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Sent: Friday, August 20, 2010 6:08 PM
To: 3-tracks comments
Cc: Berridge, William P.
Subject: Comments on Proposed Enhanced Examination Timing Control Initiative

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Re: Comments on Proposed Enhanced Examination Timing Control Initiative

Attn: 3trackscomments
Please see the attached comments.

Best regards.

Linda M. Saltiel

<<3 Track Comments.pdf>>

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August 20, 2010

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Re: Comments on Proposed Enhanced Examination Timing Control Initiative

In response to the June 4, 2010 Federal Register Notice, Oliff & Berridge, PLC submits the following comments regarding the United States Patent and Trademark Office's June 4, 2010 proposed Enhanced Examination Timing Control Initiative (hereinafter the "3-Track Initiative").

Oliff & Berridge is a nationwide law firm specializing in intellectual property matters. Its patent practice serves corporations and individuals from every industrialized nation and has prosecuted thousands of matters before the United States Patent and Trademark Office (USPTO). Its practice before the USPTO provides a perspective and depth of experience necessary to provide the following comments regarding the proposed 3-Track Initiative.

We applaud and support the USPTO's efforts to reduce the overall pendency of patent applications. However, we believe that, particularly due to the discriminatory burdens placed on foreign applicants, the 3-Track Initiative as proposed would not reduce the overall pendency of United States patent applications, and would invite avoidance efforts by thousands of foreign applicants and retaliation by foreign governments and patent offices that would only further burden the USPTO and United States applicants.

We understand that the goal of the 3-Track Initiative as proposed is to reduce the overall pendency of patent applications at the USPTO and enhance the efficiency and quality of examination by A) allowing applicants that first file, or only file, in the United States to select examination of certain applications to be: (i) expedited; (ii) treated the same as applications are currently treated; or (iii) delayed; and B) derailing examination of applications that claim foreign priority until foreign offices of first filing, and thereafter the affected applicants, meet additional requirements. Specifically, for applications filed in the USPTO that do not claim foreign priority benefits, an applicant may request expedited examination under Track I at any time, may request up to a 30 month delay under Track III, or may obtain examination under the current procedure (Track II). However, for applications filed in the USPTO that do claim foreign priority benefits, no action would be taken by the USPTO until the USPTO receives: (i) a copy of the foreign search report, if any, (ii) the first office action from the foreign office, and (iii) an "appropriate" reply to the foreign office action (i.e., as if the foreign office action had been issued in the

corresponding application filed in the USPTO. After the submission of the foreign office action and reply, an applicant may request examination under Track I or Track II, but may not request a further delay in examination under Track III. If the foreign search report and/or office action or reply were not submitted, the application might never be examined.

The proposed 3-Track Initiative disadvantages small entities and applicants that foreign file patent applications (in general, foreign applicants), in violation of at least United States law, the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement), and the North American Free Trade Agreement (NAFTA), under which international patent rights are safeguarded against discrimination based on place of origin. The proposed 3-Track Initiative would also invite retaliation from foreign governments and patent offices and counterproductive avoidance efforts by foreign applicants. Further, increased filings under Track I of the proposed Initiative may unduly increase the burden on Examiners, ultimately resulting in increased backlogs and/or hastily examined applications (contrary to the goals of the Initiative).

Our concerns, as well as recommendations for addressing these concerns, are discussed in more detail below.

I. Discrimination Against Small Entities

Track I of the 3-Track Initiative contemplates prioritized examination with the payment of a "substantial" fee (not yet determined). The fee would be sufficient to recover all of the costs associated with the contemplated service (e.g., costs of hiring and training new examiners), which may be substantial. However, the USPTO is not permitted to discount the fee for small entity applicants. Thus, small entity applicants who otherwise may not be able to afford the substantial cost recovery fee would not be afforded the benefits of prioritized examination. This would particularly discriminate against smaller corporations and individual inventors who may not otherwise be able to afford the substantial cost recovery fee and who may more urgently need expedited examination, for example, to attract investors based on issuance of patent protection.

In order to better provide small entities with access to Track I examination of their applications, the 3-Track Initiative should be implemented in a controlled manner so that the USPTO can realistically administer the new procedure and control costs. As discussed in more detail below, one way to achieve this would be to implement the 3-Track Initiative as a pilot program with a cap as to the number of applications that can be initially examined under Track I, thus keeping the costs at a manageable level as demand is measured and resources expand.

