



**FÉDÉRATION  
INTERNATIONALE  
DES CONSEILS  
EN PROPRIÉTÉ  
INDUSTRIELLE  
  
COMMUNICATION**



## **FICPI Delegation Visits USPTO on 11 June 2009**

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In conjunction with the Washington DC World Congress, a delegation of eleven **FICPI** representatives led by President **Peter Huntsman (AU)** met with leaders of the United States Patent and Trademark Office on 11 June 2009. In addition to Peter, the **FICPI** delegation included: **Bastiaan Koster (ZA)**, **Julian Crump (GB)**, **Francesco Paolo Vatti (IT)**, **Eric Le Forestier (FR)**, **Kazuaki Takami (JP)**, **Arild Tofting (NO)**, **Mark Wilson (US)**, **Jan Modin (SE)**, **Coleen Morrison (CA)** and **Ivan Ahlert (BR)**.

As with the other regular meetings that **FICPI** has with the USPTO, the meeting offered an opportunity for **FICPI** and the USPTO to engage in open dialog about a variety of issues of interest to the **FICPI** membership. The **FICPI** delegation was pleased with the amount of preparation that the Office had done for the meeting and the amount of time that they were willing to afford to the discussion.

Acting Undersecretary of Commerce for Intellectual Property and Acting Director of the USPTO John Doll welcomed the **FICPI** delegation and mentioned the value of **FICPI** input to the USPTO. In this vein, Mr. Doll mentioned the **Strategic Plan** that the Office is currently developing and urged **FICPI** to take the opportunity to comment on that plan during the comment period. He asked that the **FICPI** membership provide its input into what the USPTO of the future should be in direct and constructively critical terms and solicited any creative thoughts that the membership might have in this regard. The relevant branches of **FICPI** expect to comment upon the Strategic Plan when it is published for comment, and would urge all **FICPI** members do likewise as well.

Mary Critharis, Senior Counsel in the Office of Intellectual Property Policy and Enforcement (OIPPE), and Barry Hudson, the Acting Chief Performance Improvement Officer then led an in depth

discussion of the Strategic Plan. Mr. Hudson indicated that the USPTO is undertaking a deep re-examination of programs and their strengths and challenges. Among the challenges mentioned were issues of engagement and retention of staff, workload, decreasing revenue, and interfacing with the international intellectual property environment to improve harmonization and efficiency. Several of the **FICPI** delegation mentioned issues regarding the perceived increased difficulty in obtaining allowance of patents and a growing level of frustration at the user level due to a lack of transparency. In this regard, Mr. Hudson indicated that, as part of the development of the plan, the Office was examining the definition of “quality” in the context of patents and that definition would need to be conveyed to users in a clear manner. Again, **FICPI** was urged to comment on the plan during the comment period.



Amy Cotton, Senior Counsel in OIPPE, discussed a variety of issues regarding trilateral and multilateral initiatives concerning specifications of goods and services in trademark filings, including the USPTO’s suggestion of harmonizing lists of descriptions for goods and services. She also engaged in discussion of the Office’s position on the Norwegian proposal to eliminate basic trademark applications, which was discussed at the WIPO Madrid Working Group meeting.

There was a long discussion of the various issues involved in the **PCT Roadmap** as proposed by WIPO earlier this year and, in particular, the proposal of the USPTO at the recent PCT Working Group meeting in Geneva for a “PCT” that was interpreted by some to indicate that the Office is advocating giving binding effect to PCT reports on patentability. Such reports would be issued by a PCT authority upon having separate searches made at two other PCT authorities. Ms Critharis indicated that the USPTO advocated streamlining international and national processing of applications but was fully supportive of the PCT process. Mr. Charles Pearson, Director in the Office of Patent Cooperation Treaty Legal Administration, described the proposal at the Geneva meeting as being a long-term proposal to facilitate discussion and indicated that the intent was not to make PCT patentability reports binding on national Offices. They also indicated that they were working on a modified proposal, following a broad agreement among the PCT Working Group delegates not to discuss the US proposal further. Therefore, the **FICPI** delegates left with an understanding that the US proposal, as presented in Geneva, was unlikely to be pursued further by the Office. During this time, there was also a discussion on the topic of primary and supplemental searches, and the views of the **FICPI** delegates regarding the same. **FICPI** has consistently supported supplementary searches to be made during the international phase. Also, the **FICPI** Congress in Washington had supported a draft resolution urging that any additional searches to be made during the national phase proceedings of PCT applications should also be truly supplementary in character, so as to avoid duplication of work among the designated/elected national Offices.

Various USPTO personnel discussed the status of US patent law reform legislation and proposed new patent rules. Currently, the bills for patent law reform are not progressing in the US Congress, for a variety of reasons. Further, because there is not a confirmed Undersecretary of Commerce for Intellectual Property and Director of the USPTO, there is no political assistance being given to

Congress by the Office. In regard to the proposed new rules concerning continuations, claim numbers, RCE's, etc., these and all other rules packages are currently on hold pursuant to the *Tafas v. Doll* litigation and the lack of a political head of the Office.

The final portion of the meeting revolved around issues of how the USPTO was considering addressing the backlog and streamlining the prosecution process. **FICPI** members mentioned current frustrations with regard to restriction practice, inconsistent standards of obviousness, and piecemeal prosecution. Various personnel at the Office addressed these issues, and a lively discussion ensued. The Office personnel mentioned several initiatives that were being piloted, including a program in which examiners will conduct pre-examination interviews, in an attempt to streamline prosecution. There was also an acknowledgement that additional training on restriction and species election practice was needed and an indication that this was in process. Finally, there was an indication that the backlog of applications was actually starting to shrink, due to the hiring and training of new examiners. However, there is concern on the part of USPTO management that this will be a temporary state of affairs, given the current budgetary crunch and hiring freeze.

In closing, **Peter Huntsman** thanked the Office personnel for their time and interest, and the USPTO employees thanked **FICPI** for their participation.

**FICPI would urge all FICPI members who have comments or questions that they wish to have conveyed to the USPTO to bring such comments or questions to the attention of the Federation's officers for discussion at the next meeting of a FICPI delegation with the USPTO.**

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