

From:  
Sent: Wednesday, March 03, 2010 5:17 PM  
To: patent\_quality\_comments  
Subject: Patent Quality Comments

To the Commissioner for Patents:

To enhance the quality of issued patents the Office needs to focus on significance. It is widely recognized that independent and non-independent inventors account for roughly 50% each of the most significant advancements. But independent inventors account for only 8% of the patent applications, compared to 92% for the non-independent inventors. This means the Office must process 11.5 times as many applications from non-independent inventors to patent the same number of significant advancements. In other words, non-independent inventors are burdening the Office with an excessive rate of non-significant applications. This creates backlog and detracts from the amount of time examiners can give to applicants.

To address this reality, the Office must face the problem head-on by firmly confronting assignees, e.g., corporations and academic institutions, over the relative non-significance of the applications they are pursuing for their inventors. Patent quality cannot begin at the Office. It must, of essence, begin with applicants.

The Office itself is largely to blame, however, for the burgeoning numbers of relatively insignificant applications. Key problems are presented by 1) the Office policy of "salami slicing" applications into divisionals on grounds of technical minutia, and 2) the senselessness of prohibiting new matter without filing a continuation-in-part. The latter problem also tempts applicants into pursuing hopeless requests for continued examination. Instead, salami slicing should be abandoned and new matter should be permitted where it would lead to allowance. The new matter would be assigned a new filing date parented by the old. This will streamline the process and reduce backlog.

Divisional applications are the bane of prior art searches. Reviewers must weed through disclosures that are substantially identical, on the outside chance that a critical difference might exist between them. This creates a huge burden. It is precisely for this reason that salami slicing is rejected by academia. Instead, inventions should be patented as a whole, not salami sliced into divisionals.

For quality patents, we must reject incorporation of prosaic technicality into the claims: If one has no tangible grasp of what an invention is by reading the claims, the claims represent a legalistic fiction. We must especially reject "fishing net" claims, where applicants hope to catch unanticipated, non-obvious inventions in the future under the snare of general terms applied with retrospection. A claim cannot encompass what its corresponding invention neither anticipates nor renders obvious, even if the same words could be used to perfectly describe a new invention coming afterward.

Finally, for quality patents, the Office must focus on where the quality is coming from: independent inventors. Since independent inventors account for only 8% of the patent applications filed, yet account for 50% of the most significant advancements, this means that application-for-application we are 11.5 times as likely to pull a significant advancement out of the pile

labeled "Independent Inventors" as out of the pile labeled "Non-Independent Inventors." This is calculated as  $(50\%/8\%)/(50\%/92\%)$ , which simply compares shares of significant advancements to shares of applications for both groups. The Office should therefore give greater attention to the independent inventor group to make sure that the significant inventions found among these precious applications do not fall through the cracks of rubric, legalese, and technicality.

In the more technically demanding fields, a key to quality patents is found in the ability and willingness of the applicant to search and describe the prior art. However, recent developments have adversely affected this process for independent inventors. For example, independent inventors prosecuting their own applications who live far away from the Office are not able to use the EAST system for searches. This also excludes them from access to the accelerated examination process, which requires EAST searches to be conducted, unlike the former application-to-make-special program.

Because independent inventors have the highest significance rating for their applications it makes sense to ensure that their applications are accelerated over assignee applications. But instead the opposite is true, with the vast majority of pro se applicants having no access to accelerated examination because they do not live near enough to the Office to use the EAST system. Though this problem has been brought to the attention of the Office on numerous occasions, no effort has been made to remedy it.

To give another example, in recent years corporations like IBM and Xerox have been making disclosures available to a "tea-party" subset of the public, by depositing them with propriety firms charging a subscription fee for dissemination to the public. Although examiners have access through the EAST system, along with entities able to afford subscriptions, independent inventors prosecuting their own applications generally do not. For this reason, limited-access disclosures such as these should not be count as prior art for obviousness rejections. To do otherwise is to put inventors without access at a terrible disadvantage, since an ability to appreciate the prior art in advance of filing is the best strategy to avoid rejections based on obviousness. To do otherwise would be to define "one skilled in the art" as a member of the exclusive tea-party subset consisting of those who are privy to subscription-based prior art disclosures, rather than limiting one skilled in the art to someone having "open public access" to the prior art.

For these reasons, the Office should make the EAST system available online for public searches and the Office should discontinue reliance on databases that are not available to the open public when it comes to issuing obviousness rejections. This is important because our ability to become familiar with the prior art strongly influences our ability to prepare quality patent applications and helpful patent teachings.

Sincerely,

/EC/

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