

August 17, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: david.kappos@uspto.gov
cc: charles.pearson@uspto.gov

**RE: US/UK Proposal to WIPO on “PCT 20/20”
WIPO document PCT/WG/5/18 (May 3, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States and United Kingdom joint proposal to the World Intellectual Property Organization (WIPO) on “PCT 20/20,” as contained in WIPO document PCT/WG/5/18, dated May 3, 2012. AIPLA supports the joint initiative for PCT 20/20, and provides comments on suggested ways to refine and improve the proposal.

AIPLA is a national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property.

AIPLA has consistently supported the Patent Cooperation Treaty (PCT), and efforts of the Member States to update and improve procedures under the PCT. AIPLA applauds the current efforts of the USPTO and UKIPO to further improve the PCT, and to make it more effective and efficient for users and offices alike. We therefore support the PCT 20/20 proposal, and offer the following comments concerning sections (A) through (K), as contained in paragraph 8 of document PCT/WG/5/18, and annex.

(A) Self-Service Changes (92bis/Priority Claims)

AIPLA is not convinced that this change is necessary, as the new ePCT feature allows users to make changes under Rule 92bis, to make priority claim changes, as well as to withdraw applications as suggested in section (C) of the 20/20 proposal. The changes implemented through the ePCT are fully described in the January 2012 issue of the WIPO PCT Newsletter (http://www.wipo.int/export/sites/www/pct/en/newslett/2012/newslett_12.pdf).

AIPLA suggests that the scope of the ePCT system be expanded to increase the ease of submitting any documentation during the international phase. In addition to the submission of documents online, the concept of “self-certification,” currently introduced in the US under the PPH system, should be expanded to the PCT. The applicant alone should be responsible for the accuracy of the statements submitted, which should not be subject to secondary review.

Further, it would be beneficial if the PCT ensured that more submissions during the international phase (for example, power of attorney documents and assignments) would be accepted automatically by the DO/EOs upon entry into the national phase.

(B) Limited Chapter I Claim Amendments

The main concern with Chapter I claim amendments is that they risk delaying the issuance of ISRs/WOs. The proposal should require a firm time limit for submissions of Chapter I claim amendments. Otherwise, the result could be the postponing of the issuance of all ISRs/WOs, because amendments may be submitted in some cases. This would result in delays for everyone for the sake of the few who might want to submit amendments.

However, AIPLA suggests allowing amendments to be submitted even after the proposed time limit expires. If the amendments are submitted after the proposed time limit, they would not be examined, but they would be effective in all DO/EOs upon entry into the national phase. If applicants have the ability to amend the claims in Chapter I without examiner review, that would eliminate having to file an Article 34 amendment and enter into Chapter II in order for amendments to be effective in all designated states, or alternatively having to file preliminary amendments in each office.

(C) Simplify Withdrawal of International Applications

This feature is now available through ePCT (see (A), above).

(D) Standardizing Fee Reductions for National Stage Applications

While AIPLA supports this proposal, it could be very difficult to implement fee changes in each national office. Nevertheless, the argument could be made to the offices that PCT-PPH reduces the cost of examination and that the cost reduction should be reflected in lower fees.

The USPTO could take the lead on this issue by itself offering a fee reduction for claims meeting the criteria under Article 33(2)-(4) as searched by all ISAs. Currently the fee reduction is only available in the USPTO where the search is done by ISA/US.

(E) International Small/Micro Entity Fee (or Discount)

AIPLA has a number of concerns with respect to this proposal. First, the difficulty in implementing the proposal across all ISAs does not seem proportionate to the relatively small size of the reduction in the international filing fee, when compared to search and transmittal fees.

Second, there may be resistance from corporate filers who might not wish to pay a higher fee due to reduced fees for small/micro entity filers. A cost analysis should be performed to determine whether corporate filings would be impacted by the reduction in fees. There is also a possibility that emerging and developing countries would request a similar reduction in fees, on the assumption that the lower fee would promote economic development, further impacting the level of fees for other filers.

Third, AIPLA questions whether the small/micro entity fee would also apply to the fees payable upon entry into the national/regional phase. If so, it would be necessary to reconcile the different national requirements for what constitutes a small/micro entity, as well as to resolve the potential issue posed by countries that impose punitive measures if an applicant claims the wrong entity status.

