



## EXECUTIVE SUMMARY OF FICPI INFORMATION DOCUMENT 28 AUGUST 2013

### CET INFORMATION DOCUMENT – EXECUTIVE SUMMARY

<p><b>TITLE:</b> <i>USPTO Visit, 20 May, 2013 – Minutes of Meetings</i></p> <p><b>DRAWN UP BY:</b> <i>Commission d'Etude et de Travail (CET) Work &amp; Study Commission</i> <i>Brett Slaney, CET Assistant Reporter General</i></p> <p><b>PURPOSE:</b> For information and publication in the library section of FICPI's website</p>	<p>QR CODE:</p> 
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A delegation of FICPI members attended a meeting with top officials of the USPTO in Washington on 20 May, 2013 to discuss patent, design, and trademark issues. The FICPI delegation also had the opportunity to meet one-on-one with Director Terry Rea to discuss FICPI initiatives, resolutions, and recent activities.

The delegation first met with a large group of high-level USPTO patent officials to discuss patent and design matters. A brief presentation was provided regarding the status of the backlog, particularly with respect to RCEs and various "after final" pilot projects that allow examiners additional time to consider arguments, amendments, and IDS material. The USPTO officials also highlighted that progress towards a goal of 10 months until a first action on the merits is progressing, although is currently at 16 ½ months.

The patent session also touched on the status of the CPC, which came into effect in January 2013. The USPTO officials advised that the first publications with CPC symbols began March 14 and each week an increasing number of publications are being published using CPC,

which will continue until 100% are published under the CPC regime. The USPTO is clearly dedicated to, and enthusiastic about, the CPC as an example of various harmonization efforts undertaken by the USPTO.

The CPC update was only one component of harmonization discussions. Other topics of harmonization included the Global Dossier, IP5 discussions, and topics of study that FICPI is in a position to provide support. To that end, FICPI will be providing CET-produced materials related to grace period to assist the USPTO in their role in the IP5 discussions.

The patent and design component concluded with a lively discussion of the imminent implementation of the Hague agreement provisions by the USPTO. This discussion touched on the expected application of restriction practice once a Hague application enters the US, and the difficulties in separating formality issues from substantive examination issues. A notice of proposed regulations is currently in progress and FICPI has offered to review and comment on these regulations.

The delegation next met with acting Director of the USPTO, Terry Rea, to have an open



discussion about FICPI's work and role within the private profession. FICPI President BastiaanKoster provided a detailed update on FICPI's activities, positions, and resolutions and highlighted the desire to have USPTO involvement in the upcoming privilege colloquium in Paris. Director Rea expressed great support for this colloquium as well as FICPI's move to obtain observer status in the IP5 industry group discussions. Although the USPTO cannot influence whether FICPI obtains observer status, it was clear that the USPTO values what FICPI could bring to the table.

Other topics of discussion included harmonization and work sharing initiatives with the Global Dossier again being mentioned specifically. Project Orange and the resolutions coming out of the ExCo in Cartagena were also discussed.

The FICPI delegation also followed up on an initiative from the 2012 official visit opposing significant design fee increases. Consistent with FICPI's position, the latest fee schedule includes an increase to the filing fees, offset by a reduction in issue fees to come into effect in January 2014.

The final component of the official visit focused on trademark issues. The trademark meeting was hosted by Commissioner Deborah Cohn and various other high level USPTO trademark officials.

Commissioner Cohn provided a summary of trademark filing and examination statistics to highlight various quality control mechanisms used by the USPTO to evaluate communications between users and the USPTO, and evolution towards an entirely electronic system.

Several projects underway within the USPTO were then discussed, including a new electronic

official gazette, improvements to identification of goods and services manual, the Ideal Scale collaboration tool, and the TM Alerts subscription service.

The USPTO is also participating in various outreach programs, including one with INTA to have roundtables around the US, and another to reach the public who may or may not know they need trademark advice.

In addition to the USPTO presentations, there were interactive discussions on the USPTO position on bad faith filings, and implementation of the Madrid protocol. Regarding bad faith filings, the USPTO officials indicated that this topic is a high priority within the TM5 discussions. The difficulties in adopting US requirements under Madrid regime were also discussed.

*[End of executive summary]*