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Hon. Michelle K. Lee
Deputy Under Secretary of Commerce and Director of the
United States Patent and Trademark Office
IP.Policy@uspto.gov

Re: **Proposed Rulemaking to Further Implement First-to-File**

Dear Ms. Lee:

This letter constitutes a request for rulemaking by the Office. The rulemaking would further implement the first-to-file regime of the *Leahy Smith America Invents Act* of 2011. The proposed implementation provides a pathway to stop an unintended discrimination against American applicants who file first at home, *versus* the simpler “home country” procedures open to their competitors in Asia and Europe:

The American applicant is encumbered by unnecessary formalities early in the filing process. They *delay* the critical priority date in the race to first-to-file. In contrast, the Asian or European applicant has a simpler path to a first filing in the “home country”, and through the Paris Convention gains an earlier effective filing date in the United States. Such applicant is therefore given a leg up in the “race to the courthouse” because his filing in Tokyo or Munich is effectively his first-to-file date in Washington, D.C.

Consideration of the proposed changes should not be viewed as partisan. Indeed, you are being provided with the first release of the proposed rules so that you may take a leadership position in seeing their implementation. Your earliest help will mitigate continued discrimination against the American inventive community inadvertently created through the current quagmire of unnecessary features in the *Rules of Practice in Patent Cases*.

This letter is written *pro bono* without client sponsorship. Although the writer is President of The Naples Roundtable, Inc., this letter is written strictly on the writer's own personal behalf without review by The Naples Roundtable, Inc.

The Twin Objectives of the Proposed Rulemaking

In the first instance, the proposed changes in the *Rules of Practice in Patent Cases* permit applicants to defer certain formalities for up to fifteen months from the effective filing date, thereby permitting American applicants to file their first, priority application more quickly, on a time frame equivalent to their Asian and European counterparts.

In the second instance, some of the formalities currently required by the *Rules of Practice in Patent Cases* and the *Manual of Patent Examining Procedure* are anachronistic or otherwise no longer serve a public function. In one extreme case, a once-statutory requirement to disclose the "nature" of an invention that dates back to the Patent Act of 1836 has continued in the rules to the present day, despite the fact that as from January 1, 1953, the statutory basis was removed.

Specific Proposals to Streamline the Patent Filing Rules

Here are certain proposed changes in the *Rules of Practice in Patent Cases*. The changes would streamline procedures and put American applicants on a par with their Asian and European colleagues in the race to the Patent Office to secure the vital priority date in the brave new world of first-to-file:

(I) ELIMINATION OF REQUIREMENT FOR SPECIFIC CLAIM FORM

37 CFR § 1.71 Detailed description and specification of the invention.

* * *

(c) **[deleted]** *[In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.]*

* * *

Commentary: There is simply no statutory basis for Section 1.71(c). The requirement only adds additional work for the applicant, without serving any statutory purpose nor benefit to the public at large.

(II) SIMPLIFIED ABSTRACT REQUIREMENT

37 CFR § 1.72 Title and abstract.

* * *

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading “Abstract” or “Abstract of the Disclosure.” The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

(c) In lieu of the requirements of the foregoing paragraph, it shall be sufficient to recite verbatim the elements of the broadest claim and, in the case of an invention of a chemical or biotechnology product, a specific utility for the product should be stated.

Commentary: Proposed Section 1.72(c) would permit an applicant to draft an *Abstract of the Disclosure* that is essentially a verbatim copy of claim 1.

The current *Abstract* requirement adds nothing to help the patent community to understand the invention which should be clear from claim 1 itself. Furthermore, where the patent applicant drafts an *Abstract of the Disclosure* in accordance with instructions from the *Manual*, different language will be used to describe the invention than in the claims which can be used to *narrow* the effective scope of the claimed invention. See *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.* (Fed. Cir. 2000)(Bryson, J.); *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000).

Why not *abolish* the requirement for an *Abstract of the Disclosure*? This is a good idea, but not immediately practical, because the current requirement is part of the statute.

(III) SUMMARY OF THE INVENTION

37 CFR § 1.73 Summary of the invention.

(a) A brief summary of the invention **should recite verbatim the elements of the broadest claim** [*indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.*]

(b) **The applicant shall have the right to include a specific definition of any element of the claims, in which case the specific definition shall cabin the scope of such element in proceedings before the Office and not admit an otherwise broadest reasonable interpretation of that element.**

Commentary – Parallel Wording to the Claims: Under current Rule 73, the “nature”, “substance” and “object” of an invention are no longer required by statute or case law; they represent anachronistic requirements that have nothing to do with the realities of modern case law and, more importantly, serve no public purpose to educate the readership of the patents nor assist the Examiner in his appointed tasks. For example, while there is a deep history of a requirement for disclosing the “nature” of an invention that includes codification in the Patent Act of 1836, the requirement to disclose the “nature” of the invention has never been a part of Title 35 of the United States Code since it was first introduced January 1, 1953, *more than sixty (60) years ago*.

