

**DEPARTMENT OF COMMERCE****United States Patent and Trademark Office****37 CFR Part 1****[Docket Nos.: PTO-P-2012-0015 and PTO-P-2012-0024]****RIN 0651-AC77****Changes and Examination Guidelines To Implement the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act; Reopening of the Period for Comments****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Request for comments; reopening of the comment period.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) published a notice of proposed rulemaking and a notice of proposed examination guidelines to implement the first-inventor-to-file (FITF) provisions of the Leahy-Smith America Invents Act (AIA). The USPTO also conducted a roundtable to obtain public input from organizations and individuals on issues relating to the USPTO's proposed implementation of the FITF provisions of the AIA. The Office has received several requests for additional time to submit comments on the USPTO's implementation of the FITF provisions of the AIA. The USPTO is reopening the comment period to provide interested members of the public with an additional opportunity to submit comments to the USPTO.

**DATES:** The deadline for receipt of written comments in response to the notice of proposed rulemaking published July 26, 2012 (77 FR 43742) and notice of proposed examination guidelines published July 26, 2012 (77 FR 43759) is November 5, 2012.

**ADDRESSES:** Comments on the notice of proposed rulemaking should be sent by electronic mail message over the Internet addressed to:

*fitf\_rules@uspto.gov*. Comments may also be submitted by postal mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Susy Tsang-Foster, Legal Advisor, Office of Patent Legal Administration.

Comments on the proposed examination guidelines should be sent by electronic mail message over the Internet addressed to:

*fitf\_guidance@uspto.gov*. Comments may also be submitted by mail addressed to: Mail Stop Comments—

Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

Comments on the notice of proposed rulemaking and the proposed examination guidelines may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:**

Mary C. Till, Senior Legal Advisor (telephone (571) 272-7755, email [mary.till@uspto.gov](mailto:mary.till@uspto.gov)); or Kathleen Kahler Fonda, Senior Legal Advisor (telephone (571) 272-7754, email [kathleen.fonda@uspto.gov](mailto:kathleen.fonda@uspto.gov)), of the Office of the Deputy Commissioner for Patent Examination Policy.

**SUPPLEMENTARY INFORMATION:** The AIA was enacted into law on September 16, 2011. Public Law 112-29, 125 Stat. 284 (2011). Section 3 of the AIA amends the patent laws to: (1) Convert the United States patent system from a "first to invent" system to a "first inventor to file" system; (2) eliminate the requirement that a prior public use or sale activity be "in this country" to be a prior art activity; (3) treat U.S. patents and U.S. patent application publications

as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the U.S. or in another country; and (4) treat commonly owned patents and patent application publications, or those resulting from a joint research agreement, as being by the same inventive entity for purposes of 35 U.S.C. 102 and 103. The changes in section 3 of the AIA take effect on March 16, 2013.

The USPTO published a notice of proposed rulemaking and notice of proposed examination guidelines on July 26, 2012, to implement the FITF provisions of section 3 of the AIA. See *Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act*, 77 FR 43742 (July 26, 2012), and *Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act*, 77 FR 43759 (July 26, 2012). The notice of proposed rulemaking proposes changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) for consistency with, and to address the examination issues raised by, the changes in the FITF provisions of the AIA. The proposed examination guidelines set out the Office's interpretation of 35 U.S.C. 102 and 103 as amended by the AIA, and advise the public and the Patent Examining Corps on how the changes to 35 U.S.C. 102 and 103 in the AIA impact the provisions of the *Manual of Patent Examining Procedure* (MPEP) pertaining to 35 U.S.C. 102 and 103. The USPTO also conducted a roundtable to obtain public input from organizations and individuals on issues relating to the USPTO's proposed implementation of the FITF provisions of the AIA. See *Notice of Roundtable on the Implementation of the First Inventor to File Provisions of the Leahy-Smith America Invents Act*, 77 FR 49427 (Aug. 16, 2012).

The Office has received several requests for additional time to submit comments on the USPTO's implementation of the FITF provisions of the AIA. The USPTO is reopening the comment period to provide interested members of the public with an additional opportunity to submit comments to the USPTO.

Dated: October 5, 2012.

**David J. Kappos,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

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