





August 20, 2010

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

*Submitted via e-mail to  
3trackscomments@uspto.gov*

Attn: Robert A. Clarke, Deputy Director, Legal Administration

Re: Request for Comments on Enhanced Examination Timing Control Initiative

Dear Sir:

The United States Patent and Trademark Office (USPTO) has requested input regarding its proposed “Enhanced Examination Timing Control Initiative”<sup>1</sup> (“the Initiative”). Having long supported the USPTO’s efforts to improve patent quality, 3M Company (“3M”) and 3M Innovative Properties Company (“3M IPC”) appreciate the opportunity to provide input on the Initiative. These comments supplement our remarks made at the July 20 public meeting.

By way of background, 3M IPC is the intellectual property operations company for the worldwide 3M corporate family. 3M IPC received 518 U.S. patents in 2009 and owns a portfolio of more than 10,000 pending U.S. patent applications and issued U.S. patents. Thus, our remarks reflect our active participation in the patent arena and our substantial use of USPTO services.

3M is made up of six market-leading businesses that cover a wide range of technologies and products including medical devices, chemical compositions, information systems, software, adhesives, abrasives, cleaning products, office products, optical films, reflective sheeting, semiconductor processing materials, dental implants, orthodontic appliances, RFID readers, and electronic materials. Consequently, our remarks are based on experiences, views, and interests that span a diverse array of industries.

3M is a global enterprise; although headquartered in the United States, we have operations in more than 65 countries. Thirty-five of our international companies have laboratories that provide technical service support to customers, develop new products, and / or research new technologies. We may file patent applications to protect those new products and technologies. Sometimes it is convenient to first-file the patent application in the country where the research and development was conducted and, within the convention year, file the application in other countries, including the U.S. As a result, our remarks reflect that 3M IPC is both a “domestic-filer” (i.e., our patent applications

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<sup>1</sup> See Notice published at 75 Fed. Reg. 107, pp. 31763-31768 (June 4, 2010).

may be first-filed in the USPTO) and a “foreign-filer” (i.e., our U.S. patent applications may be based on prior, foreign-filed applications).

The USPTO has requested public comment on 33 questions that were presented in the Federal Register notice (“the Notice”). Broadly, the USPTO’s questions fall into three categories that form the key elements of the Initiative:

- (1) Three-track examination system;
- (2) Procedure for examining a U.S. patent application that is based on a prior, foreign-filed application; and
- (3) Optional, supplemental searches that would be provided by other intellectual property granting offices (IPGOs).

Our comments are organized into three sections, each addressing one of the three categories noted above. Each section contains a sub-part that includes our remarks responsive to the questions presented in the Notice. The first and second sections also contain a second sub-part that includes some additional questions that we have as well a few suggestions for that element of the Initiative.

### **THREE-TRACK EXAMINATION SYSTEM**

#### **Remarks Responsive to the Questions Presented in the Notice**

Questions 1-12 in the Notice relate to the three-track examination system. We have reproduced these questions below; our remarks accompany each question individually.

*1. Should the USPTO proceed with any efforts to enhance applicant control of the timing of examination?*

Yes. Patent applications filed at the USPTO cover a broad array of technologies that implicate a myriad of dynamic markets and industries. This makes it difficult to design a “one size fits all” patent examination system that meets the varied needs of the USPTO’s diverse customer base. Accordingly, a patent examination system that offers applicants the flexibility to select among a range of examination options in response to different market needs could be advantageous. This would afford applicants some ability to control when their applications are examined, thereby allowing applicants to align their interest in and the importance of their patent applications with the timing of the USPTO’s examination.

The patent examination system has to balance the interests of several constituencies:

- **Applicants** – who want to adequately protect their inventions and may desire the freedom to choose the speed at which their applications are taken up for examination by the USPTO;
- **The USPTO** – which needs to have an efficient, high-quality patent application examination process; and

- **The general public** – which has an interest in receiving timely notice about the scope of the patent rights because economic benefits such as job creation and stimulating new and continuing investments in business may flow from this.

Conceptually, we support a three-track examination system, provided that it is based on certain principles. These are discussed below.