Commentary – Trumping *Cuozzo Speed*: Proposed Rule 73(b) would encourage applicants to define elements at the point of novelty, and thereby cabin an otherwise “broadest reasonable interpretation” of such elements under *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1282 (Fed. Cir.2015), *aff’d sub nom Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131 (2016).

(IV) TOO MANY CLAIMS

37 CFR § 1.75 Claim(s).

* * *

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied. **Where more than twenty claims are presented in an application and there is apparent duplication amongst two or more claims, the Examiner may require the applicant to explain why all claims are necessary and require provisional election of no more than twenty claims for further prosecution.**

* * *

(d)(1) The claim or claims must conform to the invention as set forth in the **Summary of the Invention** [*remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a))*].

* * *

(e) **reserved** [*Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:*

(1) *A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,*

(2) *A phrase such as “wherein the improvement comprises,” and*

(3) *Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.]*

* * *

Commentary – Undue Multiplicity: Section 1.75(b) is designed to curb the presentation of an unreasonable number of claims to restore an effective “undue multiplicity” basis to curb the abuse where literally hundreds of claims are filed in some cases. For example, Professor Crouch in 2014 provided a top ten list of applicants who each obtained a patent with anywhere from 213 to 404 claims. Dennis Crouch, *Jumbo Patents of 2013*, PATENTLY-O (Jan. 20, 2014)

The Federal Circuit in *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293 (Fed. Cir. 2016)(Moore, J.), following *Hyatt v. U.S. Patent & Trademark Office*, 797 F.3d 1374, 1376 (Fed. Cir. 2015), has implicitly reiterated its support for the right of the Patent Office to limit the number of claims under consideration. There clearly should be no hard and fast numerical limit on the number of claims that the applicant may present to an invention. But, to the extent that there are, say, hundreds of claims, the Office has a right *and a duty* to police any evident abuse of the system with the tools at hand, particularly a rejection based upon “undue multiplicity”.

Commentary – Summary of the Invention: Section 1.75(d) would encourage applicants to include a verbatim recitation in the *Summary of the Invention* parallel to the claims.

Commentary – Summary of the Invention: Section 1.75(e) would eliminate the preference for “Jepson” claiming.

(V) PRIOR ART CITATION

37 CFR § 1.97 Filing of information disclosure statement.

Unless the applicant files a *Background of the Invention* under § 1.99, the applicant shall file an Information Disclosure Statement under this section and § 1.98:

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within **fifteen** [*three*] months of the **later of the** filing date of a national application **or claimed priority date of such national application** other than a continued prosecution application under § 1.53(d) ;

* * *

Commentary -- Background to Satisfy the Duty of Disclosure: Section 1.97 would simplify meeting the duty of disclosure by permitting the applicant to choose the new *Background of the Invention* section instead of the more cumbersome rule of current §§ 1.97, 1.98.

Commentary – Time to file an IDS: American applicants today are disadvantaged in the first-to-file race to the Patent Office to obtain a priority date. New Section 1.97(b)(1) would move to parity by requiring information disclosure for everyone, fifteen months from the priority date.

(VI) BACKGROUND OF THE INVENTION

§ 1.99. Background of the Invention¹

(a) An applicant may file a section captioned *Background of the Invention* as part of the patent application which shall consist of a list identifying the most pertinent prior art known to the applicant; a copy of each cited reference shall

¹ There is neither a statutory nor rules basis for a *Background of the Invention*. Instead the requirement for a *Background of the Invention* is found in MPEP § 608.01(c), *Background of the Invention*:

“The Background of the Invention may include the following parts:

“(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

“(2) Description of the related art including information disclosed under 37 C.F.R. 1.97 and 37 C.F.R. 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).”

accompany the citation. A *Background of the Invention* meeting the requirements of this section shall be considered to meet the duty of disclosure under 37 CFR §§ 1.97, 1.98.

(b) The *Background of the Invention* may be filed either as part of the original application or by amendment at any time up to fifteen months from the earliest claimed priority date, accompanied by a copy of each cited reference.

(c) If the *Background of the Invention* contains more than five prior art citations, the applicant shall certify that none of the prior art in the *Background of the Invention* is clearly less pertinent than the closest cited prior art.

Commentary: Section 1.99(a) would permit satisfaction of the duty of disclosure by simple *citation* of the best prior art.

Under Section 1.99(b) neither American nor overseas applicants would have an advantage in the “race to the courthouse” first-to-file regime because the deadline would be fifteen months from the *priority* date.

Section 1.99(c) would end the “document dump” system whereby applicants heretofore would accumulate every possible reference for citation to the Office, sometimes amounting to dozens of references. Now, a maximum of five prior art references could be cited without culling out less relevant prior art, but with the proviso that there would be no limit on the number of citations provided the applicant culled out the clearly less relevant prior art.

* * *

(VII) RELATED CHANGE

37 CFR § 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

* * *

(7) Background of the invention, **if present**. * * *

Commentary: The proposed change would emphasize that a *Background of the Invention* section is an optional feature.

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If you have any questions, please feel free to contact me.

Respectfully submitted,

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