



FICPI INFORMATION DOCUMENT

28 AUGUST 2013

CET INFORMATION DOCUMENT

TITLE: *USPTO Visit, 20 May, 2013 – Minutes of Meetings*

DRAWN UP BY: *Commission d'Etude et de Travail (CET) Work & Study Commission*
Brett Slaney, CET Assistant Reporter General

PURPOSE: For information and publication in the library section of FICPI's website

QR CODE:



MINUTES

DATE: 20 May 2013

TIME: 10:00 – 12:00 and 13:00 – 14:00

PLACE: Madison Building, USPTO

A. Meeting with Commissioner Focarino and Patent team (10:00-11:00)

FICPI ATTENDEES:

Bastiaan Koster
Eric Le Forestier
Danny Huntington
Robert Katz
Andrew Meikle
Brett Slaney (author)

USPTO ATTENDEES:

Andrew Faile
Peggy Focarino
Drew Hirschfeld
Steve Griffin
Donald Hajic
Janet Gongola
Mark Gruetlich
Mark Powell
Charles Pearson
Maria Holtmann
Anthony Caputa
Bob Olgewski

i) Patents

- Status of backlog

- Andrew Faile (AF) provided slides on backlog. RCE filings have leveled off, flat or decrease in growth. Danny Huntington (DH) asked why these have been flat – several pilots and IDS after allowance. Trend down for unexamined applications, with spike from AIA transition, not as large a spike as expected/predicted, trough not as deep. RCE backlog – this is increasing, with a slight leveling off. Things being done for RCEs – after final consideration, IDS after allowance, adjusted credits for examiners in short term to move some through (in place for 1 month) – this applied to all RCEs. In workflow – RCEs used to be lower on priority list



(compared to CNTs), this has been reordered based on effective filing date bringing old RCEs up the list. Completed roundtables around country on RCEs, currently working through suggestions, other tweaks to examination process, want to improve RCE situation in long term

- First action pendency and total pendency, both down. First action (forward looking) – trending down as well – affected by hiring, aiming at 10 month time frame for first office action on the merits, currently at 16.6 months.
- DH asked for clarification on RCE backlog – consequences of changes to dockets after 2009, which created backlog, moving to effective filing date – another month to get repopulated and older cases to complete

- CPC implementation

- Donald Hajec (DoHa) – gave a brief overview of implementation progress. Oct 1/12 began training “quality nominees” (class. Experts) in each technical field, to coach and mentor other examiners, QA aspects, revision projects, 4 blocks of training – feel, use, definitions. Plan to post within the next week or two.
- Field specific training – held by EPO experts, held 400 live sessions by WebEx. Immersion training – blindly classifying and comparing to EPO classified documents – can contact EPO counterpart. USPC best practice was use of definitions which were not used by ECLA, USPTO has been drafting these, put on website soon.
- First applications published with CPC symbols March 14, each week more and more documents are being published (70% by July), until it hits 100%. Examiners still working in USPC. Finalizing MOU with POPA (examiner’s union) on transition impacts to have (mid summer expected). Transition expected to be completed by December 2014, where USPC to become a static art collection. Checkpoints put in to ensure examiners learning CPC.
- Brett Slaney (BS) asked when EP documents will become included in search – DoHa said this will develop over time.
- DH asked how the examiners did in comparison to how EPO has classified – very good results so far.
- Eric LeForestier (ELF) – asked who would apply the classes at publication, the existing contractor? DoHa indicated that examiners will apply with A publications and modify later if necessary. ELF asked if other countries have expressed interest – DoHa said SIPO is interested, BR, KR, RU also interested, maybe JPO.
- Various comments made by USPTO attendees about excitement about efforts in harmonization.

- RCE Outreach



- AF explained outreach on RCEs – data collection for ideas from public and users, held roundtables and public sessions, more intimate sessions also held (see slides). Ideas have been logged in a database (1100 responses) – see “Top Areas” slide in handouts – focus on earlier portion of prosecution, received some comments on after consideration final pilot, interview practice highlighted – want exchanges earlier in prosecution, many programs not well understood or effectively used – USPTO wants to change this. Next steps to come after summer, will need to deal with union issues to make changes.
- ELF asked if there will be changes with final rejection at second action. AF indicated that this was a positive development from roundtables.

