



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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May 23, 2008

The Honorable Jon Dudas
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

Dear Under Secretary Dudas:

The American Intellectual Property Law Association has long been an ardent supporter of the Patent Cooperation Treaty. Conceived in the late 1960's as a modest step toward the goal of a global patent system, the PCT is now embraced by 139 countries. The international search and international preliminary examination provisions of the Treaty were conceived as a means by which member countries could receive a high quality work product from International Authorities and avoid duplicating the work of other national or regional patent offices.

Since the PCT entered into force in 1978, however, it has not achieved the visions of its founders for reducing the workload of patent offices. This has become increasingly apparent with the growth of patent filings globally, and especially with the increased filings of corresponding applications in an ever-growing number of countries.

The topic of how users and patent offices can take greater advantage of the PCT has been discussed many times and will be discussed again at the first session of the Patent Cooperation Treaty (PCT) Working Group, scheduled for May 26-30, 2008 in Geneva. It is the subject of a document prepared by the International Bureau entitled "Enhancing the Value of International Search and Preliminary Examination under the PCT" (document PCT/WG/1/3).

AIPLA finds itself in total agreement with the statement contained in first paragraph of document PCT/WG/1/3):

"Major patent Offices are increasingly looking at ways of sharing search and examination reports in order to reduce the unnecessary duplication of work as far as possible. The PCT was specifically designed to address this issue. Yet, it would appear that the system is not being used to its potential, with many Offices remaining distrustful of international search reports and international preliminary reports on patentability, and only a few Offices using those reports either as the basis for grant or at least as the basis for an accelerated, simplified or reduced examination process."

The issue of work-sharing between patent offices to reduce duplication of work is currently a major topic of discussion by all patent offices. New initiatives launched to address this problem include the "Patent Prosecution Highway" and the "New Route," and other proposals (the "Tri-way" and "SHARE") are under active consideration. Yet surprisingly, the PCT has not been featured in any of these discussions, even though the origins of the PCT system sprang from this vision.

Statistics show that applicants continue to increase their use of the PCT. Between the years 2000 and 2007, PCT filings increased by an average annual rate of 7.9% a year. PCT filings originating from the United States account for almost one-third of all PCT filings.

Notwithstanding this increased use of PCT, it appears that patent offices are not taking advantage of its potential. Indeed, there is a perception that the quality of the international phase work product is generally lower than that of the national phase work product. The International Bureau brought this issue to the 15th session of the Meeting of the International Authorities (PCT/MIA) held in Vienna, Austria from April 7-9, 2008. During such discussions among the International Searching Authorities, the following statements are illustrative of the comments made at that meeting (document PCT/MIA/15/13):

"there might be a perception by some examiners that a national report needed to be taken more seriously than an international report since there was no further review before national rights were granted;

"anecdotally, work done on PCT reports was commonly seen to be less comprehensive than for national reports, but analysis by one Authority of different types of reports prepared by that Office had found no difference in extent or content, only in presentation;

"it was important to continually develop quality management systems;

"international searches should be treated as seriously as national searches by Authorities;

"timeliness of the establishment of international search reports was important in addition to quality."

Despite the discussion and candid comments at the PCT/MIA meeting, little progress was made on any commitment to equalize the quality of international and national searches or improve the work-sharing capabilities of the PCT system.

AIPLA believes that if all PCT International Authorities would make a greater commitment to their tasks during the international stage, and make use of the work-sharing benefits available through PCT, it could reduce the growing backlogs and

pendency times that currently exist in national patent offices and could result in higher quality patents.

To address these issues, the AIPLA Board of Directors adopted the following resolutions:

RESOLVED, that AIPLA favors, in principle, improving the quality of international searches and international preliminary examinations, conducted by each International Authority appointed by the Assembly of the Patent Cooperation Treaty, to equal the quality of searches and examinations by such Authority for national or regional patent applications filed with it; and,

FURTHER RESOLVED, that AIPLA favors, in principle, maximizing the exploitation of such equal quality international searches and international preliminary examinations, conducted by International Authorities appointed by the Assembly of the Patent Cooperation Treaty, to avoid duplication of work by national and regional patent offices.

AIPLA respectfully requests that the US Delegation to the First Session of the Patent Cooperation Treaty Working Group meeting next week urge the other Member States of the PCT to work with it to develop concrete proposals for enhancing the quality and utilization of international searches and examinations. We are resolute in our belief that the PCT offers the most practical and immediate prospects for relief of the growing backlogs facing the world's patent offices.

We appreciate your continued efforts to attack this crisis and hope that you will find our comments useful.

Sincerely,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk
Executive Director