

From: "Hyunjin Yun"
Sent: Friday, August 20, 2010 5:08 AM
To: 3-tracks comments

Subject: KIPO's Comments on the Enhanced Examination Timing Control Initiative

Dear colleagues,

A PDF document titled KIPO's Comments on the Enhanced Examination Timing Control Initiative is attached.

We wish our comments play a constructive role in the review of the Enhanced Examination Timing Control Initiative.

If you have any questions or comments, please feel free to contact me.

Sincerely yours,

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August 20, 2010

Mr. Robert L. Stoll
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
United States of America

Re: Enhanced Examination Timing Control Initiative

Dear Mr. Stoll,

The Korean Intellectual Property Office (KIPO) offers the following comments on the *Enhanced Examination Timing Control Initiative*, which was announced on June 3, 2010, by the United States Patent and Trademark Office (USPTO).

KIPO supports the general direction of the proposal: it gives applicants greater control over when their applications are examined; it also enhances interoffice work-sharing, which in turn should help reduce the global backlog of patent applications. However, we are afraid that by not taking any office action until the USPTO receives the required document proposed in the initiative, some applicants, especially foreign applicants, might be disadvantaged. With that in mind, we would like to elaborate two major concerns:

1. The disadvantage of second filings at the USPTO

With regard to the requirements for utilizing tracks I, II, and III, we find it difficult to fully support the idea of imposing different requirements on applications that are based on a prior foreign-filed application (foreign origin applications) and applications that are not based on a prior foreign-filed application (USPTO first filers).

Postponing a Track II examination of a foreign origin application until the USPTO obtains the examination results of the first office is likely to cause problems for applicants. It seems they might not be able to get the examination results of the USPTO without first obtaining the examination results of the office of first filing. And we fear that that requirement could impose a significant burden on applicants.

In addition, the exclusion of foreign origin applications from Track III seems unfair. For your reference, we have run our own Three-Track Patent Examination System since October 2008. We offer all applicants the same choice of three tracks, regardless of whether their application is based on a prior foreign-filed application.

Furthermore, as projected in the initiative paper, we think that once the initiative takes effect it is likely that many applicants from around the world would alter their patent

filing strategies. As a result, a significant number of applicants may choose to file at the USPTO first, instead of at the applicant's national office.

We feel the objectives of the initiative could be achieved more effectively if the work-sharing scheme was first harmonized and established among the world's major intellectual property offices. In that way, examination results on priority applications could be submitted more promptly to the offices of subsequent filings and be utilized more effectively.

2. The disadvantage of the PTA for foreign origin applications

We are also concerned that the patent rights of some applicants might be limited if the patent term adjustment (PTA) is applied to foreign origin applications on the basis of the average pendency period of the office of first filing.

Because the pendency period varies according to each application or technological field, there is a significant gap in some cases between the actual pendency period and the average pendency period.

When the gap is not considered, some foreign origin applications can be disadvantaged by the PTA. Hence, we believe that the application of the PTA to foreign origin applications should be based on the *actual* pendency period rather than the *average* pendency period.

Finally, we are deeply grateful for the USPTO's enthusiasm and efforts in extending interoffice work-sharing and developing the global patent system. We hope our comments play a constructive role in the review of the *Enhanced Examination Timing Control Initiative*.

Sincerely Yours,



Jeong-yeol Park
Director General
Electronic and Electric Examination Bureau
Korean Intellectual Property Office