- Harmonization

- Mark Guetlich (MG) – wanted to highlight CPC and PPH as his favorite harmonization efforts providing a head start. Also looking at the grace period and the issues with EPC forcing member states to give up robust grace period provisions. Eastern European countries interested in teaming up with countries that also have grace period to come up with a more global standard. Aware of issues with uncertainty. Perhaps some changes to publication practice.
- ELF – agreed that there are several efforts moving in parallel (e.g. Tegernsee, WIPO, etc.).
- Mark Powell (MP) – global dossier technical concept relates to other harmonization efforts. MG – IP5 meeting shortly.
- BastiaanKoster (BK) and ELF mentioned the grace period white paper and highlighted efforts in FICPI to look at this issue, particularly on the pros and cons of a priority date system and a filing date system.

- Hague Agreement

- Charles Pearson (CP) – gave brief overview of the Hague agreement to use WIPO to file in several territories. Timeline was discussed, 1st agreement in 1925, several other acts since then. USPTO to be on board soon.
- Robert Katz (RK) – mentioned that Canada getting pressure from Europe to join Hague.
- CP – highlighted some stats and figures (see slides in handouts), indicated that USPTO will continue to restrict each application to one design once it comes into US. Highlighted role of IB in translating, examining formalities. USPTO will continue with normal substantive examination but will skip formalities. Refusal grounds will remain same as direct filed application. Working on notice of proposed regulations.



- RK mentioned that it will be difficult to determine when there is a formality issue versus 112 issue. Possible inconsistencies between direct filings and Hague filings. RK asked if any ideas floated about submissions of prior art. CP indicated that this has been discussed.
- RK – offered assistance with reviewing regs
- ELF – asked about timing. CP indicated late summer for regulations.
- BK mentioned the colloquium on patent quality – what does that mean. FICPI thanked the USPTO contributions, Drew Hirschfield (DrHi) indicated it was an enjoyable conference.

B. Meeting with Director Rea (11:00-12:00)

FICPI ATTENDEES:

Bastiaan Koster
Eric Le Forestier
Danny Huntington
Robert Katz
Andrew Meikle
Brett Slaney

USPTO ATTENDEES:

Terry Rea

- Welcome and discussions about the USPTO

- Terry Rea (TR) – welcomed us. BK offered thanks and reminder of what FICPI does.

- Brief presentation of FICPI's recent activities, positions and resolutions

- BK – highlighted patent quality colloquium and success of this meeting. Since then the ExCo in Columbia – 5 resolutions were passed: CPC and others. Colloquium on Privilege in Paris in June. DH urged USPTO to have representation at this event and provided some background on the central issues to be discussed and mentioned the new ethics rules. Many countries will be represented. Idea is to develop something that local jurisdictions can use to safeguard against, for example discovery in US. Again noted that USPTO representation would be very beneficial. BK – seconded that the USPTO should be there.

- Project Orange – Use of USPTO Statistics

- BK – provided a brief overview of Project Orange. TR asked if focus would be on in-house and private practice. BK explained that the focus would be on private practice.
- DH discussed changes to practice recently and what the future will hold, what can be provided of value, filing patterns, other aspects that would be useful to in-house attorneys. Many services have been stripped out which affects the business.



- RK – raised the fee increases discussed last year. Decided not to do the fee increases. Plan is to shift fees to have them at front end and reduce fees at the issuance. Goal is to not increase fees overall. Did not want to do this at the same time, increase filing fee stage first (last year) and in effect. Wants to ensure that the issue fees will be lowered. John Cabeca (JC) suggested that the fees were set in March in section 10 fee setting. JC did not recall if the issue fee setting was decided.

Aside: Andrew Meikle (AM) investigated this following the meeting and determined that the “shifting of fees”, i.e. the eventual reduction in issue fee will in fact occur in January 2014.

