July 2, 2013

Via Electronic Mail
Teresa.Rea@uspto.gov

The Honorable Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313

Re: Authorization to Permit Foreign Patent Offices Access to Search
Results for Pending USPTO Patent Applications

Dear Acting Under Secretary Rea:

I am writing on behalf of the American Bar Association Section of
Intellectual Property Law (the “Section”) with recommendations which would
provide to patent applicants a means to authorize permission for foreign patent
dependencies to access search results for pending USPTO patent applications.

The views expressed herein are those of the ABA Section of Intellectual
Property Law, not the American Bar Association as a whole, its House of
Delegates, or its Board of Governors.

Particularly, the Section favors inclusion, on the USPTO’s Application Data
Sheet (ADS) Form, an authorization section for providing a foreign patent office
pre-publication electronic access to the bibliographic data and search results for the
patent application, wherein priority is being claimed in that foreign patent office,
and that such authorization section, in addition to the currently available
authorization section permitting pre-publication transmittal of priority documents
on the ADS Form, be restated as “opt-out” provisions.

These recommendations arise from efforts by the European Patent Office to
provide quick but thorough searches on applications filed in the EPO and to
increase worksharing by patent offices. Under rules 141 and 70b EPC, European
patent applicants must submit to the EPO any search results from the office of first
filing as soon as they are available. Rule 141(2) EPC provides U.S. applicants an exemption, allowing search information to be provided automatically by the USPTO in electronic form to the EPO. However, the USPTO does not provide pre-publication data without the applicant’s consent, which consent must be provided by form PTO/SB/69, and unfortunately, many applicants do not submit this form.

In actuality, a similar problem exists relating to permission to send a copy of the priority document to the EPO and other regions and countries, as priority documents often must also be sent prior to publication of the U.S. application. Currently, the USPTO has automatic priority document exchanges with several patent offices. Permission for this—sending pre-publication priority patent applications—is granted through authorization on the USPTO’s Application Data. By checking an authorization box on the ADS, the applicant gives authorization in advance to the USPTO in case a foreign application is filed. Notably, this authorization for priority documents is currently not construed to include access to search results.

In an effort to improve efficiency and worksharing among patent offices and to facilitate compliance by applicants, the following recommendations are proposed:

a) We recommend that the currently-available “Authorization to Permit Access” section on the USPTO’s ADS Form be amended to specifically include authorization to send pre-publication search results to the European Patent Office.

b) Further, we recommend that the amended “Authorization to Permit Access” section be broadened to include any other country or region requiring pre-publication search results, although currently only the EPO is requesting such information.

c) We further recommend that, rather than requiring the applicant to check a box to provide explicit authorization, this authorization section be changed to an “opt-out” authorization—namely, that the statement in the ADS states that unless the box is checked, authorization is automatically given to send both the priority document and pre-publication search results whenever such results are requested by foreign patent offices in which the applicant has filed his application claiming the benefit of this priority application. Signing the ADS authorizes the USPTO to send documents, except when the “opt-out” box has been checked.
The Section appreciates the USPTO’s willingness to consider these recommendations which provide greater efficiency to patent offices and decrease the burden to applicants.

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,

Joseph M. Potenza
Section Chair
American Bar Association
Section of Intellectual Property Law