

From: Asmus, Scott J (GE Global Research)
Sent: Friday, August 20, 2010 3:29 AM
To: 3-tracks comments
Cc: Horton, Carl (GE, Corporate)
Subject: Comments on Enhanced Examination Timing Control Initiative (3-Track)

Dear Sir/Madam,

Attached are the comments from General Electric Company related to the Enhanced Examination Timing Control Initiative (aka 3-Track) as promulgated in 75 Fed. Reg. 31763.

We look forward to the continued discussion on this topic and welcome any questions. If we can be of further assistance in this regard - or on any USPTO matter - please let me know.

Regards,

/Scott J. Asmus/

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General Electric Company

Comments to USPTO Enhanced Examination Timing Control Initiatives (3 Track)

[75 Fed. Reg. 31763](#)

Thank you for the opportunity to provide comments on the USPTO proposal regarding the Enhanced Examination Timing Control Initiative.

In summary, GE is in favor of the general concept of providing options for various tracks *provided that* the rules are clearly articulated and address the concerns raised by the patent stakeholders. However, GE opposes mandatory side-tracked examination, but does encourage an optional work-sharing process. The side-tracked examination process based on a first foreign filing runs contrary to many years of harmonization efforts and raises serious concerns on reciprocal provisions in other patent offices.

Track 1 Summary

- *“prioritized” examination for a substantial fee*
- *targeted time to 1st office action of 4 months*
- *targeted time to final disposition of 12 months*

Track 1 General Comments:

Track 1 appears to be focused on the speed of examination, and while speed is desirable, we believe it is important that any such improvement in the rate of examination be accompanied with measures to maintain a high quality examination. Specifically, it is critical that a fast track approach does not incentivize the issuance of final rejections nor lead to the issuance of patents without a thorough examination, as the latter could be a tool used by non-practicing entities to obtain patents quickly with little file wrapper history and ambiguous scope. Instead, the process should allow for a thoughtful examination aimed at working towards allowable subject matter on innovative technology articulated in detailed patent applications.

A fast track option, if properly implemented, may be useful in situations such as licensing opportunities, enforcement situations, short cycle innovations and important portfolios.

Some measures to facilitate the Track 1 initiative include:

- Mandatory examiner interviews before a first office action
- Required submission of IDS
- Examination only by primary or supervisory examiners
- Specialized examiner training in fast track processing
- “Final Resolution” should be incentivized so that it will not facilitate speedy final rejection/RCE/Appeal, as the goal would be to work with the applicant

- Early publication rules should be established and those applications should be identifiable by kind code or other means
- Period for submitting third party references after publication (37 CFR 1.99) should be extended from 2 to 4 months
- Separate queue as compared to other accelerated examination processing
- Examiner interview mechanisms should be expanded to include video conferencing and web based tools
- Provide for prosecution aimed at PPH usage that is based on US examination
- Generate clear instructions to applicants including detailed guidelines on the implementation

Track 2 Summary

- *traditional examination based on file date and default track for applications*
- *can pay to convert to Tier 1*

Track 2 General Comments:

As Track 2 appears to allow for the traditional examination approach, it is important that such process is not adversely affected by the proposed three option system, but rather should lead to a decrease in pendency. This track is likely to remain the choice approach for most patent applicants, including GE, and thus it is important that implementation of a three track approach not jeopardize quality or speed.

Some measures to facilitate the Track 2 initiative include:

- Detailed metrics of the processing for each GAU and monthly tracking of the first action on the merits and other prosecution events for comparative purposes
- Designate Track specialists for each Track that strive to achieve the Track mission and respond to applicant concerns

Track 3 Summary

- *Delayed examination up to 30 months slower than Tier 2 - only available if no foreign priority claim*
- *Need to file request & pay examination fee or abandoned*
- *Side-tracked examination if based on a first foreign filing and need to wait for foreign prosecution*

Track 3 General Comments:

GE strongly opposes a mandatory side-track examination process based on the filing and prosecution of foreign priority applications. The delayed prosecution in other countries would lead to exceptionally long delays and such a process would unreasonably prejudice foreign cases and applicants. It is also important to consider that applicants may not have a filing option because certain jurisdictions impose first filing requirements for inventions made locally.

Moreover, establishing this side-tracked examination runs contrary to the concept of patent harmonization and may result in retaliatory measures. Specifically, such a system may encourage countries to adopt similar systems to the detriment of US applicants.

Furthermore, it may be subject to scrutiny leading to uncertainty and unneeded expenditure of USPTO resources. For example, it is unclear whether foreign applicants seeking protection of their patent rights are being afforded proper national treatment under the TRIPS Agreement, and there is a risk that the national treatment provisions in the Paris Convention and the TRIPS Agreement may be violated.

There should also be mechanisms to avoid gaming of the deferred track system that create uncertainty as to claim scope for prolonged time periods. New product introduction involves risk assessment, and parties may take advantage of the delay to deliberately avoid prosecution.

In contrast, an option for delayed prosecution may be desirable, particularly for pioneering innovations, pharmaceuticals and for those high-risk leading edge concepts with an uncertain likelihood of commercialization.

Some measures to facilitate the Track 3 initiative include:

- Optional (not mandatory) track for US and Foreign based applications
- Educational materials explaining the benefits of a delayed prosecution, especially with PPH
- Provide an option that would allow an anonymous party to petition to move a deferred application out of tier 3 and into tier 1 or 2 (depending upon fee)
- Mechanisms to facilitate the USPTO's use of foreign prosecution materials, including search reports, office actions and responses - without an IDS submission by applicant
- Allow Applicant to drop a delayed case in favor of another case that would take its place in the queue
- Accurate tracking of time to first response (the present automated system seems to be generally inaccurate)
- Provide an option for the Applicant to automatically deduct the examination fee from a deposit account at the 30 month period to avoid unintentional abandonment
- Work towards a change in the Rule 56 duties and the unreasonable interpretation of inequitable conduct in order to allow for an open discussion of prior art
- Allow for switching between tracks, especially in PPH situations when the Applicant has allowable subject matter
- Delay provisional patent protection that is typically based on the 18 month publication date when electing the track 3 process
- Allow for an optional Search Report akin to the PCT International Search Report that cites references and their impact on the claims
- To aid in the detrimental commercial effect of the non-practicing entities, advocate changes to the law regarding recovery of damages such that actual notice is required when asserting patents without any underlying commercialization

Thank you for your time and consideration of these comments and we look forward to working with the USPTO on this proposal as well as other measures that aim to strengthen the patent system.