

FORTY-TWO PATENT PRACTITIONERS

By Priority Mail 9405503699300232847144

Kathi Vidal, Director
USPTO
P O Box 1450
Alexandria, VA 22313-1450

April 26, 2022

Dear Director Vidal:

In this letter, the undersigned patent practitioners ask that the USPTO undertake several measures to bring the USPTO closer to providing world-class service to the PCT applicant community. The signers of this letter, either directly or through their law firms or corporations, have in the past ten years filed more than 26000 patent applications at the USPTO, including more than 2000 PCT patent applications at the USPTO. The signers of this letter, either directly or through their law firms or corporations, have in the past ten years prosecuted more than 9000 US patents to issuance as entries into the US national stage from PCT patent applications. The signers of this letter, either directly or through their law firms or corporations, have in the past ten years paid more than fifty million dollars in fees to the USPTO. Most of the signers of this letter are members of the PCT listserv, a community of over nine hundred patent practitioners who make frequent use of the Patent Cooperation Treaty.

In this letter we will briefly describe several “asks”, followed by a more detailed discussion of each of the “asks”.

We ask that the USPTO set policy and internal procedure so that, to the extent possible, the Office arranges for the particular Examiner carrying out work on behalf of the USPTO in its role as International Preliminary Examining Authority in a particular international patent application (PCT application) be the same as the particular Examiner carrying out work on behalf of the USPTO in its handling of the national-stage entry thereof.

We ask that the USPTO set policy and internal procedure so that, to the extent possible, the Office arranges for the particular Examiner carrying out work on behalf of the USPTO in its role as International Preliminary Examining Authority in a particular international patent application (PCT application) be the same as the particular Examiner carrying out work on behalf of the USPTO in its handling of any US national patent application (111(a) application) claiming domestic benefit from that particular PCT application under 35 USC § 120.

We ask that USPTO set policy and internal procedure that in an application that is being examined as a national-stage entry from a PCT application, and in which the PCT application was examined by the USPTO in its role as an IPEA, and in which the same Examiner is assigned to both tasks, that to the extent that a claim being examined in the national stage is a claim that is substantially similar to a claim that was examined by the IPEA/US, the Examiner should be

expected to arrive at the same answer as to patentability as to that claim within both tasks, barring some satisfactory explanation for arrival at a different answer.

We ask that USPTO set policy and internal procedure that in an application that is being examined as a 111(a) application claiming domestic benefit from a PCT application, and in which the PCT application was examined by the USPTO in its role as an IPEA, and in which the same Examiner is assigned to both tasks, that to the extent that a claim being examined in the child application is a claim that is substantially similar to a claim that was examined by the IPEA/US, the Examiner should be expected to arrive at the same answer as to patentability as to that claim within both tasks, barring some satisfactory explanation for arrival at a different answer.

We ask that USPTO set up an internal procedure so that the “advancement out of turn for examination” provided for in 37 CFR § 1.496 actually takes place.

We ask that USPTO provide indicators in the user interface of Patentcenter to acknowledge whether a particular application has been granted “special” status under PCT-PPH and whether a particular application has been recognized as being entitled to “advancement out of turn” pursuant to 37 CFR § 1.496.

We ask that USPTO set up a procedure within DO/EO/US so that the “special” status of a granted PCT-PPH request be honored by DO/EO/US, with prompt national-stage processing of such applications.

We ask that USPTO become a Depositing Office in the WIPO DAS system with respect to international patent applications (PCT applications) that have been filed at the RO/US (the Receiving Office of the USPTO).

Same Examiner for IPEA/US work and the related 371 or child continuity work. As mentioned above, we ask that the USPTO set policy and internal procedure so that, to the extent possible, the Office arranges for the particular Examiner carrying out work on behalf of the USPTO in its role as International Preliminary Examining Authority in a particular international patent application (PCT application) be the same as the particular Examiner carrying out work on behalf of the USPTO in its handling of the national-stage entry thereof.

The reasons for asking for a “same Examiner” result are, of course, easy to understand. First, this will minimize unnecessary duplication of effort. To the extent that a particular Examiner is already familiar with the subject matter and claims of a particular application, this can lead to some economy of effort when the application lands on the desk of that same Examiner a second time. Second, as discussed below, we are asking for the USPTO to set a goal of “drinking its own champagne”, or giving full faith and credit to its earlier work, and this goal is facilitated by having the same Examiner in the present work and on the earlier work.

