

OPPEDAHL & LARSON LLP  
DILLON, COLORADO

CARL OPPEDAHL  
MARINA T. LARSON, PH.D.  
RYAN E. ANDERSON  
JESSICA L. OLSON

TEL: + 1 970 468-6600  
FAX: + 1 970 468-0104  
WWW.PATENTS.COM

By fax 571-273-0464

Jon Dudas, Director  
United States Patent and Trademark Office

Re: USPTO's obligations under the Patent Cooperation Treaty

August 24, 2005

Dear Director Dudas:

In the past eighteen months I have written to you, on behalf of inventors who are clients of our patent firm, perhaps twenty times to ask for your assistance in getting the USPTO to establish International Search Reports ("ISR") and International Preliminary Examination Reports ("IPER"). Having spoken with many other patent attorneys about this, I find that it is a rarity for the USPTO to establish an ISR or IPER in keeping with its obligations under the Treaty. Our experience is that we have not had even a single instance in two years of the USPTO getting an ISR or IPER done on time.

Right now the USPTO only permits PCT applicants to select either the USPTO or the EPO to perform International Searches and International Preliminary Examinations. EPO charges about double the fee that USPTO charges, and thus simple economics prompts most applicants to choose the USPTO (rather than the EPO) to perform International Searches and International Preliminary Examinations. (The USPTO charges \$1000 for an International Search, while EPO charges \$2075.)

There are other Searching Authorities under the Treaty. These include Austria (which charges only \$262), Australia (which charges \$942), Canada (which charges \$1336), China (which charges only \$181), Spain (which charges \$2075), Finland (which charges \$2075), Japan (which charges \$887), South Korea (which charges only \$218), Russia (which charges \$300), and Sweden (which charges \$2075). None of these Searching Authorities, however, is available to US applicants, because the US has not specified any of them as being available.

My impression is that the USPTO would be very happy if fewer applicants were to ask the USPTO to prepare ISRs and IPERs. This would reduce the burdens which ISRs and IPERs place upon the examining corps and would free up resources within the examining corps to address issues of pendency.

POSTAL ADDRESS: P.O. BOX 5088, DILLON, COLORADO 80435-5088  
VISITING ADDRESS: 256 DILLON RIDGE RD., DILLON, CO 80435-5088

A simple cost-free step by the USPTO would bring about this happy result. Under the Treaty, the USPTO needs merely to specify every available Searching Authority. Several of these Searching Authorities (Austria, China, South Korea, and Russia) offer searches that are far less expensive than those offered by USPTO. I know that many clients of our firm would automatically select one of the least expensive Searching Authorities. This would relieve the USPTO of some of the present unwanted burden of performing International Searches.

In much the same way, USPTO should specify every available Preliminary Examining Authority.

This process of specifying Searching Authorities and Preliminary Examining Authorities is a simple one, and can be done by merely writing a letter from the USPTO to WIPO. The USPTO would benefit from this simple and cost-free step, and American inventors would benefit by being given greater choice.

I request an audience with you, or with the relevant decisionmaker within the USPTO on this issue, to discuss this further.

Sincerely,

A handwritten signature in cursive script, appearing to read "Carl Oppedahl".

Carl Oppedahl  
PTO Reg. No. 32,746

**Table I(a) — Transmittal and international filing fees [continued]**  
(amounts on 1 August 2005, unless otherwise indicated)

RO	Transmittal fee <sup>1</sup>		International filing fee <sup>1,2,3</sup> (CHF 1,400)		Fee per sheet over 30 <sup>1,2,3,4</sup> (CHF 15)	PCT-EASY reduction <sup>2,5</sup> (CHF 100)	Competent ISA(s) <sup>6</sup>
TR	CHF	100	CHF	1,400	15	100	EP
TT	TTD	750	USD	1,211 <i>(from 1.10.05: 1,102)</i>	13 <i>(12)</i>	87 <i>(79)</i>	AT EP SE US
UA	UAH	255	USD (or eq UAH)	1,211 <i>(from 1.10.05: 1,102)</i>	13 <i>(12)</i>	n a	EP RU
US	USD	300	USD	1,211 <i>(from 1.10.05: 1,102)</i>	13 <i>(12)</i>	87 <i>(79)</i>	EP US
UZ	USD <sup>7</sup>	—	USD	1,211 <i>(from 1.10.05: 1,102)</i>	13 <i>(12)</i>	87 <i>(79)</i>	EP RU
VC	Information not yet available						
VN	VND eq USD	150	VND	eq CHF 1,400	eq CHF 15	n a	AT AU EP KR RU SE
YU	YUD	3,000	YUD	eq CHF 1,400	eq CHF 15	eq CHF 100	EP
ZA	ZAR	500	ZAR	7,270	80	520	AT AU EP US
ZM	Information not yet available						
ZW	ZWD	6,000	ZWD	eq USD 1,211 <i>(from 1.10.05: 1,102)</i>	eq USD 13 <i>(12)</i>	eq USD 87 <i>(79)</i>	AT AU CN EP RU

