

Comments to the USPTO on the Notice of Proposed Rule Making, titled "Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements" published at 76 FR 18990.

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What follows are the comments I submitted in response to the USPTO's request for comments.

The Office proposals to reinterpret the law for patent term adjustment (PTA) are commendable. However, they fail to suitably account for information that applicants desire to submit during the pendency of a Board of Patent Appeals and Interferences (BPAI) appeal. An information disclosure statement (IDS) filed during a BPAI appeal will, pursuant to 1.704(d), be construed as a failure to engage in reasonable efforts to conclude prosecution, and therefore detract from PTA, unless the IDS is accompanied by a certification (that the information was, generally speaking, newly discovered by the applicant). This is because an IDS without certification is an "other paper" within the meaning of 1.704(c)(8) and therefore will act to preclude PTA in the manner specified by 1.704(c)(8).

However, the requirement for certification of an IDS filed during an appeal serves no beneficial purpose and has detrimental consequences. An IDS filed during an appeal will not be considered by the BPAI panel and will not affect the appeal. It will only be considered post appeal, by the examiner. Therefore, its filing during the appeal cannot impede prosecution.

However, certification opens up applicants to attacks of misrepresentation and inequitable conduct. And determining whether or not a certification can be made, is often a time consuming and costly exercise. Moreover, the rules in this point are so complicated that it is my personal experience that many practitioners do not recognize that the filing of an uncertified IDS during the course of a BPAI appeal may result in reduction of months or years of PTA, again, detrimentally affecting applicants and opening up practitioners to liability. For all of the foregoing reasons, the certification requirement for an IDS filed during a BPAI appeal has no beneficial purpose and has detrimental effects, and should be eliminated

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