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May 4, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents
P.O. Box 1450
Alexandria, VA 22313–1450

Attn: Nicolas Oettinger
Office of the General Counsel

Re: Comments on Request for Information: *Improving Regulation and
Regulatory Review*, 76 Fed. Reg. 15891 (March 22, 2011) (the
“Improved Review”)

Dear Under Secretary Kappos:

On behalf of the American Bar Association Section of Intellectual Property Law (the “Section”), I am writing to provide comments in response to the request by the United States Patent and Trademark Office (the “Office”) published in the Federal Register on March 22, 2011 (PTO–P–2011–0017). These comments have not been approved by the American Bar Association House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section is generally supportive of the Office’s efforts to improve its regulatory review process and to enlist the intellectual property community’s assistance in identifying and prioritizing new proposals for improving processes at the Office. In particular, the Section favors providing improved outreach to practitioners to identify problematic regulations or proposed regulations through a variety of techniques outlined below. Moreover, the Section notes with appreciation the work done by the Office in improving and identifying these processes and its willingness to discuss openly new proposals through town hall meetings and through the Office’s website.

In addition, the Section applauds the Office’s targeted customer outreach efforts, including, for example, the Biotechnology Partnership, the Business Methods Partnership, the CleanTech Customer Partnership, the Communication Technology Partnership, Design Day, the Semiconductor Partnership, the Nanotechnology Customer Partnership, the Women’s Entrepreneurship Symposium and Patent Examiner Technical Training Program. As discussed in greater detail below, the public would be well served by strengthening and expanding the Office’s existing outreach efforts.

It should be noted that the Section has concerns that the full effect of Executive Order 13563 will not be achieved since Order 13563 requires a 60 day opportunity to comment, whereas the Notice in the Federal Register, *Improving Regulation and Regulatory Review*, 76 Fed. Reg. 15891 (March 22, 2011), indicates only a 30 day opportunity to respond. As such, it is believed that the shortened response time should be extended to allow additional comments consistent with Executive Order 13563. The following comments highlight the Section's position on these and other issues raised by the Improved Review and would like the opportunity, should additional time be permitted consistent with Executive Order 13563, to supplement these remarks.

Question 1. What is the best way for the Office to identify which of its significant regulations should be modified, streamlined, expanded, or repealed? What process should the Office use to select rules for review and how should it prioritize such review?

In order to identify and prioritize potential regulatory changes, the Section believes that the Office should continue existing techniques. For instance, the Section supports the Office's use of Town Hall meetings and similar meetings with the intellectual property community to explain current initiatives and to receive further comments for potential improvements. In addition, the Section believes the public would benefit if the Office were to supplement these efforts to improve its information gathering capability using a variety of new techniques as set forth below.

- Survey different Office communities using the Office's existing websites:
 - Electronic Filing System /Private PAIR to reach patent applicants;
 - Public PAIR to reach non-applicant participants, such as reexamination requestors;
 - TEAS to reach trademark applicants;
 - TARR to reach trademark applicants and non-applicant participants such as potential opposers;
 - ESTTA and TTABVUE to reach trademark applicants and non-applicant participants such as opposers; and
 - General web page to reach the general public, such as independent inventors.
- Increase the staff dedicated to specifically address concerns on regulations and provide access to this staff via the Office's page. For example, the Ombudsman Pilot Program has been a helpful mechanism for addressing issues that arise during patent application prosecution when there is a breakdown in the normal prosecution process. In order to address issues that may be more systemic in scope, it would be helpful to create an online portal (i.e., an online ombudsmen for regulations) through which practitioners can identify problem regulations and suggest potential solutions.
- Perform regular polling of IP associations to have these associations identify problematic regulations.
- Conduct reviews of regulations in areas where there are a disproportionate number of applicant or Office procedural mistakes; mistakes on purely procedural matters often can be a good indicator that a regulation needs improvement. To identify such mistakes:

- Trigger the reviews by Notices sent to applicants to correct formalities which would indicate a common set of problems experienced by the Office and users; and
- Review Petitions to the Commissioner and Petitions under 37 C.F.R. § 1.183 to determine areas in which regulations need improvement as applicants typically do not file Petitions when the regulations are working properly.

