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Via Electronic Mail
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Attention: Pinchus Laufer, Senior Legal Advisor,
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in Response to "Request for Comments Regarding the Continuation of the Accelerated Examination Program," 82 Fed. Reg. 8 (January 12, 2017)

IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to provide input on whether the accelerated examination program should be retained.

IBM believes that providing a variety of mechanisms for Applicants to manage their patent issuances can be of tremendous value. Accelerated examination is one of those valuable mechanisms. Certainly Applicants have various interests regarding the use and protection of intellectual property and often operate under strict budget constraints. Each mechanism that the Office provides has unique requirements and features which enables Applicants to determine the most appropriate program, if any, to fit their needs on a case-by-case basis. We do not believe that the Office should foreclose on any one of those mechanisms without full consideration of the reasons for such foreclosure or potential mechanisms for replacing that to be foreclosed.

The Office cites the popularity of the Track One as one of the reasons for possibly eliminating the Accelerated Examination program, indicating that Track One requests have approached 10,000 annually. IBM notes that the number of requests that will be accepted into Track One is capped at 10,000 in a fiscal year¹. Accordingly, we submit that this suggests there is a need for an alternative mechanism other than Track One to accelerate applications.

Further, the Office points to relatively low usage of the accelerated examination program as a reason to eliminate the program. Although low usage suggests elimination of the program would have only modest impact on the program's users, it is unclear whether the program is any less used than other programs (unrelated to accelerated examination) that the Office has not proposed to eliminate and why only this program has been selected for elimination. Given that user fees are set in accordance with the cost of Office programs, it is unclear how elimination of the accelerated examination program would benefit the Office.

¹ See 82 Fed. Reg. 8 at https://www.uspto.gov/sites/default/files/patents/init_events/track1-aia.pdf

IBM recommends that the Office consider why the program may be so under-utilized. If the requirements of the accelerated examination program are too unclear, burdensome, or not applied consistently, then surely Applicants will be dissuaded from utilizing the program. For example, the accelerated examination statistics² indicate that over half of the decisions to make special under the program were either denied or dismissed. We suggest that the Office examine why the number of denials and dismissals are so high and consider possible remedies. Accordingly, we recommend that the Office consider clarifying the requirements for entering the accelerated examination program. Further, IBM encourages the Office to ensure that the requirements are being applied consistently across the patent corps by developing examiner expertise in accelerated examination (much like the Office developed expertise in reexamination).

Finally, IBM is not aware of any data that indicates that accelerated examination detracts from patent quality. Rather, it is our belief that some aspects of accelerated examination, such as the information provided in the accelerated examination support document, may even improve patent quality.

Conclusion

Applicants appreciate having multiple options to control pendency of their patent applications and eliminating accelerated examination reduces those options. IBM recommends that the Office should continue to provide and enhance the effectiveness of all alternative prosecution methods to accelerate or defer examination allowing Applicants to tailor pendency consistent with their patent strategy.

Respectfully submitted,

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² See the Office's statistics on decisions on petitions to make special under the accelerated examination program (May 29, 2015) at <https://www.uspto.gov/patent/initiatives/accelerated-examination>