

March 7, 2011

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Response to Request for Comments on Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures
76 Federal Register 6369 (February 4, 2011)

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the proposed “Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures.”

AIPLA is a national bar association with approximately 16,000 members who are primarily intellectual property lawyers and other patent practitioners in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Its members represent both owners and users of intellectual property.

Under the published Track I proposal, an applicant may request prioritized examination upon the filing of an original utility or plant nonprovisional application (including new continuing applications filed on or after implementation) if:

- (1) the application was filed via EFS-web;
- (2) the application is complete (§ 1.51(b)), with the payment on filing of any fees due under § 1.16 (including the filing fee, search fee, examination fee, and any applicable excess claims fee and application size fee);
- (3) the \$4,000 prioritized examination fee (§ 1.17(c)), the \$130 voluntary publication processing fee (§ 1.17(i)), and the \$300 publication fee (§ 1.18(d)) are paid on filing; and
- (4) the application contains or is amended to contain no more than 4 independent claims and no more than 30 total claims (no multiple dependent claims permitted).

The proposed procedure would be available only for applications filed on or after the implementation date. Prioritized examination means that the application would be accorded special status and placed on the examiner’s special docket throughout its entire course of prosecution before the examiner until a final disposition is reached, which is estimated to average

about 12 months from the date prioritized status is granted. If an applicant requests an extension of time, prioritized examination will be terminated. The Office proposes to limit requests for prioritized examination to a maximum of 10,000 applications for the first year.

In a previous letter to the Office, AIPLA raised concerns that fees for prioritized examination not be subject to fee diversion. See AIPLA Comments on “Enhance Examination Timing Control Initiative,” August 20, 2010 letter to The Honorable David J. Kappos. In the current notice, the Office indicated that the Office will need to consider eliminating the program if the appropriations received by the Office are not adjusted to reflect the projected fee revenue resulting from the prioritized examination program. The Office also indicated that it will continue to seek additional fee setting authority to provide a small entity discount for the fee for prioritized examination.

Although the proposed prioritized examination proposal will be attractive to many applicants, AIPLA continues to be concerned about the availability of applicant fees for Office programs, even though pending legislation could alleviate those concerns. While prioritized examination would be a positive development, we would not want to see such a program impinge on the normal examination and timing of non-prioritized cases. There is a risk of an adverse impact on the examination of other applications that will necessarily be delayed to handle the prioritized applications absent additional examining staff to minimize additional delay. We are also concerned that prioritized examination will promote even further delay in the examination of Requests for Continued Examination (RCEs) as their character and treatment were changed from an amended case to a Special New application, but not eligible for prioritized examination.

It is important that this beneficial procedure be available to both large entities and small entities alike, and that user fees be adjusted to accommodate that end. Clearly, a \$4,000 fee would be much more of a burden on some applicants than on others. At the same time, we understand that the costs of this procedure to the Office need to be supported by user fees. Thus, we urge the Office to continue seeking authority to apply small and micro entity fees to the prioritized examination procedure insofar as such fees could support the overall program without slowing down the process for non-accelerating filers of all types and classes.

It is not understood why the program as proposed is being restricted to applications that would be filed on or after the implementation date, as opposed to including as well pending applications that were filed via EFS-web and have not been examined. The proposed limitation may actually aggravate the backlog of pending applications awaiting examination since the applicants now waiting in the examination queue (in excess of 700,000) would be encouraged by the proposed procedure to file another duplicate application to take advantage of prioritized examination. Applicants are not likely to abandon their existing applications at least until the results of prioritized examination are known. The Office is requested to reconsider this limitation and to make the program available to all new applications that have not been examined, similar to the opportunities available under the Patent Prosecution Highway.

The proposed program requires that the request for prioritized examination and fees must be present on filing, yet the restriction on the number and type of claims is apparently subject to a Preliminary Amendment. We presume that such amendment must be made at the time of filing, for example, where a Paris Convention application has claims that do not meet the program requirements, and that such amendment cannot be filed after the filing date. There should be a

clarification of when such amendments can be made. If the Office is going to permit a post-filing amendment to put the claims into compliance, it would seem that the same latitude could be permitted for paying the appropriate fees or otherwise making the application complete. Applicants are familiar with and rely on the missing parts practice to complete applications before they are placed in the examination queue. There appears to be no compelling reason to deviate from this practice for prioritized examination that would be triggered by filing the request for prioritized examination.

The Office has indicated that it is not proposing to require early publication or even publication of an application to participate in the prioritized examination program. According to the proposal, an applicant may request non-publication of an application in Track I under 35 U.S.C. § 122(b)(2)(B)(i). Under the circumstances, it is not clear whether the Office is requiring that a publication fee (§ 1.18(d)) and an early publication processing fee (§ 1.17(i)) be paid on filing to participate in the prioritized examination program, or whether the fees are mentioned so that payment is made if they are applicable. The Office did not identify a specific processing fee under § 1.17(i), so clarification of the nature of this fee would be desirable if this process is implemented. We assume that the early publication processing fee would not be applicable unless early publication is also requested. In any event, we recommend that payment of the publication fee be required in response to a notice of allowance, as is the case for non-provisional original applications not subject to prioritized examination.

We appreciate the opportunity to provide these comments on the proposed Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures, and we would be pleased to answer any questions our comments may raise. We look forward to participating in the continuing development of rules appropriate for ex parte practice.

Sincerely,

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", with a long horizontal flourish extending to the right.

Q. Todd Dickinson
Executive Director