

May 22, 2013

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  
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**RE: Recommendation Regarding Automatic Applicant Authorization for USPTO  
to Transmit Pre-Publication Search Results to Foreign Patent Offices**

Dear Acting Under Secretary Rea:

The American Intellectual Property Law Association (AIPLA) would like to take this opportunity to provide the United States Patent and Trademark Office (USPTO) with recommendations concerning automatic applicant authorization for the USPTO to transmit pre-publication search results to foreign patent offices. In particular, we address the need for the USPTO to be able to transmit pre-publication search results to the European Patent Office (EPO) on behalf of U.S. applicants who file in the EPO, claim priority of their U.S. application, and need to file U.S. search results under Rule 141 EPC.

AIPLA is a national bar association whose approximately 15,000 members are primarily lawyers 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. Our members represent both owners and users of intellectual property. AIPLA members are among the most active users of the European Patent System.

**Background**

Rule 141 EPC and Rule 70b EPC entered into force on January 1, 2011, and apply to European Patent Applications and International Applications filed on or after that date. Those provisions require that Applicants claiming foreign priority when filing a European Patent Application must submit to the European Patent Office (EPO) a copy of the results of any novelty search carried out by the office of first filing. That copy must be filed either together with the filing of the

European Patent Application or, if it is a Euro-PCT application, upon entering into the European phase. If the search results are not yet available at those times, the applicant must file without delay a copy of the results of any novelty search after they have been made available to the applicant.

In order to alleviate the burden on the applicant, the EPO entered into negotiations with various offices, including the USPTO, and agreed to provide an exemption to applicants under Rule 141(2) EPC. The exemption was based upon an arrangement wherein there would be an automatic electronic interoffice transfer of the search data by the office of first filing, whether the first-filed application was published or unpublished. The agreement required that the data exchange be complete and be filed on a timely basis.

According to the agreed upon exemption, U.S. applicants filing in the EPO do not have to individually file the search results in the EPO, based on the understanding that the USPTO will automatically send those results as soon as an Examiner in the U.S. completes the search. The exemption for individuals from having to file such information is dependent upon delivery of the search results by the USPTO to the EPO as soon as they are available. This includes sending the search results even if they are available prior to publication of the U.S. application.

The U.S. patent statute, 35 U.S.C. § 122, prohibits the USPTO from forwarding pre-publication data without the applicant's consent. In order to obtain consent from an applicant, the USPTO has provided form PTO/SB/69, entitled "Certification and Authorization to Permit Access to Search Results by The European Patent Office (EPO)." This form is intended to be filled out prior to filing a European Patent Application in which priority has been claimed to a U.S. patent application. This form is only needed to release pre-publication search information, since release of post-publication information does not require the applicant's consent.

While the USPTO has been diligent in sending out the search results on U.S. published applications, and they have also been diligent in sending out pre-publication search results where Form 69 has been submitted, there appear to be quite a number of applications in which applicants have not submitted Form 69 and the USPTO has consequently not been able to send the EPO their pre-publication search results. This situation caused the USPTO to publish a Notice on July 30, 2012 urging applicants to timely file Form 69, and in a blog entitled "Claim Your Exemption" published on October 3, 2012, USPTO Director David Kappos further urged applicants to file Form 69. However, the EPO has indicated that it still is not receiving a significant number of pre-publication search results from the USPTO.

### **Importance to U.S. Patent Applicants**

The provision of fast searches by EPO is important to U.S. applicants who file there, and is significant to worksharing endeavors. Further, as the USPTO continues to reduce its backlog in providing a first action on the merits, more and more U.S. Patent applications are being examined before the 18-month publication. In fact, the USPTO has set a target of first action on

the merits within 10 months, with a goal to achieve that within a few years. More and more pre-publication searches will occur, and this will aggravate the problem.

Since the EPO agreed to the exemption under Rule 141(2) EPC contingent upon the ability of the USPTO to provide such information electronically, failure of applicants to provide permission under Rule 69 may cause the EPO to revoke the exemption for applicants from the U.S. This would place on U.S. applicants the burden of additional time, cost and processing to file the search results with the EPO, and thus would serve as an impediment and unnecessary pitfall.

### **Recommended Solution**

AIPLA believes that the best solution to this problem would be to extend and modify the existing authorization process for priority documents, to make it apply to the Rule 141 EPC case. Since priority documents must also be sent to foreign offices prior to publication of the U.S. application, the USPTO has established automatic priority document exchanges with a number of patent offices, including the EPO, Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO) and the World Intellectual Property Organization (WIPO). The USPTO handles permission to send pre-publication priority documents to these patent offices through an “Authorization to Permit Access” checkbox in the Application Data Sheet (ADS) Form that is filed with the initial U.S. application. If the applicant checks this box on the ADS, it gives authorization in advance for the USPTO to send the priority document in the event that a foreign application is filed.

AIPLA believes that this simple and effective solution could be utilized to address the EPO Rule 141 EPC situation, and makes the following recommendations:

- 1) That the Authorization on the ADS form be amended to include the sending of pre-publication search results to the European Patent Office. (Although currently only the EPO is requesting such information, we recommend that the amended Authorization be broadened to include any other office that requires pre-publication search results.)
- 2) That the Authorization section of the ADS be changed to an “Opt-Out” Authorization, wherein the statement in the ADS would recite that, unless the box is checked, Authorization is automatically given. This should apply to both the priority document and to pre-publication search results requested by foreign patent offices in which the applicant has filed an application claiming the priority of the U.S. application. The signature on the bottom of the ADS will provide such Authorization except when the “Opt-Out” box has been checked. This would help solve the problem of applicants who require that the pre-publication information be sent, but neglect to check the box in the ADS or file Form 69.

In respect of this recommendation, the AIPLA Board of Directors recently adopted the following resolution:

RESOLVED, that AIPLA favors having the USPTO include in the Application Data Sheet (ADS) Form, as part of the authorization section permitting pre-publication transmittal of priority documents, an Authorization for providing the EPO as well as any other foreign patent office wherein priority is being claimed and also requesting it, pre-publication access to the bibliographic data and search results, and that such entire Authorization section be re-cast in the form of an “opt-out” provision.

It is believed that following this recommendation will alleviate the current and growing problem with the EPO, will provide the necessary reassurance required by the USPTO for applicant’s Authorization, and will avoid pitfalls for applicants who are foreign filing but fail to submit the extra form (Form 69).

AIPLA looks forward to working together with the USPTO to help create a streamlined, user friendly process for U.S. applicants to file patent applications internationally. We would be happy to provide any additional comments or information that would be helpful.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive, flowing style.

Jeffrey I.D. Lewis

President

American Intellectual Property Law Association