information or documents to the USPTO.

We invite the USPTO to provide guidance on the explanation of pertinence and applicability required by subsection (b). For example, the new regulations may provide distinct content guidelines for written statements submitted pursuant to (a)(1) and (a)(2). IPO suggests that a written statement submitted pursuant to (a)(2) contain an explanation of the claim interpretation believed to be expressed in the patent owner statement.

We also suggest that the USPTO provide guidance as to how the USPTO will consider written statements submitted pursuant to (a)(2) in light of the different approaches to claim interpretation by the USPTO and the federal courts. The USPTO applies the broadest reasonable interpretation, while the federal courts construe a claim in light of its ordinary meaning, the associated specification and file history, and extrinsic evidence (in some cases), and may reach a narrower interpretation than the broadest reasonable interpretation.

Additionally, the regulations may include an example of an acceptable explanation of pertinence and applicability, as is currently included in M.P.E.P. § 2205 for patent or printed publication submissions.

IPO suggests requiring each submission of a statement under (a)(2) to include the following information: (a) forum in which the statement was made (i.e., federal court, USPTO); (b) federal court case number or U.S. patent application number; (c) status of proceeding in which statement was made; and (d) relationship of proceeding to the patent for which the submission is being made. Such information would allow the USPTO and others to quickly identify and verify the source of the statement.

We further suggest requiring any additional information submitted under subsection (c) to include the identification of relevant or relied upon passages as well as a statement of the relevancy of the information to the patent owner's statement. The additional information submitted could be voluminous and this would allow reasonably quick and efficient evaluation of the information.

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IPO recommends providing for the submission of supplemental affidavits or declarations explaining the contents of an (a)(2) submission, such as is currently allowed for patent or printed publication submissions under M.P.E.P § 2205.

We also suggest clarifying the meaning of “Federal court” in § 301(a)(2) to include proceedings before the International Trade Commission (ITC). The ITC is a frequently used forum for patent enforcement.

IPO suggests providing the patent owner with a period in which to submit a reply to any submission made under § 301 that will be entered into the patent file. This would provide the patent owner with a reasonable opportunity to protect its asset.

### **3. Preissuance Submissions by Third Parties pursuant to Section 8**

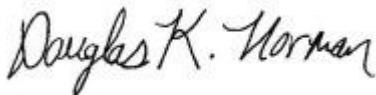
The AIA amends 35 U.S.C. § 122 to allow preissuance submissions by third parties. We support drafting rules that clearly set forth the requirements for third parties to submit prior art publications for consideration and inclusion in the record. Such rules will allow rightful intellectual property owners to avoid impermissible or inaccurate descriptions of prior art publications by third parties while improving patent quality by ensuring consideration of the most relevant prior art.

Pursuant to part (1) of new § 122(e), a third party may submit “any patent, published patent application or other printed publication of potential relevance to the examination of the application” as long as the submission is made in writing and within the designated period. Since the statute will encompass any “other printed publications,” IPO suggests that the USPTO develop rules that will accommodate the submission of publications that are available only in electronic format.

Although some electronic documents do not include a readily apparent publication date, the rules should establish procedures that allow a third party to authenticate a document either under appropriate evidentiary rules (e.g., the Federal Rules of Evidence) or by submission of a declaration. Such a declaration should include information pertaining to how and when the third party accessed the electronic document. Where appropriate, the declaration may rely on websites, such as [www.archive.org](http://www.archive.org), which allow a user to determine the content of a website as of a particular date. Regardless of the procedure used to substantiate the date of publication of electronic publications, the rules should clearly convey that the third party will bear the burden of establishing the publication date of the electronic publication.

IPO again thanks the USPTO for consideration of these preliminary comments and would welcome any further dialogue or opportunity to support the USPTO concerning this matter.

Sincerely,



Douglas K. Norman  
President