



701 Exposition Place, Suite 206 • Raleigh, NC 27607
Phone: 919-230-9635 • Email: representative@napp.org
Website: <https://www.napp.org/>

November 12, 2021

Mail Stop Comments-Patents
Drew Hirshfeld
Commissioner for Patents
The United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Via Email to: patentpractice@uspto.gov

Re: Access to Case Law Decisions Cited in the MPEP

Dear Commissioner Hirshfeld:

The National Association of Patent Practitioners (NAPP) is a nonprofit 501(c)(6) membership association dedicated to serving the needs of professionals working in the field of patent prosecution. The mission of NAPP is to provide networking, education, collegial exchange, benefits, and a collective voice in patent law practice. NAPP represents hundreds of patent practitioners specializing in patent prosecution before the United States Patent and Trademark Office (USPTO). We provide these public comments regarding patent-related regulations and procedures.

NAPP members and other patent practitioners are frequent users of the Manual of Patent Examination Procedure (MPEP). The MPEP cites several case law decisions that are difficult to obtain without accessing premium subscription-based online legal databases such as Lexis or Westlaw. For example, MPEP 715.05 cites the following case law decisions, neither of which is easily accessible online: (i) *In re Corba*, 212 USPQ 825 (Comm'r Pat. 1981) cited in MPEP 1504.20; and (ii) *Adler v. Kluver*, 159 USPQ 511 cited in MPEP 715.05. A cursory search of Appendix II of the MPEP reveals the following case law decisions, which are either unavailable online from any common free legal research tool or available only from unreliable third-party sources:

Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990); *In re Abacab Int'l Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pat. 1987); *In re Affidavit Filed After Final Registration*, 152 USPQ 292, 1966 C.D. 53 (Comm'r Pat. 1966); *Ahrens v. Grey*, 1931 C.D. 9, 402 O.G. 261 (Bd. App. 1929); *In re Alcon Laboratories Inc.*, 13 USPQ2d 1115 (Comm'r Pat. & Tm. 1989); *Ex parte Allen*, 2 USPQ2d 1425 (Bd. Pat. App. & Inter. 1987); *Ex parte Badger* 1901 C.D. 195, 97 O.G. 1596 (Comm'r Pat. 1901); *Ex parte Balzarini*, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991); *Ex parte Bartfeld*, 16 USPQ2d 1714 (Bd. Pat. App. & Inter. 1990).

In addition, numerous case law decisions cited in the MPEP relating to design patents are only available in text format, which format does not include drawing images critical to understanding the case law decisions.

The lack of access to case law decisions cited in the MPEP is problematic for several reasons. From the perspective of inventors, access to case law is vital to advocate for the patentability of their inventions. Inventors cannot learn from the facts and application of law in case law decisions cited in the MPEP, which they cannot access. Limited access to case law decisions cited in the MPEP, therefore, forecloses arguments the inventor would otherwise pursue. The lack of access to case law decisions cited in the MPEP also raises the cost of pursuing a patent by inflating the time and expense of legal research. These concerns are especially salient for pro-se inventors and solo and small firm patent practitioners who have limited resources and cannot afford a subscription to a premium legal database. Further, those seeking to study and prepare for admission to the Examination for Registration to Practice in Patent Cases before the USPTO ("Registration Examination") frequently will not have access to these case law decisions cited in the MPEP. Finally, as a public authority, the USPTO should be transparent in its guidance to patent examiners and the public. By including these case citations in the MPEP, the USPTO is signaling the value of the case law decisions. Limited access to these case law decisions is contrary to the public policy of transparency and disclosure at the foundation of our patent system.

In light of the difficulty for patent practitioners accessing these case law decisions cited in the MPEP and the policy implications highlighted above, NAPP respectfully requests the USPTO consider the issue that some cases cited in the MPEP are not readily available to the public via electronic means. NAPP would be pleased to assist in resolving this issue. For example, one solution may include creating

an online appendix to the MPEP with a repository of the case law decisions cited in the MPEP. Alternatively, the case law decisions listed in Appendix II of the MPEP could include hyperlinks to an accessible online repository of cases to improve access. Such a repository might be economical as digital storage costs are at historic lows. Such a repository would: (i) improve the quality of work by practitioners and inventors by reducing inefficient research time, (ii) improve equitable access to patent case law, (iii) increase transparency of subject matter potentially covered in the Registration Examination, and (iv) further reduce the cost of pursuing patent protection by enabling small and solo practitioners to avoid unnecessary research expenses.

We look forward to the USPTO's consideration of this issue and appreciate your attention to this matter.

Sincerely,



Christopher M. Turoski

President, National Association of Patent Practitioners