RESPONSE TO THE USPTO REQUEST FOR COMMENTS
"Provisions for Persons Granted Limited Recognition to Prosecute Patent Applications and Other Miscellaneous Matters"

Submitted by: The National Association of Patent Practitioners
Government Affairs Committee

Introduction

The following comments are submitted in response to the USPTO request for public comment with respect to the notice of Proposed Rulemaking appearing in the Federal Register Vol. 70, No. 66 (70 Fed. Reg. 17629), dated Thursday, April 7, 2005. The USPTO invited comments, with respect to: proposed changes to 37 CFR sections 1.4, 1.11, 1.17, 1.31, 1.32, 1.33, 1.34, 1.36, 1.78, 3.28, 3.31, 3.73, and 10.112.

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents and patent attorneys. We have approximately 500 members in 13 countries. The patent practices of the practitioner members are focused primarily on patent prosecution practice, namely practice before the USPTO. As part of our mission statement, we aim to create a collective nationwide voice to address issues relating to patent prosecution practice.

We welcome this opportunity to respond to the USPTO solicitation with respect to the proposed rulemaking addressing provisions for persons granted limited recognition to prosecute patent applications and other miscellaneous matters.

Comments

NAPP's comments are limited to the provision relating to providing English-language translations of provisional applications. The USPTO states that the change is intended to require that such translations be filed in the provisional application file, as opposed to the files of the nonprovisional application or applications claiming benefit of the provisional, and NAPP supports that concept. NAPP wishes to make several comments with respect to the specific language of the rules relating to this subject.

1. From the background information in the Notice of Rulemaking (70 Fed. Reg. 17631, right column), *inter alia*, NAPP understands that the USPTO considers the provision of an English-language translation of the provisional application an absolute requirement for granting benefit of the provisional application's filing date in any nonprovisional application. However, NAPP sees no statutory or regulatory basis for that assumption. If the USPTO intends to require an English-language translation in all cases, it should promulgate a rule expressly stating such. Proposed amended rule 1.78(a)(5)(i-iii) and (6) apply to the failure to provide a reference to the benefit application claimed and do not apply to the failure to provide English translations. Only subpart (iv) relates to the English translation, but it does not expressly state that English-language translation is a condition of benefit. The statute does not require English at all.

The following language could be added as an initial sentence to 1.78(a)(5)(iv) to rectify the omission: "Benefit to a provisional application may not be granted in any nonprovisional

application or any international application designating the United States of America unless the provisional application is in English or an English-language translation is provided with a certification of the accuracy of the translation."

2. The final sentence of Rule 1.78(a)(5)(iv) states, in part, that if the translation is not provided in response to the notice, the consequence is that the nonprovisional application will be abandoned. NAPP believes that the consequence instead should be that the claim to benefit would be waived. This is parallel to the failure to provide a timely claim of benefit in the nonprovisional application, as found in 1.78(a)(5)(iii). If a valid application remains patentable without the benefit of the non-English provisional, the Office should examine and approve it on its merits, and the failure of the applicant to provide the translation should do no more than eliminate the benefit claim.

In the alternative, this portion of the rule should provide that the applicant's express withdrawal of the benefit claim is an adequate alternative response to the notice such that it will not cause abandonment of the nonprovisional application. As presently worded, the failure to respond with a statement that the translation has been actually filed in the provisional application appears to result in automatic abandonment, even if the benefit claim is withdrawn. NAPP assumes that this was not the USPTO's intent.

3. NAPP also wishes to comment on the specific language of Rule 1.78(a)(5)(iv), which states, in part, "…applicant will be notified and given a period of time within which to file, in the provisional application, an English-language translation of the non-English language prior-filed provisional application…"

The language "a period of time" is vague and indefinite. Realizing that, if the translation is required for affording benefit but missing, the USPTO need not provide the full six-month statutory time period, we believe that the USPTO therefore should make it clear on the record what specific time period is meant by "a period of time". A parallel change should also be in order for Rule 1.52(d)(1), which contains the same phrase.

NAPP is concerned that, without clarification in the rule, the period of time selected may be insufficient to obtain a translation or may be variable depending on the opinion of the particular USPTO official sending the notice in any given case. NAPP also realizes that in most cases, applicants will have a sufficient amount of time to obtain a translation before filing a nonprovisional application. However, there may be special circumstances that may not enable an applicant to obtain a translation before filing a nonprovisional application. Therefore, a sufficient amount of time should be provided to the applicant to obtain the translation. Clarification by way of change to the language of the rule is kindly requested.

These comments were prepared by the government affairs committee of NAPP.

Respectfully submitted,

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