Our second “ask” directs itself to the similar situation of the case of a US national patent application (111(a) application) that claims domestic benefit under 35 USC § 120 from an earlier PCT application in which the USPTO was the International Preliminary Examining Authority. (A

typical example of this is the so-called “bypass continuation” application.) Once again, the reasons for asking for a “same Examiner” result are easy to understand. Again this will minimize unnecessary duplication of effort. Again, to the extent that a particular Examiner is already familiar with the subject matter and claims of a particular application, this can lead to some economy of effort when the child application lands on the desk of that same Examiner. And again, as discussed below, we are asking for the USPTO to set a goal of “drinking its own champagne”, or giving full faith and credit to its earlier work, and this goal is facilitated by having the same Examiner in the present work and on the earlier work.

Full faith and credit, or “drinking its own champagne”. We ask that USPTO set policy and internal procedure that in an application that is being examined as a national-stage entry from a PCT application, and in which the PCT application was examined by the USPTO in its role as an IPEA, and in which the same Examiner is assigned to both tasks, that to the extent that a claim being examined in the national stage is a claim that is substantially similar to a claim that was examined by the IPEA/US, the Examiner should be expected to arrive at the same answer as to patentability as to that claim within both tasks, barring some satisfactory explanation for arrival at a different answer. We ask the same for a 111(a) application that is a child case from a PCT application, and in which the PCT application was examined by the USPTO in its role as an IPEA, and in which the same Examiner is assigned to both tasks, that to the extent that a claim being examined in the child application is a claim that is substantially similar to a claim that was examined by the IPEA/US, the Examiner should be expected to arrive at the same answer as to patentability as to that claim within both tasks, barring some satisfactory explanation for arrival at a different answer. (Again a typical example of such a case might be a so-called “bypass continuation” case.)

This is, of course, the present practice at the European Patent Office, and this is what prompts us to ask this of the USPTO. On a practical level, and speaking in somewhat colloquial terms, this would mean that USPTO Examiners would be told that they are expected to get the same answer the second time that they got the first time, except when there is a good reason for failing to get the same answer the second time.

It is easy enough to think of good reasons why a claim that was patentable before the IPEA/US might turn out not to be patentable during the 371 examination or during the 111(a) child case examination. It might turn out that during a top-up search, some prior art is found that for some good reason could not have been found at the time of the IPEA/US search. As another example, a third-party submission of prior art during the 371 examination or during the 111(a) child case examination might bring to the Examiner’s attention some reference that could not have been found in the search collections available to the Examining Corps at the time of the IPEA/US search.

It might be suggested that it would be extra work for Examiners to be asked to identify claims for which the “drinking of its own champagne” is called for. There are at least two reasons why this ought not to present much extra work for Examiners.

First, recall that as described here, the “asks” assume that it is the same Examiner in both the present task and the previous task. It ought not to be such a heavy lift to ask a particular

Examiner to go back to look at that Examiner's own work product from just a short time earlier, and to look for claims that contain the same words. Indeed once the USPTO were to announce the "drinking its own champagne" policy, it seems to us that any Examiner doing IPEA/US work would quite naturally develop new habits of putting notes into the file for the very purpose of facilitating review of the file a few months or a year later when the (probably almost inevitable) 371 case or 111(a) case comes back around.

Second, in some proportion of 371 cases and 111(a) child cases with claims that "sufficiently correspond" to claims previously examined by IPEA/US, the work of matching up the earlier claims with the later claims would have already been carried out by the applicant in a PCT-PPH request. The PCT-PPH request would be a very strong and direct signal to the Examiner that "drinking of its own champagne" is called for, barring some surprise about later-developed citations or the like.

Magnitude of the tasks, and possible learning opportunities. The Director is invited to consider that carrying out these "asks" involving IPEA/US would not be very much work. Not very many applicants file Demands at all (only about 10% of cases). Of the applicants that do file Demands, only some fraction of the applicants select IPEA/US. This puts a natural upper bound on the number of times per year that the steps described here would present themselves to be carried out.

In the face of this, the learning opportunities would be many. How often would a top-up search really uncover a reference that changes the outcome as to patentability for a claim? How often would the grant of a PCT-PPH request present not only the benefits to the USPTO that are by now already quite well documented, but also further benefits due to the "drinking of USPTO's own champagne"?

Indeed suppose that after some period of years it were to develop that the "drinking of USPTO's own champagne" as to IPEA/US were to the USPTO's benefit? Suppose it were to turn out that this is perceived by stakeholders within the USPTO and outside the USPTO as beneficial? If so, then maybe this could be one of many inputs to the USPTO in a longer-term consideration of the possibility of bringing some of the ISA/US work back into the Examining Corps.

