

From:

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Subject: IBM Corporation's Comments in Response to "Enhanced Examination Timing Control Initiative"

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Via Electronic Mail
3trackscomments@uspto.gov

Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Robert A. Clarke

IBM Corporation Comments in response to “*Enhanced Examination Timing Control Initiative*,” 75 Fed. Reg. 31763 (June 4, 2010)

IBM supports the United States Patent and Trademark Office’s efforts to improve efficiency and provide additional choices to patent applicants by creating a more flexible patent procurement process. We thank the Office for the opportunity to share our views on the Enhanced Examination Timing Control Initiative (3 Track proposal). IBM agrees that options such as deferral, work sharing between patent offices, and prioritization (acceleration) will provide valuable options to applicants and help improve the patent procurement process.

IBM believes that deferral or acceleration of search and/or examination provides applicants the opportunity to adjust patent strategies based on commercial interests such as the need for patent protection in a quickly evolving market or the desire to delay investment in patenting until market needs are better understood. Deferral also provides applicants with an opportunity to obtain better information regarding patentability and the value of an invention before investing in the full cost of obtaining patent protection. We therefore believe the general approach of implementing three tracks by adding accelerated and deferred examination to the current process is a reasonable way to add timing options to patent procurement. IBM also recognizes the burden on the Office and applicants, and possible impact on commercial entities, in implementing these procedures. As described more fully below, IBM encourages measures such as application publication, correlation of Office work to fees, pilot programs, and careful balancing of incentives regarding patent term adjustment and procedural requirements, which will help ensure the success of timing control programs.

IBM fully supports work sharing between patent offices. While we recognize the significant efficiencies that can be achieved, we are also concerned with certain aspects of the 3 Track proposal as it relates to applications claiming priority to

non-US applications (hereinafter “counterpart applications”). We suggest below adjustments to the Office’s proposal for handling such counterpart applications, to avoid unequal treatment, provide optimal incentives, and to help address the differences in law and procedure that persist from one jurisdiction to another. We also strongly urge the Office to adopt a voluntary pilot as a first step for implementing new examination tracks, and in particular for changes such as those proposed for examining counterpart applications, to ensure fairness and achieve the best results.

We do not see an immediate need for any additional tracks beyond the three currently proposed, and suggest any such additional track(s) should be considered in light of the performance of the proposed three. Collecting, analyzing, and publishing data on all aspects of the 3 Track proposal is important for assessing the success of the program and making needed adjustments.

Our comments below, generally arranged as answers to the questions posed in the above-captioned notice, address the three tracks proposed by the Office, including accelerated (prioritized) and deferred examination, handling of counterpart applications, and supplemental searching. (Questions 1, 2 & 3, generally directed to the outlines of the proposal, are answered in the above introductory remarks).

A. Prioritized Examination (Track I, Questions 4-9)

General remarks

Voluntary acceleration, or prioritization, of patent examination is a positive step providing flexibility to applicants and the Office. Under proposed Track I, applicants would receive expedited prosecution, including a first office action on the merits within four months and a final disposition within twelve months of prioritized status being granted. Applicants could thus obtain enforceable patent rights of certain scope within a short time, to serve their commercial interests such as meeting correspondingly short product lifecycles and development times. The proposed prioritized examination track also dispenses with the burdensome requirement of the current accelerated examination program to submit an Examination Support Document (ESD). The Office would effectively implement compact prosecution, potentially reducing the number of hours of examination time and enhancing efficiency.

The requirement of an increased fee to cover additional Office expense for implementing the program is reasonable and fair. However, IBM has concerns regarding calculation of this fee. We would appreciate more detailed information from the Office on how this fee will be set, and what the mechanism would be for initial and ongoing assessment or adjustment. If all accelerated applications are joined in the same queue, then how will the Office determine what fraction of the

additional examiner workload (and thus cost) is attributable to Track I applications? We also would like to know if such additional examiners must be hired (resulting in a net gain in examiner head count) before the program can be implemented.

Thorough, substantive review by the Office is a critical element of the patent examination process. All applications are equally entitled to such review, whether they are examined in Track I, II, or III, or as part of any special program. A consistent level of review for Track I may be enabled through Office initiatives such as the First Action Interview Program, limiting the number of claims, and requiring timely responses. We also urge the Office to ensure development of a complete record of patent prosecution, including fully documented reasons for allowance and interview proceedings, notwithstanding the accelerated time frame.