**Table I(b) — Search fees**  
(amounts on 1 August 2005, unless otherwise indicated)

ISA	Search fee <sup>1</sup>											
AT	EUR	200	CHF	311	KRW	264,000	SGD	430	USD	262	ZAR	1,620
AU	AUD	1,200	CHF	1,126	EUR*	684	KRW	948,000	NZD	1,282	SGD	1,490
	USD	942	ZAR	5,800	<i>*(from 1.9.05: EUR 769)</i>							
CA	CAD	1,600	CHF*	1,520	EUR*	985	USD	1,336				
	<i>*(from 15.9.05: CAD 1,600)</i>		CHF	1,681	EUR	1,078						
CN	CNY	1,500	CHF	207	EUR	137	USD	181				
EP <sup>15</sup>	EUR	1,550	CAD	2,520	CHF	2,432	CYP	905	DKK	11,520	GBP	1,078
	ISK	129,000	JPY	217,300	MWK	194,000	NOK	12,650	NZD*	2,884	SEK	13,870
	SGD*	3,410	USD**	2,075	ZAR	12,000						
	<i>*(from 15.9.05: SGD 3,410)</i>		NZD	2,622								
	<i>*(from 1.10.05: SGD 3,150)</i>		SGD	3,150	USD	1,877						
ES <sup>15</sup>	EUR	1,550	CHF	2,432	USD*	2,075	<i>*(from 1.10.05: USD 1,877)</i>					
FI	EUR	1,550	CHF	2,432	USD	2,075						
JP	JPY	97,000	CHF	1,097	EUR	692	KRW	920,000	USD	887		
KR	KRW	225,000	CHF	272	EUR	168	NZD	315	USD	218		
RU <sup>16</sup>	USD	300	CHF	344	EUR	227						
SE	SEK	13,870	CHF	2,432	DKK	11,520	EUR	1,550	ISK	129,000	NOK	12,650
	USD*	2,075	<i>*(from 1.10.05: CHF 2,432)</i>		USD	1,877						
US	USD	1,000	300 <sup>17</sup>	CHF*	1,171	342 <sup>17</sup>	EUR	787	224 <sup>17</sup>	NZD	1,360	420 <sup>17</sup>
	ZAR**	6,000	1,700 <sup>17</sup>									
	<i>*(from 1.9.05: USD 1,000)</i>		CHF	1,269	342 <sup>17</sup>							
	<i>** (from 1.10.05: ZAR 6,000)</i>		ZAR	6,800	2,100 <sup>17</sup>							

**Table II — Preliminary examination fees**  
(amounts on 1 August 2005, unless otherwise indicated)

IPEA	Preliminary examination fee <sup>18</sup>		Handling fee <sup>3, 18</sup> (CHF 200)
AT	EUR	200	EUR 129
AU	AUD	550 1,000 <sup>19</sup>	AUD 218
CA	CAD	800	CAD 213
CN	CNY	1,500	CNY eq CHF 200
EP <sup>15</sup>	EUR	1,530	EUR 129
ES	EUR	513.03	EUR 129
FI	EUR	550	EUR 129
JP	JPY	36,000	JPY 17,600
KR	KRW	225,000	KRW 171,000
RU <sup>16</sup>	USD	200 <sup>20</sup> 300 <sup>21</sup>	USD 173
SE	SEK	5,000	SEK 1,160
US	USD	600 750 <sup>22</sup>	USD 173 (from 1.10.05: 157)

Footnotes to fee tables:

