Is it Applicable? The Conditionally Applicable Certain Rules Effective September 16, 2012

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I. INTRODUCTION

The USPTO promulgated final rules "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act". 77 FR 48776 (August 14, 2012)(herein after the "final rules package"). The final rules package contains many significant changes to rules of patent practice for 111(a) and 363 applications. However, this article is not about the changes to the rules and changes to practice imposed by the changes to the rules for 111(a) and 363 applications. Instead, this article discusses the conditions under which changes to certain rules apply.

The final rules package was promulgated pursuant to the notice and comment requirements under US law. A notice of proposed rule making was previously published. See "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act; Proposed Rule". 77 FR 982 (January 6, 2012)(herein after the "proposed rules package"). The USPTO reviewed the comments in response to the notice of proposed rule making, modified the proposed rules and published the final rules package, in view of the comments.

The final rules package contains an "Effective Date" provision stating that "The changes in this final rule take effect on September 16, 2012."

The final rules package *also contains* an "Applicability Date" provision stating that "The changes to 37 CFR 1.9, 1.12, 1.14, 1.17(g), 1.27, 1.32, 1.33, 1.36, 1.41, 1.42, 1.43, 1.45, 1.46, 1.53(f) and (h), 1.55, 1.56, 1.63, 1.64, 1.66, 1.67, 1.76, 1.78, 1.81, 1.105, 1.131, 1.153, 1.162, 1.172, 1.175, 1.211, 1.215, 1.321, 1.421, 1.422, 1.424, 1.431, 1.491, 1.495(a), (c), and (h), 1.497, 3.31, 3.71, 3.73, and 41.9, and the removal of 37 CFR 1.47 and 1.432, apply only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012." The "Applicability Date" provision makes the changes to the itemized list of rules recited in the "Applicability Date" provision conditional. The remainder of this article construes the conditions in the "Applicability Date" provision in an attempt to determine the conditions when the changes are applicable.

II. CONSTRUCTION OF CONDITIONS IN THE "APPLICABILITY DATE" PROVISION

The proposed rules package contained no proposed "Applicability Date" provision, and therefore the public had no opportunity to comment on the "Applicability Date" provision. The final rules package contains no discussion of the "Applicability Date" provision. There is nothing in the regulatory promulgation process expressly explaining the meaning or intent of this provision. To complicate matters, the itemized list of rules contained in the "Applicability Date" provision is a subset of the complete set of rules changes in the final rules package. As you can see from the "Applicability Date" provision, this provision makes "changes to" the itemized list of rules "apply *only to* patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012." Consequently, changes to certain rules apply, conditionally, depending upon whether the thing to which it might apply is a "patent application[] filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012." The possible conditions are: (1) "patent application[]"; (2) patent application "filed under 35 U.S.C. 111(a) or 363"; and (3) patent application filed "on or after September 16, 2012". Questions arise as to the meaning of some of these conditions.

The first condition is that the changes to the conditional rules in the "Applicability Date" provision apply only if the thing to which they might apply is (1) a "patent application[]". Patents are not patent applications. This condition apparently excludes patents and therefore excludes applicability of the changes to the rules specified in the "Applicability Date" provision for proceedings involving patents, such as reexaminations. In order to short circuit analysis of this condition, however, I note that there are only a few rules listed as in the "Applicability Date" provision that would apply to non patent applications. These are the rules that apply to patents in addition to applications. These rules are: 1.321; 3.31, 3.71, and 3.73. The change to rule 1.321 is a conforming amendment (that would not require different procedures depending upon whether the changes to 1.321 were applicable). The changes to 3.31, 3.71, and 3.73, in the abstract, would require different procedures depending upon whether the changes to these rules were applicable. However, it seems that, in all instances, the effect of the new rules during prosecution of an application that matures into a patent would result in the changes to 3.31, 3.71, and 3.73 being irrelevant to actions in a post grant proceeding. For example, a reexamination of a patent filed pursuant to new rule 1.46 (identifying the juristic entity as the applicant) would not seem to require any different action by the patentee under the old and new rules, in order for the

patentee to be entitled to prosecute the reexamination. Accordingly, the first condition appears, in practice, to not be a substantive condition.

The third condition is that the changes to the conditional rules specified in the "Applicability Date" provision apply only to a patent application filed "on or after September 16, 2012." The condition "on or after September 16, 2012" (as opposed to a condition whether the thing is a patent application or a patent) is clear and not controversial. And, as just noted, the condition whether the thing is or is not a patent application, appears, in practice, to not be a substantive condition.