II. Unfair, Unlawful And Counterproductive Discrimination Against Foreign Applicants

The 3-Track Initiative unfairly discriminates against foreign applicants in a way that is contrary to current law, rules and treaties, such as, for example, 35 U.S.C. §§ 131 and 154 and the TRIPS and NAFTA treaties. Various ways in which foreign applicants are unfairly and unlawfully discriminated against are discussed in more detail below. The best way to eliminate this unfair, unlawful and counterproductive discrimination, which is also discussed below, would be simply to treat all applicants equally.

A. The 3-Track Initiative Would Cause Counterproductive Delays And Backlogs

Discrimination by the 3-Track Initiative is counterproductive on its face in that it would postpone examination, without limits, of approximately one half the patent applications filed in the United States. There can be no doubt that this will increase, rather than decrease, the backlog of unexamined applications in the USPTO. Such treatment is also contrary to United States law. For example, 35 U.S.C. §131 states that "The Director shall cause an examination to be made of the application" While the Director is entitled to impose some prerequisites to examination on applicants, nothing in the patent statutes allows the Director to precondition examination on activities by foreign patent offices taking place before U.S. examination will begin.

1. One Half Of All U.S. Patent Applications Would Be Subject To Uncontrolled And Unlawful Examination Delays

United States patent applications that are based on a prior foreign-filed application (typically filed by foreign applicants) make up roughly one half of all United States applications. Examination of substantially all such applications would be delayed beyond that of applications not claiming priority to a foreign-filed application. This would occur because applications first filed in a foreign patent office would not be immediately docketed for examination under either Track I or Track II, and would instead be held in limbo, potentially for years, before even entering a queue for examination.¹

¹ PCT applications, even if filed in a foreign Receiving Office, would have to be treated as United States applications for purposes of the Initiative under 35 U.S.C. § 363. However, if the improper discriminatory aspects of the proposal are not eliminated, to the extent that a PCT application claims priority to another application, the PCT search report/written opinion and reply should be treated as satisfying the required foreign office action and reply requirement. There is no reason why a search report/written opinion by an international authority should not be given equal weight to the first office action of the priority country.

Specifically, applications first filed in a foreign country would not obtain examination (and would not be placed in the queue for examination under either Track I or Track II) until after a first office action on the merits has been received from the foreign office of first filing, and an "appropriate" reply thereto has been submitted to the USPTO. Thus, examination of United States applications claiming priority to a foreign application cannot begin (and will not even enter the queue for examination) until after the foreign office of first filing has examined the original application and has issued an office action. Neither the USPTO nor the applicants will have any control over the minimum amounts of such delays, although foreign applicants could exacerbate such delays by postponing filing copies of the replies in the USPTO.²

Examination of applications claiming priority to a foreign application will thereby be delayed, at no fault of the affected applicants, potentially for years, whether the applicant ultimately elects Track I or Track II, whereas applications first filed in the United States (or in a non-examination country), if the goals of the 3-Track Initiative are actually achieved, may receive a first office action in four months and may expect to receive a final action within one year. Thus, regardless of which track an applicant of a United States application claiming foreign priority chooses, the applicant would be subject to delays in prosecution beyond delays experienced by applicants who first file in the United States.

Because approximately half of all applications filed in the USPTO are filed by applicants who first file in a foreign country, this program would actually increase the backlog at the USPTO far beyond the current (Track II) levels, contrary to the goals of the proposed 3-Track Initiative. In addition, to avoid this substantial delay, many foreign applicants would be incentivized to file first, or simultaneously, in the United States, creating a surge in United States applications that would have otherwise been spread out over time or potentially not filed in the United States at all, which would also increase the backlog in the USPTO.

Such discrimination also violates NAFTA and the TRIPS Agreement.³ It discriminates based on the territory where inventions were made, requiring foreign inventors to file first in the United States in order to obtain benefits available to United States inventors. This imposes substantive and procedural disadvantages and delays on foreign applicants. It does not merely

² This could discriminatorily favor some foreign applicants by allowing them to intentionally delay examination of their U.S. applications without the limitations placed on United States applicants.