IBM believes that many applicants, both foreign and domestic, will be interested in using Track I for certain applications where speedy issuance is critical. We do not believe counterpart applications should be prevented from entering Track I until prosecution from the office of first filing is received, unless undue delay can be avoided by coordinating prosecution between the office of first filing and the USPTO. Otherwise, the purpose of Track I is thwarted for these applicants. Treatment of counterpart applications under the 3 Track proposal is discussed further below in Part C.

Question 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.

Answer: We support a single queue for examination of all accelerated and/or prioritized applications to promote administrative efficiency. The USPTO may wish to go further and combine all prioritized applications into a single program (not just a single queue), where variations may be implemented through waiver or “opting in,” such as the USPTO waiving the prioritization fee for “green” applications.

It is not entirely clear from the notice if all applications in this queue are handled for all stages of prosecution on an expedited basis (as opposed to simply beginning prosecution out of turn). The former seems more consistent with the purposes of Track I, and in any event, it would be extremely difficult to use one queue unless all applications are examined the same way. Clarification on this point would thus be appreciated.

We are concerned (as noted above) that the fees charged for Track I correspond to the cost associated with implementation of that program only, not all accelerated programs. Also, we believe the Office should ensure that applications in Track II are not delayed as a result of implementing accelerated or prioritized examination programs.

We agree that providing statistics is critical, and understand it may be easier to do so if all tracks are joined, but in any event statistics should be provided to the extent possible. Statistics reflecting Track II should also be examined to ensure Track I is not having an adverse impact on applications in the “normal” queue. Useful statistics could include: time to first office action on the merits; number of office actions per abandonment and/or allowance; rate of abandonment, allowance, appeal, and claim amendment; basis for rejections; and of course overall pendency. This list is by no means exhaustive – all statistics relating to the substance and process of examination would be helpful to understand the performance of Track I and Track II.

Question 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? 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.

Answer: The applicant should be required to pay a fee that reflects the additional cost of prioritized examination for the RCE filing. Assuming an increased fee is needed, it is not clear that it should be equal to the initial fee for prioritized examination as the examiner is now familiar with the application. Given the applicant’s investment in expediting prosecution, it is likely any RCE filing in Track I is unavoidable, and not a delay tactic.

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

Answer: Yes, we believe prioritized examination should be available at any time provided the applicant is willing to pay the fee. The Office may wish to consider potential disruption in their examination processes. (For the purposes of answering this question, we assume the Office is not suggesting a separate track for appeal, merely that the applicant may request prioritized examination at any time during the application lifecycle, including any appeals).

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

Answer: Yes, limiting the number of total claims and independent claims is a reasonable way to implement Track I. The Office's proposed limits should give applicants sufficient flexibility to protect inventions while enabling thorough examination on an expedited basis. IBM suggests the Office also consider limiting the number of independent claims to 3, and total claims to 20, reflecting the current cap under the initial filing fee.

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

Answer: Yes. Applicants should be responsible for assisting the Office in performing compact prosecution in Track I. Alternatively, the Office may consider permitting extensions of time but imposing higher fees, possibly double or triple those assessed during Track II. Increased fees are an appropriate deterrent as the applicant has voluntarily chosen to pursue Track I. We also suggest the use of early interviews. However, we urge the Office not to penalize an applicant who fails to meet a deadline or pay a higher fee with abandonment. Instead, the application should default to Track II.

Question 9. Should prioritized applications be published as patent application publications shortly after the request for prioritization is granted? How often would this option be chosen?

Answer: Yes, assuming such early publication does not generate cost increases or delays. IBM generally supports publication of all applications at 18 months. Given the expected issuance of Track I applications 12 months after the request for prioritization is granted, the benefit of even earlier application publication is not expected to be significant. Thus, if the requirement for early publication discourages applicants from requesting prioritization, the USPTO should consider making this an optional element of Track I.

B. Deferred Examination (Track III, Questions 10-12)

Question 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?

Answer: Yes. IBM believes that deferred examination, such as the method of Track III's applicant-controlled deferred docketing, is a sensible way for the USPTO to direct its resources to those applications viewed as most important by applicants, and away from the unimportant ones. (see, Steven Bennett and David Kappos, *Deferred Examination: An Idea Whose Time Has Come*, (2009),

<http://www.ip-watch.org/weblog/2009/03/12/inside-views-deferred-examination-a-solution-whose-time-has-come>).

