

Alternatives to Prompt, High-Quality Examination of All Patent Applications

Douglas K. Norman,
IPO President

&

Herbert C. Wamsley,
IPO Executive Director

2010 FICPI/AIPLA Colloquium:
“The Patent Offices Backlog Crisis”

Alternatives to Single-Track Examination

- Deferred examination
- Multi-track examination
- Multi-tiered patent rights
- Other alternatives

Deferred Examination

- **Features**
 - Separated search & examination
 - Length of deferment varies
 - “Dropout” of abandoned applications
 - May encourage more domestic-only filings

Deferred Examination

- **Concerns**
 - Loss of notice/increased uncertainty about rights
 - Inefficiency of separation of search and examination
 - More difficult freedom-to-operate searches
 - May incentivize filing on minor improvements

Multi-Track Examination

- **USPTO Three-Track Proposal (4 June 2010)**
 - Track I: Accelerated Exam
 - Limited to 4 independent, 30 dependent claims
 - Early publication
 - Track II: Standard Exam
 - Track III: Deferred Exam
 - Up to 30 months
 - Publication required, but no search
 - Limitations for applications claiming foreign priority

Multi-Track Examination

- **Concerns**

- Early-stage determination of which applications are worth accelerating may be difficult
- “Pay to play” – may be expensive for small entities
- Stripping resources away from standard track
- Uncertain patent claim scope for deferred track

Multi-Tiered Patent Rights

- **Utility models & related systems**
 - *Gerbrauchsmuster* (Germany)
 - Innovation patent (Australia)
- **General Features**
 - Lower obviousness threshold
 - Designed to fill “gap” in protection for lower-level innovations
 - Shorter term
 - Limited examination/no examination

Multi-Tiered Patent Rights

- **Concerns**

- Low filing numbers compared to utility patents
- Strategic use of utility model protection as interim for patentable inventions
- Confusion about rights conferred, need for post-registration examination (Australia) before assertion

Other Alternatives

- **Unexamined design rights**
 - No backlog problem with design patents in US
- **Unexamined/limited examination**
 - Historical failure in US
- **Application Auctions**
 - Virtually impossible to project appropriate cap on annual applications
 - Could price out small entities

Preferred Backlog Solutions for the US

- Full funding – no diversion
- More examiners
- Better training
- Better infrastructure
- More work-sharing
- Rules reforms