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October 20, 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

RE: Supplemental 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".

My views herein are in addition to my previous comments directed to the circumstances under which an inventor's disclosure will protect the inventor's right to a patent on the inventor's disclosed invention (wherein I suggested that the rules of law for 131 declarations were relevant).

Upon reading the comments from many others posted by you regarding the PTO's positions in the proposed examination guidelines, it is clear that there are divergent views on the issues of public use, on sale, and exceptions to 102 due to inventor pre filing disclosures. Clearly those issues present open legal questions for which legal certainty will only be provided by judicial precedent. The PTO role is one of gatekeeper; it has no power to make substantive law. Accordingly, rather than picking a position on each open legal question based upon an attempt to construe the muddled legislative record, as it has done in the proposed examination guidelines, the PTO should merely act in its gatekeeper capacity, by construing each open legal issue in the manner most biased against applicants and therefore most likely to result in prompt judicial review and resolution of those issues.

Further, the PTO should make it policy to expedite prosecution and appeal within the PTO in those cases, so that the open legal questions inherent in the new AIA version of 35 USC 102 are resolved judicially as rapidly as possible. It can do that by notifying the examining corps that the issues of public use, on sale, and exceptions to prior art based upon an inventor's

disclosure are in fact open legal questions, that the PTO is not advocating a construction, but requiring rejections in appropriate circumstances so that the Courts can promptly decide the open legal issues, and by instructing the examining corps and the PTAB to make special any case in which such rejections are made, until the issues of law are judicially resolved to a legal certainty.

I specifically note that the PTO's proposed guidelines on secret public use or sale, would result in lack of a duty of disclosure that a secret public use or sale existed, resulting in very long delays before relevant facts ever reached a court for judicial review.

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

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