By allowing the applicant to pay the examination fee within thirty months of the actual filing date, Track III would offer an applicant the option to “pay as you go” for the services received from the USPTO. IBM believes that the payment of the search fee should also be deferrable until the applicant requests the search (at any time up to the request for examination) since until the search is requested, the USPTO does not need to perform and mail the search report. For some Track III applicants, requesting and paying for the search before the request for examination may provide the applicant a better understanding of the challenges to come during examination, thus enabling the applicant to make a more informed decision about whether to proceed with the expense of examination. For other Track III applicants, saving the search fee for an application that is abandoned at the end of the 30 month period is an important cost savings. Under the current patent application process, where all fees are paid up front, inventors have no incentive to withdraw applications prior to examination. Track III would give applicants the financial incentive and time in which to make more informed decisions. Since examination would only occur by request and payment of the fee, applicants would need to purposefully choose to move into the examination phase.

The effectiveness of fee-related incentives, even for fee amounts less than \$1,000, can be seen by examining maintenance fee payment statistics. (See, e.g., statistics collected by Dennis Crouch, showing the percent of applicants who declined to pay the four, eight and twelve year maintenance fees from approximately 1998 – 2008.

<http://www.uspto.gov/web/offices/ac/qs/ope/fee2009september15.htm>). If in some cases patentees are willing to forgo the protection of an issued patent to save maintenance fee costs, then we would expect patent applicants who have only an expectation of obtaining an enforceable patent to be at least as likely to drop some applications for a similar or perhaps even smaller cost savings.

IBM agrees with the view expressed by certain commentators on the benefits of enacting legal intervening rights to protect a third party from “late claims” in a deferred patent application. (See, the “Fordham Legal Intervening Rights Proposal,” which sets forth three statutory changes to enact legal intervening rights. The Fordham Proposal is explained in Harold C. Wegner’s paper, *A Comparative View of American Patent Reform*, presented to the Fourteenth Annual Conference on International Intellectual Property Law and Policy, Fordham University School of Law, April 20-21, 2006, New York.) IBM recognizes that the USPTO cannot control the assertion of “late claims,” and that legislation would be necessary to create such legal intervening rights.

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

Answer: Yes. All Track III applications should be published at 18 months. Such publication provides harmonization with other patent systems and ensures that the Track III applications are available as prior art. If the search fee has been paid and the search report generated, then the search report also should be published at 18 months. Otherwise, the search report should be published when it is later generated.

Publication at 18 months provides notice to the public of the content of the patent application, including the claims as filed. While such publication does not eliminate uncertainty regarding “late claim” coverage (see answer to Question 10 above regarding intervening rights), it does provide notice of potential coverage more generally through the specification and filed claims. IBM also suggests the Office publish the Track status of applications, for example on public PAIR, to provide additional information relating to expected pendency.

Given the uncertainty to the public associated with late examination and issuance, we urge the Office to require applicants electing Track III to publish at 18 months, even if the application is only filed in the US.

Question 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?

Answer: Certainly, if the applicant chooses to defer examination through Track III, then the deferral period is not delay caused by the USPTO and PTA offset should not be applied for the deferral time. (Deferral is more properly understood as applicant requested delay under 35 USC § 1.54(b)(1)(B)(iii)). However, once examination is requested by the applicant, the applicant should be credited with a PTA offset for any USPTO delay.

We do not understand the meaning of “aggregate USPTO pendency to a first Office action on the merits” and would appreciate some clarification on this point, and how this time period relates to adjustments in patent term under 35 USC § 1.54.

C. Counterpart Applications (Questions 13-20)

General Remarks

IBM supports worksharing programs between patent offices, to promote efficiency and reduce waste by leveraging the work of the office of first filing in subsequent counterpart prosecution. We are concerned, however, with unfairness to applicants who are subject to uncontrollable delay at the office of first filing as well as the potential for strategic delay by applicants who may

choose a slow office of first filing to unduly delay US patent prosecution and issuance.

We suggest the Office implement worksharing by coordinating prosecution with other patent offices such that examination occurs at approximately the same time at each office for the initial application and its counterparts; and that in general, average time from filing to examination for counterparts is approximately the same as that for domestic priority applications in a given patent office. Coordination would advance the goals of worksharing, promote equal treatment, and obviate the possibility of other countries adopting uncoordinated programs that may disadvantage US-origin and other nondomestic applicants.

