

Comments of American Intellectual Property Law Association

Public meeting
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Patent Cooperation Treaty

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Founded in 1897, AIPLA is a national bar association constituted primarily of lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. AIPLA's more than 16,000 members represent both owners and users of intellectual property.

AIPLA thanks the USPTO for the opportunity to present these comments at this public meeting.

Some history of the Patent Cooperation Treaty

The United States signed the Patent Cooperation Treaty on June 19, 1970, and ratified the Treaty on November 26, 1975.

The Patent Cooperation Treaty entered into force on January 24 ,1978.

Some history of the Patent Cooperation Treaty

From the outset, it was intended that the work of the International Searching Authorities and International Preliminary Examining Authorities would offer benefits to filers and to patent offices

This work was and is intended to provide a preliminary indication as to patentability

This work was and is intended to permit Offices examining national- and regional-stage applications to avoid duplication of work already carried out by the ISAs and IPEAs

USPTO's commitment to the Patent Cooperation Treaty

On May 28, 1987, USPTO promulgated 37 CFR § 1.496 (“Rule 496”), which provides “out of turn” examination of a US national-stage application that presents only claims that were treated favorably in the international stage by ISA/US and/or IPEA/US

This “out of turn” examination permits the Examining Corps in the national-stage work to attend to national-stage examination while the work of the ISA/US and/or IPEA/US is fresh in mind

This treatment is intended to avoid duplication of effort and rework in the Examining Corps

USPTO's commitment to the Patent Cooperation Treaty

From 1978 to the present, USPTO has consistently recognized the value of work by ISAs and IPEAs in the international stage, by charging reduced national-stage fees where an International Search Report is provided

From 1978 to the present, USPTO has also consistently recognized the value of work by ISA/US and IPEA/US in the international stage, by charging smaller national-stage fees where the claims presented in the national stage were treated favorably by ISA/US and/or IPEA/US

How things stand thirty years later ...

Thirty years later, some of the goals of PCT have indeed been consistently achieved ...

including filing in a single format that facilitates national- and regional-stage entry ...

and preservation of filing options until as much as 30 months after the priority date ...

How things stand thirty years later ...

In at least one Office (EPO), the examination in the regional stage does often utilize the work done earlier in the international stage by that Office

But such utilization of such previous work is not often seen in other Offices including USPTO

How things stand thirty years later ...

There is room for improvement in the area of a national- or regional-stage Office utilizing work done by International Searching Authorities and International Preliminary Examining Authorities

Such improvement would benefit filers and Offices

It would save rework and duplicative work in
Offices

It would help filers get patents faster and cheaper

What can USPTO do?

The single area for improvement that would offer the greatest benefits for filers and for Offices including USPTO ...

is improvement in the quality of work carried out by ISA/US and IPEA/US

How to gauge improvement in the quality of work carried out by ISA/US and IPEA/US?

The single strongest indicator would be for USPTO to utilize fully the findings of ISA/US and IPEA/US in its own national-stage examination

Such action by USPTO would likely encourage other Offices to consider utilizing such work in their own national- and regional-stage examination

What else can USPTO do?

USPTO has not consistently complied with the “out of turn” requirement of Rule 496

If USPTO were to utilize fully in national-stage examination the findings of ISA/US and IPEA/US ...

this would make it particularly helpful if USPTO were to consistently comply with the “out of turn” requirement of Rule 496

What else can USPTO do?

It is important that IPEA/US establish International Preliminary Reports on Patentability (Chapter II) timely

This means establishing IPRPs well in advance of the 30-month date

What else can USPTO do?

When examining a national-stage application, it is important that USPTO comply with the unity-of-invention standard

See 37 CFR § 1.499 and MPEP §1893.03(d)

What else can USPTO do?

In recent months USPTO has made substantial progress in mailing Filing Receipts more promptly after entry into the US national stage

This benefits filers

It will be desirable if further progress is made so that eventually, Filing Receipts will be mailed in national-stage applications as promptly as in 111(a) applications

What else can USPTO do?

It is noted that if an ISA imposes complicated competency limitations, this makes extra work for RO/US each time an international application chooses that ISA and turns out to fall outside of the competency limitations

If more ISAs can be certified by RO/US without complicated competency limitations that would make extra work for RO/US, this would be good for filers

What can USPTO do?

The single most important thing USPTO can do relating to the Patent Cooperation Treaty is Improvement in the quality of work carried out by ISA/US and IPEA/US

AIPLA has submitted written comments on other areas identified in the Notice

AIPLA thanks USPTO for the opportunity to give this presentation and to submit written comments

THANK YOU!