The second condition specifies that the changes to the conditional rules in the "Applicability Date" provision apply only (2) to patent applications "filed under 35 U.S.C. 111(a) or 363". This condition has two alternatives. First, the "filed under 35 U.S.C. 111(a)" and second the "filed under 35 U.S.C. ... 363".

The "filed under 35 U.S.C. ... 363" is unambiguous because 363 refers to international applications that designate the US. Therefore, "filed under 35 U.S.C. ... 363" can only refer to, and necessarily includes, all PCT applications that designate the US.

The "filed under 35 U.S.C. 111(a)" condition in the "Applicability Date" provision is problematic because the meaning of "filed under" is unclear. Does "filed under 35 U.S.C. 111(a)" refers to only 35 USC 111(a) applications or does it refer to 35 USC 111(a) applications and any one or more of 35 USC 111(b) applications (provisional); 35 USC 161 applications (plant); 35 USC 171 applications (design); and 35 USC 251 applications (reissue). Each of these types of applications would normally be considered to have been "filed under" its own 35 USC authorizing statutory section or chapter, and not "filed under" 35 USC 111(a). Cf. United States v. Ron Pair Enterprises, Inc., 489 US 235, 243 (1989)("plain meaning of legislation should be conclusive, except in the 'rare cases [in which] the literal application of a statute will produce a result demonstrably at odds with the intentions of its drafters.'") Accordingly, the structure and organization of 35 USC does not indicate that "filed under 111(a)" refers to any type of application other than 111(a) applications.

However, 35 USC 111(a) has provisions for filing requirements (filing of specification, declaration, other than for provisional applications, a claim), and some of these provisions for filing requirements in 111(a) are incorporated by reference expressly or inferentially in sections of 35 USC specifying requirements for filing the non 111(a) types of applications. See 35 USC 111(b)(8); 35 USC 161, second paragraph; 35 USC 171, second paragraph; 35 USC 251, third paragraph. Hence, it is conceivable that "filed under" 111(a) recited in the "Applicability Date" provision of the final rules package means more than just

111(a) applications because "filed under" may refer to any type of application for which the statute includes a reference to 111(a) expressly or inferentially in order to specify requirements for filing that type of application.

Since "filed under" is arguably ambiguous, *noscitur a sociis* may be helpful. "Under this canon, 'an ambiguous term may be given more precise content by the neighboring words with which it is associated.' United States v. Stevens, 130 S.Ct. 1577, 1588 (2010)." Bilski v. Kappos, 130 S.Ct. 3218, 3227 (2010). Thus, how other portions of the statute and how other portions of the final rules package use the phrase "filed under" are relevant to construing what this phrase means in the "Applicability Date" provision.

Prior to the Leahy-Smith America Invents Act (herein after the "AIA"), 35 USC contained the following recitations arguably relevant in construing "filed under". 34 USC 41(a)(3)(E) refers to "The *provisions of section 111(a)* of this title relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in this paragraph with respect to an application *filed under* section 111(a) of this title. The provisions of section 371(d) of this title relating to the payment of the national fee shall apply to the payment of the fee specified in this paragraph with respect to an international application." This passage distinguishes between "provisions of section 111(a)" and "application filed under section 111(a)," which indicates that the reference to the "provisions" is not the same as reference to "filed under". 35 USC 102(e) refers to "an international application *filed under* the treaty defined in section 351(a)." 35 USC 119 and 122 refers to a "provisional application *filed under* section 111(b) of this title." This indicates that a provisional application is "filed under" 111(b), which implies that a provisional application is not filed under 111(a). 35 USC 122 indicates that design applications are "*filed under*" chapter 16 of 35 USC. 35 USC 111(a) is not in chapter 16. This indicates that design applications are not "*filed under*" 111(a). 35 USC 154(b), when read in connection with the other patent term specifications, implies that applications "*filed under* 111(a)" excludes design and plant patent applications. 35 USC 351(c) defines an international application "*filed under*" the PCT to mean a PCT application. This indicates that "*filed under*" refers to authorization for filing a PCT application and does not refer to requirements for filing a PCT application. Thus, 35 USC suggests that "*filed under*" refers to the authorizing statutory section and not provisions with which an application filing must comply.

Similar reviews of the AIA and the final rules package also indicate that "*filed under*" refers to statutory grant of authority for filing the various types of patent applications.