³ "...patents shall be available and patent rights enjoyable without discrimination as to the place of invention" (TRIPS Agreement, Article 27.1); "...patents shall be available and patent rights enjoyable without discrimination as to ... the territory of the Party where the invention was made" (NAFTA Article 1709.7); "Each Party shall accord to nationals of another Party treatment no less favorable than that it accords to its own nationals with regard to the protection and enforcement of all intellectual property rights," (NAFTA Article 1703.1).

require disclosure by all applicants of foreign patenting activities to the USPTO, but preconditions examination on the timing of such activities only for applicants that first file outside the United States -- i.e., foreign inventors.⁴

Furthermore, export control laws of many countries (including the United States) require that inventors first file patent applications in their own country or receive authorization before filing in another foreign country. Even if a foreign applicant would choose to first file in the United States to avail itself of prioritized examination, that foreign applicant may have to wait for permission from its own country before doing so. This delay could be detrimental to the foreign applicant because many countries outside of the United States use a first-to-file system to determine priority of invention. Thus, foreign applicants, at no fault of those applicants, may have a later date of invention imposed upon them than would a United States applicant. For example, while a United States applicant and a foreign applicant may both complete an application for filing the same day, the foreign applicant must wait for permission to first file in the United States. As a result, the United States applicant will likely receive an earlier filing date, which may be relied on to establish an earlier date of invention if the United States applicant later files a corresponding application in almost any foreign country. Such a delay imposed on foreign applicants not imposed on United States applicants could deny the foreign applicants an earlier date of invention worldwide, as well as increasing the backlog at the USPTO, contrary to the above treaty obligations.

2. The Additional Filing Requirements In One Half Of All U.S. Patent Applications Would Unlawfully Increase Delays And Backlogs

Under the 3-Track Initiative, in order to obtain examination, an applicant who first files in a foreign country would need to submit a first office action from the office of first filing along with an "appropriate" reply to the USPTO, which would not be required by applicants who first file in the United States. Such discrimination also violates NAFTA and the TRIPS Agreement because it discriminates based on the territory where inventions were made, requiring applicants that first file outside the United States (i.e., foreign inventors), to provide additional information not required by applicants that file first in the United States.

The requirement for "appropriate" replies to foreign offices actions is vague. The 3-Track Initiative defines an "appropriate" reply to be a reply prepared as if the foreign office

⁴ As further discussed below, the proposed Initiative allows some foreign applicants to request examination under Track I or Track II without a first office action having been issued in the office of first filing, if the applicant can show that the office of first filing will not issue a first office action. This differentially discriminates in favor of applicants from non-examination countries, again in violation of NAFTA and TRIPS. It further encourages other countries to abandon examination or make it optional, eliminating quality benefits of sharing foreign patent office work product through its submission in Information Disclosure Statements.

action was made in the application filed in the USPTO. Thus the 3-Track Initiative appears to dictate how an applicant should reply to a foreign patent office, and require that the applicant argue U.S. law and U.S. claims to the foreign patent office. Alternatively, it may require that applicants file a "reply" in the USPTO as to rejections of foreign claims made under foreign law. Under either scenario, the Initiative would cause backlogs at the USPTO to further increase.

For example, under either scenario, United States examiners will be forced to examine often literally translated foreign office actions and replies in addition to their own U.S. office actions and replies. This work will often be meaningless, since the foreign claims are often very different from the U.S. claims, and the applied foreign law is often very different from U.S. law. In addition, U.S. examiners will have to examine foreign office actions and replies in order to determine whether the replies are "appropriate," adding to their burden of examination. Specifically, examiners would need additional time to determine the "appropriateness" of the reply, to issue office actions addressing any perceived lack of "appropriateness," to consider petitions contesting any allegations of failure of such foreign replies to be "appropriate," and to consider the substance of the office actions and replies. This new activity in about one half of all U.S. patent applications will inevitably increase the burden on the USPTO, and therefore increase backlogs. The "appropriateness" requirement would also slow down foreign patent examination, as foreign applicants have to address U.S. issues when dealing with their home-country replies, thus creating larger backlogs abroad that would reverberate back on the USPTO.

Presumably also, the USPTO will not accept foreign office actions and replies in non-English languages. This will also impose costs and delays on foreign applicants and create further delays in the USPTO.

Incredibly, under the first scenario, the proposal would appear to require foreign applicants to address United States law and potentially non-existent claims in replies filed in foreign patent offices. The proposal states, "Where one or more rejections were made in the foreign office action, applicant's reply ... would have to include arguments why the claims in the USPTO-filed application were allowable over the evidence relied upon in the foreign office action." Thus, foreign patent offices would be burdened with replies that address United States law and regulations, even as to United States claims that do not even exist in the foreign application. This would clearly slow down and overburden foreign patent applicants and patent offices, increasing backlogs worldwide.

