

January 13, 2015

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: michelle.lee@uspto.gov

**Re: Recommendation Regarding Deference to Favorable Findings of the
International Searching Authority of the USPTO During Examination
of a U.S. National Phase from a PCT Application**

Dear Deputy Under Secretary Lee:

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 the deference given to the work product of the International Searching Authority of the USPTO (ISA/US). AIPLA hopes this recommendation will aid the USPTO as it strives for greater efficiency and higher quality examination of patent applications.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA's members represent a wide and diverse spectrum of individuals, companies, and institutions, and are involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

Background

Under the Patent Cooperation Treaty (PCT), each PCT application is searched and examined by an International Searching Authority. Some applicants choose in addition to file a Demand, by which they purchase the services of an International Preliminary Examining Authority. Later the applicant enters the national or regional phase in one or more patent offices.

The USPTO has served as an International Searching Authority since it joined the PCT in 1978. When the U.S. joined Chapter II of the Treaty, the USPTO also began to serve as an International Preliminary Examining Authority. In its role as ISA/US and IPEA/US, the USPTO has conducted searches and evaluated the patentability of inventions claimed in PCT patent applications filed by applicants in the U.S. and in many other countries.

A report called *The Future of the PCT* prepared by the World Intellectual Property Organization highlights the importance of a patent office giving full faith and credit to its own work as an ISA.¹ The report says:

Most fundamental is the Treaty requirement obliging each International Searching Authority (ISA) to conduct an international search which is as good as its facilities permit. This means that the international search must be *at least* as good as would be performed for national applications. One of the first actions which is necessary for ISAs must be a commitment not only to making this true, but to *demonstrating to everybody* that it is the case by themselves fully relying on this work in the national phase. In other words, each ISA should, to the greatest extent possible, do the work only once, during the international phase, and fully integrate that work into its national granting procedure when the same application later enters the national phase before the same Office acting as a designated Office. (paragraph 13)

However, practitioners before the USPTO report that, in many cases, little or no deference is given to findings of ISA/US. What often happens is that the USPTO Examiner examining a US national phase application for patentability will reject the application over references that were not cited by the ISA/US. Therefore, the results of the ISA/US search are not often helpful in predicting what will happen in the US national phase.

Recommendation

To fully realize the goals of the PCT, and to bring more clarity to applicants and practitioners before the USPTO, AIPLA recommends that the USPTO give the findings of the ISA/US and IPEA/US presumptive deference when examining a U.S. national phase application filed from a PCT application.

To further this recommendation, the AIPLA Board of Directors recently adopted the following resolution:

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors the United States Patent and Trademark Office (USPTO), in its examination of a US national phase from a Patent Cooperation Treaty application, giving presumptive and substantial deference to findings of the International Searching Authority of the USPTO, and to findings of the International Preliminary Examining Authority of the USPTO, subject to any required top-up search.

The desired outcome would be that a favorable finding by ISA/US or IPEA/US would lead to a nearly automatic allowance by USPTO in the US national phase, subject to any needed “top-up” or supplemental search. The assumption is that the quality of the work carried out by USPTO in

¹ PCT/WG/2/3, Available at http://www.wipo.int/edocs/mdocs/pct/en/pct_wg_2/pct_wg_2_3.pdf.

its role as ISA or IPEA would be at least as good as the work that USPTO would carry out in its examination of other patent applications. Thus, it is intended that any grant of a patent on a National stage application that has passed through the ISA/US or IPEA/US would be based upon a search and examination of a quality equaling or exceeding that of any other patent application.

Of course, AIPLA supports continuing improvements to searches in the USPTO, and therefore we do not advocate deference to searches and patentability opinions that would result in less than the highest quality patents being issued. To the extent that the USPTO must take preliminary steps to improve the quality of the ISA/US and IPEA/US work products before deference can be given, AIPLA supports taking the necessary steps as soon as practicable so that the benefits discussed below can be realized.

Benefits

AIPLA believes that implementing this recommendation would be beneficial to both the USPTO and U.S. innovators. Giving deference to ISA/US and IPEA/US work product would bring greater efficiency to the USPTO. Under present practice, the USPTO or contractor often searches and examines patent applications twice – once in the international phase and again in the US national phase. The USPTO only should need to search and examine an application once, to determine whether it is patentable.

Granting presumptive deference also would promote science and the useful arts. U.S. inventors would be able to more confidently make business decisions about patent expenditures knowing that real deference would be given to ISA/US and IPEA/US findings. Those with patentable inventions would be able to obtain their patents sooner and more economically than was previously possible.

Still another important benefit would develop over time as patent offices around the world would place greater trust in the quality of the work product of ISA/US and IPEA/US. This would be a source of deserved pride within the USPTO and would reflect well upon the US. Additionally, it would set a valuable example for other patent offices that provide ISA and IPEA services.

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AIPLA supports the USPTO's continuing efforts to improve the quality of work being produced. AIPLA would welcome the opportunity to answer any questions that this recommendation may raise.

Sincerely,



Sharon A. Israel

President

American Intellectual Property Law Association