The Section also believes that the public would additionally benefit if the Office strengthens its information evaluation with this gathered information as follows:

- Form additional advisory groups with practitioners and pro se applicants with respect to both patents and trademarks to select and prioritize changes in the regulations;
- Continue efforts to consult with other patent and trademark authorities with a similar level of sophistication, e.g., JPO and EPO;
- Form advisory groups to evaluate the monetary effect and difficulty in implementing regulations with practitioners and pro se applicants in order to give the Office direct experiences with the effect that new regulations can have without needing to rely on consultants to perform this function. Using advisory groups would likely help determine which regulations will have unintended burdens and difficulties; and
- Provide more feedback on existing proposals, such as the status of whether a proposal remains viable and when another action is anticipated as well as an outline of alternatives to each proposal to provide context to pending proposals.

Question 2. What can the Office, relative to its regulation process, do to reduce burdens and maintain flexibility for the public while promoting its missions?

The Section believes that the Office can improve its process of examining the need for, and use of, information or submissions required under existing regulations. In essence, is the Office requiring applicants to supply information and documents which it cannot or does not use, or which does not better inform the public about the scope of the patents or trademarks being examined? Examples include the following:

- 37 CFR 1.83 requires every claimed feature be illustrated, if the drawings are presented, even when such drawings do not improve the understanding of the invention, which is what is required under 35 U.S.C. § 113; and
- The Office routinely requires inventor addresses for represented inventors instead of just seeking them when there is a need to contact the inventors. The interests of the represented inventor are already protected since the registered practitioner has a duty to be able to contact the inventors.

The Section also believes that there should be a check on the logic of deadlines imposed. Specifically, is the Office requiring that actions be taken well before the Office needs to or can react? An example includes the following:

- 37 CFR 1.111(a)(2) restricts what can be submitted to supplement a response, even though the Examiner has not taken up the file for action.

The Section also believes that the Office should ensure forms implementing regulations properly track the regulations. An example includes the following:

- The Advisory Action form does not properly track 37 CFR 1.116.

The Section also believes that the Office should ensure that the regulations track statutory language and provide different mechanisms for complying in different situations. An example includes the following:

- For claiming domestic priority, 35 U.S.C. § 120 requires only that the specification contains “the specific reference to the earlier filed application”, whereas the Office requires in 37 CFR 1.78(a)(2) both that the specification include: 1) this specific reference required under 35 U.S.C. § 120; and 2) that the type of priority is specified (i.e., continuation, divisional). Yet, if the inventor has satisfied only 1) with the specific reference and thus complied with the statute, the inventor must file a complete Petition for an “Unintentionally Delayed Benefit Claim” and pay a large entity fee to comply with the regulation instead of being allowed to revise the specification. There is no statutory basis for the second requirement (2), and, while inventors should be required to amend the specification, there should not be a required fee.

The Section also believes that the Office should ensure that the Actions identify or suggest possible changes which will shorten prosecution. An example includes the following:

- While Office Actions from Patent Examiners will provide reasons for allowability for claims having allowable subject matter, there is no mechanism for suggesting additions to claims which, if adopted, would increase the number of allowed claims or place the entire application in condition for allowance.

The Section also believes that the Office should work to ensure that the Office of Petitions is more accessible and provides a more meaningful, timely review of filed Petitions. An example includes the following:

- Currently, Petitions are not necessarily decided before a next action by the Examiner, which can render the filing of a Petition moot. The Office should ensure that the Examining Corp and the Office of Petitions have synchronized timetables for responding, which would also help the Office in identifying potentially problematic regulations. This is particularly true in the CRU, as the CRU Examiners are required to act with “special dispatch,” and therefore often act prior to Petitions.

Question 3. How can the Office ensure that its significant regulations promote innovation and competition in the most effective and least burdensome way? How can these Office regulations be improved to accomplish this?

In answer to Question 3, the Section suggests the Office reduce to the minimum the information and actions required of applicants. In order to accomplish this reduction, the Section suggests that the Office:

- Do an analysis of whether it is more cost effective for an applicant or the Office to supply information to a file; and
- Identify those actions routinely required of applicants that could instead be selectively requested in given cases because the actions are only useful in a limited number of cases.

