

Proposed resolution relating to "out of turn" national-stage filings (res "B")
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, and further supports USPTO compliance with 37 CFR section 1.496 which provides for "out of turn" examination of applications which USPTO has treated favorably in the international stage; Specifically, AIPLA supports USPTO implementing its examiner docketing system in such a way as to flag such "out of turn" applications to the Examiner so that the Examiner will know to take such applications "out of turn". AIPLA also supports USPTO making such "flags" visible to the applicant in the Private PAIR system.

Past action:

None directly on point.

Discussion:

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. In the case of an application in which USPTO served as the IPEA, for example, 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.

This provision of Rule 496 was promulgated in 1987, and one might be forgiven for assuming that in 1987, USPTO would have duly incorporated some flag in its Examiner docketing system so that the Examiner would know to take such an application "out of turn". There are many other such flags, such as flags telling the Examiner which cases are "special" and which cases are "accelerated exam" cases, and so on. As it turns out, however, USPTO has never done anything to let Examiners know which cases are supposed to be examined "out of turn" under Rule 496.

The practitioner that chooses to be proactive will monitor the progress of an "out of turn" case through the patent office, and as soon as the case is docketed to the Examiner, the practitioner will call up the Examiner on the telephone to inform the Examiner of the need to take up the case "out of turn". In most cases, however, the Examiner will never have heard of Rule 496 and will have no idea that there is any reason to examine the application "out of turn". It often takes escalation to the SPE and then to the Director of the Tech Center to bring about compliance with Rule 496.

What is unfortunate about this is that the Examiner should actually be glad to be told of such a Rule 496 case, since this represents two easy counts. The Examiner to whom the case has been docketed is, in most cases, the same Examiner who already found the claims to be novel and to possess inventive step in the International Preliminary Report on Patentability.

If USPTO were to set up such a "flag" in the Examiner docketing system, this would permit USPTO to

save money and reduce pendency by getting such cases back into the hands of the Examiner as quickly as possible after the favorable examination in the international stage.

It should be appreciated that there is no recurring cost to USPTO if it were to implement this system. The setting of the flag does not take up any labor cost. The setting of the flag can simply be triggered in an automatic way by the filer's having paid fee code 1640 or 2640 for "National Stage Search Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)" or 1643 or 2643 for "National Stage Examination Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4).

Indeed the one-time cost of setting up the automatic flag would presumably be recovered by USPTO very quickly in terms of reducing the labor cost of examining national-stage cases (because the Examiner would see the national-stage case while the international-stage case, at least in the case of an IPRP, was still fresh in mind).

It would be extremely helpful if such "flags" could be made visible to the applicant in the Private PAIR system. This would permit the applicant to independently check to make sure that USPTO personnel had not overlooked the entitlement of a particular national-stage application to being examined "out of turn".

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 flag such "out of turn" cases in the Examiner docketing system, just as USPTO already flags "special" cases and the like.

The Committee has 110 "active voting" members. 57 members voted using AIPLA's web-based voting system, thereby providing a quorum. The vote was 50 supporting, five opposing, and two abstaining.

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