

From: Kwangjun Kim

Sent: Friday, August 20, 2010 7:06 AM

To: 3-tracks comments

Subject: Re: Samsung Electronics' Comments re Enhanced Examination Timing Control Initiative

Dear Sir:

I am enclosing comments of Samsung Electronics in response to the Enhanced Examination Timing Control Initiative by the USPTO as Noticed in 75 FR 31,763 (2010-6-4). Samsung Electronics appreciate the opportunity to comment.

Sincerely,

Kwangjun Kim, Esq.

Vice President

Patent & Technology Analysis Group

Intellectual Property Center

Samsung Electronics Co., Ltd



August 20, 2010

VIA E-MAIL ONLY TO: 3trackscomments@uspto.gov

Mail Stop: Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Robert A. Clarke

Re: Samsung Electronics' Comments re Enhanced Examination Timing Control Initiative by the USPTO as Noticed in 75 FR 31,763 (2010-6-4) ("Initiative")

Dear Sir:

In response to the request for comments in the above captioned notice, Samsung Electronics Co., Ltd. ("Samsung") respectfully comments as follows:

Samsung, globally recognized for its innovative products in consumer electronics, semiconductor, telecommunication and information technology, has consistently been one of the most prolific user of the US patent system, and thus one of the most valuable client of the USPTO, for over a decade.¹ Samsung, while being generally in favor of some aspects of the Initiative (i.e., the proposed addition of the Tracks I and III),² opposes those aspects of the Initiative that proposes differential treatment of applications claiming the benefit of foreign priority differently from those first filed in the US.

Samsung shares the concerns expressed by many others that the proposed discriminatory treatment of those foreign priority based US applications, if implemented as proposed, will have the effect of negating over 125 years of unabated mutual recognition of domestic rights for foreign inventions by the contracting nations under the Paris Convention, will place substantial and undue additional burden and associated cost exclusively and disproportionately on foreign applicants by requiring additional submissions, and will result in additional delay in examination of those applications claiming foreign propriety benefits.³

In addition, Samsung believes at least one aspect of the Initiative may be beyond the rule making authority of the USPTO as it is directly at odds with the US Patent Act as promulgated by the US Congress, and as interpreted by the courts. It is axiomatic patent

¹ Samsung has made the top 10 US patent acquiring private sector organizations list compiled by the USPTO for 9 out of the past 10 years – ranked 11th in the year 2002, and ranked 2nd in each of the years 2006-2009

² Samsung, as with many others, believes that it may be possible to achieve the stated goal of the Initiative, i.e., a reduction in the examination pendency, through the proposed multi-track approach, however is concerned with the possibility that the creation of the faster Track 1 resulting in the examination under Track 2 becoming even slower or inferior in quality as a result of inadequate resources made available for the Track 2 examination.

³ For example, in 2008, the average pendency to receive a first office action was 25.7 months in the USPTO, 12.1 months in the KIPO, 19.0 months in the EPO, and 28.5 months in the JPO. See, Four Offices Statistical Report 2008, ch. 4, table 4, <http://www.trilateral.net/statistics/tsr/statisticsreport/fosr08.pdf>. Proposed requirement for the submission of the first office action by the foreign office of the first filing and the applicant's response to such office action before docketing for examination will undoubtedly result in substantial delay in the overall examination process for foreign priority based US applications.

law that, under the patent statutes and under the courts' interpretation and application of the same statutes, it is the USPTO, not the applicant, that bears the initial burden of establishing a *prima facie* case of unpatentability, a failure to meet such burden entitling the applicant to a grant of a patent.⁴ The Initiative as proposed requires that “[w]here one or more rejections were made in the foreign office action, applicant’s reply...would have to include arguments regarding why the claims in the USPTO-filed application were allowable over the evidence relied upon in the foreign office action.”⁵ Samsung is of the view that such requirement for applicants’ pre-examination arguments in support of patentability as a threshold condition for examination improperly shifts the initial burden of the USPTO to the applicants, and would be a change in the substantive law. Further, the requirement for such pre-examination arguments by the applicant may be particularly problematic in light of the likely differences in the claims between the foreign application and the US application and between the substantive laws of the respective countries.