- TR indicated that the fee setting process is difficult and does not wish to go through it again. Will not look at the fee schedule for maybe 3 years (or following the Hague) – Hague fees not section 10 fee setting (cost recovery). PCT fees will be involved in Hague fee setting. TR indicated that whatever was set in March 2013 are set and will be in effect for 3 years unless Congress wants another look at it.
- JC said he would look back at fee setting schedule and will follow up with fee experts to obtain clarification and justification.
- ELF wanted to discuss the SCP submission on efficiencies on work sharing. FICPI is supportive of sovereignty and indicated that CET will be supporting this. WIPO is concerned with slow pace of movement on the current agenda items (incl. privilege). MG indicated that the submission was designed to bring a conversation back to the table and see progress.
- DH – privilege issues coming to forefront in Unitary Patent in Europe. Raised issue with giving privilege only to lawyers but indicated that this breaks down when corresponding with foreign patent attorneys who are not lawyers. US has privilege but not for patent agents, and believes USPTO could be important to these discussions. DH highlighted that privilege is misunderstood by many – it should be considered protection of client confidentiality. Having materials from USPTO (or someone in person even better) for the colloquium would be helpful to the discussions. TR indicated that materials will be provided, hopefully a live person.
- TR – indicated that USPTO is working with WIPO on work sharing and other countries. WIPO easy to work with lately, wants to make positive change.
- DH comments reminded ELF of collaborative search efforts. Stage 2 should involve users so that applicants know that they are part of the pilot to get feedback. ELF – position taken that early searches should be available, FICPI is promoting the provision of search even when examination is delayed.
- MG – agreed and appreciates this issue. Global dossier may include a feedback button to gather data on what went well or not. TR commented on EPO style of early search is not good – long time until action. Timeliness issues are sensitive right now, certainty of rights also important to USPTO.



- BK – indicated that early searches would improve patent quality. BK also asked about global dossier progress. TR indicated this is moving quickly but not sure who is going to drive/own the system. Want to standardize so that everyone owns it. Could move to a central filing system as well.
- ELF indicated that FICPI is supporting an open system to interface with our docketing systems.
- BS brought up the early search issue and overlap with after final/RCE issues. TR indicated USPTO is not interested in separating search and examination. Focused on getting FAOM merits in 10 months, stressed that we should be using after final programs that should become permanent eventually. This may change to an applicant opt-in.
- DH offered to provide materials for lobbying implementation.
- TR returned discussion to IT compatibility question from ELF. Said that corporations quicker to upgrade IT systems than law firms. May provide some requirements to interface with the system. DH noted that IE 10 has issues when accessing documents through USPTO. DH through PEC in FICPI is developing a standardized form/letter for communicating with foreign associates for filing instructions. Indicated this could help with standardizing with global dossier. BK asked on timing. MG said that pilots underway in the next few months. The proof of concept will be finalized shortly.

C. Meeting with Commissioner Cohn and Trademark team (13:0014:00)

FICPI ATTENDEES:

Bastiaan Koster
Eric Le Forestier
Danny Huntington
Robert Katz
Andrew Meikle
Brett Slaney

USPTO ATTENDEES:

Deborah Cohn
Sharon Marsh
Mary Denison

- General update on trademark issues

- DC and BK welcomed and BK provided intro to FICPI.
- DC provided some statistics – see handouts. Quality measures are based on reviews of legal accuracy of decision making. Exceptional office action – measures legal accuracy and quality of communications between attorneys and office. From random selection of cases, and must meet every criteria. DH queried incentive structure for examiners to reach this exceptional level. DC highlighted that trademark group received gold medal for service. Also, USPTO designated #5 on best places in gov't to work.



- Stats include how many applications are entirely electronically, from both ends. DH asked if there is an indication of any type of users that are not electronic – seems to be law firms. Feedback was that agent of record will miss something if do so electronically. Courtesy email addresses can be added to avoid missing deadlines.
- Expecting 4% increase in filings, examiners appearing to produce as expected, number of examiners increasing, pendency to first action is 3.2 months, disposal pendency of 12 months, efficiency measures cost of disposal expected to be \$621 but tracking to be lower than that. DH questioned the relative large increase from 2012 to 2013 – IT overhead seems to be a factor. Also, asked if sequestration was affecting USPTO – not affecting the trademarks side too heavily.
- DC covered some projects:
 - New electronic OG will replace PDF based system for web-based system to save time for users. Scheduled for October 2013. Getting info/feedback and beta testing will come soon. BK asked if it would like to TM View – no it would not. This is just the newsletter. Familiar with TM View but no plans to join yet, not a major priority maybe an add-on. Do participate in TM Class.
 - Working on improving identification of goods and services manual to include requested changes. Can check immediately if what is entered is acceptable.
 - Put up a collaboration tool for exam guides (Idea Scale), a way for public to log on before things issued/made final. DH asked how long this would be up. When something new is posted. TM Alerts is a subscription service on USPTO website would provide alerts regarding when things are posted. FICPI should have someone following this service.
 - TMAP – like the MPEP for trademarks, updates to practice are posted on Idea Scale to allow users to provide feedback before they are implemented.
 - Outreach – two strong programs, one for trademark practitioners, the other for the public. A. Working with INTA to have roundtables around country for trademark practitioners to discuss trademark issues, exchange practice tips. Next one is June 4, 2013 at USPTO. Also having a web cast for practitioners that work with the trademark status and retrieval site and software issues (technical people presenting). Set up focus groups that are issue dependent – e.g. what users want to see in official gazette. B. Reaching the public who may or may not know they need trademark advice or information – e.g. small business owners. Launched trademark outreach program, getting positive reviews.
- Mary Denison (MD) indicated that Beta version of new system will be indicated in an alert. BK indicated that OHIM demo will be in Sorrento, suggested we arrange for something for USPTO to do same in a future meeting.
- ELF remarked on difficulties in Europe with use of public systems that users do not understand (e.g. TM View). Highlighted the TM View disclaimer. DC indicated that USPTO has a basic fact booklet (includes suggestion to get legal advice). DC supported the use of a



