

From: wtfryer
Sent: Friday, August 20, 2010 3:51 PM
To: 3-tracks comments
Subject: Professor Fryer's Comments -- Tracks Proposal -- Design Patent

Attention Robert A. Clarke

Hello again Robert! I am sending you my comments on the subject proposal. Thank you for the guidance on the proposal process. The comments were prepared using MS-Word (2003).

Bill Fryer

COMMENTS ON U. S. PATENT AND
TRADEMARK OFFICE PROPOSAL

*ENHANCED EXAMINATION TIMING CONTROL
INITIATIVE
(TRACKS PROPOSAL)*

SUBMITTED BY WILLIAM T. FRYER III
PROFESSOR OF LAW EMERITUS,
UNIVERSITY OF BALTIMORE SCHOOL OF LAW
AND
U. S. PATENT ATTORNEY

AUGUST 20, 2010

CONTACT: WTFRYER@AOL.COM
TELEPHONE (CELL): 240-475-4770

PROFESSIONAL WEB SITE ON U. S. AND
INTERNATIONAL INDUSTRIAL DESIGN
PROTECTION, WITH AUTHOR'S DETAILED CV, AT
[HTTP://WWW.FRYER.COM](http://www.fryer.com)

COMMENTS SUBMITTED IN RESPONSE TO REQUEST PUBLISHED IN
FEDERAL REGISTER VOL. 75, NO. 107, FRIDAY, JUNE 4, 2010. PAGES 31763-
31768, U. S. PATENT AND TRADEMARK OFFICE DOCKET NO. PTO-2010-0035

I. EXECUTIVE SUMMARY

A. THE PROPOSED ENHANCEMENT EXAMINATION TIMING CONTROL INITIATIVE (TRACKS PROPOSAL) SHOULD NOT APPLY TO DESIGN PATENTS.

B. THE PTO DESIGN PATENT EXPEDITING PROCEDURE IS WORKING VERY WELL.

C. THE TRACKS PROPOSAL WOULD NOT WORK EFFECTIVELY WITH MANY FOREIGN NATIONAL DESIGN PROTECTION SYSTEMS OR THE HAGUE AGREEMENT.

D. THE PTO CAN ACCOMPLISH ITS GOALS FOR DESIGN PATENTS BY PROMPTLY IMPLEMENTING THE HAGUE AGREEMENT.

II. INTRODUCTION

The opportunity to submit comments is greatly appreciated. These comments must be limited. They will point to the resources available to the Patent and Trademark Office (PTO) for a detailed evaluation. The author will be willing to provide more detailed information on request.

A. PTO DESIGN GROUP 2900, PART OF TECHNOLOGY CENTER 1600, HAS AN EXCELLENT PERFORMANCE RECORD WITHOUT SIGNIFICANT BACKLOG.

At the PTO 2010 Design Patent Day the current outstanding performance statistics of Design Group 2900 were presented. This Group is now close to meeting the goals stated for the Tracks Proposal, with an average 4 months to first office action and average 12 months to grant. If the Tracks Proposal is implemented for design patents, the effect on Group 2900 and the design owners they serve must be analyzed carefully as a part of the planning stage.

Design patents are a unique form of intellectual property rights, recognized around the world as having a distinct role that is very important to the U.S. economy. A recent report by a national committee has documented the importance of industrial design developments to the U. S. economy, See Report of the U. S. National Design Policy Summit; January 19, 2009; information on this report can be obtained from the Industrial Designers Society of America, <http://www.idsa.org>).

These facts lead to the conclusion that there is no present need to include design patents in the Tracks Proposal.

B. THE PTO DESIGN PATENT EXPEDITING PROCEDURE IS WORKING VERY WELL.

The PTO 2008 Design Patent Day had an extensive discussion of the design patent expediting procedure (also known informally as the Rocket Docket), 37 CFR § 1.155. The requirements to use this procedure include submitting a search report and paying a significant supplemental fee. There were several very favorable comments on the effectiveness of the Rocket Docket from patent attorneys at the PTO 2010 Design Patent Day conference.

The integration of the Rocket Docket design patent expediting procedure as a part of the Tracks Proposal could cause the utility patent related examination issues to distract the PTO from serving the unique design patent needs. For example, design patents have no publication before patent grant, for reasons that are special to the nature of design in the market place. In addition, the expected PTO implementation of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement), ratified by the U. S. Senate, has a publication procedure that will accelerate the publication of design patents to about 4 months from receipt of the International Registration application at WIPO.

C. THE TRACKS PROPOSAL WOULD NOT WORK EFFECTIVELY WITH MANY FOREIGN NATIONAL DESIGN PROTECTION SYSTEMS OR THE HAGUE AGREEMENT.

There are two main general types of design protection systems related to design patents on which foreign rights are obtained under the Paris Convention for the protection of Industrial Property. Most of the design protection systems have no substantive examination. These systems publish the filed application and rely on oppositions or other court actions to eliminate the significant economic conflicts. The other type of design protection in general terms is similar to the U. S. design patent system, requiring substantive examination. Since there are variations that contrast these systems, the international task is to make them work together.

One very important vehicle for this interface of systems is the Hague Agreement. Many questions arise under the Tracks Proposal when the current foreign design systems are considered for interfacing with the Tracks Proposal U. S. design patent system examination procedures. For example, since most foreign design patent related systems do not have substantive examination, will the U. S. filed Convention design patent be allowed to prioritize under Track I? Many of the foreign based U. S. foreign design patent applications would be in this category. If there is the option for many foreign based design patent applications to receive prioritization, is this result fair to other

countries where their design owners must wait for an office action and prepare an amendment to receive that status? Is this situation fair to design owners that chose Track II? Design protection moves quickly to market. It is best to address the current technology utility patent problems separately, in their flight plan, and allow design patents to move separately, effectively as needed. This advice comes from this author's considerable experience in working with both utility patents and design patents around the world. Most countries have a separate statute and procedure for design patent related protection.

D. THE PTO CAN ACCOMPLISH ITS GOALS FOR UTILITY DESIGN PATENTS BY PROMPTLY IMPLEMENTING THE HAGUE AGREEMENT.

The international community has developed the Hague Agreement to solve many of the concerns existing with utility patents, such as expediting design protection publication, improving intellectual property offices communication and more rapid examination of design patent type protection. Other design protection issues can be resolved if most of the countries that have major design protection systems work together as members of the Hague Agreement.

III. CONCLUSIONS

The PTO is congratulated for its initiatives to develop international cooperation for improving utility patent examination. Design patent protection in the U. S. does not have the major problems that utility patents experience now. There is no significant PTO design patent backlog problem. The Tracks Proposal is not the best way to improve U.S. and foreign design patent protection. It should not apply to design patents. The way to achieve the best results for design patents protection in the U.S. and internationally is to promptly complete the PTO implementation of the Hague Agreement. This option now exists for U. S. trademarks and utility patents through the Madrid Protocol and the Patent Cooperation Treaty. The PTO Design Group 2900 is ready to take on this opportunity.

Additional information on the Hague Agreement history and operation can be found on the author's web site, at <http://www.fryer.com>. This author recently submitted comments on the PTO Draft 2010-2015 Strategic Plan that are relevant to PTO management and advocacy for improved design patent protection.

Respectfully submitted,

William T. Fryer III