

AMERICAN BAR ASSOCIATION

SECTION OF INTELLECTUAL PROPERTY LAW

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October 6, 2006

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
600 Dulany Street

Madison West Bldg, Suite No. 10D44
Alexandria, VA 22314

Attn: USPTO Strategic Plan Coordinator
StrategicPlanning1@uspto.gov

Re: Request for Comments on the United States Patent and Trademark
Office's Draft Strategic Plan for FY 2007-2012

Dear Mr. Secretary:

In response to your Request for Comments on the Draft Strategic Plan for FY 2007-2012, dated August 21, 2006, and published in the Federal Register of August 24, 2006, the American Bar Association Section of Intellectual Property Law ("the Section") submits the comments that follow. These comments have not been submitted to or approved by the ABA House of Delegates or Board of Governors, and should not be considered as representing the views of the Association.

The Section supports the United States Patent and Trademark Office's ("USPTO") general strategic goals of optimizing patent and trademark quality and timeliness and improving intellectual property protection and enforcement domestically and abroad.

In addition to the comments below on several specific topics in the draft Strategic Plan, the Section will submit additional comments as further details of the proposed implementation of the Strategic Plan for FY 2007-2012 are made available. We note that the Draft Strategic Plan for FY 2007-2012 published on August 24th (the Strategic Plan") refers to various attachments not included in the publication and not discussed here.

GOAL 1 of the Strategic Plan – Optimize Patent Quality and Timeliness

A. Proposed Strategic Response by USPTO to Objective 1: Provide high quality traditional examination of patent applications leading to final disposition of most applications in XX months by 2012.

The Initiatives described in the Strategic Plan include the proposal of a "Patent Application Peer Review Pilot" in which "public sector volunteer experts will review

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published applications and provide prior art.” The Section expresses its willingness to consider and provide comments on such a program once details are made available. For example, the Section supports in principle the establishment of an appropriate panel of experts to work with the USPTO to make recommendations for improving the process of identifying the best prior art in the examination process. However, the Section opposes outsourcing of the search function by the USPTO to the extent that it embodies an organizational separation of the search function from the examining function, unless and until pilot studies demonstrate that efficiency and/or quality will be improved by outsourcing.

B. Proposed Strategic Response by USPTO to Objective 2: Improve quality and timeliness of patent examination by developing a patent suite of products.

This Objective proposes a strategy of offering alternative products and thereby moving away from the current one-size fits all filing and examination system. The Section wishes to express its willingness to consider and provide comments on different patent products that may be proposed by the USPTO when further details concerning this proposal are provided. However, the Section would oppose creation of patent products that would result in differential treatment of patent applications. This includes how inventions are treated with respect to timeliness of examination, patentability, criteria for publication, opportunities to challenge patentability, prior art disclosure requirements, as well as presumptions of validity, requirements for validity or requirements for enforceability.

C. Proposed Strategic Response by USPTO to Objective 4: Transform appeals processing, and enrollment and discipline functions.

The Initiatives include a proposal to enhance registered practitioner requirements. The Section is willing to consider and provide comments concerning the details of this proposal when they are made available. The Section agrees that maintaining an acceptable level of competence to practice before the USPTO includes continuing study of the law, and the Section supports the USPTO’s discretion to require persons, as a condition of continued registration to practice before that agency, to periodically complete a reasonable amount of continuing legal education pertinent to such practice. However, the Section opposes, in principle, the imposition of a fee on practitioners for continued registration to practice before the USPTO if there is no assurance that such fees will be used to further the operations of the USPTO regarding the administration of the registration system.

GOAL 3 of the Strategic Plan – Improve Intellectual Property Protection and Enforcement Abroad

A. Proposed Strategic Response by USPTO to Objective 2: Continue efforts to develop unified standards for international IP practice.

The Section supports the USPTO’s ongoing efforts to pursue harmonized patent laws and will consider and provide comments on specific measures as they are made available. For example,

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the Section favors enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure under 35 U.S.C. § 112 of the invention or, in the event of an assignment of rights, shall belong to the assignee thereof. The Section opposes in any patent harmonization treaty involving the United States any requirement for a change in United States patent law that would restrict the scope of patentable subject matter available under 35 U.S.C. §101.

Sincerely,

A handwritten signature in black ink, appearing to read 'SBM', written in a cursive style.

Susan Barbieri Montgomery
Chair, Section of Intellectual Property Law