disclaimer to avoid users believing legal advice is not needed. Public outreach also highlights that this is a complex process and legal advice is recommended. MD indicated a report is being prepared showing value of trademark attorneys for filing trademark applications. ELF indicated this would be worth including in Project Orange.

- Series of videos online on parts of trademark practice. Good feedback from US attorneys, e.g. to explain to clients or for training. DC – suggested that we look at these.

- FICPI Study on bad faith filings – Information available from the USPTO

- BK indicated that FICPI is looking at this, e.g. SIPO. Wanted to check with other offices to get information to SIPO. TM5 project on bad faith filings. Japan hosting seminar this year on bad faith filings.
- ELF asked if seminar is for public – DC said yes. ELF asked what kind of information is available from TM5 – DC said not yet. TM5 website will be set up to convey this type of information. Sharon Marsh (SM) suggested we be in touch with OPEA (Cynthia Henderson to contact FICPI) – Cynthia.henderson@uspto.gov. High priority in TM5. Trademark group should get in touch with Cynthia.

- Perceived changes in the nature of trademark examination, actions, and responses

- BK explained this was to promote a discussion of what the philosophy of US examiners for benefit of international members. DC suggested that TMAP is a good source, as it is updated to see how the process is changing. SM indicated that links are being provided in office actions rather than having all information in action.

- Consistency of examination between Examiners and cases

- BK explained this is an issue to communicate US practice to non-US members. Highlighted Project Orange and purpose of that study.
- DC – cases are assigned within 3 month period, assigned to same examiner for same applicant and similar mark. If having a problem, call the managing or senior attorney. OR, use the consistency mailbox to discuss problems with inconsistencies. Limited to same applicant (SM mentioned this). Not overly used, but is used.

- Consideration of a use requirement for owners of registrations made under Madrid Protocol



- DC asked what this issue is about. Use requirements are different when filed through Madrid. Once registered, use requirements are the same. If mark is based on an Int'l filing, use requirement is not there until registration.
- DH indicated that non-US registrations have additional requirements that clogs the register by coming through Madrid. By having a use requirement, they would not be able to keep those registrations. USPTO has a use requirement. If changed for Madrid, would require same for other filings. Mandatory use requirement would be contrary to Madrid. MD and SM indicated a pilot is underway for use. After filing affidavit of use between 5-6 years, ask for additional examples of use. Collecting results of pilot to get sample information. Negative feedback on earlier requirement of use DH asked if capturing US and Madrid cases – yes. Did not want to limit to Madrid filings. DH commented that there seems to be some creep to other cases. SM - Reflection of different system elsewhere, filing broadly. ELF and DH commented on discussions earlier this week on difficulties in Europe with IP translator, class headings, etc.
- DC commented that some European systems moving to EU standardized non-examining systems. BK added that this puts a burden on applicants to watch system. SM suggested speaking to OHIM about these issues. DC indicated a study comparison would be interesting. ELF indicated oppositions not expensive in Europe, routine work, rarely comes to litigation. More often arbitration is used to separate broad rights.
- DC asked why there is a sentiment to move to US style system. ELF indicated that cost of solving overlap between broad rights can be prohibitive and would prefer certainty and consistency. SM commented that clearance searches must be difficult. ELF agreed that this is a problem. BK commented that CET view is that consistency is preferred. DH added that expecting smaller clients are burdened because the battle will likely come, regardless of size of company.

[End of document]