

From:  
Sent: Friday, August 20, 2010 2:32 AM  
To: 3-tracks comments  
Subject: Comments on the Proposed Enhanced Examination Timing Control Initiative in the United States

Dear Sirs,

Please find attached Mitsubishi Electric Corporation's comments on the Proposed Enhanced Examination Timing Control Initiative. If you have any questions, please do not hesitate to contact us.

Best regards,

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August 20, 2010

Comments on the Proposed Enhanced Examination Timing Control Initiative in the United States

Director of the USPTO,

Mitsubishi Electric Corporation hereby comments on the proposed Enhanced Examination Timing Control Initiative in the United States in which applicants can select one of three tracks of examination. We find the proposed three-track system largely unacceptable because of some disadvantages as follows:

- 1) Examination of an application filed in the USPTO that is based on a prior foreign-filed application (hereinafter referred to as a "non-USPTO first-filed application") will be delayed compared to examination of an application filed in the USPTO that is not based on a prior foreign-filed application (hereinafter referred to as a "USPTO first-filed application"); and
- 2) Additional burdens will be imposed on applicants of non-USPTO first-filed applications, such as the need to submit a copy of the search report, a copy of the first office action from the foreign office where the application was originally filed, and an appropriate reply to the foreign office action.

However, if such additional burdens are eliminated and the three-track system is applied equally to all applications, i.e. if non-USPTO first-filed applications are treated equally to USPTO first-filed applications, we can withdraw the opinion above and accept the system. In fact, Track III (delayed examination track) would be preferable for some of our applications for which the relevant business trends or goals are still unclear at the time of the filing.

Regarding point 1) above, sometimes there are cases where an applicant files an application in the JPO first, but wishes to obtain a patent more quickly in the United States than in Japan due to the applicant's specific business needs. In such cases, obtaining the US patent will be delayed under the proposed system, since examination of the US application does not start until the completion of the examination of the Japanese application, which needs not be patented in haste. If the applicant requests accelerated examination in Japan in order to accelerate the examination in the United States, the applicant will incur some additional costs, which will be a great disadvantage.

From the competition point of view, it will be sufficient for a company that files its applications in the USPTO first to file ordinary national applications. On the contrary, we will always have to file PCT applications in Japan in order to avoid the disadvantages arising from the introduction of the proposed system. Since a PCT application is more expensive than an ordinary application, if the number of PCT applications increases as a result of the introduction of the proposed system, our products are very likely to lose price competitiveness.

Regarding point 2) above, it is considered to be difficult for USPTO examiners to use office actions issued by the JPO and the responses thereto submitted by applicants as they are, because these

documents are all prepared in Japanese. Thus, if the proposed system is formally introduced, we are afraid that translation of these documents into English would become obligatory. Such translation requires enormous costs and workload, and could critically affect our competitive strength against other companies in the United States.

As regards the costs, the requirement to provide a copy of the search report, the first office action and an appropriate reply thereto causes applicants to bear additional costs. The applicants also need to pay fees to Japanese patent attorneys for sending the related documents to US attorneys and fees to the US attorneys for submitting the documents to the USPTO. These costs will total to several hundred dollars per application, and should the translation also be required, yet additional costs will arise.

In the case of the JPO or the EPO, even if there are some developments in the examination of a US counterpart to a Japanese or European application, the office never requests the applicant to submit a copy of the office action issued by the USPTO and the response thereto by the applicant. The same applies to Patent Offices in other countries such as the SIPO or the KIPO. Of course, we find no problem in the examination authority in each country obtaining the examination documents pertaining to foreign counterparts to national applications by their own effort. However, if such workload is to be imposed on applicants, we oppose such a scheme.



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