

**From:** Bryant Young  
**Sent:** Monday, March 07, 2011 4:49 PM  
**To:** track\_I\_comments  
**Cc:** lmtimallmtima@aol.com; Steven Jamar  
**Subject:** IIP SJ Comments on Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Timing Control Procedures

Attached please find the Comments of the Institute for Intellectual Property and Social Justice submitted in response to the USPTO request for Comments on Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures.

<http://www.federalregister.gov/articles/2011/02/04/2011-2585/changes-to-implement-the-prioritized-examination-track-track-i-of-the-enhanced-examination-timing>

Respectfully submitted,

Bryant L. Young  
IIP SJ Scholar in Residence



**INSTITUTE FOR INTELLECTUAL PROPERTY  
& SOCIAL JUSTICE, INC.**

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**IIPSJ Comments on Changes to Implement the Prioritized  
Examination Track (Track I) of the Enhanced Examination Timing  
Control Procedures**

**I. Commentator Information**

These comments are submitted by the Institute of Intellectual Property and Social Justice at the Howard University School of Law, by its Director, Prof. Lateef Mtima, its Associate Director, Prof. Steven D. Jamar, and its Scholar in Residence and Chair of Institute Development and Advancement, Bryant L. Young, in response to the United States Patent and Trademark Office's Request for Comments on Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures, as published in the Federal Register, Vol. 76, No. 24, p. 6369-6376 Friday, February 4, 2011 (FR Doc. 2011-2585).

The Institute of Intellectual Property and Social Justice (IIPSJ) was founded in 2002 to address the social justice implications of intellectual property law and practice both domestically and globally. IIPSJ's work ranges broadly and includes scholarly examination of intellectual property law from the social justice perspective; advocacy for social-justice aware interpretation, application, and revision of intellectual property law; efforts to increase the diversity of the those who practice IP law; and programs to empower historically and currently disadvantaged and under-included groups to exploit IP effectively.

**II. Comments on Changes to Implement the Prioritized Examination Track  
(Track I) of the Enhanced Examination Timing Control Procedures**

The costs of filing and obtaining a U.S. patent from the United States Patent and Trademark Office (USPTO) are primary considerations for inventors and business owners, especially for those who lack the resources of major corporations. Another major factor and frequent drawback is the consideration of the time it takes the USPTO to determine whether an invention is valid and patentable. Thus, the USPTO has recently presented an optional prioritized examination, which aims to make the process faster for applicants who pay a surcharge.

Specifically, the USPTO proposes "to provide applicants with greater control over when their original utility or plant applications are examined and promote work sharing between

intellectual property offices.”<sup>1</sup> This should provide fast examination for applicants who request it, pay an additional fee, and comply with all requirements.<sup>2</sup>

Through the following comments, IIP SJ encourages the implementation of and compliance with the new changes to the rules of practice. These comments to the USPTO’s proposed changes to the current rule address topics pertaining to the social justice perspective. Under proposed rule 1.102(e), a request for prioritized examination may be filed with an original utility or plant nonprovisional application.<sup>3</sup> The application cannot contain or be “amended to contain more than four independent claims, more than thirty total claims, or any multiple dependant claim.”<sup>4</sup>

The average cost of preparing a patent application of minimal complexity is approximately \$8,548.<sup>5</sup> This cost can range from about \$5,000 to over \$15,000, depending on the simplicity or complexity of the invention.<sup>6</sup> The government filing fee to the USPTO for a utility patent application is \$1,090, or \$545 for a small entity.<sup>7</sup> This fee includes the basic filing fee, search fee, and examination fee.<sup>8</sup> It will cost about \$9,638, or \$9,093 for a small entity, to have a relatively simple non-prioritized, non-provisional utility patent application prepared and filed. Prioritizing the application is a wise investment if one has the funds. Having the application prioritized adds \$4,000 more to the total cost, which is roughly half the cost of the preparation and filing fees, with the stated goal being to provide a final disposition in 12 months.<sup>9</sup>

To offset the production time used for examining prioritized applications, the USPTO plans to use the added revenue for hiring more examiners.<sup>10</sup> Limiting requests, in this case to a max of 10,000 applications the first year, should also help to alleviate concerns that the examination of other applications will be significantly delayed.<sup>11</sup> IIP SJ would propose, however, that the \$4,000 prioritized examination fee be reduced in half for small entities, such as is the case for most other USPTO fees, as small entities would stand to gain the most from prioritized examination, but would be the least likely to afford it.<sup>12</sup> Small entities are largely dependent on capital from investors, who see patent procurement as protecting their investment. Start-up companies that have a patent portfolio are better able to attract more investors to help grow their

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<sup>1</sup> Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures; Proposed Rule, <http://www.gpo.gov/fdsys/pkg/FR-2011-02-04/pdf/2011-2585.pdf> (Feb. 4, 2011).

<sup>2</sup> *Id.*

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<sup>6</sup> The Cost of Obtaining a Patent in the US, <http://ipwatchdog.com/2011/01/28/the-cost-of-obtaining-patent/id=14668/> (Jan. 28, 2011).

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business, which allows them the ability to hire more people. This minor change to the proposed rule should have a profound effect on encouraging innovation and moving our nation's economy forward, in accordance with President Obama's objectives and comments in the 2011 State of the Union Address.<sup>13</sup>

As reflected in our comments, we support adoption of the proposed rule, as it would decrease the time for resolving eligible patent applications and could potentially provide an additional assist to small and independent applicants, while having minimal impact on the pendency of non-prioritized applications.

Respectfully submitted:

Institute for Intellectual Property and Social Justice  
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Prof. Steven D. Jamar, Associate Director  
Bryant L. Young, Scholar in Residence and  
IIPSJ Chair of Institute Development and Advancement

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<sup>13</sup> Remarks by the President in State of Union Address, <http://www.whitehouse.gov/the-press-office/2011/01/25/remarks-president-state-union-address> (Jan. 25, 2011).



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