

From: lawrence pope
Sent: Tuesday, March 01, 2011 9:13 PM
To: track_1_comments
Cc: Christopher A. Bullard; Charles Van Horn
Subject: Individual Comments on Track 1 Proposal @ 76 FR 6369

I am a patent practitioner with 37 years of experience as both in house counsel with large research oriented corporations and in private practice with law firms. Throughout my career I have been quite involved in patent prosecution and have carefully followed the changes in the rules of practice over the years. I have submitted comments on my own behalf and on the behalf of organizations and testified in response to USPTO rule proposals a number of times during my career.

I am currently a sole practioner whose practice is patent preparation and prosecution.

My comments, which are also attached, are as follows:

I see substantial merit in the United States Patent and Trademark Office (USPTO) Track 1 proposal of the of February 4, 2011 at 76 FR 6369, with the understanding that the USPTO will only proceed with or maintain the program if it is permitted to retain all the fee income generated by applicants seeking Track 1 status under the Track 1 program. I see considerable merit in a program which would allow patent applications to voluntarily accelerate the handling of their applications upon the payment of an appropriate fee and compliance with some formal requirements so long as the existence of the program does not adversely impact other patent applicants. The I assume that the USPTO will be able to avoid any adverse impact if it is permitted to use all of the \$4,000 fee it proposes to collect from each program participant and with these funds will be able to obtain the needed resources including additional examiners.

I do have some concerns and questions with regard to specifics both omitted and included in the proposal:

1. The proposal does not address the issue of restriction practice. The I believe that the procedure should explicitly address how a restriction requirement is to be handled:
 - a. I believe that Examiners should be instructed to make restriction requirements by phone whenever possible and to invite a discussion of the restriction requirement at the time it is made with a view to reaching a consensus with the applicant.
 - b. I recommend that Track 1 participants be permitted to traverse restriction requirements.
 - c. I recommend that petitions from restriction requirements in Track 1 cases be handled by a procedure that would provide the examiner decisions on petition which would allow the him to examine the restricted out subject matter, in the case of a reversal, such that the target 12 months to final disposition can still be met.
2. I believe that the Track 1 procedure should explicitly provide for a notice as to whether or not Track 1 status has been granted and, if not, why not. As the formal

- requirements are rather minimal and straightforward, a check form similar to those used with regard to the entry of after final amendments under 37 CFR 1.116 might be appropriate.
3. I believe that the eligibility of applications for Track 1 should be clarified and broadened:
 - a. The comments indicate that continuing applications (which I understand to refer to continuations, divisional and continuations-in-part) with appropriate filing dates are eligible but the proposed 1.102(e) uses the language “an original utility... nonprovisional application”. I recommend the language “an original or continuing utility... nonprovisional application”.
 - b. It is not apparent why a request could not be permitted when a PCT application enters National Stage. I recognize that a patent applicant could simply file a continuation claiming the priority of the PCT application instead of entering National Stage but questions whether this creates unnecessary administrative work for both the USPTO and the patent applicant. Also, it seems that such continuation approach would deny the applicant the discounts to the search and examination fees normally available to PCT applicants. In this regard, it is noted that a PCT application is only eligible for Patent Prosecution Highway acceleration if a claim had been found to satisfy novelty and inventive step in the International Stage.
 - c. I recommend that a request for Track 1 status be fileable with an RCE whether Track 1 status was sought in the initial filing of the application or not. It is apparent that a patent applicant can obtain access to the Track 1 program by filing a continuation application but forcing him to so to obtain or continue Track 1 status for a patent application already under active prosecution seems counterproductive and to create unnecessary administrative burdens.
 - d. I am especially concerned that, for an application already granted Track 1 status, the applicant be given the opportunity to continue that status by the payment of an additional fee. Such an application would have already been found compliant with the Track 1 requirements and it would be an application with which the examiner is already quite familiar.
 4. I suggest that the initial 10,000 requests be allocated in some fashion to provide greater access to those patent applicants facing greater delays to a first action on the merits. It only seems fair that those applicants who have been waiting an inordinately long time for examination get the first opportunity to access the initially limited program. There is currently a great disparity in this delay depending on the subject matter of the application. Perhaps a monthly quota could be allotted to each subject matter category, and after such a short period any allocated requests that were not utilized could be released to general use during the remainder of the year.
 5. I recommend deletion from the proposed 1.102(e) of the references to a processing fee under 1.17(i) and a publication fee under 1.18(d):

- a. To the extent that the \$4,000 fee set by proposed 1.17(c) captures the additional cost for Track 1 handling, there seems to be no justification or logic to an additional fee for just requesting such status. If the projected cost for track 1 handling is actually \$4,130 then clarity would suggest proposing 1.17(c) reflect this. In any case, 1.17(i) does not contain any reference to 1.102 and there is no current proposal to add such a reference so the currently proposed reference to 1.17(i) is confusing.
 - b. It is unfair to seek a publication fee under 1.18(d) from an applicant whose application may never be published or allowed. In normal prosecution this fee is only collected from an applicant when his application has been allowed and then only if he elects to proceed to issuance. A Track 1 application may well go abandoned well before even the initial 18 month publication in view of rejections made in the 12 month prosecution window.
6. I recommend that statistics be published on the number of requests received as well as the aggregate time to final disposition at the greatest level of granularity practical. Perhaps it will make sense to break down the numbers at the Group Art Unit level or at some higher level such as the Technical Center.
7. I also recommend that there be a reflection of the split between the number of regular applicants and the number of small entity applicants for each statistic reported, regardless of whether a reduced fee is authorized for small entities requesting Track 1 status. This status information should be available from the filing fees for each application. The USPTO could then potentially use this information to advocate for reduced fees for small entities.

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