

**From:**

**Sent:** Friday, August 13, 2010 12:35 PM

**To:** 3-tracks comments

**Subject:** Avaya Comments re: Three Tracks Proposal

To Whom It May Concern:

On behalf of Avaya Inc., one the nation's largest voice communications network equipment providers, we are pleased to submit the following comments in response to the USPTO's three tracks proposal [Docket No.: PTO-P-2010-0035]. Please feel free to contact me should you have any questions.

Best regards,

Stephanie Childs  
Vice President, Government Affairs  
Avaya Inc.  
1212 New York Avenue Suite 1212  
Washington, DC 20005  
(202) 378-5790  
schilds@avaya.com

DEPARTMENT OF COMMERCE-United States Patent and Trademark Office

[Docket No.:PTO-P-2010-0035]

Enhanced Examination Timing Control Initiative; Notice of Public Meeting

Comments in response to the above.

Avaya Inc. supports the initiative under consideration for the USPTO providing applicants greater control over when their applications are examined and to enhance work sharing between intellectual property offices. We believe that these measures would provide applicants with more options in pursuing their applications and in bringing the benefits of innovation to the marketplace earlier. This can also serve nascent businesses get quicker access to capital with resultant societal benefits including increasing employment.

The following brief comments are in response to specific questions included in the Notice:

1. Should the USPTO proceed with any efforts to enhance applicant control of the timing of examination?

YES

2. Are the three tracks above the most important tracks for innovators?

YES, although Avaya has a concern that the slow track is subject to possible abuse, which should be curbed.

3. Taking into account possible efficiency concerns associated with providing too many examination tracks, should more than three tracks be provided?

Avaya does not support more than three tracks at this time since it would create added complexity.

4. Do you support the USPTO creating a single queue for examination of all applications accelerated or prioritized (e.g., any application granted special status or any prioritized application under this proposal)? This would place applications made special under the "green" technology initiative, the accelerated examination procedure and this proposal in a single queue. For this question assume that a harmonized track would permit the USPTO to provide more refined and up-to-date statistics on performance within this track. This would allow users to have a good estimate on when an application would be examined if the applicant requested prioritized examination.

Yes. It is a good idea for the USPTO to create a single queue for examination of all applications accelerated or prioritized. This is consistent with the USPTO's goal of promoting the efficient examination of patent applications. However, if the cost of choosing an accelerated examination over a prioritized examination is more expensive, or vice versa, it may not be fair to place all accelerated examination cases and prioritized cases in the same queue.

5. Should an applicant who requested prioritized examination of an application prior to filing of a request for continued examination (RCE) be required to request prioritized examination and pay the required fee again on filing of an RCE? NO For this question assume that the fee for prioritized examination would need to be increased above the current RCE fee to make sure that sufficient resources are available to avoid pendency increases of the non-prioritized applications.

No. The applicant should not have to pay an additional fee to prioritize the application upon filing an RCE. Once the applicant pays the fee for a prioritized examination, the application should have that prioritized status for the pendency of that application.

6. Should prioritized examination be available at any time during examination or appeal to the Board of Patent Appeals and Interferences (BPAI)?

Yes. It is even more important to have the option of a prioritized examination during an appeal to the BPAI. This is because, at the appeal stage, the applicant has already waited several years for a determination whether his/her invention is patentable. Allowing the applicant to pay a fee to accelerate the appeal process would be very attractive to most applicants.

7. Should the number of claims permitted in a prioritized application be limited? What should the limit be?

Avaya does not support a limit or at least a limit set too low. Additional fees for claims beyond a specific threshold are available as a mechanism to recover the additional expense in examining patents with higher number of claims.

8. Should other requirements for use of the prioritized track be considered, such as limiting the use of extensions of time?

No comment at this time.

9. Should prioritized applications be published as patent application publications shortly after the request for prioritization is granted? NO How often would this option be chosen?

No. The prioritized application should be published when the patent issues. This is assuming that a final disposal in track I will occur within twelve months of filing an application as noted in the Federal Register. It is not likely that an applicant will choose to publish his/her application shortly after the request for prioritization is granted.

10. Should the USPTO provide an applicant-controlled up to 30-month queue prior to docketing for examination as an option for non-continuing applications? How often would this option be chosen?

No. Avaya will likely not use this option.

11. Should eighteen-month patent application publication be required for any application in which the 30-month queue is requested?

No comment at this time.