We further observe that the patent prosecution highway (PPH) program has generally yielded efficiencies in examination such that counterpart applications often enjoy expedited examination. IBM urges the USPTO to establish a similarly coordinated program before implementing worksharing, and to use pilot programs and collect detailed statistical information before adopting any mandatory special conditions for examination of counterpart applications. We provide more detail in our answers to specific questions below.

Question 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?

Answer: Yes, subject to the need for coordination as discussed above. In the absence of such coordination, we oppose suspension. Furthermore, even if search and examination between patent offices is successfully coordinated, we do not believe the applicant should be required to submit a reply in USPTO format.

IBM also believes Track III, should be made available to Paris Convention applicants for a time period up to 30 months from the earliest priority date. (Applications filed under the Patent Cooperation Treaty (PCT) are already entitled to a 30 month delay before initiating national phase prosecution).

With respect to Track I (and possibly Tracks II and III), we suggest an appropriate discount be offered to applicants who submit a reply in USPTO format.

To promote comity among patent offices and fair treatment of US-origin inventors and IP owners who seek patent coverage in other jurisdictions, the USPTO should treat counterpart applicants with reasonable parity relative to US-origin applicants. IBM favors an approach where all three tracks are available to both US-origin and counterpart applicants, with appropriate provisions to encourage sequencing of work flow between patent offices.

The USPTO suspension proposal would force counterpart applicants to perform and provide to the USPTO (as a prerequisite for examination) analysis of the patentability determination of another patent office, including evaluating the relevancy of prior art in the form of "*an appropriate reply to the foreign office action as if the foreign office action was made in the application filed in the USPTO.*" This requirement goes far beyond the appropriate and worthy goal of leveraging the work product of the office of first filing ("OFF"). Indeed, the USPTO acknowledges in its discussion of the benefits of Track I over the current accelerated examination program, that "... *some applicants [do not] want to perform the search and analysis required by the accelerated examination program*" Such analysis is burdensome for applicants, and may expose them to risks such as prosecution history estoppel. The USPTO proposal never requires US-origin applicants to provide this type of analysis even as a prerequisite to Track I. Thus, we submit it is unfair to impose this requirement on foreign-origin applicants.

IBM does recognize the USPTO's interest in leveraging the work of the OFF, which may be encouraged through the use of appropriate incentives. As noted above, the ideal solution is to limit worksharing to patent offices that agree to coordinate examination timing with the USPTO, thus avoiding delay associated with waiting for the office action and search report from the OFF. In the absence of such coordination, the USPTO may wish to consider offering fee discounts to applicants who delay Track II until the OFF office action and search report is received and submitted. (While the same incentive could certainly be offered for Track I, it seems unlikely to be effective given applicant's express interest in speed). Since these documents would provide assistance to the USPTO in examination, a fee discount is a reasonable incentive. An additional fee discount could be offered if applicants choose to submit a USPTO reply to the OFF office action on a voluntary basis. Our proposal would allow counterpart applicants to control initiation of prioritized examination on an equal footing with US-origin applicants, without undue delay or a requirement for ex-ante prior art analysis.

We are also aware that some applicants may seek to strategically delay prosecution by choosing an OFF having relatively long delays before substantive examination. In no event should applicants be required or allowed to delay initiation of US prosecution beyond 30 months from the date of priority, as this subjects the public and the applicant to an inordinate level of uncertainty.

Where the applicant is required or voluntarily supplies the office action and search report from the OFF, the USPTO should be mindful of the potential translation expense imposed on applicants. While this cost may not be unreasonable when compared to typical prosecution costs and fees, the USPTO may wish to consider providing an additional fee reduction to reflect the reduction in examiner labor cost from access to OFF prosecution.

Question 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?

Answer: Yes to the first question – PTA should be offset if delay is caused by the applicant. With respect to the second question, treatment should reflect the extent to which the cause of delay is reasonably within applicant's control.

In some instances, suspension of prosecution is a disadvantage to applicants, while in others it may be preferred. This is consistent with applicants' desire to use prioritized or deferred examination depending on business needs. While in many cases it is apparent that delay is attributable to the applicant (i.e. choosing to defer under Track III), it is less clear if delay is the result of time to examination in a foreign OFF. Applicants seeking longer delays may be motivated to "forum shop" for offices with longer backlogs, to the extent that is possible under applicable law. Such forum shopping should not be rewarded with longer patent terms.