1. The pendency of Track II patent applications – those on the normal examination route – should not increase relative to the pendency of patent applications at the USPTO today. Ideally, the pendency of Track II patent applications will decrease. We suggest that the USPTO adopt clear pendency targets for each examination track, monitor compliance with those targets, and adjust staffing levels and other resources as needed to ensure continued adherence to those targets.
2. The fee for participating in Track I should allow the USPTO to cover its costs for administering Track I while remaining reasonable for applicants, otherwise the benefits afforded by Track I may be seen as more illusory than real. The Notice says that the Track I fee will be “substantial” but we are not aware of a public announcement regarding what that fee will be or exactly how it will be determined, and so this remains an open question.
3. The system does not discriminate against applicants based on where their patent applications were first-filed. If the three-track system imposes substantively different rules on applicants merely based on where applications were first-filed, then it may leave the impression that the system discriminates against certain applicants. The Notice recognizes that applicants may first-file their patent applications in their local regional or national patent office for business reasons or to delay the translation costs that will be incurred upon filing in the USPTO.

However, there are many other reasons why applicants might decide to file first in their local regional or national patent office, and to treat them differently for that rational decision could be seen as unfair.

Some countries permit patent applications to be first-filed in another country without permission. Other countries permit patent applications to be first-filed in another country only after paying for and obtaining a foreign filing license. This, of course, takes time and money that the applicant may not have. In some countries, the procedure for obtaining a foreign filing license may not be well-established, may not be clear, or the time required for the license to be granted may be unpredictable. It would be unfair to penalize applicants who can easily first-file in the USPTO (to avoid being treated differently) relative to applicants who cannot.

4. The maximum delay available for a patent application proceeding under Track III is 30 months from the earliest priority date. The Notice was not clear on when the

30-month delay period would begin but remarks offered by USPTO officials at the July 20 public meeting indicated that the 30-month delay period would be measured from the earliest priority date. We agree with that approach. Similarly, we understand the USPTO will mandate publishing Track III patent applications at 18 months from the earliest priority date. We support this requirement too (except for patent applications that are subject to a secrecy order or a classified classification).

5. As compared to patent applications on Track II or Track III, patent applications on Track I should not be subject to rules that would: (a) shorten the deadlines for responding to USPTO communications; (b) limit the extensions of time that are available to applicants; or (c) require Track I applicants to provide the USPTO with additional information such as an application support document.

Such measures could compromise an applicant's ability to draft and prosecute the patent application in a way that best serves the applicant's interests and could be perceived as forcing the applicant to choose between speed of examination and quality of the issued patent. Prosecution speed may be affected by many factors that are beyond the applicant's control (e.g., availability of inventors, need to compile technical information to support an affidavit, obtaining translations of foreign language documents, etc.). Shortened response deadlines or limited extensions of time could easily penalize an applicant in these circumstances as compared to an applicant who is not subject to the same restrictions. Applicants should not be forced to choose between speed of examination and the quality of the issued patent.

6. The system does not favor or disadvantage applicants based on their size or financial means, otherwise the system may be seen as unfair. One possible way to avoid this would be to scale the participation fees based on applicant size – for example, by having different fees for large, small, and micro entities.

*2. Are the three tracks above the most important tracks for innovators?*

Yes.

*3. Taking into account possible efficiency concerns associated with providing too many examination tracks, should more than three tracks be provided?*

No, because having more than three tracks would likely add complexity, if not confusion, to the system, but without offering a clear benefit to the USPTO, the applicant, or the public.

*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.*

Yes. As noted in response to question #1, for simplicity, transparency, and ease of administration, there should be one queue for all accelerated or prioritized applications.

*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.*

No, unless the USPTO can demonstrate that: (a) there is an additional cost to the USPTO to examine a RCE for which prioritized examination was previously requested, as compared to a RCE for which prioritized examination was not previously requested; and (b) the additional cost is not covered by the fee that was paid upon making the original request for prioritized examination.

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

Yes, if there are sufficient resources available to permit all accelerated or prioritized applications to proceed within the time limits or pendency targets established by the USPTO.