Under the second scenario, the 3-Track Initiative would require that two separate replies to a foreign office action be prepared, one for the foreign patent office based on the laws of that country, and the other for the USPTO based on United States law. The laws of various foreign countries are different than those of the United States. For example, the standards for obviousness, and for the substance of replies, are often different. Thus, it would appear that if a claim is rejected in a foreign application by a foreign patent office, an applicant would need to determine if there could be a corresponding rejection of any similar claim or claims in the United

States application, and then argue against such a rejection, or even amend the corresponding claim(s), based on United States law and standards.

There is no guarantee that office actions in many applications will have any relevance at all to United States examination. For example, foreign office actions are often directed to requirements that do not exist under United States law (e.g., inclusion of drawing numbers in claims, claim formats, inclusion of prior art descriptions in specifications), yet foreign applicants will have to wait for, and respond to, such office actions before the USPTO will examine their United States applications, and U.S. examiners will have to review those office actions and replies. No benefit to the USPTO will result from such delays, but the United States backlog will grow as a result of them. The USPTO would transform from one of the faster major patent systems to one of the slowest in the world, since foreign patent offices would necessarily initiate examination before the USPTO will even put about one half of its applications into an examination queue.

Preparing "appropriate" replies would also involve time and costs (including the substantial costs of translations) not required to be expended by applicants who first file in the United States, while further increasing U.S. pendency. Further, such replies would lead to the development of new complexities in the law of prosecution history estoppel and subject foreign applicants to unlawful discrimination by subjecting them to estoppels to which United States applicants would not be subjected, since foreign applicants would effectively have to prosecute their United States claims in response to foreign office actions as well as in response to USPTO office actions.

Under either scenario, the likelihood of retaliation against this incredible burdening of foreign patent applicants and patent offices is extremely high. The flip side of such a requirement is that United States applicants would have to address the laws, regulations and claims of each of their foreign applications in response to United States office actions. Imagine the effect on United States backlogs of replies that must address not only the rejections made by United States examiners, but also all potential foreign rejections of similar and different claims! Further imagine the effects on United States applicants of having to translate and submit such replies in all of the languages and patent offices of their foreign counterpart applications! The increases in United States and worldwide patenting backlogs and costs could be massive.

B. Foreign Applicants Would Be Unlawfully Subjected To A Loss Of Patent Term Extension Not Imposed On U.S. Applicants

According to the 3-Track Initiative, patent term adjustment ("PTA") may be offset by delays of a foreign patent office. Specifically, for an application claiming foreign priority, the USPTO is considering a rule to offset positive PTA accrued in the application when applicant files the required documents (e.g., a copy of the foreign search report, first office action, and "appropriate" reply) after the aggregate average period to issue a first office action on the merits.

For example, if the aggregate average time to issue a first office action is 20 months and applicant submits the required documents 30 months after the filing of the application, then the proposed PTA reduction would be 10 months beginning on the expiration of the 20-month period and ending on the date of the filing of the required documents.

Thus, delays by foreign patent offices would create an offsetting reduction against any positive PTA accrued due to USPTO delays. As a result, applicants that first file in a foreign country, at no fault of those applicants, would be subject to loss of PTA in their United States applications due to delays in the office of first filing. This result is contrary to United States law. This is emphasized by 35 U.S.C. §154(b)(1)(B), entitled "GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY." This "GUARANTEE" makes no exceptions for foreign applicants or for delays by foreign patent offices. To the contrary, the delay imposed on foreign applicants by the USPTO derailing examination of their applications should be construed as a USPTO delay, entitling them to patent term extension under §154.

According to 35 U.S.C. § 154 (b)(2)(C)(i), the period of adjustment of the term of a patent shall be reduced by a period equal to the period of time during which the *applicant* failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. However, the 3-Track Initiative would subject applicants, of applications first filed in a foreign country, to patent term reduction due to no such failure.

35 U.S.C. §154(b)(2)(C) permits the Director to prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. However, the fact that an applicant previously filed a priority application in another country is irrelevant to his or her efforts to conclude processing or examination of a United States application. The timing of search and examination in foreign applications is often completely out of an applicant's control. It would be arbitrary and capricious, and far beyond the scope of statutory construction, to penalize applicants who first file in a foreign country, such as, for example, their home countries, by construing such filing as failure to engage in reasonable efforts to conclude processing or examination of a United States application.

