

From: Frank Marino
Sent: Wednesday, January 16, 2013 11:45 AM
To: QualityApplications_Comments
Subject: Request for Comments on Preparation of Patent Applications

Dear Director Kapos,

This responds to your "Request for Comments on Preparation of Patent Applications" of 01/15/2013.

Frankly, I'm amazed that it took this long for the USPTO to finally recognize the effects of your systematic weakening of the Patent Bar Examination, and admittedly a bit entertained to see you now struggling to figure out how to deal with the poor quality of the patent applications you are receiving as a result...all the while trying to avoid having to admit the obvious cause. The answer is simple; if you want competently prepared patent applications, you need competent patent application preparers. You need to restore the bar exam to its former degree of difficulty.

In my opinion, the "dumbing down" of the practitioner's exam that started in the mid 1990's was the result of the high failure rate by law school graduates who were great at law, but only marginal technically. After spending hundreds of thousands in law schools, hoping to become patent attorneys, and passing their state bars with ease, these technical amateurs could not pass the PTO bar exam after multiple tries and got frustrated. They and their firms (which had hired them with a "pass the patent bar by..." provision) lobbied for an easier test. So you lowered the bar of the bar to let in people who should not have been let in, and now you wonder why the applications you are receiving are such a mess?

Patent application preparation and prosecution is far more akin to engineering than to the practice of law. We really need to recognize that the qualities that make the best patent practitioners have nothing to do with their ability to master constitutional or criminal law and focus on the qualities that really matter... technical expertise. I have worked with so many of these recently inducted patent attorneys who graduated at the top of their law school class but cannot draft a decent patent claim...cannot grasp the meaning of a claim or adjudge its validity, cannot interpret a technical description or read an engineering drawings... yet because I am "only" a patent agent, they are qualified to advise clients on these issues and I am not? Just because they passed a state bar exam that focused on family and insurance law?

I have a BSEE from Northeastern University and I am reasonably competent in all of the technical fields in which I operate. I have dozens of patents of my own. I managed Intellectual Properties for my employer as a part of my responsibilities as VP of R&D, and have hired litigators and overseen numerous patent-related litigations. I consider myself as qualified as any USPTO-registered practitioner in my dealings with the office, but I have no legal training or education.

I studied for the "old" bar exam in 1993 that had a 30% pass rate and 4-time testing average the way I had studied through engineering school, the old-fashioned way, in a quiet room with a highlighter and a bottomless supply of coffee. I did not attend a \$1000 3-day intensive Patent Bar Review Course to learn how to shortcut the intent of the exam and learn only what I had to

know to pass it. And I passed it safely on my first try. For any qualified technical person, that old exam was reasonable and it certainly did not need to be changed.

I believe that you will never get a consistent number of quality-prepared patent applications until you return the bar exam to its original degree of difficulty and then weed out all those who “snuck in” under the easier exam. I also believe that you need to improve the quality and qualifications of some of your examining staff or even the most well-prepared applications will be wasted on blind eyes. If you do this, your application quality will improve by itself and your examiners will be able to spend their time cooperating with qualified practitioners to help inventors (your customers) get the claim coverage they deserve...the way it use to be.

Most Sincerely,

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