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

We are reluctant to accept limitations on the number of claims in Track I patent applications, whether by type (e.g., independent or dependent claims) or total number, because this might affect an applicant's ability to protect its invention. However, we also recognize that having an inordinately large number of claims may consume additional USPTO resources and slow down the USPTO's consideration of the application – which would be inconsistent with the objective of Track I. Accordingly, any limitation on the number of claims would have to strike a fair balance among affording the applicant adequate flexibility to protect its invention, examination speed, cost, and USPTO resources.

If the USPTO limits the number of claims that are permitted in a prioritized application, then the proposal of having no more than four independent claims and thirty total claims is inadequate. A higher threshold of, for example, at least six independent claims and at least forty total claims would better serve the goal of affording the applicant adequate flexibility to protect its invention.

However, limiting the number of claims raises another question regardless of the limits. During prosecution will an applicant be able to present claims that exceed any limits established by the USPTO?

Regarding the element of cost, the current USPTO fee structure already imposes a surcharge on applicants for claims in excess of three independent claims and / or twenty total claims to address the additional costs associated with examining the extra claims. If this is not sufficient, then the USPTO could consider applying a steeper claim fee structure or a tiered claim fee structure for Track I patent applications that contain more claims than allowed with the basic filing fee.

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

No. Patent applications on Track I should not be subject to rules that would limit the extensions of time that are available to applicants. (Also refer to our answer to question #1.) For at least two reasons, limiting the use of extensions of time should be unnecessary. First, the “substantial” fee that the USPTO has stated will be imposed on applicants electing prioritized examination should provide sufficient motivation for compact prosecution. Second, applicant’s own interest in having selected prioritized examination in the first place, makes it unlikely that an applicant would unnecessarily delay prosecution of that application.

*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?*

Yes. In order to provide timely public notice regarding the content of the patent application, prioritized applications should be published as patent application publications shortly after the request for prioritization is granted or 18 months from the earliest priority date, whichever is earlier.

*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?*

No, but if implemented the USPTO should ensure that: (a) the application is required to be published as a patent application publication 18 months from the earliest priority date; (b) the 30-month queue prior to docketing for examination is measured from the earliest priority date; (c) a procedure is provided for a third party to trigger examination of an application that has been placed in the 30-month queue and prior to the application being taken up for examination; and (d) once a patent application exits the 30-month queue, it is placed in the same line-up as applications that are entering the USPTO on Track II (i.e., examination begins no later than for a patent application placed on Track II on the same day).

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

Yes. See answer to question #10.

*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?*

In general we agree that the PTA applicable to patent applications proceeding on Track III (deferred examination) should be adjusted to reflect that the processing of the application has been delayed at the applicant's request. However, it is unclear how the USPTO intends to apply this concept. For example, what is meant by the "aggregate USPTO pendency" and how will this be calculated? Upon receiving further information from the USPTO about its plans for calculating PTA or examples of how it will be applied, we may be able to supplement our answer.

### **Questions and Suggestions**

We have the following questions about and suggestions for the proposed three-track examination system.

1. Currently pending applications.
  - a. Are currently pending applications eligible for Track I or Track III?
  - b. Will future-filed applications that claim priority to a currently pending application be eligible for Track I?
  - c. How will the three-track system affect the pendency of currently pending applications (including RCEs), and any divisional, continuation, or RCE patent applications that are filed in the future and that claim priority to a currently pending patent application?
2. Applications filed after the three-track system begins.
  - a. Will divisional and continuing applications that claim priority to a patent application that was filed after the three-track system began be eligible for Track I?
  - b. Does the answer to (a) depend on whether the parent application was on Track I?
3. Patent applications on Track I can be expedited by adopting techniques that will encourage compact prosecution. In keeping with the spirit of compact prosecution, we encourage the USPTO to consider how it can (further) incentivize the use of techniques such as telephonic restrictions, first action interviews, other interviews, effective/liberalized after final practice, etc. We also urge the USPTO to consider offering incentives that will encourage applicants to respond more promptly. (For example, under current practice, an applicant is afforded certain advantages by responding to a "final rejection" within the first two months of the response period.)



