

From: Sinai Yarus [email address redacted]
Sent: Sunday, August 17, 2014 9:23 AM
To: patent_pendency2014
Subject: Patent pendency goals: public commentss

648In response to your request for comment

1. Are the current targets of 10 month average first action patent pendency and 20 month average total patent pendency the right agency strategic targets for the USPTO, stakeholders, and the public at large? If not, what are the appropriate average first action patent pendency and average total patent pendency targets, and what is the supporting rationale for different targets?

Current targets of 1/20 months look great, with the stipulation that an increase in fees is not needed to achieve them.

2. Should the USPTO have first action pendency and total pendency targets be met by nearly all applications (e.g., 90 or 95 percent of applications meeting the pendency target) rather than seeking to meet the specific overall targets of 10 months and 20 months respectively?

Get the averages down to 10/20 months, then work on the variability.

3. Should the USPTO consider technology-specific patent pendency targets, for example, at the Technology Center level? If so, should all the Technology Centers have the same target? If not, please explain why Technology Centers should have different pendency target levels and how they should be determined?

Technology centers that are the furthest from the goals right now may need more time to comply. The Office should investigate whether some technology centers have objective problems (e.g. high number of applications/Examiner or high percentage of relatively inexperienced Examiners) and offer support to help meet goals.

4. With an eye to patent term adjustment (PTA), the USPTO wants to know if they should consider using a first action pendency target tied to minimizing the number of applications in which

a first action is not mailed within 14 months? Similarly, the USPTO is also asking whether the PTA provisions include more specific actions by the USPTO in specific timeframes. Should the USPTO also consider using some of the other PTA specific timeframes for their optimal pendency targets?

The current PTA rules are complicated enough. Let's not add another layer.

5. A USPTO policy to encourage completing first office actions too soon after the filing date of an application does not allow for the publication of all pertinent patent prior art and for the appropriate window for third-party prior art submissions. Thus, the USPTO asks whether the benefits of a prompt first Office action outweigh potential concerns of the Office action being issued too quickly?

Yes. The benefits outweigh the risks. Applicants are free to pursue re-issue if relevant art publishes after their patent is granted. Of course, Office personnel should screen recent relevant publications prior to grant at 20 months.

6. Should the USPTO be cautious at this point in time to avoid going too low in first action pendency due to so many recent changes in patent law? For example, the USPTO pointed to significant case law decisions that may impact large categories of inventions and possibly lead to reduced patent filings.

If filings go down, it should be easier to meet goals no? I'm not sure "too low in first action pendency" is a relevant term. Inventors are usually anxious to see a first Office action as soon as possible.

7. In addition to seeking public input on optimal patent first action and total pendency levels, the USPTO also is interested in knowing if there are other activities where pendency or timeliness should be measured and reported. What other metrics should the USPTO consider utilizing to measure pendency or timeliness throughout the examination process? Further, specifically regarding RCEs, what other metrics should the USPTO consider utilizing to measure the pendency or timeliness regarding RCEs? Should these metrics also be considered for other continuing-type applications (i.e., continuation, continuation-in-part, and divisional applications)?

As a consumer of USPTO service I would be interested to see data on:

-average time from RCE to subsequent Office action

-average time from RCE to disposal

-percentage of RCEs which lead to notice of allowance (with and without an intervening Office Action

-percentages of cases eventually allowed with 0; 1; 2; and 3 or more RCEs respectively.

Dr. S. Yarus
Patent Agent (#64811)

[email address redacted]
WWW.IPAttitude.com

NOTICE: This mail contains confidential and/or privileged information and is for the entity named. If you received this e-mail in error, any disclosure, copying, distribution or use of the contents is unlawful. Please notify sender via return e-mail and delete the message and attachment(s). Sender accepts no responsibility for viruses associated with this e-mail or attachments. Tha