C. Foreign Applicants Would Unlawfully Be Denied The Opportunity To Request A Delay That Would Be Available To U.S. Applicants

The 3-Track Initiative permits applicants of first filed applications in the United States that are non-continuing applications to request a delay of up to 30 months for payment of the examination fee and docketing for examination (Track III). Track III permits deferral of certain fees by United States applicants if Track III examination is requested. The advantages of being able to obtain a 30-month delay, including a delay in paying the examination fee, would not be afforded at all to applicants that filed first in a foreign country. As previously noted, the

disparate treatment of such applicants would violate the TRIPS Agreement and NAFTA, under which international patent rights are safeguarded against discrimination based on place of origin.

Furthermore, to avail themselves of Track III, or non-discriminatory use of Tracks I or II, many foreign applicants will file first in the United States, possibly with foreign language applications, which would further burden the USPTO to check the foreign-language filings and extend the average pendency of examination in the USPTO.

D. The Proposed 3-Track Initiative Unlawfully Favors Some Foreign Applicants Over Others

The proposed Initiative favors applicants from some countries over applicants from other countries, in violation of NAFTA and TRIPS. Some foreign applicants may be subject to: (i) later filing dates of their applications, and (ii) loss of more PTA than other foreign applicants, through no fault of their own.

For example, an applicant of a foreign country that does not require authorization from its own country to first file in the United States may be afforded an advantage (e.g., an earlier filing date) over a foreign applicant that chooses to file first in the United States but does require permission from its own country before doing so.

Furthermore, foreign applicants of a country that examines patent applications more quickly or does not examine them at all would be afforded advantages (e.g., smaller loss of PTA and earlier examination) over foreign applicants of another country that does examine patent applications and does not do so as quickly. For example, as discussed above, applicants of applications first filed in a foreign country would be subject to examination delays and loss of PTA in their United States applications due to delays in the office of first filing. Foreign applicants in a country that examines applications earlier or does not examine applications at all would not be subject to such delays or loss of patent term.

Thus, depending on the export control laws, examination laws, and speed and efficiency of examination in various foreign countries, foreign applicants will be subject to disadvantages as between each other, in addition to the disadvantages for not having first filed in the United States.

This arbitrary and capricious proposal would also favor governments that do not examine applications, with no apparent benefit to the USPTO or anyone else. The 3-Track Initiative may thus encourage applicants not to seek, or foreign patent offices not to pursue, examination of applications, which appears to be contrary to the USPTO goals of work sharing. Instead, it would focus all examination efforts worldwide in the USPTO.

The proposed 3-Track Initiative fails to even contemplate countries with optional examination systems (e.g., Australia). Would applicants that first file in a country that allows the option of choosing whether to have applications examined have an advantage in choosing no examination so that they could then avail themselves of Track I examination while keeping an earlier filing date in their country of origin?

III. Retaliation By Foreign Patent Offices

The 3-Track Initiative states that major patent filing jurisdictions, such as the Japanese and European patent offices, have already adopted office-driven systems in which they address first the applications for which they are the office of first filing. However, the Initiative does not provide any information regarding these alleged office driven systems and fails to provide justification for the unlawful discrimination of the present proposal. The issue also arises as to whether any such office-driven systems discriminate against foreign applicants to the same extent as that of the 3-Track Initiative, or whether any such systems should be halted as treaty violations.

The 3-Track Initiative, if implemented as currently proposed, would most likely result in foreign patent offices retaliating by implementing procedures that would discriminate against applicants that first file in the United States. For example, foreign patent offices may subject applicants that first file in the United States to: (i) delays equivalent to what their own citizens would experience in the United States if they choose not to first file in the United States (i.e., potential delay of years before the application would be placed in a queue for examination), and (ii) preparation and submission of documents not required of other applicants, including requiring United States applicants to file replies based on foreign patent laws and rules in their United States applications. This would be counterproductive. Such actions would result in barriers to a United States applicant entering the worldwide market, affect investments and profits of United States applicants, and cause other financial and competitive burdens for applicants who first file in the United States, much as the present Initiative appears to be intended to do to foreign applicants.

Furthermore, as noted above, for inventions invented in the United States, a foreign filing license must be received before patent protection can be pursued in foreign countries. If a foreign patent office of a country that follows the first-to-file system implemented a procedure similar to the 3-Track Initiative, a United States applicant desiring to file first in that foreign patent office would suffer a disadvantage over an applicant of another country that does not have to wait for authorization to file a patent application in that foreign patent office.

