In response to Docket Notice PTO-P-2012-0024, Philips Intellectual Property and
Standards submits these comments on behalf of Koninklijke Philips Electronics N.V.
and its associated companies (collectively "Philips"). Philips typically files about one
thousand five hundred new patent applications each year. The vast majority of these
applications is first filed as United States provisional patent applications and later filed
as applications under the PCT which designate the United States, together with many
other countries, and claim priority from the earlier US provisional application.

We are concerned that the transitional provisions of proposed rules 1.55 and 1.78 which
will require us to identify subject matter differences between the disclosures of the
priority and PCT application, together with the ongoing obligation to identify claims
supported by the priority applications are unnecessary and unduly burdensome. Our
experience indicates that issues of intervening prior art and conflicting applications,
which would trigger a need for the Office to consider whether examination should be
conducted under FITF or FTI statutes, are only relevant for a small percentage of
cases, and we urge the USPTO to adopt rules that postpone the requirements for
submission of the statements contemplated by the proposed rules until a real need
arises.

Specifically, we propose that the USPTO adopt rules which initially treat all
transitional applications as falling under the AIA/FITF provisions, and which then
provide an option for applicants to invoke examination under the pre-AIA/FTI
provisions after prior art has been cited which would not be relevant under the
FTI provisions.

We also note that the proposed rules fail to provide any meaningful definition of when
subject matter in a patent application is considered “new”, and thus become particularly
uncertain and burdensome for applicants who base priority claims on foreign language
applications where uncertainties in translations could lead to unnecessary disputes.

Respectfully submitted

Jack E. Haken
Vice President
Philips Intellectual Property and Standards
jack.e.haken@philips.com
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