Two further canons appear applicable in construing the meaning of the recitation "filed under 35 U.S.C. 111(a)" in the "Applicability Date" provision: the canon against superfluity (cf. Microsoft Corp. v. i4i Ltd. Partnership (2011)) and *inclusio unius est exclusio alterius* (cf. United States v. Koonce, 991 F.2d 693, 698 (11th Cir. 1993)). These canons may be applied to sections of the AIA and directly to the recitation in the "Applicability Date" provision.

The canon against superfluity is relevant when considering section 4 of the AIA. Section 4 of the AIA includes *inter alia* 35 USC 115 and 35 USC 118. 35 USC 115(a) as amended by the AIA, first sentence, reads "An application for patent that is *filed under section 111(a)* or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application." Section 4(e) of the AIA provides the following effective date provision. "The amendments made by this section [sic; section 4 of the AIA] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to *any patent application* that is filed on or after that effective date." The AIA section 4(e) effective date provision makes the AIA section 4 applicable "to any patent application," whereas the portion of section 4 dealing specifically with the requirement to "name [] the inventor for any invention claimed in the application" appearing in 35 USC 115(a) is limited to an application for patent "*filed under section 111(a)* or [that] commences the national stage under section 371". The distinction between words used in the AIA section 4 effective date provision and words used in the AIA section 115(a), and the canon against superfluity, indicate that the recitation "*filed under section 111(a)* or commences the national stage under section 371" in 115(a) further limits the recitation "any patent application" in the effective date provision.

The canon against superfluity can also be directly applied to the "Applicability Date" provision “apply only to patent applications filed under 35 U.S.C. 111(a) or 363." To avoid superfluity, this provision must provide some exclusion. Therefore, it should be construed as a condition that does exclude something. I noted above that the possibilities what it excludes include various types of applications and non applications. I also noted that there appear to be no circumstances in which the condition affects non applications, which indicates that non applications (aka patents) are not relevant to the condition. This suggests that the condition “apply only to patent applications filed under 35 U.S.C. 111(a) or 363" excludes some types of applications. Applying the canon against superfluity therefore results in a conclusion that the condition "filed under 35 U.S.C. 111(a) or 363" excludes some types of applications.

Applying *inclusio unius est exclusio alterius* directly to the "Applicability Date" provision "apply only to patent applications filed under 35 U.S.C. 111(a) or 363" results in the conclusion that this phrase excludes some types of applications. This is because "111(a) or 363" are enumerations of species of a genus of application types including non provisional, provisional, plant, design, reissue, and PCT.

Moreover, the Court of Appeals for the Federal Circuit has also referred to the phrase "filed under" in connection with patent application to mean a reference to the statutory section granting authority to a party to file the type of application at issue. Cf. In re Beineke, (Fed. Cir. August 6, 2012) (plant application "filed under" 161); In re Weiler, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986)(reissue application "filed under" 251). While not case holdings, these cases seem to confirm the plain meaning of "filed under."

On the other hand, as noted in United States v. Ron Pair Enterprises, Inc., supra, the plain meaning should prevail, unless "literal application of a statute will produce a result demonstrably at odds with the intentions of its drafters." One can also look at the effect of construing the "filed under" to exclude changes to the rules from being applicable to 111(b), 161, 171, and 251 applications. At least the changes to rule 1.175 (directed to changes in reissue application practice), would never go into effect if reissue applications were not construed to be "filed under 111(a)" for purposes of the "Applicability Date" provision. Changes to rules that never go into effect would seem to be "demonstrably at odds with the intentions of its drafters." At least for reissue applications, this observation casts doubt on the construction that "filed under" in the "Applicability Date" provision refers only to 111(a) and 363 applications.

I conferred with OPLA (Office of Patent and Legal Administration, which is the USPTO division that is in charge of rules drafting) personnel on this issue. My discussions with OPLA personnel indicate their belief that "filed under 111(a)" is, or was intended to be, expansive, but was not intended to cover 111(b) applications.

III. SUMMARY AND CONCLUSION

In summary, the final rules package "Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act" published at 77 FR 48776 (August 14, 2012) contains an "Applicability Date" provision which makes changes to certain rules conditional, and some of the conditions are ambiguous. Consequently, there are situations where it is unclear

whether the conditions are satisfied and therefore whether the changes to certain rules specified in the final rules package apply to those situations.

In conclusion, I think that there is uncertainty regarding when rules specified in the "Applicability Date" provision are satisfied, and therefore whether the changes to the rules listed in the "Applicability Date" provision apply in particular circumstances. I submit that it would be beneficial for the USPTO to clarify the conditions under which it intends the "Applicability Date" provision to apply.

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