

From: Robert J. Yarbrough
Sent: Wednesday, February 25, 2009 1:15 PM
To: AC6/Comments
Subject: comments to proposal for deferred examination

Sirs,

Attached are the comments of the Pennsylvania Intellectual Property Forum in response to the request for public comment published at 74 Fed. Reg. 4946 on January 28, 2009, concerning deferred examination.

Robert J. Yarbrough
Chairman
Pennsylvania Intellectual Property Forum

PENNSYLVANIA INTELLECTUAL PROPERTY FORUM
201 NORTH JACKSON STREET • MEDIA • PENNSYLVANIA • 19063
PHONE: (610) 891-0668 • FAX: (610) 891-0655
EMAIL: ROBERT@YARBROUGHDLAW.COM

February 25, 2009

Mail Stop Comments - Patents
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: 'Request for Comments and Notice of Roundtable on Deferred
Examination for Patent Applications'
74 Fed. Reg. 4946 (January 28, 2009)
Attn: Robert W. Bahr

Dear Mr. Commissioner:

In the Federal Register notice dated January 28, 2009, the U.S. Patent and Trademark Office requested public comment regarding whether the PTO should consider a program of deferred examination. This letter presents the comments of the Pennsylvania Intellectual Property Forum ("Pennsylvania IP Forum").¹

A de facto program of deferred examination currently exists in the PTO due to the long pendency times in many art units. The members of the Pennsylvania IP Forum whose names appear below generally **SUPPORT** an optional program of deferred examination, with certain caveats, as follows.

1. **The program should be structured so that competitors of the applicant are not prejudiced by the deferral.**
 - a. **To limit uncertainty, the allowed duration of a deferral should be limited.**

During the period of time that a patent application is pending, the outcome of the patenting process is uncertain both for the applicant and for a competitor of the applicant. To limit this period of uncertainty, the allowable duration of a deferral should be limited, for example to five years. We believe that few

¹ The Pennsylvania IP Forum is an organization of patent practitioners and intellectual property attorneys located principally in Southeastern Pennsylvania. While some of us represent large entities, all of us represent individual inventors and small entities. Large entities already have significant advocates in Washington. Our purpose in making these comments is to provide a voice to individual inventors and small entities that otherwise would not be heard.

PENNSYLVANIA INTELLECTUAL PROPERTY FORUM

applicants will wish to request examination after that time due to the limited remaining life of any resulting patent.

- b. To limit uncertainty, the PTO should consider allowing persons other than the applicant to request examination.**

For a competitor for whom the prospect of a final issuance or denial of the applicant's patent is preferable to the uncertainty of a pending application, the PTO may allow the competitor to pay a fee and request examination on behalf of the applicant.

- c. Eighteen month publication of deferred applications should be mandatory.**

A competitor may be prejudiced by a deferred examination where the competitor does not know about the pending application. For example, the competitor may expend research and development resources and work to develop a market for a product in which someone else has an undiscoverable prior right. To eliminate this prejudice, we recommend requiring publication at eighteen months for any applicant requesting deferred examination.

- 2. The program of deferred examination should be structured to encourage deferral.**

If applicants are prejudiced by the deferred examination program, applicants will not defer examination and the PTO will experience no reduction in the number of applications waiting for review. The applicant should pay no higher fees than any other applicant and, preferably, should be given a discount. As one possible discount, the PTO should consider deferring some or all application fees until examination of the application is requested. Patent term extensions should apply to delays by the PTO occurring after the applicant pays the examination fee and requests examination.

- 3. The program of deferred examination should be structured to encourage abandonment of deferred applications.**

If an applicant abandons an application during the period of deferral, the review burden of the PTO for that application is eliminated. The PTO should consider incentives for express abandonment of deferred applications, such as providing refunds of application fees for abandonment during the period of deferral.

PENNSYLVANIA INTELLECTUAL PROPERTY FORUM

We suggest that the amount of any refund decrease over the allowable period of deferral to encourage early abandonment.

4. The wealth of international experience in deferred examination should be tapped and the successful aspects of programs of other countries emulated.

Deferred examination has been in use around the world for several years. The benefits and pitfalls of deferred examination should be well known. We recommend that the PTO tap the experience of other countries in formulating the deferred examination program.

The members of the Pennsylvania IP Forum appreciate the opportunity to comment and would be pleased to further assist the Office in any manner necessary to consideration of the issues discussed above.

Very truly yours,



Robert J. Yarbrough
PTO Reg. No. 42,241
Chairman,
Pennsylvania Intellectual Property Forum

The following participants in the Pennsylvania IP Forum endorse these comments.

Stuart S. Bowie, PTO Reg. No. 22,652

Brian P. Canniff, PTO Reg. No. 43,530

Richard A. Elder, PTO Reg. No. 30,255

Gerry J. Elman, PTO Reg. No. 24,404

Lawrence A. Husick, PTO Reg. No. 31,374

Deborah Logan, PTO Reg. No. 54,279

M.P. Moon, PTO Reg. No. 53,844

Scott R. Powell, PTO Reg. No. 58,378