



April 29, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Alexandria, VA 22313-1450
Attention: Nicolas Oettinger

Via Email: regulatory_review_comments@uspto.gov

Re: Improving Regulation and Regulatory Review, 76 Fed. Reg. 15891 (March 22, 2011)

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) submits the following comments pursuant to the United States Patent and Trademark Office's (Office) request for information on "Improving Regulation and Regulatory Review," published in the Federal Register on March 22, 2011. We thank you for the opportunity to provide our comments.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and over 11,000 individuals who are involved in the association either through their company, firm, or university, or as an inventor, author, executive, or attorney member.

IPO appreciates the opportunity that the Office has provided the public in its efforts to determine whether any of its existing significant regulations should be "modified, streamlined, expanded, or repealed in order to make the Office's regulatory program more effective and less burdensome."

We are providing comments that both suggest ways to form a process for selecting rules for review, and also suggest some specific topics for review. The suggestions should not be considered exhaustive and IPO would hope to have the opportunity to respond further as the regulatory improvement initiative proceeds.

1. What is the best way for the Office to identify which of its significant regulations should be modified, streamlined, expanded, or repealed? What process should the Office use to select rules for review and how should it prioritize such review? How can the Office best encourage public participation in its rule making process? How can the Office best provide a forum for the open exchange of ideas among the Office, the intellectual property community, and the public in general?

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The Office should identify and prioritize specific regulations by a combination of internal evaluation and dialog with others. Examples of internal Office evaluation would include:

- a review of petitions filed by the applicant community to determine the relative frequency of specific issues that arise
- a re-evaluation of any regulations that would appear to impair or run counter to the goals of “compact prosecution;” an example would be a review of the regulation that permits a final office action as a first action in a continuation or RCE application
- an evaluation of any regulations that appear to be inconsistent with its own practices; an example would be to review rules governing the timing of applicant requests for reconsideration of patent term adjustment with regard to “B” delay – in particular a “B” delay challenge should not be required to be filed at the time that the issue fee is paid
- an evaluation of regulations to ensure that there no inconsistencies with international treaties such as the PCT and the Madrid Protocol

Examples of dialog with others would include:

- involvement of the Public Advisory Committees for ideas and evaluation of ideas
- continued publication of Federal Register notices that solicit comments and new ideas, with 60 to 90 days provided for members of the public to comment
- use of “roundtables” to provide a more in-depth opportunity for discussion of particular regulations or issues, or to aid in development of priorities
- prompt publication of written comments sent to the Office
- improved access to information and comment on the Office website

Generally speaking, IPO believes the Office should start its evaluation from a “clean slate.” Beginning with a comparison between present rules and the requirements of the statute as interpreted by the courts, the rules should be re-evaluated. Examples would include evaluation of RCE practice, rules for section 371 filings, the petition process for filing IDS documents under seal, the patent classification system, the patent

prosecution examiner interview process, prosecution procedures “after final”, the appeal process, and the re-examination process.

2. What can the Office, relative to its regulation process, do to reduce burdens and maintain flexibility for the public while promoting its missions? How can the Office ensure that its significant regulations promote innovation and competition in the most effective and least burdensome way? How can these Office regulations be improved to accomplish this?

One of the primary ways to reduce burdens on the patent and trademark community would be to eliminate requirements for applicants to provide information to the Office when that information is already available. For example, current information disclosure rules do not require applicants to submit copies of U.S. patent documents. This practice could be expanded to include published PCT and foreign applications that are readily available through WIPO. Further, the Office should reconsider any requirement for applicants to submit documents such as references or office actions already of record in co-pending applications.

Specifically on the trademark side, the Office could consider regulations to promote uniformity of goods and services identifications between the Law Offices such that goods and services descriptions approved by an Examining Attorney in one Law Office can be assured approval by an Examining Attorney in another Law Office. Such regulations would reduce the number of Office Actions relating to unacceptable goods and service identifications, thereby reducing the burdens on the Trademark Office overall.

Ultimately, the best way to promote innovation and competition in the most effective and least burdensome way involves improving patent quality and reducing pendency. IPO has previously provided a number of suggestions in that regard.¹ A further step in this process would include improved transparency to the public during patent prosecution. The Office should consider, for example, upgrading its system to enable access to public PAIR by computer-automated search engines. Such an advance would allow the public much better access to information on patenting activities. The resulting improvement in transparency would potentially benefit innovation and competition in many ways.

The burdens of regulations can also be reduced, and transparency can be improved, by reviewing existing regulations and proposed new regulations for clarity of

¹ A recent example includes IPO’s Comments regarding “Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, 76 Fed. Reg. 7162 (Feb. 9, 2011), http://www.ipo.org/AM/Template.cfm?Section=Board_Resolutions_and_Position_Statements&template=/CM/ContentDisplay.cfm&ContentID=29265. See also, IPO’s Comments on USPTO draft Strategic Plan for FY 2010-2015, http://www.ipo.org/AM/Template.cfm?Section=Board_Resolutions_and_Position_Statements&template=/CM/ContentDisplay.cfm&ContentID=26601.

writing and ease of understanding. Points in regulations should be presented in a logical sequence and the most important points should be highlighted. Related items should be grouped together. Sections and subsections should have informative headings. Unnecessary jargon and minutiae should be eliminated.

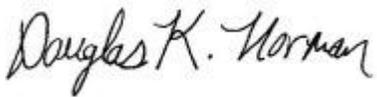
3. Are there Office regulations that conflict with, or are duplicative of, regulations from other agencies?

One significant way to reduce the potential for conflict or duplication is to provide flexibility in rules. The analytical approach described above, involving a review of the statute and the regulations arising from implementation would be an excellent way to approach this issue.

In particular however, it is suggested that the Office review and re-evaluate the canons and rules in 37 C.F.R. Part 10 (See, "Patent and Trademark Office Code of Professional Responsibility," 37 C.F.R. Part 10, §10.20 *et seq.*). Practitioners are often independently subject to codes of conduct through other state and federal regulatory or licensing tribunals, and there are occasions where the various canons may conflict or be duplicative.

IPO again thanks the Office for this opportunity for public involvement, and would welcome any further dialog or opportunity to support the Office during its regulatory review and regulation improvement project.

Sincerely,



Douglas K. Norman
President