

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2010-0035]

Enhanced Examination Timing Control Initiative; Notice of Public Meeting

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of public meeting; request for comments.

SUMMARY: This notice announces a public meeting to solicit public opinions on an initiative being considered by the United States Patent and Trademark Office (USPTO) to provide applicants with greater control over when their applications are examined and to enhance work sharing between intellectual property offices. Under the initiative, for applications filed in the USPTO that are not based on a prior foreign-filed application (e.g., that do not claim foreign priority benefit), applicant would be able to: (1) request prioritized examination (Track I); (2) for non-continuing applications, request a delay lasting up to 30 months in docketing for examination (Track III); or (3) obtain processing under the current procedure (Track II) by not requesting either (1) or (2). For applications filed in the USPTO that are based on a prior foreign-filed application, no

action would be taken by the USPTO until the USPTO receives a copy of the search report, if any, and first office action from the foreign office and an appropriate reply to the foreign office action as if the foreign office action was made in the application filed in the USPTO. Following or concurrent with the submission of the foreign office action and reply, applicant may request prioritized examination or obtain processing under the current procedure.

This initiative aims both to provide applicants with the type of examination they need and to reduce the overall pendency of patent applications (which currently stands at almost three years). Overall pendency would be decreased in three ways: (1) increased resources in Track 1 would result in increased output; (2) reuse of search and examination work done by other offices would result in greater efficiency; and 3) applicants who chose Track III because their applications were of lower value might ultimately decide not to pursue their application examination efforts had been expended on the applications. As a part of the three-tracks, an applicant may request and pay for a supplemental search from a participating intellectual property granting office. Any member of the public may submit written comments on this initiative being considered by the USPTO.

DATES AND TIMES: The public meeting will be held on **July 20, 2010**, beginning at 1:30 p.m.

Persons interested in attending the meeting must register by 5:00 p.m. Eastern Standard Time (EST) on **July 16, 2010**.

Written comments must be submitted by **August 20, 2010**.

ADDRESSES: The public meeting will be held at the USPTO, in the South Auditorium of Madison West, 600 Dulany Street, Alexandria, VA 22314.

Written comments should be sent by electronic mail message over the Internet addressed to 3trackscomments@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 Robert A. Clarke. Although comments may be submitted by mail, submission via e-mail to the above address is preferable.

The written comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the USPTO Internet Web site (address: <http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included.

FOR REGISTRATION TO GIVE A PRESENTATION IN THE MEETING: If you wish to make an oral presentation at the meeting, you must register by sending an e-mail

to the e-mail address, 3trackscomments@uspto.gov, by 5:00 p.m. EST on **July 13, 2010**.
See the registration information provided below.

FOR FURTHER INFORMATION CONTACT: Robert A. Clarke ((571) 272-7735), Deputy Director, Office of Patent Legal Administration, directly by phone, by e-mail to Robert.Clarke@uspto.gov, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. For further information on supplemental searches, contact Mary Critharis, 571-272-8468, Senior Patent Counsel, External Affairs, directly by phone, or by e-mail to Mary.Critharis@uspto.gov.

SUPPLEMENTARY INFORMATION: This notice announces a public meeting to solicit public opinions on an initiative being considered by the USPTO to provide applicants with greater control over when their applications are examined and to promote greater efficiency in the patent examination process. For applications filed in the USPTO which are not based on a prior foreign-filed application (e.g., that do not claim foreign priority benefit under 35 U.S.C. 119(a)-(d)), an applicant could: (1) request prioritized examination; (2) for non-continuing applications, request an applicant-controlled delay lasting up to 30 months prior to docketing for examination; or (3) obtain processing under the current procedure by not requesting either (1) or (2). For applications filed in the USPTO that are based on a prior foreign-filed application, no action would be taken by the USPTO until the USPTO received, in the U.S. application: (1) a copy of the search report, if any; (2) a copy of the first office action from the foreign office where the

application was originally filed; and (3) an appropriate reply to the foreign office action. Where the foreign office action indicated that the foreign-filed application was allowable, all that would be required for the appropriate reply would be notice to the USPTO. Where one or more rejections were made in the foreign office action, applicant's reply could include an amendment but would have to include arguments regarding why the claims in the USPTO-filed application were allowable over the evidence relied upon in the foreign office action. Following or concurrent with the submission of the foreign office action and reply, applicant could request prioritized examination or obtain processing under the current procedure. This proposal would increase the efficiency of the examination of these applications by avoiding or reducing duplication of efforts by the office of first filing and the USPTO. Because efficiency gains are anticipated in the roughly one half of all applications that are filed first abroad, the result should be substantial improvement in the USPTO's performance. By contrast, under the PTO's primary current mechanism for worksharing, the patent prosecution highway program, scaling up has been limited by the fact that it remains voluntary and can only be utilized in situations where the USPTO has not already begun its examination work. Perhaps for this reason, major patent filing jurisdictions like the Japanese and European patent office have already adopted office-driven systems in which they address first the applications for which they are the office of first filing.

