

From:
Sent: Wednesday, July 07, 2010 5:37 AM
To: 3-tracks comments
Cc: Rai, Arti
Subject: Enhanced Examination Timing Control Initiative

Dear Sirs:

Please confirm safe receipt of these comments on the Enhanced Examination Timing Control Initiative.

Yours very truly,
Stephan Freischem

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Enhanced Examination Timing Control Initiative

Dear Sirs,

My name is Stephan Freischem. I have been a German and European Patent Attorney for more than 15 years.

In my capacity as Deputy Secretary General of AIPPI (International Association for the Protection of Intellectual Property) I had the pleasure to attend a Colloquium of AIPLA and FICPI on the patent offices backlog crises.

During this seminar, Ms. Arti Rai from the USPTO presented the three track strategy currently under discussion in the USPTO. During the discussions following her presentation she encouraged the participants to submit comments to the USPTO in response to the request for comments published in the Federal Register on June 4, 2010.

As my firm represents quite a large number of applicants and owners of US patents we closely follow the developments in the US Patent System. Further, as a user of the European Patent System and the national German Patent System, I would like to present a few comments on the three track strategy based on our local experience.

Control of the timing of the examination

Generally, I think that enhanced applicant control of the timing of the examination is good. Germany offers a deferred request for examination which can be submitted within the first 7 years after the filing date. This leaves plenty of time for the applicant to find out whether the subject matter of the application is worth prosecuting and considerably reduces the percentage of patent applications that are actually examined.

However, applicant control of the timing of examination may create serious problems for third parties. A pending patent application may be an obstacle for competitors. It is very difficult, if not impossible, to find funding for a product that is covered by claims of a pending patent application of a competitor. Therefore, a patent application pending for 7 years plus the regular duration of the examination proceedings will award the applicant with a factual protection that is similar to the protection of a granted patent. For this reason, the German patent system allows for thirds parties to file requests for search and examination of pending patent applications. These entities will not be party to the examination proceedings. Nevertheless, the public in general has the same control of the timing of the examination as the applicant.

When introducing a system that enables the applicant to control the timing, third parties should be able to exercise the same control, obviously by paying the same fees as the applicant, if they believe they are being blocked by an unpatentable patent application. Limiting timing control to the discretion of the applicant would create an unbalanced system.

Third parties requesting accelerated examination do not have to be a party of the examination proceedings if there is sufficient opportunity for post-grant opposition/re-examination. Of course, observations filed by third parties should always be considered by the examiner.

Publication of applications in track three

The questions published in the Federal Register refer to the publication of pending applications in several instances. Most countries publish patent applications 18 months after the priority date.

I would be in favour of publishing all applications 18 months after the priority date. This strategy would provide a balanced and internationally accepted system of early publication of patent applications and avoid problems of providing different publication rules for the applications in the different tracks.

Limitation of fast track to US first filings

The limitation of the fast track to US first filings will inevitably lead to a significant increase in US application numbers. Applicants who did use other offices for first filings in the past will be forced to change their strategy and file first in the US.

The US market is (one of) the most important markets for innovative enterprises worldwide. A granted US patent is very valuable for financing the market entry of a new product as well as for the protection of new products against competing products. For this reason, applicants are generally interested in speedy examinations in the USPTO.

If applicants claiming foreign priorities are excluded from the fast track, they will change their strategy and file first in the US.

This effect is amplified if the USPTO halts the examination proceedings of second filings until a copy of the search report and the first office action from the first filing office is submitted, since these requirements further slow down the US examination proceedings. The timing and speed of the US examination will then not depend on the cooperation of the applicant with the USPTO but of the speed of a foreign filing office.

Requirement to provide a copy of the search report and first office action of the first filing office

If the USPTO considers integrating search and examination reports of foreign offices into the US examination proceedings, this effort cannot be limited to search and examination reports from the **first filing** offices.

In the case of a priority claimed from an application in a country which allows deferred examination (for example Japan or Germany), such a requirement may halt the US examination proceedings for a substantial period of time. In the case of German applications, applicants very often do not request examination in the office of first filing. The German applicants may request the German PTO to perform a search but not file a request for examination. The examination request will later be filed in the European Patent Office and the German patent application will be dropped after the European Patent Office allows the case. Therefore, for quite a substantial number of German first filings, the office of first filing will never issue an office action.

I strongly support the initiative of work sharing and of using the work results of other patent offices. However, this work sharing should not be limited to office actions of the offices of first filing. Instead, the information disclosure requirements should be ex-

tended to the submission of foreign office actions issued for all patent applications within one patent family (claiming the same priority). The US examiner should be allowed to decide to which extent he uses the work results from foreign offices. However, the requirement to provide work results from foreign offices should not slow down the US examination proceedings. Delayed examination may strongly effect competitors, especially in cases where the subject matter of the pending patent application is not patentable over the prior art.

A rule that forces US examiners to wait for other IP offices to do their work will create a risk to the general public by unduly increasing the number of pending patent applications and extending the duration of the examination proceedings.

Very truly yours,



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European Patent Attorney