

Proposed resolution relating to entry into the US national stage (res "A")
Patent Cooperation Treaty Issues Committee of AIPLA

Here is a proposed resolution for consideration by the Board.

RESOLVED, that the American Intellectual Property Law Association supports, in principle, the use of the Patent Cooperation Treaty, and supports USPTO's bringing the quality of PCT processing to world-class level;

Specifically, AIPLA supports USPTO's processing of papers for entry into the US national stage at least as promptly as USPTO processes the filing of ordinary domestic (111(a)) patent applications.

Past action:

None directly on point.

Discussion:

An e-filed domestic US patent application will often receive its official Filing Receipt (or Notice of Missing Parts) within as little as a week after the filing of the patent application. A paper-filed domestic US patent application often takes longer to receive its official Filing Receipt (or Notice of Missing Parts) but still this work usually gets done within three weeks of filing.

In contrast, in recent years it has routinely taken more than a year for USPTO to take up national-stage papers (also called "371 papers") and it has often taken more than eighteen months for USPTO to mail an official Filing Receipt for such papers.

In recent months, USPTO says it has been "attacking the problem from both ends", with some USPTO employees trying to process the national-stage papers at the tail of the backlog, and with other USPTO employees trying to process newly filed national-stage papers.

Practitioners have anecdotally reported occasional national-stage entry filings in recent times in which the official Filing Receipt has been received about two months after e-filing of the national-stage papers.

Why we care how long this takes. In response to questions about the extremely slow processing of national-stage filings, USPTO personnel have pointed out that national-stage cases are docketed to Examiners based upon the "371 completion" date, not based upon the date that a Filing Receipt is mailed. This means that if a particular Examiner's backlog was, say, twenty months, then a delay in national-stage processing of eighteen months is not a problem, because the Examiner would not have examined the case until the twentieth month in any event.

There are at least three reasons why this is not really a good answer to the problem.

Rule 496 cases. USPTO rules provide that when an applicant enters the national stage presenting only claims that USPTO had already found patentable in a Written Opinion or International Preliminary Report on Patentability, USPTO is required to advance such applications "out of turn" for examination. ([37 CFR section 1.496](#), last sentence.) Such "out of turn" examination makes perfect sense.

There are several distinct reasons why it is important to move Rule 496 cases along without delay. Some cases qualify for Rule 496 treatment because IPEA/US wrote an IPRP that was favorable. When

this happens, the USPTO Examiner who wrote the IPRP and found all claims patentable ought to be given the national-stage case while it is still fresh in the Examiner's mind. This permits the most efficient use of work previously carried out within the USPTO. Another reason is that if a case has been found patentable in the international stage, it is smart to get it into the hands of the national-stage Examiner so that the case can be allowed in the national stage, thereby reducing pendency. Finally, if and when ISA/US resumes having the search and examination carried out by USPTO Examiners, it will again be important to get the national-stage into the hands of the Examiner as soon as possible after the Examiner has written a favorable ISR/WO.

But when USPTO processing of national-stage papers takes months or even more than a year, this eviscerates the "out of turn" requirement of Rule 496. By the time a year goes by, the Examiner who wrote the IPRP will likely have forgotten all about the case, or may have been promoted out of the Examining Corps or may have retired from the USPTO.

Missing and dead inventors. If USPTO looks at an oath or declaration and finds it wanting for some reason (e.g. an interlined correction that was not initialed and dated) and informs the filer promptly, then it is an easy matter to go back to the inventors to get a new oath or declaration signed. If, on the other hand, USPTO does not get around to telling the filer about some problem with the oath or declaration until a year or a year and a half later, the inventor may well have disappeared or died.

A similar problem presents itself if a Rule 47 petition has been filed (which is of course supported by a declaration detailing the efforts that were undertaken to try to obtain the signature of the unwilling inventor). If USPTO takes a year or a year and a half to get around to telling the filer that there is something wrong with that declaration, it may be difficult or impossible to remedy the defect. The person with personal knowledge of the efforts that were undertaken may have died or disappeared.

Fourteen months. Recall that the calculation for patent term adjustment takes as its goal that a first Office Action be mailed within fourteen months. If USPTO were some day to reach this fourteen-month goal, then delays in national-stage processing beyond fourteen months would disserve this goal.

Low-backlog art units. There are art units within USPTO which, for one reason or another, happen to have very low backlogs. A national-stage case destined for such an art unit ought to get released to the Examining Corps promptly enough to permit the art unit to examine the case in its own regular course of work.

Dave Kappos, Undersecretary of Commerce and Director of the USPTO, recently said:

We are also focused on bringing the quality of PCT processing to world-class level.

The time is right for AIPLA to offer its encouragement to USPTO to indeed bring the quality of PCT processing to world-class level, and one of the steps toward this focus is to process national-stage papers at least as timely as the processing of domestic patent applications.

The Committee has 110 "active voting" members. 57 members voted using AIPLA's web-based voting system, thereby providing a quorum. The vote was 55 supporting, one opposing, and one abstaining.

Other Committee members, both "active voting" and "information only", have indicated support for the resolution by email.