Since the requirement to provide a copy of the search report, first action and an appropriate reply is being considered to avoid or reduce duplication of effort, the USPTO seeks comment on whether this requirement should be limited to first filings at offices

that have qualified as international searching authorities under PCT Article 16. In addition, in order to avoid delays in disclosure, the USPTO seeks comment on whether the requirement to provide a copy of the search report, first action, and an appropriate reply (which would result in examination delay at the office of second filing) should be limited to applications that are published.

While it is believed that most applicants will continue to file applications first in their national or regional office based on business needs or costs of translation, comment is also requested on whether the USPTO should anticipate a larger number of applications being filed at the USPTO first rather than an applicant's national office. Additionally, would this filing pattern change if (as proposed in various patent law reform bills) a foreign filing date could be used as a prior art date under US law?

The idea of office-driven worksharing, or SHARE (“Strategic Handling of Applications for Rapid Examination”) has already been the subject of some public commentary.

On October 21, 2009, the USPTO published a Notice in the Federal Register inviting the public to submit written comments and participate in a roundtable discussion on work sharing. See Request for Comments and Notice of Roundtable on Work Sharing for Patent Applications, 74 FR 54028 (October 21, 2009). Many of the comments regarding SHARE raised the concern that delayed examination of the foreign origin applications may work a disadvantage to USPTO first filers with respect to the patent term adjustment (PTA) that may accrue. This concern could be addressed by giving all applicants some

control on when their application is examined so that the applicant can best benefit from the patenting process. Specifically, under the current proposal, those who file first in a foreign office can choose subsequently to accelerate in the USPTO. Some were also concerned that SHARE would only work well if coordinated with other offices. The coordination has already started with some offices. For example, the USPTO and the Korean Intellectual Property Office (KIPO) are conducting a small-scale pilot to gather empirical data and test the feasibility of the SHARE concept. More recently, the USPTO and the United Kingdom Intellectual Property Office (UKIPO) committed to develop a plan to optimize reuse of work on patent applications that are jointly filed with the USPTO and UKIPO.

Others suggested that the search or examination fees be reduced or delayed. The instant proposal permits deferral of certain fees if Track III examination is requested. Because many comments focused on examination delays in the office of first filing, comments to this notice are requested on whether PTA should be limited by a request by applicant for deferred examination in the office of first filing. Similarly, comments are also requested on whether PTA should be limited if the applicant does not request accelerated examination in the office of first filing.

The USPTO also intends to harmonize the existing examination procedures for applications having been granted accelerated or “special” status including:

(1) applications under the accelerated examination program; (2) applications under the various patent prosecution highway programs; (3) applications advanced under other

programs under 37 CFR 1.102 (e.g., applicant's age or health); or (4) national stage applications advanced out of turn because an international preliminary examination report (IPER) prepared by the United States International Preliminary Examining Authority or a written opinion on the international application prepared by the United States International Searching Authority states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1)-(4), have been satisfied for all of the claims presented in the application entering the national stage. The USPTO is holding a public meeting and inviting public comments to seek views on whether this initiative should go forward and what changes should be considered. Further meetings may be announced by the USPTO, as appropriate.

The USPTO recognizes that the traditional "one-size fits all" examination timing may not provide applicants much opportunity to choose the examination timing they need. Therefore, in addition to the current standard procedure (Track II), the USPTO is considering providing applicants with greater ability to seek prioritized examination (Track I) or, for non-continuing applications that do not claim the benefit of a prior foreign-filed application, the ability to seek an applicant controlled up to 30-month queue prior to docketing for examination (Track III). By allowing applicants some control over the timing of examination, it is anticipated that examination resources would be better aligned with the needs of innovators.

