

Domestic Implementation of First-to-File: Shortcomings at the PTO

On the fifth anniversary of the *Leahy Smith America Invents Act* of 2011, the U.S. PTO has still failed to eliminate unnecessary procedures that slow down the filing date. This is so critical in the real world of first-to-file *versus* the streamlined requirements in Asia and Europe where an earlier effective filing date is routinely achieved: Overseas applicants gain a competitive edge in the United States.

The pdf version of this note includes an attachment that explains the problem and what can be done by the American patent community.

Regards,
Hal

November 10, 2016

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To the Patent Community:

Re: **Domestic Implementation of First-to-File**

Colleagues:

On the fifth anniversary of the *Leahy Smith America Invents Act* of 2011, the U.S. Patent and Trademark Office continues to put disclosure roadblocks in the way of a prompt first filing, so necessary under First-to-File.

American patent applicants face a PTO-created discrimination against gaining an early filing date through outdated and now unnecessary filing requirements and procedures. Their Asian and European counterparts file their “home country” applications *without* the same problems, as a result of which their U.S. Paris Convention filings on a routine basis gain a significant priority advantage.

Given that the race to file in the “home country” Patent Office determines the first-to-file priority date in the United States, this means that the quicker to file Asians and Europeans routinely gain months (or more) of priority versus American patent applicants for U.S. patent rights.

Anecdotal Experience: Proposals Swept Under the Rug

At a public meeting in Washington, D.C. this past May, this writer suggested to an upper level PTO official that the U.S. urgently needs to modify its *Manual of Patent Examining Procedure* to exclude the many technical traps built into filing procedures, *all unnecessary*.

The upper level PTO official was indignant. He challenged this writer to share his thoughts with the Office.

The writer did just that. (His list is attached.)

He got a prompt *pro forma* response. (This was many months ago, in May.)

Then, nothing further.

While it certainly doesn't bother this writer if he doesn't get a substantive response, what is troublesome is that there must be many, many folks who have made parallel suggestions for reform:

How many proposals have been swept under the rug?

Outline of Deficiencies: The Treatise

Inspired by the responsiveness *vel non* of the Office to his own suggestions for modification of the MPEP, this writer has made the deficiencies of the *Manual* one of the focal points of his treatise, FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE, about to be made available online on Westlaw.

Everyone Should Help the PTO Update its *Manual*

At the time of this writer's correspondence with the PTO, a "Top Ten" list of items that should be dealt with to meet the challenge of first-to-file was shared with the Office (*as attached*).

For an online revision of the Westlaw treatise, what items should be included *beyond this list?*

Identify your own items *omitted* from the list, so that we may update the Westlaw treatise to include your contributions. The goal is to have a "Top 100" list of outdated points in the *Manual* so the Office can do its job.

The Office should then simplify procedures by eliminating practice tips that are simply outdated and, if followed, lead to a delayed filing date, something that cannot be tolerated in a first-to-file world.

Whither AIPLA, IPO and P-PAC?

This writer has not studied what these patent focused groups have done, although it is acknowledged that AIPLA has published a massive treatise by Kasper *et al.*

In the first instance, it is up to the three organizations to identify problems and propose solutions.

Very truly yours,

Hal

Harold C. Wegner

HCW:scm

Attachment: Winning the First-to-File Race to the Patent Office:
Ten Things not to Include in the Application (May 2016)

WINNING THE FIRST-TO-FILE RACE TO THE PATENT OFFICE: TEN THINGS *NOT* TO INCLUDE IN THE APPLICATION*

Harold C. Wegner**

Now that the *Leahy Smith America Invents Act* approaches its fifth anniversary of enactment, many practitioners have gained familiarity with specific requirements *necessary* for drafting claims and supporting disclosure. Yet, even today, Americans all too often take much longer to file a patent application than their European and Asian counterparts.

Of course, if an American first inventor is second-to-file because of delays inherent in the American system, this means that no matter how brilliant a job of patent drafting has led to the second-to-file application, his competitor, the second-to-invent but first-to-file applicant will upon publication of his application gain a patent-defeating right that vitiates the American first inventor's claims to the same invention.

A major culprit that slows down the American filing process is the ambiguous and outdated set of instructions in both the *Rules of Practice in Patent Cases* as well as the *Manual of Patent Examining Procedure*. Americans waste time in filing their first applications in order to comply with the requirements and suggestions in these documents which are outside the statute.

Among the requirements or practice suggestions that lack validity for a best practices approach may be mentioned the following myths:

(1) “I must recite the ‘field of the invention’”

The *Manual* states that the inventor should designate the “field” but there is no statutory basis for this requirement. See FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE, § 6[c] *Background of the Invention* (quoting MPEP § 608.01(c), *Background of the Invention*, ¶ (1), *Field of the Invention*). See also § 6[c][1], “*Field of the Invention*”.

* Harold C. Wegner, FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE (2016)

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(2) “I must “describ[e] * the prior art’ in the specification”**

There is absolutely no requirement to describe the prior art in the specification. See *id.*, ¶ (2), *Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98*.

(3) “The CFR says I should include a ‘[b]ackground of the invention”

See *id.* § 6[c], *Background of the Invention* (quoting 37 CFR § 77(b)(5)). The rule is lacking in statutory basis.

(4) “The MPEP says I should recite problems leading to the invention”

There is nothing in the statute to support this requirement of the *Manual*. See *id.* (quoting MPEP 608.01(c) *Background of the Invention*, ¶ 2 (“[T]he problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated.”) Indication of “problems” may also be basis for substantive rejection of the claims. See § 6[c][3][B], *KSR-Related Problems with “Problems”*.

(5) “The MPEP says I should disclose the ‘gist’ of the invention”

Reciting a “gist” is an antiquated requirement of no basis in the statute today. See § 6[d], *Abstract of the Disclosure* (quoting *Guidelines*) (Abstract should permit upon cursory inspection “*the nature and gist of the technical disclosure*”).

(6) “I must disclose the best mode in the *original filing*”

A best mode defect is no longer fatal as the applicant under the new law may file a continuation-in-part that includes a best mode without loss of priority right. See MPEP § 608.01(h), *Mode of Operation of Invention* (“If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured ***.”) But under the *Leahy Smith America Invents Act* (35 USC § 120) the best mode defect can be cured by filing continuation-in-part adding best mode.

(7) “I should cite prior art as part of the original application papers.”

There is no requirement to cite prior art in the specification *at any time* provided a parallel Information Disclosure Statement is filed within three months from the filing date. See MPEP § 609.04(b), *Timing Requirements for an Information Disclosure Statement*.

(8) “I should summarize the ‘nature and substance’ of the invention”

The “nature” requirement is statutory, dating back to the 1830’s, but not a part of the patent law since January 1, 1953. See MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*).

(9) “Any object recited should be that of the invention as claimed[.]”

This is a quotation from MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*). But, an “object” is not a statutory requirement.

(10) I should disclose “the exact nature, operation, and purpose ...”

See MPEP § 608.01(d), *Brief Summary of the Invention* (quoting 37 CFR § 1.73, *Summary of the Invention*). The “nature” requirement was introduced by statute in 1836 as a codification of case law dating to 1793. See § 6[b][4], “*Nature of the Invention*”: *1836 Statutory Basis*. By 1870, any reason to define the “nature” of the invention evaporated. See § 6[b][5], *1870 Law Mandating Claims to Define the Invention*.