4. We urge the USPTO to consider other incentives / approaches that may encourage early abandonment of patent applications whether or not they are on Track III.
  - a. Give applicants the option: (i) to file the application and request and pay for search and examination all at once; or (ii) to file the application and pay for a search and then later separately request and pay for examination. With the search and examination fees paid up front, as currently required, the incentive may be for the applicant to simply wait and see what the USPTO determines in a first action on the merits.
  - b. For each patent application that is abandoned prior to examination, allow the applicant to place a case on Track I or Track II at a reduced fee.
  
5. Fees.
  - a. If the request for prioritized examination is submitted after a substantial amount of examination has occurred, will the fee be less than the fee that is charged in the case where prioritized examination is requested before examination has started?
  - b. Has the USPTO considered granting a partial refund or other credit to applicants who request prioritized examination but then opt out before examination starts (or even during examination) if this reduces the demand on USPTO resources?
  - c. The Federal Register refers to a “surcharge” for Track III? What is the purpose of the surcharge and what will it be?
  - d. The Notice mentions deferring Track III fees. How will this work?

**EXAMINING PATENT APPLICATIONS THAT ARE BASED ON A PRIOR, FOREIGN-FILED  
PATENT APPLICATION**

**Remarks Responsive to the Questions Presented in the Notice**

Questions 13-20 in the Notice related to examining patent applications that are based on a prior, foreign-filed patent application. We have reproduced these questions below; our remarks accompany each question individually.

*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?*

No. Although we appreciate that each year the USPTO receives a substantial number of non-USPTO first-filed patent applications and that reusing the work generated by the office of first filing (OFF) may facilitate the USPTO’s own consideration of the same application, we do not believe that the USPTO should suspend prosecution of these applications to await submission of the search report and first action on the merits (FAOM) by the foreign office and a reply in USPTO format.

There are several reasons for this.

1. **It discriminates against applicants based on the country of first-filing.** This approach discriminates among applicants based on the country where the patent application was first-filed. It subjects foreign applicants to different rules in terms of both the timing of examination and the information that has to be submitted. As explained above (see our answer to question #1, point 3), there are many reasons why applicants might decide to first-file first their patent applications in their local regional or national patent office. To treat these applicants differently for that rational decision could be seen as unfair. Some foreign applicants may be able to easily first-file their patent applications in the USPTO (to avoid being treated differently) while others may not be able to do this as easily. It would be unfair to penalize the latter group of applicants relative to the first group of applicants.
2. **U.S. assignees could be subjected to different or inconsistent treatment.** A system that discriminates among applicants based on the country where the patent application was first filed may subject U.S. assignees to different or inconsistent treatment. A global company that is headquartered in the U.S. may have research and development facilities in the U.S. and other countries.

Such companies may have many reasons to first-file their patent applications in the country where the research and development was done: export control regulations may restrict first-filing in another country; business reasons; deferring translation costs; the practicality of filing first in the country where the inventors, the research records, and the patent professional who prepares the patent application are located; etc. (Refer also to our answer to question #1.)

Thus, the country of first-filing for U.S. assignees could be the U.S. or another country. Even though all of these patent applications may owned by or assigned to the same company or corporate family, their U.S. patent applications would be treated differently by the USPTO depending on whether the applications were filed first in the U.S. or filed first in another country.

3. **Delays in the OFF could trigger disparate treatment among foreign applicants in the USPTO.** This approach could result in foreign applicants, as a class, being treated differently by the USPTO. Applicants who first-file in foreign patent offices that historically have had long delays before starting examination or during examination, whether by regulation or simple backlog, will experience longer delays in the USPTO relative to applicants who first-file in countries that process cases more quickly.
4. **Requesting accelerated examination in the OFF may not be an effective solution.** In theory, foreign applicants who wish to avoid delay in the examination of their U.S. patent applications could request and pay for accelerated examination in the OFF, if available. But this is a strange outcome – in order to have their U.S. patent applications handled on Track II (normal examination in the USPTO), these applicants would have to request accelerated examination in the OFF, even if they

do not want or need a patent in that country on an expedited basis.