Under the present US examination practice and rules, an applicant claiming the benefit of foreign priority is already under an obligation to disclose material information, including information relating to foreign office actions. This however is equally true for those applicants of US first filed applications. That is, when an applicant first files a US application, and subsequently files an application in a foreign country, during the pendency of the US application, the applicant is obligated to disclose to the USPTO material information relating to the foreign office actions. It is unclear to Samsung why the USPTO should consider the information relating to the foreign office actions in one situation (i.e., when the foreign application is the first filed application) to be different from or presumably more helpful to the US examiners than those foreign office actions in the other situation (i.e., when the application is first filed in the US). Presumably, the USPTO could just as well place the US first filed application in abeyance once the applicant files a foreign application, and require the submission of an office action from the foreign office along with the applicant’s response and/or statement of patentability before the US application is docketed again for examination. There simply is no logical justification for the proposed differential treatment between US first filed applications and foreign first filed applications.

Accordingly, for at least the above stated reasons, Samsung opposes any differential treatments of the foreign first filed applications from the US first filed applications, and urges the USPTO to apply the multi-track examination scheme, if implemented, without the creation of a disfavored class of applications.

Having provided the above general comments, Samsung responds as follows:

⁴ See, e.g., *In re Oetiker*, 977 F. 2d 1443, 1445 (Fed. Cir. 1992) (“The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant... the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.”); (“If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”) (Internal Citations Omitted).

⁵ 75 FR (2010.6.4) at 31,764

Q1. Should the USPTO proceed with any efforts to enhance applicant control of the timing of examination?

Subject to the above general comments, and provided the current examination pendency (i.e., under Track II) will be shortened or at least not further delayed as a result of the multi-track approach, Samsung is generally in support of the USPTO's efforts to enhance applicants' ability to selectively prioritize and/or delay examination of applications as such enhancement may improve applicants' ability to manage uncertainties in the relevant market conditions and/or technological advancements.

Q2. Are the three tracks above the most important tracks for innovators?

Subject to the above general comments, and provided the current examination pendency (i.e., under Track II) will be shortened or at least not further delayed as a result of the multi-track approach, Samsung believes the proposed three tracks are minimum number of tiers for the USPTO to consider establishing, and thus agrees the same three tracks are the most relevant tracks.

Q3. Taking into account possible efficiency concerns associated with providing too many examination tracks, should more than three tracks be provided?

In the absence of proposal for tracks other than the three specifically proposed tracks, it appears difficult to speculate on the possible efficiency ramifications of additional tracks. While Samsung currently believes the presently proposed three tracks are sufficient, Samsung defers its comment on any additional tracks until such additional tracks are actually proposed and until Samsung does learn of the particulars of the additional tracks.

Q4. 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)?

Samsung considers the accurate statistical accounting of the applications prioritized under Track I distinct from the other types of expedited applications important in order not to result in the cost for the other types of special applications also being borne by the Track I users. Conversely, if handling of the Track I prioritized applications places extra burden on the handling of other types of expedited examinations and thus result in further delays from the examination schedule the expedited applications would otherwise receive, such result is also undesirable.

Accordingly, unless sufficient safeguard measures against the above concerns can be set in place, Samsung generally do not support a single queue arrangement.

Q5. 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?

Samsung favors allowing an applicant to request prioritized examination of an RCE application. However Samsung does not believe the applicant should be required to pay the full Track I request fee again if the applicant had already requested and paid the full required fee for the Track I examination with the original filing. In light of the fact that by the time of the filing of the RCE application, substantive issues and the scope of the required search may have been sufficiently developed, the USPTO resources required for the examination of



the RCE application may be less than that required in examining a newly filed application on the merits for the first time. Accordingly, Samsung is in favor of requiring either no additional Track I request fee or at a minimum a substantially reduced fee when filing an RCE of a Track I application.

Q6. Should prioritized examination be available at any time during examination or appeal to the Board of Patent Appeals and Interferences (BPAI)?

Yes.

Q7. Should the number of claims permitted in a prioritized application be limited? What should the limit be?

Samsung does not oppose placing a reasonable limit on the number of claims in a prioritized application.

Q8. Should other requirements for use of the prioritized track be considered, such as limiting the use of extensions of time?

Samsung declines to comment on the undefined "other requirements," and opposes limiting the use of extension of time.

Q9. Should prioritized applications be published as patent application publications shortly after the request for prioritization is granted? How often would this option be chosen?