- 1 Payable to the receiving Office in the currency or one of the currencies prescribed by it.
- 2 The international filing fee is reduced by CHF 100 where: (a) the request is presented as a computer print-out prepared using the PCT-EASY features of the PCT-SAFE software; (b) the request is filed together with a computer diskette, prepared using that software, containing a copy in electronic form of the data contained in the request and of the abstract; and (c) the PCT application is filed with a receiving Office which is prepared to accept the filing of PCT applications containing requests in PCT-EASY format together with PCT-EASY diskettes.
- 3 This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant fulfills the criteria indicated on the PCT website at: [www.wipo.int/pct/en/fees/fee\\_reduction.pdf](http://www.wipo.int/pct/en/fees/fee_reduction.pdf)
- 4 Where the PCT application as filed contains a sequence listing part in computer readable form only, or both in that form and on paper, under Section 801 of the Administrative Instructions under the PCT, and where that application is filed with a receiving Office which is prepared to accept such filings, a fixed component of 400 times the fee per sheet over 30 is payable for the sequence listing part, irrespective of the actual length of that part (see Section 803(ii) of the *Administrative Instructions*).
- 5 Where the international application is filed in electronic form in accordance with and to the extent provided for in Part 7 and Annex F of the Administrative Instructions and where the international application is filed with a receiving Office which has notified the International Bureau under Section 710 of the Administrative Instructions that it is prepared to receive international applications in electronic form, the international filing fee is reduced by CHF 200 if the text of the description, claims and abstract is not in character coded format, and by CHF 300 if the text of the description, claims and abstract is in character coded format. Only the following receiving Offices have sent such a notification so far: RO/EP, ES, FI, FR, GB, IB, JP, KR and NL. The equivalent amounts of those reductions in the relevant currencies are as follows: CHF 200=EUR 129, GBP 90, KRW 171,000, USD 173 (from 1.10.05: USD 157); CHF 300=EUR 193, GBP 134, JPY 26,400, KRW 256,000, USD 260 (from 1.10.05: USD 236).
- 6 For the search fee payable to the receiving Office, consult the entry in Table I(b) for the competent International Searching Authority.
- 7 The amounts are not yet known or, where known, are subject to periodical revision. The Office or the agent should be consulted for the latest applicable schedule of fees.
- 8 This fee is reduced by 80% where the applicant is a natural person.
- 9 The first amount of the transmittal fee is applicable to individuals or entities employing less than 25 persons. The second amount is applicable to entities employing 25 persons or more.
- 10 This fee is not payable in respect of international applications filed by applicants fulfilling the conditions indicated on the PCT website at: [www.wipo.int/pct/en/fees/fee\\_reduction.pdf](http://www.wipo.int/pct/en/fees/fee_reduction.pdf)
- 11 The competent International Searching Authority(ies) for an international application filed with the International Bureau as receiving Office is (are) the Authority(ies) which would have been competent if the international application had been filed with the receiving Office of, or acting for, the Contracting State of which the applicant (or any of the applicants) is a resident or national. See also *PCT Applicant's Guide*, Vol. I/B, Annex C (IB).
- 12 The Japan Patent Office is competent only for international applications in Japanese.
- 13 Plus EUR 1 for the preparation of additional copies, for each page and each copy.
- 14 Plus 12.5% GST (Goods and Services Tax) for New Zealand residents.
- 15 The search fee payable to the EPO and the Spanish Patent and Trademark Office, as well as the preliminary examination fee payable to the EPO, are reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in Item 4(a) of the Schedule of Fees annexed to the PCT Regulations, and in accordance with the decision of the EPO's Administrative Council of 11 October 2000, the text of which was included in *PCT Newsletter* No. 11/2000. The States concerned are those indicated in part 1 of the table on the PCT website at: [www.wipo.int/pct/en/fees/fee\\_reduction.pdf](http://www.wipo.int/pct/en/fees/fee_reduction.pdf), with the exception of Bulgaria, the Czech Republic, Estonia, Hungary, Lithuania, Poland, Romania, Slovakia and Turkey.
- 16 The applicant may, instead of paying the USD amount, pay the equivalent amount in RUR at the exchange rate applicable, on the date of payment, at the Central Bank of the Russian Federation, provided that, in the case of the search fee, the receiving Office accepts payment in RUR.
- 17 Payable when a corresponding prior US national application has been filed under 35 USC 111(a), ((i) prior to 8 December 2004, the basic filing fee under 37 CFR 1.16(a) has been paid, or (ii) on or after 8 December 2004, the basic filing fee under 37 CFR 1.16(a), the search fee under 37 CFR 1.16(k) and the examination fee under 37 CFR 1.16(o) have been paid) and the prior US national application is identified by the application number if known, or if the application number is not known, by the filing date, title and name of applicant (and preferably by the application docket number), in the international application or accompanying the papers at the time of filing the international application.
- 18 Payable to the International Preliminary Examining Authority in the currency or one of the currencies prescribed by it.
- 19 Payable when the international search report was not issued by the Australian Patent Office.
- 20 Payable when the international search report was established by the Russian Patent Office.
- 21 In all cases where footnote 20 does not apply.
- 22 Payable when the international search was not carried out by the United States Patent and Trademark Office (USPTO) (provided that the USPTO is a competent International Preliminary Examining Authority in the particular case—see *PCT Applicant's Guide*, Vol. I/B, Annex C (US)).