

From: Lee Hollaar [e-mail address redacted]  
Sent: Friday, September 09, 2011 8:16 PM  
To: ai\_a\_implementation  
Subject: Attn: Hiram Bernstein - Patents: prioritized examination rules

I'm writing to suggest that you consider a change in the regulations for prioritized examination that was not in the February 4, 2011, NPRM for enhanced examination: requesting immediate publication of the application if priority is granted. In Comment 12 of that NPRM, the Office indicated that it was not proposing that. However, the AIA makes changes that makes requiring early publication more desirable.

You may have heard the scare story from opponents of the patent reform bill, where a second-filer gets a patent because he paid for prioritized examination and was properly granted his patent before the first applicant's application was published and became prior art, either because it was less than eighteen months after it was filed or the first applicant requested that the application wasn't published. Under the present law, the storytellers note, this would result in an interference, but under the patent reform bill, the second filer receives a patent that is valid until the first filer's application becomes prior art when it is finally published. And then the Office has the problem of a now-invalid patent out there.

That obviously makes the Office look bad by making it seem like one can "steal" a patent by paying an extra \$4,800, and the first applicant then has to pay at least \$2,520 (current fee, with no discount for a small entity) for an ex parte reexamination to correct the problem.

The problem can be minimized if immediate application publication is required for prioritized examinations. The first applicant, if he is monitoring published applications, can request early publication of his application, since the subject matter is no longer a trade secret because of the publication of the prioritized application. He can then bring his application to the attention of the examiner performing the prioritized examination as prior art as of its filing date, so that the second-filed application will be rejected. This clearly would make the AIA work better than the current law, which depends on costly interferences.

Monitoring prioritized examinations by the first applicant would be simplified if a code were included with published applications to indicate which are undergoing prioritized examination, so that on the average fewer than 200 applications would need to be reviewed each week. In many cases, the title or classification would be enough to indicate that it is not related to the first-filed application.

As I mentioned, the AIA makes changes that encourage monitoring pending applications. Rather than the current law's policy against pre-issuance opposition to a patent without the "express written consent of the applicant," see 35 U.S.C. 122(c), Sec. 8 of the AIA encourages timely pre-issuance submissions by third parties to help the Office be aware of prior art before a patent is issued. That will substantially benefit the Office by providing prior art that might not otherwise be available to an examiner. But that new provision meshes with prioritized examination ONLY if the application is published in time for third parties to submit prior art before a patent is issued.