

**NEIFELD IP Law, PC**  
4813-B Eisenhower Avenue  
Alexandria, Virginia 22304

Tel: 1-703-415-0012  
Fax: 1-703-415-0013  
Web: <http://www.Neifeld.com>  
Email: [general@Neifeld.com](mailto:general@Neifeld.com)

October 12, 2012

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent  
and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street Alexandria, VA 22314

VIA EMAIL: [fitf\\_guidance@uspto.gov](mailto:fitf_guidance@uspto.gov)

RE: Comments on "Examination Guidelines for Implementing the First-Inventor-to-File  
Provisions of the Leahy-Smith America Invents Act" published at 77 FR 43759 (2012).

Dear Under Secretary Kappos:

I am a patent attorney. I have a substantial background in interference practice and  
appeals to the Board. I express my personal views and concerns regarding the proposed  
"Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the  
Leahy-Smith America Invents Act".

At 77 FR 43767 and 69, citing 35 USC 102(b)(1)(B) and (b)(2)(B), the Offices proposes  
guidelines for examination which state that "Even if the only differences between the subject  
matter in the prior art disclosure that is relied upon under 35 USC 102(a) and the subject matter  
publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes,  
or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.

First, I agree with previous comments by the AIPLA that this construction of the statute  
would vitiate the ability of inventors to rely upon early disclosure to protect their patent rights.  
In effect, this construction promotes delay in disclosure of inventions, which is contrary to the  
intent of the AIA to promote early disclosure.

Second, I note that the Office has adopted asymmetric patent defeating standards for 35  
USC 135 on the one hand compared and 35 USC 102(b)(1)(B) and (b)(2)(B) on the other hand.

The Office's standard when the inventor's disclosure to a third party can defeat the third  
party's right to patent, when the inventor petitions for a derivation proceeding, is whether the  
invention claimed by the third party is an obvious variation of the invention that the inventor  
disclosed to the third party. See "Changes To Implement Derivation Proceedings" at 77 FR  
56068 (2012), promulgating 37 CFR 42.405(b)(3)(I); the 37 CFR 42.401 definition "Same or  
substantially the same means patentably indistinct"; the construction (see response to comment 2,  
at 77 FR 56071-72) that "patentably indistinct" means "anticipated by *or obvious* over the

petitioner's claim"; and the construction (see response to comment 25) at 77 FR 56075 that "In a derivation proceeding, a petitioner must make a showing as to each of the respondent's claims that it believes is derived subject matter. § 42.405(b)(3)(I). Specifically, the petitioner must demonstrate that the respondent acquired knowledge of the claimed invention from the petitioner. Hence, the 'acquired knowledge,' which the petitioner must define as part of its proof, determines the scope of subject matter that would have been anticipated *or obvious* from the acquired knowledge." Italics added for emphasis. That is, the Office has taken the position that derivation within the meaning of 35 USC 135 includes obvious differences to what was disclosed, consistent with the holding in OddzOn Products, Inc. v. Just Toys, Inc., 122 F. 3d 1396 (Fed. Cir. 1997).

However, the Office's interpretation in the guidelines for examination regarding when an inventor's disclosure will protect the inventor's right to a patent on the inventor's disclosed invention and obvious differences thereof does not apply the obviousness standard. Accordingly, it is asymmetric. I believe that asymmetry is not consistent with the policy underlying our patent laws to promote innovation via promoting early disclosure. I suggest that the Office consider a guideline for examination that does promote early disclosure by removing the asymmetry.

The CCPA provided what I believe are symmetric rules of law for obtaining a right, and defeating another's right, to inventions, in the context of 131 declarations and 102(g). I suggest that the Office consider a guideline for examination based on these rules of law. I specifically suggest the Office consider the rules of law in the following two cases.

In In re Stempel, 241 F. 2d 755, 759 (CCPA 1957), the Court stated that:

We think this is a too literal construction of the rule and not in accord with past practice. See Ex parte Burt and Ex parte Clifford, supra. We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.

In In re Spiller, 500 F.2d 1170, 1178, 182 USPQ 614, 619 (CCPA 1974), the Court stated that:

The question, then, is whether the rule of Stryker ought to be extended to a situation where the Rule 131 showing is not fully commensurate with the reference but renders the claimed invention obvious. We think Stryker is controlling in this situation as well, and that such an extension of Stryker is supported by our earlier decision in Hostettler, supra.

Very truly yours,  
/RichardNeifeld/  
Richard A. Neifeld  
President, Neifeld IP Law, PC

Printed: October 12, 2012 (12:15pm)

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