Prioritized Examination (Track I): For some applicants with a currently financed plan to commercialize or exploit their innovation or a need to have more timely examination

results to seek additional funding, more rapid examination is necessary. While some programs are currently available to prioritize applications (e.g., the accelerated examination program and the petition to make special program), some applicants neither want to perform the search and analysis required by the accelerated examination program nor can they seek special status based on the conditions set forth in 37 CFR 1.102. For such applicants, the USPTO is proposing optional prioritized examination upon applicant's request and payment of a cost recovery fee. A request for prioritized examination may be made in a USPTO first-filed application at any time and may be made in any other application only after receipt of a copy of the search report, if any, and first action on the merits from the intellectual property office in which the relied-upon application was filed and an appropriate reply to that action in the application filed in the USPTO. On granting of prioritized status, the application would be placed in the queue for prioritized examination.

The fee would be set at a level to provide the resources necessary to increase the work output of the USPTO so that the aggregate pendency of non-prioritized applications would not increase due to work being done on the prioritized application. The fee would also be set to recover any other additional costs associated with processing the prioritized application. For example, if work output is to be increased by hiring new examiners, then the fee for prioritized examination would include the cost of hiring and training a sufficient number of new employees to offset the production work used to examine prioritized applications. Under the USPTO's current statutory authority, the USPTO is not permitted to discount the fee for small entity applicants. Should the USPTO's

authority to set fees be enhanced, it is anticipated that the USPTO would discount this fee for small and micro entity applicants, given the substantial fee that would need to be charged to recover all of the costs associated with the contemplated service.

The USPTO is also considering limiting the number of claims in a prioritized application to four independent and thirty total claims. In addition, the USPTO is considering requiring early publication of prioritized applications so that applications would be published shortly after a request for prioritization is granted, or eighteen months from the earliest filing date claimed, whichever is earlier.

All applications prioritized on payment of a fee, or accelerated or advanced out-of-turn under existing programs, would be placed in a single queue for examination on the merits and would be taken up out-of-turn relative to other new or amended applications. The goals for handling applications in this queue would be to provide a first Office action on the merits within four months and a final disposition within twelve months of prioritized status being granted. If this process is implemented, the USPTO anticipates that it would provide statistics on its progress in meeting these goals on its Internet Web site.

To maximize the benefit of this track, applicant should consider one or more of the following: (1) acquiring a good knowledge of the state of the prior art to be able to file the application with a clear specification having a complete schedule of claims from the broadest that the applicant believes he is entitled in view of the state of the prior art to the narrowest that the applicant is willing to accept; (2) filing replies that are completely

responsive to the prior Office action and within the reply period (shortened) set in the Office action; and (3) being prepared to conduct interviews with the examiner.

Traditional Timing (Track II): Applications for which neither prioritization nor an applicant-controlled up to 30-month queue prior to docketing for examination is requested will be processed traditionally, except that applicants may request prioritized examination at any time (e.g., on filing of a notice of appeal) and, for any non-continuing application, applicants may request an applicant-controlled up to 30-month queue prior to being placed on the docket for examination on the merits. An application that claims the benefit of a prior-filed foreign application will not be docketed for examination in Track II until: (1) a copy of the search report, if any, (2) a copy of the first action on the merits by the intellectual property office in which the priority application was filed, and (3) a reply to that action in the application filed at the USPTO has been received.

An applicant-controlled up to 30-month queue prior to docketing (Track III): Some applicants file an application just prior to the statutory bar date but before a commercially viable plan for exploitation of the innovation has been developed or financed. To better provide for the timing of examination that such applicants desire and to provide a similar time period to that provided internationally, the USPTO is considering permitting any applicant in an application that does not claim benefit of a prior-filed foreign application or prior non-provisional application to select, on filing or in reply to a notice to file missing parts, an applicant-controlled up to 30-month queue prior to docketing for examination. In order to avoid delays in notice to the public, any application requesting

Track III must also be published as an 18-month patent application publication. An application granted this status would be placed in a queue for applicant to request examination and pay the examination fee with the surcharge (if not already paid) within thirty months of the actual filing date of the application or any relied-upon provisional application (i.e., to which benefit is claimed under 35 U.S.C. 119(e)). Failure to request examination within the 30-month period would result in abandonment of the application. The request for examination and examination fee (and surcharge) would be due on the 30-month date but could be submitted early (e.g., on filing of the application) with a request that the application remain in the pre-examination queue for a period of time (e.g., up to 30 months from filing). On expiration of the time period, the application would be placed in the queue for examination.

On receipt of the request for this queue, the USPTO would determine if the application was ready for publication as a patent application publication (except for the receipt of the examination fee) and determine if any request for nonpublication made on filing had been rescinded. If both conditions were met, the application would be placed in a queue to await a request for examination and payment of the examination fee. If the application was not ready for publication, a requirement to place the application in condition for publication would be made and, once satisfied, the application would be placed in the 30-month queue. The request for examination and payment may be made at any time during the 30-month period. If no request is made within the 30-month period, the application would be held abandoned. The examination fee and the surcharge may be paid within the

30-month period or may be submitted after a timely request for examination is filed on notice of non-payment by the USPTO, along with any required extension of time fees.