Moreover, the Section believes that the Office should review the texts of regulations for understandability and access by applicants. Examples of how this can be accomplished are as follows:

- Create advisory panels of both practitioner and pro se applicants to focus on readability of the regulations.
- Review guidance documents with a view to eliminating inconsistencies and redundancies. While the Office has implemented a “Discuss the MPEP” and “Discuss the TMPEP” web discussion tools, which allow such submissions on very specific sections, these tools are limited to specific sections as opposed to the entire MPEP or TMPEP. There is further no such commentary for appellate procedures at the Trademark Trial Appeal Board.
 - For instance, consider whether MPEP 700 Examination of Applications should be consolidated with MPEP 2100 Patentability
 - Create a “Discuss the TTAB Manual of Procedure” web discussion tool similar to the existing “Discuss the MPEP” and “Discuss the TMPEP” web discussion tools
- Consolidate the sources of guidance, which are currently distributed on various Office webpages, in addition to the MPEP and the TMPEP.
 - Consider putting “pilot” programs such as the Pre-Appeal Brief Conference in the MPEP.
 - Consider moving established procedures such as Accelerated Examination (MPEP 708.02(a)) from the MPEP to CFR.
 - Complete the TTAB Manual of Procedure, which has not been updated since March 2004.

Question 4. Are there Office regulations that conflict with, or are duplicative of, regulations from other agencies? If so, please identify any such rules and provide any suggestions you might have for how this conflict or duplication can be resolved in order to help the Office achieve its mission more effectively?

In view of the time constraints identified above, the Section has not identified specific Office regulations which conflict with regulations at other agencies. However, the Section suggests that such inconsistencies can be identified in the following manner:

- Conduct a survey of practitioners, requesting that they identify inconsistent or duplicative regulations from other agencies. The survey response would probably be improved if the Office identified the other agencies it feels might have such regulations.
- Review petitions to the Commissioner and court actions involving the Office to determine how other agencies are considering the issue being raised.

Question 5. How can the Office best encourage public participation in its rule making process? How can the Office best provide a forum for the open exchange of ideas among the Office, the intellectual property community, and the public in general?

The Section notes that the Office's existing use of Town Hall meetings has been effective in encouraging public participation. Thus, the Section suggests that the use of Town Hall meetings be expanded to ensure that they are held in advance of specific rule proposals to address concerns that the Office determines might be addressed by a rules proposal and also include Town Hall meetings in additional locations outside of Washington, D.C.

The Section also believes that, while Public Advisory Committees are useful, their utility is limited given their limited memberships. Specifically, the Section suggests expanding the Public Advisory Committees' memberships to include representation from:

- all significant constituencies, for example, including in-house practitioners for small and large entities, pro se applicants, practitioners representing small entities and practitioners representing large entities;
- organizations with significant Office user membership, such as the Section, AIPLA, BIO, INTA and IPO;
- interested constituencies identified from responses to previous rule proposals; and
- regional advisory committees in cities with substantial patent or trademark activity.

The Section also believes that, even where not required, the Office should adopt all rules via proposal, public comment period and hearing procedure. The Office needs to provide thoughtful substantive replies to comments received in response to rule proposals to the maximum extent possible and avoid pro forma replies.

The Section believes that additional participation can be encouraged by interfacing more with publications of general circulation to explain the Office's mission and how it is attempting to serve that mission.

- Provide input to publications of general circulation, such as, for example, the *Milwaukee Journal Sentinel*, which did a major series of articles on the patent system and which could have benefited from such input;
- Interface with credible online blogs in addition to maintaining the *Director's Forum: David Kappos' Public Blog*; and
- Utilize and interface with other forms of social media, such as Twitter®, Facebook®, and LinkedIn® to more rapidly disseminate information to a broader audience.

The Section believes that the Office should continue with its outstanding efforts to improve the Office website, but also believes that the Office should consider the following additional improvements:

- Improve the site index to reflect changes in the website;
- Consider creating a mobile form of the website for use on mobile devices;

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- Consider adding specific lesson plans to the Office for a children's webpage to help teachers or local IP practitioners teach children the importance of intellectual property and the Office's mission.

In closing, the Section appreciates the Office asking for input on how to improve its regulatory process as well as how to identify specific regulatory burdens.

If you have any questions or require further explanation concerning any of our comments, please do not hesitate to contact me. Either I or another member of the leadership of the Section would be pleased to respond to your inquiries.

Very truly yours,



Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law