

Perceptions on the Propagation of Perplexity Pertaining to Provisionals

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Intro

- Some observations on opposition to provisionals in Israel
- Some contrasts in legislation and rule-making – US vs. IL

US Provisionals –pros/cons

Positives:

- Low filing fee (can file iteratively)
- No formalities
- Expire at 1 year (only publish if you want)
- Extra year of patent term
- Easy to make available via DAS
- Some advantages in US pre-AIA

Negatives:

- No formalities
- Administratively confusing
- USPTO not user-friendly

We can do this here, better, and keep the money in IL!

Some observations on response to idea

ILPO Zoom meetings summer 2020:

- Opposition principally from one office
- Couched in paternalistic terms
- Concern about inability to monetize?
- Better to put effort into preventing poaching of patent drafting work from Israel

Suggestions for Implementation in IL

- USPTO administratively confusing:
 - Provisional Cover Sheet vs. Application Data Sheet
 - Communication by snail mail
- If going to implement in Israel, make the interface user-friendly
- Give us private PAIR/ePCT!

Observations about the process

- Israel PO published proposed rules for provisionals
- Israel PO (MOJ) published call for comments on possible statutory changes
- Why the ILPO?
- Why create provisionals via rules?

Observations about the process cont'd

USPTO:

- Rarely involved in statutory changes
- Rulemaking limited –
 - Notice-and-comment (per APA)
 - can't be substantive
 - *Tafas v Dudas*
- So why ILPO involved in substantive rule-making, statutory amendments?
- Knesset ineffective
- Greater influence in parliamentary system

Proposed Rules themselves

Rules for Provisionals as example:

- No downside, potential upside. But
- Are they authorized or *ultra vires*?
- ILPO proposal is to create new class of application
- Alternatively, statute says fee set by rule, so:
- Could divide fee; basic fee gets filing date, + search + exam fee
- Non-payment of remainder = abandonment
- Abandonment = no publication
- If have 3 fees, could pay for early search

Proposed Rules themselves cont'd

Why via rule rather than statute?

- Easier.
- Less likely to get changed.

Observations about the process cont'd

Concerns about PTO in substantive statutory changes:

- PTO's perspective is not that of inventors/investors/practitioners
- PTO has its own concerns which affect IP policy but are tangential
- PTO's own perception of its role being "protecting the public"
- Potential conflicts in top PTO people simultaneously being:
 - Administrators
 - Legislators/lobbyists
 - Adjudicators