Advancement out of turn for Rule 496. As mentioned above, we ask that USPTO set up an internal procedure so that the "advancement out of turn for examination" provided for in 37 CFR § 1.496 actually takes place. It will be recalled that 37 CFR § 1.496 was promulgated in 1978, when the USPTO first acceded to the PCT. One of the policy goals of the "advancement out of turn for examination" was to recognize that if ISA/US or IPEA/US had found one or more claims to be patentable, and if an applicant were to enter the US national stage presenting only such claims, then internal efficiency within the USPTO could be enhanced by getting the application onto the desk of the Examiner while the application was still fresh in mind. The problem is that as things now stand, there is actually no mechanism, no business process rule within the USPTO, to actually fulfil this obligation upon the USPTO to advance the application out of turn. Nothing, for example, in the USPTO's case management system, flags such applications. As things now stand, it is up to the applicant to be aware of this absence of any fulfilment of this obligation by

the USPTO, and it is up to the applicant to pester the Examiner to take up the application “out of turn”.

There are, however, easy ways that inputs could be provided to business process rules within the USPTO. To give one example, when an applicant enters the US national stage under conditions satisfying 37 CFR § 1.496, the applicant qualifies for a reduced search fee and a reduced examination fee. These reduced search and examination fees have particular “fee codes” in USPTO’s systems. It ought to be a straightforward matter for USPTO’s system developers to devise business process rules that draw upon those fee codes as triggers for the advancement out of turn.

PCT-PPH and Rule 492 indicators in Patentcenter. We ask that USPTO provide indicators in the user interface of Patentcenter to acknowledge whether a particular application has been granted “special” status under PCT-PPH and whether a particular application has been recognized as being entitled to “advancement out of turn” pursuant to 37 CFR § 1.496. As things now stand, an observer outside of the USPTO can only make a guess as to whether a particular application is actually being given “special” treatment in USPTO’s case management system. While an entry in IFW or the Transaction History may indicate that a PCT-PPH request has nominally been “granted”, what the external observer is unable to know is whether the corresponding flag in the case management system did actually get set. We ask that indicators be provided that permit external observers to learn what has actually been set in the case management system. As a corresponding matter, if and when USPTO actually sets up some internal mechanism for fulfillment of USPTO’s obligations under 37 CFR § 1.496, it is requested that this, too, be indicated so that the external observer may independently confirm that the “advancement out of turn” status has been set.

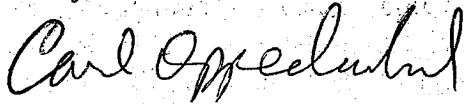
Prompt Filing Receipts for 371 cases that are on the PCT-PPH Highway. Over the past decade, there have been times when the part of the USPTO responsible for national-stage processing under Section 371 (the “DO/EO/US”) has had backlogs of as much as a year and a half. For applications that are destined for art units which themselves have backlogs exceeding a year and a half, this magnitude of delay is not necessarily a big problem for some applicants. But when an applicant has a 371 application in which a PCT-PPH request has been granted, and in which a half a year or a year may pass before the DO/EO/US releases the case to the Examining Corp, the delay disserves everyone’s interests. It disserves the USPTO’s interests in unnecessarily delaying the possible PPH benefits on pendency and Examiner workload. It disserves the applicant’s interests in getting an application examined promptly. With all of this in mind, we ask that USPTO set up a procedure within DO/EO/US so that the “special” status of a granted PCT-PPH request be honored by DO/EO/US, with prompt national-stage processing of such applications.

Become a Depositing Office with respect to RO/US. The international patent system under the Paris Convention offers the opportunity for an applicant to claim priority from an international patent application (PCT patent application). Most patent offices around the world have chosen to become Depositing Offices in the DAS system with respect to PCT applications filed in their Receiving Offices, including the patent offices of Australia, Austria, Brazil, Canada, Chile, China, Colombia, Denmark, Finland, France, Georgia, India, Israel, Italy, Mexico, Morocco,

Netherlands, Norway, Spain, Sweden, and Turkey. In addition, the Eurasian Patent Office, the European Patent Office, and the World Intellectual Property Organization have chosen to become Depositing Offices in the DAS system with respect to PCT applications filed in their Receiving Offices, bringing the total to twenty-four Offices at the present time. Conspicuous by its absence on this list is the United States Patent and Trademark Office. It is requested that the USPTO become a Depositing Office in the DAS system with respect to PCT applications filed in RO/US.

We thank you for your consideration of these PCT-related requests.

Sincerely,



Carl Oppedahl, signing for:

Sarah Adriano, Adriano & Associates
Mitchell Apper, Pioneer Patents, LLC
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