Upon receipt of the examination request and fee, the application would be placed in the queue for examination, but the receipt date of the examination request would be used as the “date in queue.” Thus, the application will be taken up for examination as if the request date was the application’s actual filing date. If applicants determine that more rapid examination is desirable, then they may request (and pay the required fee) for prioritized examination while the application is in the queue for examination.

Currently, the USPTO is considering a rule to offset any positive PTA accrued in a Track III application when applicant requests that the application be examined after the aggregate average period to issue a first Office action on the merits. For example, if the aggregate average time to issue a first Office action is 20 months and applicant requests that the application be examined at month 30, the proposed PTA reduction would be 10 months beginning on the expiration of the 20-month period and ending on the date on which applicant requested examination to begin. The overlap with the aggregate average period when the USPTO would not be able to have issued a first Office action on the merits would not be treated as an offsetting reduction.

Similarly, for an application in any of the three tracks that claims foreign priority, the USPTO is considering a rule to offset positive PTA accrued in the application when applicant files the required documents (that include a copy of the search report, if any,

and first office action from the foreign office and an appropriate reply to the foreign office action as if the foreign office action was made in the application filed at the USPTO) after the aggregate average period to issue a first Office action on the merits. For example, if the aggregate average time to issue a first Office action is 20 months and applicant submits the required documents 30 months after the filing of the application, then the proposed PTA reduction would be 10 months beginning on the expiration of the 20-month period and ending on the date of the filing of the required documents. Thus, delays by foreign offices beyond the aggregate average time for the USPTO to issue a first Office action on the merits would be an offsetting reduction against any positive PTA accrued by the delay in issuing a first Office action while the USPTO awaits the preparation of a search report and first action by the office of first filing.

In Tracks I and II, if the U.S. application claims the benefit of a prior-filed foreign application, and the relied-upon foreign application is abandoned prior to an action on the merits being made available, applicant must notify the USPTO and request that the application be treated for examination queuing purposes as if the foreign priority claim had not been made. The USPTO is considering making the failure to notify the USPTO within three months of the abandonment in the foreign office trigger a PTA offset as the USPTO would not appreciate the need to treat the application as if first-filed in the USPTO until such notice is given. Similarly, if the office of first filing has a practice of not producing actions on the merits, applicant would need to notify the USPTO that the application should be treated for examination queuing purposes as if the foreign priority claim had not been made.

The USPTO is also considering negotiating with one or more intellectual property granting offices (IPGOs) to provide an optional service for applicants at the USPTO to request that the USPTO obtain from one or more IPGOs a supplemental search report. This supplemental search report will be considered in preparation of the first Office action on the merits by the examiner. An additional search will be conducted by the examiner at the USPTO. This option would be subject to the USPTO negotiating appropriate agreements with one or more IPGOs. The USPTO is also considering providing a short period for applicant to review and make any appropriate amendments or remarks after the supplemental search is transmitted prior to preparing the first action.

Comments on one or more of the following questions would be helpful:

1. Should the USPTO proceed with any efforts to enhance applicant control of the timing of examination?
2. Are the three tracks above the most important tracks for innovators?
3. Taking into account possible efficiency concerns associated with providing too many examination tracks, should more than three tracks be provided?
4. Do you support the USPTO creating a single queue for examination of all applications accelerated or prioritized (e.g., any application granted special status or any prioritized application under this proposal)? This would place applications made special under the “green” technology initiative, the accelerated examination procedure and this proposal in a single queue. For this question assume that a harmonized track would permit the USPTO to provide more refined and up-to-

- date statistics on performance within this track. This would allow users to have a good estimate on when an application would be examined if the applicant requested prioritized examination.
5. Should an applicant who requested prioritized examination of an application prior to filing of a request for continued examination (RCE) be required to request prioritized examination and pay the required fee again on filing of an RCE? For this question assume that the fee for prioritized examination would need to be increased above the current RCE fee to make sure that sufficient resources are available to avoid pendency increases of the non-prioritized applications.
 6. Should prioritized examination be available at any time during examination or appeal to the Board of Patent Appeals and Interferences (BPAI)?
 7. Should the number of claims permitted in a prioritized application be limited? What should the limit be?
 8. Should other requirements for use of the prioritized track be considered, such as limiting the use of extensions of time?
 9. Should prioritized applications be published as patent application publications shortly after the request for prioritization is granted? How often would this option be chosen?
 10. Should the USPTO provide an applicant-controlled up to 30-month queue prior to docketing for examination as an option for non-continuing applications? How often would this option be chosen?
 11. Should eighteen-month patent application publication be required for any application in which the 30-month queue is requested?

