

**From:** Paul Morgan <pmorgan5@rochester.rr.com>  
**Sent:** Thursday, October 13, 2011 4:22 PM  
**To:** IP Policy  
**Subject:** PTO Requested comments on the AIA "Prior Commercial Use" Defense Legislation

This is response to your FR notice requiring a rapid public response.

As you know, this AIA Sec. 5 legislation will essentially expand the scope of the present prior user rights statute (35 USC §273) from business method patents to many other patents.

It is important to note that a *statistically significant substantial number* of subject business method patents have issued in the years since §273 was enacted in 1999. [Albeit I do not know the exact number, and that would depend on how broadly the scope of §273 would be judicially determined. As far as I am aware, it never has been.] In any case, it is important to note that I and others who have researched reported cases on usage of that present statute *have not found a single reported case* in which the successful use of this statute has been reported, and only one in which it had even been attempted. Thus, there would seem to be valid statistical support for projecting in your study a *very small usage* of the new AIA Sec. 5, contrary to some of the hyperbole by some of its opponents.

That should not be surprising, since few prior commercial uses do not also generate prior art which can be used to defend against later filed patents without the added burdens and dangers this statute requires to establish its purely personal defense [which does not invalidate any patent]. However, this new statute may provide important potential protection needed in some cases because of the AIA elimination of the present 35 USC §102(g) defense of prior invention.

As your FR notice requires, this is a statement that I do not represent *anyone's* interests. This is a purely *pro bono* personal comment by a retired patent attorney.

Thank you,

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