

**From:** Haken, Jack  
**Sent:** Tuesday, October 02, 2012 12:37 PM  
**To:** fitf\_guidance  
**Subject:** Docket PTO-P-2012-0024

In response to Docket Notice PTO-P-2012-0024, Philips Intellectual Property and Standards submits these comments on behalf of Koninklijke Philips Electronics N.V. and its associated companies (collectively "Philips"). Philips typically files about one thousand five hundred new patent applications each year. The vast majority of these applications is first filed as United States provisional patent applications and later filed as applications under the PCT which designate the United States, together with many other countries, and claim priority from the earlier US provisional application.

We are concerned that the transitional provisions of proposed rules 1.55 and 1.78 which will require us to identify subject matter differences between the disclosures of the priority and PCT application, together with the ongoing obligation to identify claims supported by the priority applications are unnecessary and unduly burdensome. Our experience indicates that issues of intervening prior art and conflicting applications, which would trigger a need for the Office to consider whether examination should be conducted under FITF or FTI statutes, are only relevant for a small percentage of cases, and we urge the USPTO to adopt rules that postpone the requirements for submission of the statements contemplated by the proposed rules until a real need arises.

**Specifically, we propose that the USPTO adopt rules which initially treat all transitional applications as falling under the AIA/FITF provisions, and which then provide an option for applicants to invoke examination under the pre-AIA/FTI provisions after prior art has been cited which would not be relevant under the FTI provisions.**

We also note that the proposed rules fail to provide any meaningful definition of when subject matter in a patent application is considered "new", and thus become particularly uncertain and burdensome for applicants who base priority claims on foreign language applications where uncertainties in translations could lead to unnecessary disputes.

Respectfully submitted

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