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April 18, 2011

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents
P.O. Box 1450
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Attn: Robert A. Clarke
Deputy Director
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

Re: Comments on *Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures*, 76 Fed. Reg. 6369 (February 4, 2011).

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the request the United States Patent and Trademark Office (the “Office”) published in the Federal Register on February 4, 2011 (PTO-P-2010-0092). In particular, the Section submits the following comments on the *Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures*, 76 Fed. Reg. 6369 (February 4, 2011) (the “proposed Track I program”). These comments have not been approved by the ABA House of Delegates or Board of Governors, and should not be considered to be views of the American Bar Association.

The Section supports a program which would allow applicants to voluntarily accelerate the handling of their applications upon the payment of an appropriate fee and compliance with reasonable formal requirements so long as the existence of the program does not adversely impact other patent applicants. It is the Section’s understanding that the Office expects to be able to avoid any adverse impact on applications outside of the proposed Track I program if the Office is permitted to use the entirety of the \$4,000 fee the Office proposes to collect from each program participant to obtain the needed resources to achieve meaningful accelerated examination.

The Section appreciates the Office’s efforts to provide the public with greater transparency regarding the success of the proposed Track I program. However, the Section has concerns with regard to several aspects of the proposed Track I program that relate to restriction practice and which applications are eligible for the program. In addition, the Section favors the creation of a separate program that would provide U.S. applicants with greater access to the benefits of the Patent Prosecution Highway (PPH) Program. The following comments highlight the Section’s position on these issues.

1) The Section favors full reporting on the success of the proposed Track I program.

The Section appreciates the Office's efforts to provide the public with greater transparency regarding the success of the proposed Track I program. In particular, the Section applauds the Office's plans to post data at the work group level on the Office's Internet Web site that will show whether or not the Office is making its goals.

Several members of the Section have indicated it would be helpful for the published statistics to include the number of requests received as well as the aggregate time to final disposition at the greatest level of detail practical. It would also be helpful for the published statistics to include a reflection of the split between the number of large entity and small entity applicants for each statistic reported, regardless of whether a reduced fee is authorized for small entities requesting Track I status.

2) The Section is concerned the proposed Track I program does not address restriction practice.

The Section believes that the procedure should explicitly address how a restriction requirement is to be handled. Several members of the Section indicated it would be helpful to encourage Examiners to make restriction requirements by phone whenever possible and to invite a discussion of the restriction requirement at the time it is made with a view to reaching a consensus with the applicant. The Section recommends that Track I participants be permitted to traverse restriction requirements. In addition, it would be advantageous for petitions from restriction requirements in Track I cases to be handled by a procedure that would provide the Examiner a timely decision on petition which would allow the Examiner to examine the restricted out subject matter, in the case of a reversal, such that the target 12 months to final disposition can still be met.

3) The Section favors broadening the scope of Track I to include national stage applications under the Patent Cooperation Treaty and Requests for Continued Examination.

The Section favors allowing participation in Track I for national stage applications under the Patent Cooperation Treaty (PCT) in addition to those filed under 35 U.S.C. § 111(a). The Section recognizes that, under the proposed Track I program, an applicant could simply file a continuation application claiming the benefit of priority of a PCT application instead of filing a national stage application. However, members of the Section have raised concerns that this continuation approach would create unnecessary administrative work for both the Office and the applicant. In addition, such a continuation approach would deny the applicant the discounts to the search and examination fees normally available to PCT applicants. In this regard, it is noted that a PCT application is only eligible for PPH acceleration if a claim had been found to satisfy the novelty and inventive step in the International Stage.

The Section further favors allowing a request for Track I status be filed with a Request for Continued Examination, regardless of whether Track I status was sought in the initial filing of the application. It is apparent that an applicant can obtain access to the proposed Track I program by filing a continuation application. However, requiring an applicant to obtain or continue Track I status for a patent application already under active prosecution may create unnecessary administrative burdens. The Section is especially concerned that, for an application already granted Track I status, the applicant be given the opportunity to continue that status by the payment of an

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additional fee. Such an application would have already been found compliant with the Track I requirements and it would be an application with which the examiner is already quite familiar.

4) The Section favors the creation of a separate program that would provide U.S. applicants with greater access to the benefits of the Patent Prosecution Highway Program.

The Section acknowledges and appreciates the Office's efforts to provide enhanced examination in exchange for the payment of a substantial fee. The Section further recognizes the Office currently has a procedure in place by which an application can be made special if complex searching requirements are met. However, the Office does not have a program that places U.S. applicants on equal footing with foreign applicants for the purposes of the PPH Program. As noted in the Section's Comments on The Draft USPTO FY 2010-2015 Strategic Plan, the only opportunity U.S. filers have in making use of the PPH Program is by chance the U.S. examiner has completed the examination process before a foreign patent office has begun prosecution of the corresponding case. While foreign patent offices provide very easy mechanisms for accelerating examination in their countries so that their filers can have access to the PPH Program in the United States, the United States only offers either a very costly (the proposed Track I program) or a very complex procedure for obtaining accelerated examination. Thus, the Section strongly encourages the Office to consider a program which would grant U.S. applicants the ability to request acceleration for the purpose of participating in the PPH Program without first having to: (1) pay the substantial fee set forth in the proposed Track I program; or (2) utilize a program with substantial legal risks. This will permit the PPH Program to be used by U.S. applicants so that they too can benefit from this program in obtaining expedited allowance in foreign patent offices.

In closing, the Section appreciates the Office asking for input on the proposed changes to implement the prioritized examination track (Track I) of the Enhanced Examination Timing Control Procedures.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,



Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law