

Dear Director Kappos:

I am writing in response to the request for comments published in the Federal Register on Wednesday, December 9, 2009. Please consider the following:

1. The USPTO should adjust its implementation of the PCT system so that the search and examination during the PCT phase is respected by the USPTO upon entry of the national phase. Where the USPTO issues a favorable report on patentability during the PCT phase, it should lead to the prompt grant of a patent by the USPTO in the national phase.
2. Beyond delaying costs associated with foreign filing, the PCT system is a useful tool for streamlining foreign filing and prosecution. Where, for example, an applicant elects the EPO as the search and examination authority, the same examiner assigned during the PCT phase typically will examine the application upon entry to the national phase in the EPO. Consequently, a favorable report on patentability leads to the prompt grant of a European patent. This grant, in turn, can be persuasive in a number of foreign jurisdictions and leads to prompt and efficient grant of foreign rights beyond the EPO.
3. The primary disadvantage of contracting out the search is that the results are sometimes less complete, particularly with respect to dependent claims, and are not respected by the examiner assigned to the application upon entry of the national phase. Consequently, the search reports are of more limited value because they do not necessarily provide a good indication of whether the claims ultimately will be allowed to issue in a patent.
4. No response.
5. Yes. This is a good mechanism to streamline international prosecution and reduce costs of foreign prosecution.
6. Yes. Obtaining a favorable report on patentability is an efficient way to manage foreign prosecution especially with the benefit of the PPH.
7. Yes. One concern, however, is timeliness. The USPTO would need to provide a timely examination in order for this to be useful.
8. No response.

9. Delaying issuance of the International Search Report leaves less time for examination during Chapter II.
10. Yes. This would be a useful tool for improving the quality of examination during the PCT phase.
11. Please see response no. 2.
12. No response.
13. Please see response no. 2.

Thank you for your consideration.

Sincerely,

Heath W. Hoglund

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