If the USPTO adopts IBMs proposal to coordinate prosecution for counterpart applications, then there should not be a motivation to forum shop, and thus no need to adjust the accrued PTA. To the extent such coordination can not be achieved, we have also suggested an option for applicants to delay initiation of prosecution voluntarily until the necessary documents are received, subject to a possible fee reduction. Given the voluntary nature of the second option, we suggest such delay should be treated as requested by applicant under 35 USC 154(b)(1)(B)(iii), thus not contributing to patent term extension.

Question 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?

Answer: No. See Answer to question 13.

Question 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?

Answer: No, worksharing need not be limited to International Searching Authorities (ISAs). Qualification as an ISA ensures that a minimum standard of search and examination will be applied, but there are other patent offices which are recognized for high standards of search and examination; for example, the patent offices of Germany and the United Kingdom. The USPTO should require quality assurances from non-ISA patent offices eligible for worksharing, as the USPTO has suggested in the 3 Track proposal for IPGOs providing supplemental searching.

Question 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?

Answer: It is unclear when, if ever, a counterpart utility patent application would not be subject to publication as a patent application 18 months from the first priority date. To the extent that a counterpart application might not be subject to a publication requirement, we do not support an exemption based on that status, as the requirement for providing OFF prosecution to the USPTO seems unrelated to whether the application is published. We also strongly support publication and thus oppose what would appear to be an incentive to avoid publication.

Question 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?

Answer: Not sure. While first filing at the USPTO merely to avoid the delay and requirements proposed could increase backlog, we do not believe it will occur with a high frequency. The extent to which applicants will choose to file first in the US may also be influenced by adoption of similar programs in other countries.

Some countries simply do not allow applicants to file first in another country if the invention was made domestically. Some countries also impose national security requirements that make it compulsory to either file an application domestically first, or obtain permission from the national patent office to file first outside the country of invention. The change in USPTO procedures should have little or no effect on such applications. We encourage the USPTO to consider the percent of counterpart applications that originate in countries with such restrictions, to help determine the overall and country-specific effect of the proposed changes.

One of the main reasons for filing a priority application in the country of invention is to have the Paris Convention year in which to make the decision whether and where to foreign file, while avoiding the costs (translations, hiring foreign counsel) and obstacles (see above regarding legal requirements) associated with filing first in another country such as the US. The changes to USPTO procedures for counterparts are unlikely to be sufficient to outweigh the advantages of a first filing in the country of invention/origin in these situations.

The other main reason for using a Paris Convention filing for the US is that this ensures the maximum term of protection for the invention, in that the 20 year term for the patent runs from the date of the US filing, while the invention enjoys protection as of the priority date – i.e., the term of protection for the invention is 1 year under the Paris Convention plus 20 years from the US filing date.

Finally, we believe the number of applicants who would prefer to have examination of their applications delayed is probably greater than those that wish accelerated or prioritized examination. This, in addition to the above-stated reasons, means the number of applicants likely to file first in the USPTO as a consequence of the change in procedure should be relatively small.

Question 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?

Answer: Frequently, if the priority country accepts English language applications. If the priority application was filed in another language, applicants may not wish to lose the additional investment in preparing the application. Increase is unlikely, except perhaps where the patentability requirements of the OFF may be perceived as more stringent than those of the USPTO.

As long as the US is the largest commercial market, there will be a proportion of inventions where protection is required in the US but not elsewhere in the world; this will inevitably mean that a proportion of the USPTO Paris Convention filings will be based upon an abandoned foreign filed application. As indicated above, there are a number of reasons for filing and abandoning the priority application; the USPTO proposals do not make these less or more attractive.

Question 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?

Answer: For PCT direct first filing, the national stage application should be treated as a USPTO first-filed application. For PCT Convention filing based on a prior application, the national stage application should be treated as a non-USPTO first filed application. If the PCT claimed priority from a US filing, then the application should be considered as a continuing application.

For a national stage filing from PCT direct, there is no OFF beyond the RO/ISA which presumably has already acted in the course of the PCT proceedings. The USPTO would presumably have access to those PCT proceedings, although it might consider imposing a translation burden on applicant if the PCT proceedings were not carried out in English. The USPTO might consider fee reductions if applicant has completed a Chapter II proceeding.

For national stage filing from a PCT filed in the Convention year after a first foreign filing, the rules should apply as if the case were a Convention filing in the US. There is an OFF which is to examine the application, so this treatment would seem appropriate.

For national stage filing from a PCT claiming benefit of an earlier US filing, treatment as a continuing application seems appropriate.