12. Should the patent term adjustment (PTA) offset applied to applicant-requested delay be limited to the delay beyond the aggregate USPTO pendency to a first Office action on the merits?
13. Should the USPTO suspend prosecution of non-continuing, non-USPTO first-filed applications to await submission of the search report and first action on the merits by the foreign office and reply in USPTO format?
14. Should the PTA accrued during a suspension of prosecution to await the foreign action and reply be offset? If so, should that offset be linked to the period beyond average current backlogs to first Office action on the merits in the traditional queue?
15. Should a reply to the office of first filing office action, filed in the counterpart application filed at the USPTO as if it were a reply to a USPTO Office action, be required prior to USPTO examination of the counterpart application?
16. Should the requirement to delay USPTO examination pending the provision of a copy of the search report, first action from the office of first filing and an appropriate reply to the office of first filing office action be limited to where the office of first filing has qualified as an International Searching Authority?
17. Should the requirement to provide a copy of the search report, first action from the office of first filing and an appropriate reply to the office of first filing office action in the USPTO application be limited to where the USPTO application will be published as a patent application publication?

18. Should there be a concern that many applicants that currently file first in another office would file first at the USPTO to avoid the delay and requirements proposed by this notice? How often would this occur?
19. How often do applicants abandon foreign filed applications prior to an action on the merits in the foreign filed application when the foreign filed application is relied upon for foreign priority in a U.S. application? Would applicants expect to increase that number, if the three track proposal is adopted?
20. Should the national stage of an international application that designated more than the United States be treated as a USPTO first-filed application or a non-USPTO first-filed application, or should it be treated as a continuing application?
21. Should the USPTO offer supplemental searches by IPGOs as an optional service?
22. Should the USPTO facilitate the supplemental search system by receiving the request for supplemental search and fee and transmitting the application and fee to the IPGO? Should the USPTO merely provide criteria for the applicant to seek supplemental searches directly from the IPGO?
23. Would supplemental searches be more likely to be requested in certain technologies? If so, which ones and how often?
24. Which IPGO should be expected to be in high demand for providing the service, and by how much? Does this depend on technology?
25. Is there a range of fees that would be appropriate to charge for supplemental searches?

26. What level of quality should be expected? Should the USPTO enter into agreements that would require quality assurances of the work performed by the other IPGO?
27. Should the search be required to be conducted based on the U.S. prior art standards?
28. Should the scope of the search be recorded and transmitted?
29. What language should the search report be transmitted in?
30. Should the search report be required in a short period after filing, e.g., within six months of filing?
31. How best should access to the application be provided to the IPGO?
32. How should any inequitable conduct issues be minimized in providing this service?
33. Should the USPTO provide a time period for applicants to review and make any appropriate comments or amendments to their application after the supplemental search has been transmitted before preparing the first Office action on the merits?

Registration Information: The USPTO plans to make the meeting available via Web cast. Web cast information will be available on the USPTO's Internet Web site before the meeting. The written comments and list of the meeting participants and their associations will be posted on the USPTO's Internet Web site (<http://www.uspto.gov>).

When registering, please provide the following information: (1) your name, title, and, if applicable, company or organization, address, phone number, and e-mail address; and

(2) if you wish to make a presentation, the specific topic or issue to be addressed and the approximate desired length of your presentation.

There is no fee to register for the public meeting and registration will be on a first-come, first-serve basis. Early registration is recommended because seating is limited.

Registration on the day of the public meeting will be permitted on a space-available basis beginning at 1:30 p.m. Eastern Standard Time, on **July 20, 2010**.

The USPTO will attempt to accommodate all persons who wish to make a presentation at the meeting. After reviewing the list of speakers, the USPTO will contact each speaker prior to the meeting with the amount of time available and the approximate time that the speaker's presentation is scheduled to begin. Speakers must then send the final electronic copies of their presentations in Microsoft PowerPoint or Microsoft Word to 3trackscomments@uspto.gov by **July 16, 2010**, so that the presentation can be displayed in the Auditorium.

If you need special accommodations due to a disability, please inform the contact person (see FOR FURTHER INFORMATION CONTACT) by **July 16, 2010**.

Date: _____

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