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Dear Mr Fraser:

Coincidentally, today on one of the patent attorney email lists, an issue came up, and I realized it's relevant to this ICR.

When an applicant files a patent application, the fee covers a certain amount of examination, up to a limit. When the first deadline on that limit closes, 37 C.F.R. § 1.116(b) gives a list of reasons that a submission filed after that limit will be considered.

The problem is the PTO's Form PTOL-303. This form gives an examiner a list of reasons to not consider a submission. The list of reasons on Form PTOL-303 is incompatible with the list of 37 C.F.R. § 1.116(b). § 1.116(b) is the deal that was negotiated fair-and-square between the public and the Patent Office in a notice-and-comment proceeding.

The list on PTOL-303 has no grounding anywhere. It's just guidance. The PTO is fully funded by user fees, and the PTO is quite consistent in refusing to honor or enforce regulations that operate in favor of the public, if those regulations would reduce the PTO's fee income. As a practical matter, PTOL-303 is the operative binding limit on submissions. But it has no grounding in any law, only the PTO's fee revenues. Frankly, PTOL-303 is nothing but expropriation. There is no legal basis for guidance to preempt a regulation that operates to reduce burden on the public.

The difference between § 1.116(b) vs. PTOL-303 is a fairly frequent topic of discussion among patent attorneys. Based on frequency of discussion, I estimate that PTOL-303 creates several tens of millions of dollars of burden annually. The PTO has never properly booked that burden.

The PTO's Supporting Statement requests clearance for collections of information pursuant 37 C.F.R. § 1.116(b). Those may be approved. Information collections pursuant to Form PTOL-303 should be disapproved.