5. **May encourage forum shopping.** Applicants may attempt to circumvent the USPTO's rules by "forum shopping" – that is, by first-filing their patent applications in the USPTO. If this were to happen, then the USPTO's objective of reusing the work generated by the OFF would be undermined. In fact, the USPTO could end up being in a worse position if "forum shopping" resulted in the USPTO receiving even more patent applications that are filed even sooner than they are today. Conceivably, the patent prosecution highways that the USPTO has recently negotiated with other patent offices could become one-way streets with the USPTO being the OFF that provides information to other patent offices for them to reuse.
6. **Risk of retaliation by foreign patent offices.** Other patent offices may retaliate by adopting parallel rules to level the playing field. If this happens, then U.S. applicants who file patent applications in those patent offices would be disadvantaged.
7. **Substantive value of the requested information is unclear.** USPTO prosecution would be suspended to await submission of the search report and a first action on the merits (FAOM) by the foreign office and a reply in USPTO format. However, the substantive value of this information to the USPTO is unclear. The foreign FAOM will be based on applying the law and patenting requirements of that country, which are not necessarily relevant to examining the application under U.S. law. Similarly, the applicant's reply to the FAOM will address the law of that country, not U.S. law. If the foreign FAOM and / or the reply are not in the English language, they will be of limited value to the USPTO.
8. **The three-month notice requirement for abandoned foreign applications could be easily missed by applicants.** The USPTO has recognized that an exception is needed for patent applications that are first-filed in a foreign patent office and then are abandoned prior to receiving a search report and a FAOM from the foreign patent office. The USPTO proposes that such applicants notify the USPTO that the first-filed application has been abandoned. Failure to notify the USPTO within three months of the first-filed application having been abandoned will trigger a patent term adjustment offset. This notice requirement could be easily missed by applicants. Many important USPTO timing requirements that are related to the next action that the applicant must take in prosecution are conveyed to the applicant through USPTO communications (Office actions, issue fee notices, etc.). The USPTO should consider clearly informing all foreign applicants of this requirement via a communication issued upon filing of the application.

*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?*

It is unclear how the USPTO intends to apply this concept. For example, what is meant by the “average current backlogs to first Office action” and how will this be calculated? If this is tied to the activity in particular art units, then it would seem to be difficult to accurately calculate that average, especially if it is a “moving target,” or avoid differences among art units. We are also concerned whether this would affect foreign applicants equally or differently. Upon receiving further information from the USPTO about its plans for calculating PTA or examples of how it will be applied, we may be able to supplement our answer.

*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?*

No, because replies submitted to the office of first filing (OFF) office action will likely address issues, whether formal, related to clarity or support, or prior art, that are based on the patent law of the OFF, and which may or may not be relevant to examination under the guidelines of the USPTO. Presumably, what is valuable to a USPTO examiner is not so much the office action issued by the OFF (and applicant’s reply thereto) but rather any references cited in that office action.

*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?*

In general, we do not believe that such a requirement is appropriate (see our answer to questions #13 and #15). While we understand the benefit to the USPTO if it receives search information from an office that has qualified as an International Search Authority (ISA), applying this only to offices of first filing (OFFs) that have qualified as an ISA could unfairly and disproportionately burden applicants for whose OFF is an ISA. These applicants would be subject to delay and additional information submission requirements that would not apply applicants from other patent offices.

For applicants whose OFF is *not* qualified as an ISA, the USPTO could level the playing field by commissioning a preliminary search report that would be prepared by a third party patent office or private entity at the request of and under the direction of the USPTO. However, this raises a follow-on question: who would pay for such a search – the applicant (who has already paid to file the application in the OFF and the USPTO), or the USPTO?

*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?*

No, whatever approach that is adopted should apply to all foreign applicants equally.

*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?*

Yes, this is a potential concern. (See our response to question #13.) Although it is difficult to predict how frequently this would happen, some applicants might attempt to circumvent the USPTO's requirement by "forum shopping" – that is, by filing first in the USPTO. If this happened to a significant degree, then the recently negotiated patent prosecution highways could become one-way streets; the USPTO workload would increase and the objective of reusing work generated by the OFF would be undermined. The USPTO would become the entity that would generate work for reuse by other patent offices.

*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?*

We are not sure how often this happens.