Samsung opposes the publication of the prioritized application any sooner than the usual 18 months from the earliest priority date applicable to any other US patent application.

Q10. 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?

Samsung is generally in favor of applicants' ability to request the examination be deferred up to 30-month.

Q11. Should eighteen-month patent application publication be required for any application in which the 30-month queue is requested?

Yes. The usual 18 months from the earliest priority date should be used for publication.

Q12. 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?

Subject to the above general comments, Samsung opposes any differential application of the PTA offset between US first filed and foreign first filed applications, and is of the view that the proposed PTA offset may be unnecessarily complicated, and may result in the overall determination of the patent term overly complex.

Q13. 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?

As previously stated, and for reasons stated, Samsung opposes any such suspension of examination.

Q14. 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?

As previously stated, and for reasons stated, Samsung opposes the suspension of examination, and accordingly has no view on the application of PTA offset that presumes the suspension.

Q15. 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?

As previously stated, and for reasons stated, Samsung opposes any such mandatory pre-examination statement of patentability by the applicant.

Q16. 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?

As previously stated, and for reasons stated, Samsung opposes any such delay in the examination of and any additional submission requirement for foreign priority applications regardless of the qualification status of the foreign office of first filing.

Q17. 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?

As previously stated, and for reasons stated, Samsung opposes any such delay in the examination of and any additional submission requirement for foreign priority applications regardless of the publication status of the US filed application.

Q18. 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?

Samsung believes that all applicants, including Samsung, who currently file first in their respective home offices, are likely to seriously consider filing some significant portion of their application first in the US as the Initiative, if implemented as proposed, penalizes the first filing in a foreign office. This will have the effect of eliminating virtually all benefits the applicants currently enjoy under the Paris Convention.

Q19. 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?

Samsung generally do not abandon foreign priority applications solely in consideration of filing in the US.

Q20. 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?

Samsung generally opposes any differential treatment of any application under the proposed Initiative, and believes, as it relates to the proposed Initiative, a national stage of an international application should be treated in the same manner as any other application before the USPTO.

Q21. Should the USPTO offer supplemental searches by IPGOs as an optional service?

The Federal Register notice relating to the supplemental searches by IPGOs other than the USPTO is unclear as to whether such supplemental searches will be optional at the request of the applicants, rather than as a USPTO mandate. Samsung does not oppose such supplemental searches if they are purely optional and only at the request of the applicants.

Q22. 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?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q23. Would supplemental searches be more likely to be requested in certain technologies? If so, which ones and how often?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q24. Which IPGO should be expected to be in high demand for providing the service, and by how much? Does this depend on technology?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q25. Is there a range of fees that would be appropriate to charge for supplemental searches?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q26. 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?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q27. Should the search be required to be conducted based on the U.S. prior art standards?

To the extent sufficient competency can be assured, for which Samsung is somewhat skeptical, Samsung believes it logical that any supplemental search performed by a non-US IPGO should be based on the U.S. prior art standards. Samsung's understanding is that any optional search performed by a non-US IPGO will not supplant the USPTO search, but will be an addition to a competent search by a US examiner.

Q28. Should the scope of the search be recorded and transmitted?

Yes. To the extent a supplemental search by a non-US IPGO was requested and



performed, Samsung believes the scope of the search should be made available to the USPTO and to the applicant.

Q29. What language should the search report be transmitted in?

To the extent a supplemental search by a non-US IPGO was requested and performed, Samsung believes the search report should be transmitted by the IPGO in the English language obviating the need for the applicant to provide a translation, which may raise many unintended consequential issues, including issues relating to a possible inequitable conduct allegation.

Q30. Should the search report be required in a short period after filing, e.g., within six months of filing?

Samsung does not agree with the underlying premises of this question, and believes no such supplemental searches should be required, but rather should be an option on request by the applicant. As to the specific timing of such search report relative to the application filing, Samsung does not offer a view at the present time.

Q31. How best should access to the application be provided to the IPGO?

Samsung presently lacks sufficient information, and thus offers no comment as to this question.

Q32. How should any inequitable conduct issues be minimized in providing this service?

See Samsung's answer to Q29 above.

Q33. 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?

Samsung opposes any required responses by the applicant prior to an office action by the USPTO, however does not oppose a time period for an optional response by the applicant.