Finally, if the proposal were implemented, clear guidelines would need to be formulated concerning requirements to track changes in entity size. Any obligation to make retroactive fee payments because of an increase in the entity size should be discouraged.

(F) Integrate National/International Phases, Use a National First Action on the Merits for PCT Search Report, Require Response to Negative Comments in the National Phase

AIPLA supports this proposal only in cases where the ISR/WO would be the first national office action for the national/regional office of the selected ISA. The proposal would reduce duplicative work by the office, and it would therefore be reasonable that the applicant should be required to respond to any negative comments upon entry into the national phase in that office. The EPO currently issues only one ISR/WO for both the international and regional phases. This model could be referred to when promoting a similar model for all ISAs.

The proposal to integrate the national and international phases is fundamentally related to the proposal on mandatory top-up searches (see (I), below). If the ISR/WO is used as the first national office action, the scope of the top-up search should be limited to references which have an earlier filing date than the application, but which had not yet been published at the time of the first search. To allow search by the national office of references other than these would eliminate any efficiency obtained through a requirement to respond to negative comments in the ISR/WO.

(G) Mandatory Recordation of Search Strategy

AIPLA supports this proposal because it would enable a second examiner to take better advantage of the first examiner’s work product. A second examiner would also be able to determine if she/he agreed with the search strategy of the first examiner, and could perform an additional search more efficiently. The proposal would also increase the efficiency and quality of PPH applications at the national level.

However, the proposal would require a uniform format for classification of the search strategy to reduce confusion and wasted time by the second examiner in understanding the work product of the first examiner. A common language should be used to facilitate understanding of the search strategy from office to office.

Further, the search strategy should be made available to the applicant/users after the 18 month publication date to allow the applicant to better understand how the examiner’s approach affected the search.

(H) Collaborative Searching (2+ Offices), Eliminate Supplementary International Search

AIPLA supports the concept of a collaborative search performed by the USPTO, EPO and KIPO. However, it would need to be determined whether applicants would be interested in a collaborative search in spite of the additional costs. The supplementary international search has been used sparingly, and it should be determined whether the reason is largely due to the added costs. If the cost of SIS has been the overriding concern, then collaborative search may be equally unpopular.

The use of collaborative search may be enhanced by providing for faster examination when collaborative search is elected. This would help differentiate applicants who actively use the PCT to increase efficiency in the national phase from applicants who use the PCT as a means to delay examination in the national stage.

An additional concern is that a single search, as compared to a collaborative search, may be perceived to be of inferior quality. The PCT should take active steps to ensure that a single search is not perceived to be inferior once collaborative search is introduced.

(I) Mandatory Top-Up Searches

AIPLA supports mandatory top-up searches as a measure that would improve the quality of Chapter II. It is, however, necessary to clearly define the scope of the top-up search to limit an examiner’s ability to perform searches that overlap with the Chapter I search. Any additional references should be forwarded to the applicant and the applicant should be allowed to respond to the references. Further, to avoid delays in receiving the IPRP II, there should be a time limit for the top-up search to be performed.

(J) Development and Implementation of the Global Dossier and Incorporation into the PCT

Given the work currently being done on the CPC Classification System and the availability of Common Citation Document, AIPLA supports the implementation of a Global Dossier. The Global Dossier’s potential to greatly increase efficiency would significantly benefit both filers and the various offices during the examination process. It could also be of benefit to allow the applicant to add references to the applicant’s own files in the Global Dossier.

(K) Formal Integration of the Patent Prosecution Highway into the PCT, Fast Track of National Phase Applications, Improve Reuse of PCT Work at the National Phase

AIPLA supports integration of PPH into the PCT. Such a system would offer great efficiency and cost reductions for national offices, thereby promoting the overall purpose of the PCT.

However, the decision whether to fast-track an application with claims that meet the requirements of Article 33(2)-(4) must be at the option of the applicant. The speed with which an applicant wants an application to proceed through the national offices is often impacted by other considerations, and accelerated examination is not always preferred.

(L) Making the Written Opinion of the International Searching Authority Available to the Public after International Publication

AIPLA supports making the WO available to the public after publication of the application. Because most countries have an 18 month publication date, there is no longer a need to keep the WO confidential after publication. Making the WO available would increase transparency in the PCT.

* * * * *

Thank you for allowing AIPLA the opportunity to provide comments on this Proposal. AIPLA looks forward to further dialogue with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

William G. Barber

President

American Intellectual Property Law Association