Presumably, however, many applicants who rely upon a foreign-filed patent application for a priority claim in a U.S. patent application will enter the USPTO by way of the PCT. In this case, the applicant is likely to receive the international search report (ISR) / written opinion (WO) / international preliminary report on patentability (IPRP) issued during Chapter I / II of the PCT before receiving a first action on the merits (FAOM) from the office of first filing (OFF). If the information supplied under the PCT casts doubt on the patentability of the claimed invention or suggests a range of patentable subject matter that is less than the applicant is willing to accept, then such patent applications might be abandoned prior to receiving a FAOM from the OFF, and might not be filed in the USPTO at all.

This early assessment of patentability (prior to entering the national stage) is an often-stated advantage of using the PCT. If capitalized upon by the USPTO, it could affect the number of foreign-priority patent applications that are filed in the USPTO. If the USPTO accepted the ISR / WO / IPRP issued during Chapter I / II of the PCT in lieu of a FAOM from the OFF, then applicants might be encouraged to use the PCT to satisfy the USPTO's proposed requirement that applicants provide information from the OFF (e.g., search report, FAOM, etc.) before initiating examination of their U.S. patent applications.

This could reduce the number of patent applications that are filed in the USPTO as a result of an early assessment of patentability.

Refer to the “Questions / Suggestions” section below, item #1, for other alternatives on obtaining potentially relevant references that could also affect the number of patent applications that are filed in the USPTO and that claim priority to a foreign-filed patent application.

*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?*

As we understand this question, it is asking whether the national stage of an international application that designated more than the United States should be eligible for Track III. (An initial USPTO first-filed application would be eligible for Track III, but a non-USPTO first-filed application and a continuing application would not be eligible for Track III.) Since the national stage of an international application already benefits from delayed examination, it would be inappropriate to allow that application to be further delayed by using Track III. It would be appropriate to treat such an application as a non-USPTO first-filed application.

### **Questions and Suggestions**

We have the following questions about and suggestions for the proposal on examining patent applications that are based on a prior, foreign-filed patent application.

1. **Alternative to suspending the prosecution of foreign applications.** Since a foreign FAOM will apply the law and patenting requirements of that country (as will applicant’s response thereto), they may be of limited value to a USPTO examiner. Presumably, what is valuable to a USPTO examiner are any references that are cited in the foreign FAOM. Accordingly, the USPTO may wish to focus on adopting procedural requirements that will identify relevant references early in the examination process.

For example, the USPTO could require that applicants need only provide the preliminary search information (and not a FAOM or a reply thereto) such as: (a) a search report issued by the OFF, if it has been determined by the USPTO that the OFF is likely to generate information that will be useful to the USPTO (e.g., an OFF that is qualified as an ISA); (b) a search report published by the ISA (which could be the USPTO); or (c) a preliminary search report prepared by a third party patent office or private entity at the request of and under the direction of the USPTO (although this last approach raises the follow-on question on who would pay for the search – the applicant, who has already paid to file the application in the OFF and the USPTO, or the USPTO?).

2. **Relationship to other USPTO initiatives.** The USPTO has recently negotiated patent prosecution highways with patent offices in other countries and those

programs have objectives that are related to this element of the Initiative. Similarly, the USPTO has embarked on projects like SHARE with the Korean Intellectual Property Office (KIPO) and related efforts with the European Patent Office (EPO) and the Japanese Patent Office (JPO).

- a. How are these different programs related to each other and how will they be coordinated so as to work together?
- b. If the Initiative depends in part on successfully implementing counterpart programs in other patent offices such as the EPO, JPO, KIPO, etc. do the other patent offices support the counterpart programs and what will happen if, after implementation, the counterpart programs do not work in the way expected?

### OPTIONAL SUPPLEMENTAL SEARCHES

#### **Remarks Responsive to the Questions Presented in the Notice**

Questions 21-33 in the Notice related to optional supplemental searches. We have reproduced these questions below; our remarks accompany each question individually.

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

No. Conceivably, supplemental searches might be one vehicle by which foreign applicants could satisfy the USPTO's proposed requirement that such applicants provide certain information from the office of first filing (OFF) (e.g., search report, first action on the merits from the OFF, etc.) before initiating examination of their U.S. patent applications. Beyond this possible use, it is unclear how frequently supplemental searches would be requested by applicants because: (a) foreign applicants already receive such information as a result of first-filing in a country other than the U.S.; and (b) domestic applicants who intend to file outside the U.S. will eventually receive this information from foreign patent offices. Under these scenarios, the primary user of supplemental searches would appear to be domestic applicants who do not intend to file their patent applications outside the U.S., but it is unclear whether such applicants would avail themselves of this option.