In addition to the counterproductive quid pro quo retaliation, the 3-Track Initiative would likely lead to other forms of trade retaliation. Many countries with slow patent examination do not enjoy proportional filings by United States applicants in their countries. For example, examination is slow in many South American countries, but proportionately more of their

citizens file in the United States than do United States citizens file in their countries. Retaliatory patenting practices would not provide adequate redress for the adverse impact on their trade from discriminatory delayed patenting in the United States. Thus, they would be likely to turn to other forms of discrimination, e.g., in exports or imports of agricultural products, natural resources, or, appropriately, United States patented goods. This could be highly disruptive to international trade and relations.

IV. Risk Of Decreased Efficiency, Quality and Timeliness Of Examination At The USPTO

Applicants seeking prioritized examination under Track I may overwhelm the USPTO's existing resources. Based on current USPTO statistics, approximately one half of all United States patent applications are by applicants whose country of origin is the United States. If too many of those applicants, possibly supplemented by foreign applicants forced to file first in the United States, sought prioritized examination, the 3-Track Initiative system would be overwhelmed, would be very expensive, and Track II applications would experience substantial delays, contrary to the goals of the Initiative. Careful consideration needs to be given to the administration of Track I cases in particular, to ensure that expedited examination is achieved without any compromise of the quality of the examination, and to ensure that Track II applications would not suffer even further delays. Further, if a large number of eligible applicants choose Track I, the expense of implementing the 3-Track Initiative could be prohibitive. For example, small entities that could not otherwise afford prioritized examination under Track I could be burdened with even further examination delays than the current average of 34 months for completion of examination.

One way to address the potential for decreased efficiency at the USPTO based on the currently proposed 3-Track Initiative would be to implement any such program in a controlled manner so that the USPTO can realistically administer the new procedure. As discussed in more detail below, one way to achieve this would be to implement the 3-Track Initiative as a pilot program with a cap on the number of applications that can be examined on Track I.

V. Recommended Adjustments To The Currently Proposed 3-Track Initiative

A. Pilot Program

The currently proposed Initiative could be revised so as to better assess costs (and thus limit potential harm to small entities and other applicants). Specifically, the 3-Track initiative could be implemented as a pilot program, in which the USPTO would cap the number of applications in which an applicant would be permitted to elect prioritized examination under Track I, until it is better known how many applicants would actually seek examination of their applications under Track I and until resources grow to allow high quality, timely examination in all tracks. A percentage of the applications in which an applicant would be permitted to elect

prioritized examination under Track I should be reserved for small entities to ensure that small entities have an opportunity to participate.

By capping the number of applications in which applicants may pursue examination under Track I, the USPTO would be able to more easily determine the cost of implementing and maintaining the 3-Track Initiative. For example, such a pilot program would allow the USPTO to better plan how many new examiners would have to be trained and hired, and would allow the USPTO to add and train examiners as needed, in a controlled manner.

B. Treat All Applicants (Domestic/Foreign) The Same

Furthermore, all applicants should be treated equally. Specifically, applicants who first file in a foreign country should also: (i) be allowed to request delayed examination under Track III; (ii) not be forced to wait for a search report or first office action to issue in the country of first filing before requesting examination under Track I, II or III; and (iii) not be forced to first provide the USPTO with a copy of the first office action in the country of first filing along with an appropriate reply thereto before choosing to pursue examination under Track I, II or III.

C. PTA

As to the proposed changes to PTA, applications, regardless of which track of examination is chosen, should only be subject to loss of patent term extension based on *applicant delay*, consistent with U.S. law. Thus, Track III delays should be treated as applicant delays; no other PTA adjustments should arise from the Initiative unless the Initiative causes USPTO delays that require additional PTA to be granted to Track I and/or Track II applications.

D. Other Current Procedures For Expedited Examination

The other avenues for expedited examination currently offered at the USPTO should continue in the same queue as applications under Track I. Specifically, the current avenues including, for example, applications: (i) under the various patent prosecution highway (PPH) programs, (ii) under the accelerated examination program, (iii) expedited due to an inventor's advanced age or poor health, or (iv) pertaining to green technology should obtain expedited examination at the same pace as Track I applications.

* * * * *

We would support the Initiative if modified as discussed above.

Respectfully submitted,



Linda M. Saltiel