



October 4, 2022

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property and Director
U.S. Patent and Trademark Office
600 Dulany St.
Alexandria, VA 22314

via https://www.regulations.gov (Docket Number PTO-P-2022-0008)

Re: Comments Regarding Proposed Rulemaking Pertaining to Patent Term Adjustment

Dear Director Vidal:

Intellectual Property Owners Association (IPO) submits the following comments and suggestions in response to the USPTO's Federal Register Notice entitled "Standardization of the Patent Term Adjustment Statement Regarding Information Disclosure Statements," published at 87 Fed. Reg. 41267 (July 12, 2022) (the "FRN").

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

The FRN proposes to revise the Patent Term Adjustment (PTA) rules to require use of USPTO Form PTO/SB/133 to make the statement required to invoke the 37 CFR § 1.704(d) PTA "safe harbor" when filing certain Information Disclosure Statements ("IDSs"). Under the proposed rule, if Form PTO/SB/133 is not filed on the same day as the IDS at issue, the IDS will not be sheltered from a PTA deduction even if the required statement was made in another paper filed on the same day as the IDS. Thus, under the proposed rule changes, failure to use Form PTO/SB/133 could result in a loss of patent term. Such an elevation of formalities over substantive patent rights would be inequitable and inappropriate and could have a disparate impact on pro se applicants, independent inventors, and small businesses.

IPO supports the USPTO's efforts to improve the accuracy of PTA calculations, further automate the procedures for calculating PTA, and reduce the incidence of deficient safe harbor

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statements, but does not believe the statutory right to PTA should rest on the use of a specific form, especially when use of Form PTO/SB/133 has been entirely voluntary since it was first made available in 2018. Instead, IPO urges the USPTO to consider a more flexible approach.

In particular, IPO urges the USPTO to continue the current practice of permitting applicants to make the required safe harbor statement(s) in any paper filed on the same date as the IDS but require a request for reconsideration of PTA under 37 CFR § 1.705(b) (and the associated fee) to invoke the safe harbor if Form PTO/SB/133 was not used. Such a flexible approach would encourage applicants to use Form PTO/SB/133 without imposing the harsh penalty of loss of patent term when the form is not used. IPO believes the flexible approach will enable the USPTO to realize many of the goals discussed in the FRN without creating a procedural trap that could jeopardize valuable patent term.

IPO appreciates the USPTO's consideration of these comments.

Sincerely,

A handwritten signature in black ink, appearing to read 'Karen Cochran', is centered on the page. The signature is fluid and cursive, with a large initial 'K' and 'C'.

Karen Cochran
President