12. Should the patent term adjustment (PTA) offset applied to applicant-requested delay be limited to the delay beyond the aggregate USPTO pendency to a first Office action on the merits?

Probably Yes, but needs additional study.

13. Should the USPTO suspend prosecution of non-continuing, non-USPTO first-filed applications to await submission of the search report and first action on the merits by the foreign office and reply in USPTO format?

Avaya views this favorably provided the search report is available in a timely manner. Also, questions remain regarding the delay and dealing with the communication between offices. For example, how is the USPTO queue affected when a foreign office action issues and a response is filed? Does it trigger it such that the case is then picked up and examined immediately? What if the foreign response includes claim amendments?

14. Should the PTA accrued during a suspension of prosecution to await the foreign action and reply be offset? If so, should that offset be linked to the period beyond average current backlogs to first Office action on the merits in the traditional queue?

Yes and Yes.

15. Should a reply to the office of first filing office action, filed in the counterpart application filed at the USPTO as if it were a reply to a USPTO Office action, be required prior to USPTO examination of the counterpart application?

Probably Yes. However, problems will exist in different jurisdictions due to different statutory requirements for patentability.

16. Should the requirement to delay USPTO examination pending the provision of a copy of the search report, first action from the office of first filing and an appropriate reply to the office of first filing office action be limited to where the office of first filing has qualified as an International Searching Authority?

Yes, it should be a requirement that the International Searching Authority is qualified. However, this is based on the belief that the search report, first action, and reply with respect to the office of first filing are given great precedential value or deference by the USPTO. On the contrary, if the search report, first office action, and reply are not given great deference and the Examiner is allowed to perform his/her own search aside from the search report, the International Searching Authority does not have to be qualified.

17. Should the requirement to provide a copy of the search report, first action from the office of first filing and an appropriate reply to the office of first filing office action in the USPTO application be limited to where the USPTO application will be published as a patent application publication?

No comment at this time.

18. Should there be a concern that many applicants that currently file first in another office would file first at the USPTO to avoid the delay and requirements proposed by this notice? How often would this occur?

No comment at this time.

19. How often do applicants abandon foreign filed applications prior to an action on the merits in the foreign filed application when the foreign filed application is relied upon for foreign priority in a U.S. application? Would applicants expect to increase that number, if the three track proposal is adopted?

Do not know.

20. Should the national stage of an international application that designated more than the United States be treated as a USPTO first-filed application or a non-USPTO first-filed application, or should it be treated as a continuing application?

No comment at this time.

21. Should the USPTO offer supplemental searches by IPGOs as an optional service?

No comment at this time.

22. Should the USPTO facilitate the supplemental search system by receiving the request for supplemental search and fee and transmitting the application and fee to the IPGO? Should the USPTO merely provide criteria for the applicant to seek supplemental searches directly from the IPGO?

YES to the first question.

23. Would supplemental searches be more likely to be requested in certain technologies? If so, which ones and how often?

No comment at this time.

24. Which IPGO should be expected to be in high demand for providing the service, and by how much? Does this depend on technology?

No comment at this time.

25. Is there a range of fees that would be appropriate to charge for supplemental searches?

Preliminary view is \$500-\$1000.

26. What level of quality should be expected? Should the USPTO enter into agreements that would require quality assurances of the work performed by the other IPGO?

High quality. YES.

27. Should the search be required to be conducted based on the U.S. prior art standards?

YES.

28. Should the scope of the search be recorded and transmitted?

YES.

29. What language should the search report be transmitted in?

ENGLISH.

30. Should the search report be required in a short period after filing, e.g., within six months of filing?

YES.

31. How best should access to the application be provided to the IPGO?

Access should be available electronically with assurance of security and limited access. It is important that IPGO is under a confidentiality agreement with respect to access to the application.

32. How should any inequitable conduct issues be minimized in providing this service?

The IPGO should be held to the same Rule 56 standards that all associated with the application are held to. That is, the IPGO should search for and provide any references that that IPGO believes will be material to the patentability of the claimed invention. Perhaps once the search is complete, the IPGO's duty can be severed but while the search is active, the IPGO should be held accountable. A possible approach may be to let the applicants go directly to the IPGO for requesting, paying for and receiving supplemental searches.

33. Should the USPTO provide a time period for applicants to review and make any appropriate comments or amendments to their application after the supplemental search has been transmitted before preparing the first Office action on the merits?

YES. This will only enhance the quality and strength of the final product – the patent – and hopefully result in true, validly issued patents.