

From: Kurt VanVoorhies
Sent: Thursday, February 26, 2009 9:28 PM
To: AC6/Comments
Subject: Attn: Mr. Robert W. Bahr Re: Comments on Deferred Examination
for Patent Applications

Dear Mr. Bahr:

Attached please find comments in response to the Request for Comments
and Notice of Roundtable on Deferred Examination for Patent
Applications published in 74 Red. Reg. 4946.

Respectfully yours,

Kurt L. VanVoorhies, Ph.D., P.E.
Reg. No. 38,643

Comments on Deferred Examination for Patent Applications: 74 Fed. Reg. 4946

I commend the USPTO, the moderator and the participants for the extraordinarily constructive roundtable held on 12 February 2009 to discuss deferred examination for patent applications.

Further to my previous comments submitted on 03 May 2006 in response to the proposed Claims and Continuation Rules -- excerpted hereinbelow -- I strongly urge the USPTO to provide for a deferred examination of patent applications. This would be of benefit to inventors of both large and small entities who wish to protect inventions for which they have not had either the resources or time to fully develop or commercialize.

In response to the constructive and thoughtful suggestions offered during the roundtable, I respectfully suggest that a deferred examination system provide for the following:

1. Applications subject to deferred examination should be subject to 18 month publication.
2. Third parties should be able to initiate examination of applications subject to deferred examination. This should be at a sufficient cost to the party requesting examination so as to preclude frivolous third party requests, but with the applicant obligated to pay the majority of the cost.
3. Third parties should be able to electronically submit information material to the patentability of any application subject to deferred examination (or any other patent application, for that matter), including a provision for identification of relevant portions thereof. Preferably, this information would be text searchable, with the provision by the USPTO for text searching within this information for a given patent application.
4. Applications subject to deferred examination should be subject to search at the discretion of the USPTO.
5. Applicants, especially small entities, could benefit if the USPTO provided for an applicant-controlled field in the PAIR database to indicate if an applicant is actively seeking to sell or license a particular invention.
6. The public would benefit if the USPTO provided for optional applicant-controlled fields in the PAIR database indicating a) if the invention had been actually reduced to practice and b) if the invention was being produced or worked.
7. Payment of the examination fees should be deferrable until making a request for examination.
8. The fee for maintaining an application in deferred status should be substantially less than the normal maintenance fees of issued patents.
9. The period of deferral should not be limited.
10. Applicants should be able to file superseding CIP applications of applications subject to deferred examination so as to provide for protection and disclosure of improvements.
11. Applicants should not be entitled to any patent term adjustment for periods during which the examination thereof is deferred, but otherwise patent term adjustment should become available following a request for examination.

Respectfully Submitted,
/Kurt L. VanVoorhies, Ph.D., P.E./
Kurt L. VanVoorhies, Ph.D., P.E.
Registration No. 38,643

26 February 2009

Comments on Deferred Examination for Patent Applications: 74 Fed. Reg. 4946

Excerpt from “**Comments on Proposed Changes to Practice: 71 Fed. Reg. 48, 61**” originally submitted to USPTO on **03 May 2006** by Kurt L. VanVoorhies, Ph.D., P.E.

(see: http://www.uspto.gov/web/offices/pac/dapp/opla/comments/fpp_claims/vanvoorhies.pdf)

“The undersigned strongly urges the USPTO to **not** adopt the proposed changes to the rules [i.e. the Claims and Continuation Rules], but instead to consider other options that address the real problem, which the undersigned respectfully submits is the examination of patent applications for inventions that are either never reduced to practice or which are never commercialized, and for which there is never a real need to perfect the associated rights of exclusion that a Letters Patent would provide. If applicants are given a right to delay examination indefinitely over the 20 year life of the non-provisional application, provided that the application is published, and if the public is given the opportunity to initiate a request for examination of an application, then applicants will benefit from not having to incur the costs of examination and issuance of patents for which they are uncertain of the merits of their invention, the public will benefit from the publication of the application and the opportunity to initiate examination if they have a commercial or competitive interest in the invention and wish to know the metes and bounds of the claims, and the USPTO will benefit from not having to examine so many applications to new inventions. This will free up examination resources to work on the examination of applications for commercially important inventions for which the right to exclude is necessary, and to examine any continuations that the applicants believe are necessary to secure their full rights to exclude others from practicing the invention that they have invented. This would also free up examination resources to provide for the reexamination of patents under infringement litigation, so as to assist the Courts in objectively verifying that the claims at issue are patentable, and perhaps to assist the Courts in an objective interpretation of those claims. These and other suggestions will be expounded upon in forthcoming comments to be provided in response to the USPTO’s request for public input on the new USPTO Strategic Plan.

Pareto’s principle, also known as the law of the vital few or the 80-20 rule, provides that in anything a few (20 percent) are vital and many (80 percent) are trivial. In view of this principle, it may be suggested that a relative few of the patent applications have vital commercial importance, and should not be encumbered by the proposed changes to the rules. Instead, other changes can be crafted which will be beneficial to all of the interested parties, and which will provide for a substantial reduction to the burdens of the USPTO.”