Moreover, the USPTO may incur potentially significant costs to negotiate suitable arrangements with the entities that would perform the supplemental searches. Administrative challenges associated with implementing this program can also be envisioned. For example, if non-English language references are identified by the other IPGO, will the USPTO (or the applicant) be in a good position to evaluate these references, how will the responsiveness of the IPGO and the quality of the search results be assessed, how will the fee for the search be established, etc.? In addition, if the IPGOs request that the USPTO provide reciprocal search services, will the USPTO have the resources needed to carry out these requests?

For at least these reasons, we do not support this element of the Initiative and encourage the USPTO to consider whether this is the best use of its limited resources.

*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?*

As noted in our answer to question #21, we do not support this element of the Initiative. However, if it is implemented, then, in order to lower applicants' barrier for entry to obtain a supplemental search, the USPTO should facilitate the process as proposed in the question, provided that: (a) the USPTO has adequate resources to administer the program in a timely and efficient manner; (b) the search results are placed into the USPTO file for consideration by the examiner; and (c) if the application is taken up for examination, then the search results are recorded on a PTO Form 892 or equivalent (i.e., the USPTO acknowledges that the search results were considered).

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

No answer provided to this 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?*

Presumably those IPGOs that already have well-established searching capabilities would be in high demand. One indication may be found by looking at the current usage of the various international search authorities qualified under the PCT and the technologies associated with their respective searches.

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

In order to encourage applicants to use this service, the fee must be reasonable. Many factors will bear on whether the fee is considered to be reasonable such as the complexity of the technology that has to be searched, how much information is provided for non-English language references, the breadth and depth of the search, etc. In general, however, the fee should be competitive with (and ideally less than) the fee charged by high quality, reputable private search firms.

*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?*

The level of quality should be comparable to what the USPTO would provide in conducting a similar search. The USPTO should enter into agreements that would require quality assurances of the work performed by the other IPGO.

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



Yes. See our answer to question #26. In addition, the search should be sufficient to identify references that would qualify as prior art in the U.S. based on the effective date of the reference, even if such references would not qualify as prior art in the IPGO conducting the search (i.e., references that qualify as prior art under 35 USC §102(e)).

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

Yes, to provide information regarding the search that is commensurate in scope with information that is available for those searches that are conducted by the USPTO. In addition, consider whether it would be helpful for the USPTO to have this information when conducting its own search and examination activities.

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

English.

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

To make the results most useful to the USPTO and the applicant, the search report should be required within a short period of time. Six months would be at the outer limit of an acceptable range. Requiring that the results be available in 3 to 6 months would make them more useful.

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

Consistent with how the IPGOs will carry out their work, access to the application should be provided in an appropriately secure manner that maintains the confidentiality of any non-public information.

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

As noted in the answer to question #22, the search results should be placed into the USPTO file for consideration by the examiner and, if the application is taken up for examination, then the search results should be recorded on a PTO Form 892 or equivalent. In addition, the results should be noted on the cover page of any issued patent.

*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?*

The USPTO should consider a short period for optional comment by the applicant. However, since the search results are not provided with an Office action or an analysis of

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the references by the USPTO, the applicant should not be required to provide a written response.

We appreciate having been invited to offer remarks at the July 20 public meeting and being allowed to provide additional input on the Initiative through these written comments. We recognize that a proposal of this complexity must be carefully constructed so that it is responsive to the diverse interests of applicants, the USPTO, and the general public.

We look forward to hearing more about the USPTO's plans for refining and implementing the Initiative and would be pleased to have an opportunity to continue to comment on and discuss the same with the USPTO.

Sincerely,

A handwritten signature in black ink that reads "Steven E. Skolnick". The signature is written in a cursive, flowing style.

Steven E. Skolnick, Reg. No.: 33,789;  
Gregory D. Allen, Reg. No. 35,048;  
Kevin H. Rhodes, Reg. No. 42,102; and

on behalf of 3M Company and 3M Innovative  
Properties Company