D. Supplemental Search (Questions 21-33)

General remarks

IBM supports the PTOs proposal to provide supplemental searching options to patent applicants. We believe any patent office that is either an International Search Authority (ISA) under the Patent Cooperation Treaty (PCT), or meets a similar level of search quality (such as the patent offices of the United Kingdom or Germany), would be an appropriate resource for supplemental searching.

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

Answer: Yes. IBM suggests allowing applicants to choose the IPGO, or alternatively limit IPGO resources according to the qualifications noted above. We also suggest targeting supplemental searching to IPGOs having particular expertise searching in the relevant subject matter area, which could be facilitated if each IPGO identifies its area(s) of search expertise.

Question 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?

Answer: Yes, as to the first question, if such services do not unduly raise cost or cause delay for applicants. Such service could be provided optionally for a processing fee. The USPTO could reduce costs and administrative burden by requiring e-filing for eligibility, or alternatively offering a supplemental search fee discount for e-filing.

While any guidance provided by the USPTO regarding search criteria would be welcome, we believe that such guidance standing alone would be of significantly less value to applicants than a search facilitated by the USPTO directly. USPTO facilitation would allow applicants to leverage the USPTOs established working relationships with other patent offices, and allow the USPTO to better integrate IPGO search with the examination process.

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

Answer: In general, additional searching may be most valuable in emerging technologies where finding the closest prior art is challenging. Specific IPGOs

may be chosen on the basis of search capability, prior art database coverage and searchability, search report quality, and subject matter patentability in the relevant jurisdiction. While we do not suggest any particular office for any particular technology, we note that the prior art databases of the most frequently used patent offices are the most likely to be comprehensive, and thus those offices would be good candidates for supplemental searching.

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

Answer: See answer to Question 23.

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

Answer: Yes. We would expect the fee to be similar to the current USPTO search fee. If the applicant can choose the IPGO, then it would be reasonable for the IPGO to charge its customary search fee in exchange for the IPGOs customary search.

Question 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?

Answer: Consistent with our general remarks above, IBM believes there should be quality assurances. If, for example, the IPGO is a qualified ISA, and agrees to perform the search using the same care as it would for any other application, then that should be sufficient for this purpose. If a patent office adheres to sufficiently high standards for searching, then it need not be a qualified ISA to be an IPGO.

While the USPTO may wish to receive input from applicants regarding search quality, IBM suggests that the USPTO will be the better judge of which patent offices should be identified as IPGOs.

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

Answer: Yes, to the extent possible, so it is clearly relevant for both the applicant and the USPTO. Ensuring the IPGO can apply US prior art standards could be part of the qualification process.

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

Answer: Yes. Not only is this helpful to the applicant and the USPTO in determining scope of search, it should also help improve international searching

techniques by sharing methods and understanding of prior art between patent offices. We suggest including, for example, key words and classes searched.

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

Answer: English.

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

Answer: Yes, so it is maximally effective for making prosecution and examination decisions. Consider triggering deadline on applicant request date, not filing date, unless request must be made at filing.

Note that the appropriate timing will depend on which track the applicant has chosen. Thus, six months from filing date may be too long for Track I, and too soon for Track III. Triggering the deadline on the search request date or examination request date might address Track III timing issues, however, a shorter time frame may be needed for Track I.

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

Answer: Electronically.

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

Answer: The search results, including any search report, should go directly to both the applicant and the examiner.

Question 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?

Answer: Yes, if that can be done without disrupting the examination queue or the patent term adjustment calculation. The USPTO may wish to consider encouraging early interviews for this purpose. While allowing time for comments and/or amendments could speed and improve prosecution, we do not believe such comments should be required. The search may uncover only background or cumulative references, and in any event, mandatory responses before the first office action on the merits would be unduly burdensome for applicants.

E. Conclusion

IBM thanks the Office for providing the patent community an opportunity to participate in its efforts to create a flexible approach to examination timing. We remain committed to working with the Office to develop new approaches and solutions to the important goal of improving the patent procurement process.

Respectfully submitted,

Manny W. Schechter
Chief Patent Counsel
Intellectual Property Law
IBM Corporation
schechter@us.ibm.com
Voice: 914-765-4260
Fax: 914-765-4290

Marian Underweiser
Counsel
Intellectual Property Law
IBM Corporation
munderw@us.ibm.com
Voice: 914-765-4403
Fax: 914-765-4290