BUSINESSEUROPE

COMMENTS

20 August 2010

BUSINESSEUROPE COMMENTS ON USPTO'S ENHANCED EXAMINATION TIMING CONTROL INITIATIVE

BUSINESSEUROPE welcomes the opportunity to provide comments on USPTO's recently unveiled Enhanced Examination Timing Control Initiative.

In view of the serious challenges the various major patent systems are facing, we are definitely appreciative of the USPTO's initiative to promote greater efficiency in the patent examination process, in particular through the sharing of work results.

However, to prevent unintended disadvantages and to limit the inherent complexity of the new scheme, we believe that certain issues should be clarified before the proposed system is introduced. At this stage, our comments are directed to the main principles involved in the proposal. We may offer further comments at a later stage regarding some of the more detailed questions raised in the USPTO document.

Comments relating to applications filed in the USPTO that are based on a prior foreign-filed application

This part of the proposal is, of course, of primary importance for European industry and we would like to offer the following comments.

- It is not entirely clear whether and to what extent the US applications involved will be able to benefit from the flexibility of the proposed new system, i.e whether Track I or even Track II will be practically available. There is a concern that applicants having first filed outside the United States will have only Track III, or a variation of it, at their disposal. Another concern is the potential effect on PCT applications entering the US national phase and the possibility for the applicants involved to use the PCT-PPH system.

- We understand why the USPTO would want to have the search report / first office action at the Office of First Filing (OFF) and the reply thereto available at the time the examination starts but we believe there should be a time limit beyond which examination would start anyway. Otherwise, there may be situations where excessive delays would occur, which are not in the interest of legal certainty, may be unfair to applicants and may lead to undesired practices.

- The requirement that the reply to the first office action of the OFF is to be not only translated but also modified to become the reply, including claim amendments, that would have been made if the office action had been produced by the USPTO raises concerns in terms of additional costs, of consistency with the general objective of harmonization, notably at Trilateral level, and of potential risks for the applicant down the road, e.g. issues of

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inequitable conduct. In our view, the most important element of the foreign prosecution, as well as the most directly relevant to the US examiner, is the search report or the art cited in the office action. Providing the US examiner with an adaptation to US law and practice of a reply and claim amendments made under a different body of law and practices is likely to prove more confusing than helpful.

Comments relating to Track I

We believe there is benefit to be derived for both applicants and the USPTO from an accelerated track if it does not lead to additional delays in the normal handling of applications.

How attractive the scheme will be for applicants will depend largely on the level of the corresponding fee and on the limitations, e.g. limitation regarding the number and organization of claims, that will be introduced.

As already mentioned above, the extent to which applications claiming a foreign priority will be eligible to Track I is a serious concern for us.

Comments relating to Track III

Although the proposal is careful not to use the expression "deferred examination" in relation with Track III, we believe the proposed scheme raises the same kind of issues as deferred examination. BUSINESSEUROPE does not support deferred examination. Any step taken by the USPTO in that general direction would be likely to have profound international repercussions. This aspect of the proposal is the one that requires the most careful consideration and caution. It is all the more so if it were practically to become the standard approach for foreign-priority based applications. We would like to emphasize the following points.

- It is somewhat unclear whether the proposal is simply to delay the docketing for examination by 30 months from the priority date, with the examination, once started, progressing at the standard, Track II, pace or if the whole examination process will be slower compared to an examination under Track II. If the former, the long term benefits for the USPTO may be limited unless a significant number of Track III applications are not followed by a request for examination before the end of the 30-months period. If the latter, and particularly in the event that Track III proves very successful with applicants, there may be an effect on the level of legal certainty for the whole community.

- To limit any possible negative effect, the delay should not go beyond 30 months from the priority date.

- Also, all Track III applications should be published at 18 months from priority date.

- Offering the possibility for third parties to request an early start of the examination is an intellectually satisfying concept but it should be carefully

weighed against the difficult questions it raises regarding who should pay for the examination and the additional layer of complexity it adds for both applicants and examiners with the potential development of undesired strategies.

Respectfully submitted