

RESPONSE TO THE USPTO REQUEST FOR COMMENTS
“Strategic Plan – 2007-2012”

Submitted by: The National Association of Patent Practitioners
Government Affairs Committee
Ron Reardon, President
Louis J. Hoffman, Government Affairs Liaison

Introduction

The following comments are submitted in response to the Request for Comments on USPTO's Draft Strategic Plan for FY 2007-2012 [Federal Register: August 24, 2006 (Volume 71, Number 164)][Page 50048].

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents and patent attorneys. NAPP has approximately 450 members in 13 countries. The patent practices of the practitioner members are focused primarily on patent prosecution, namely practice before the PTO. As part of NAPP's mission statement, we aim to create a collective nationwide voice to address issues relating to patent prosecution practice. For more information about NAPP, visit www.napp.org.

NAPP speaks for a significant share of patent agents and a fair number of patent attorneys. Approximately 5% of all active U.S. patent agents are members of NAPP. NAPP membership also includes hundreds of patent attorneys, generally those more involved in active prosecution before the PTO. In preparing this document, comments from members of NAPP, who participate in our government affairs committee, were solicited and collected. Those members most interested in the subject volunteered to work on drafting or reviewing the comments. Accordingly, we believe that the information provided here is representative of the prevailing wisdom of NAPP members.

NAPP welcomes the opportunity to comment on the PTO's Strategic Plan and hopes its comments prove useful.

Comments

NAPP's comments are limited to patent practice, although some of the comments may have general applicability to trademark practice as well.

1. Training of Patent Examiners.

NAPP applauds the PTO's goals for training of patent examiners. NAPP believes that the PTO's training program should include training in the English language for examiners for whom English is not their first language. Although the PTO's examiners are undoubtedly skilled in their respective arts, NAPP's members have found on

numerous occasions that the patent application process is hampered by certain examiners' lack of proficiency with spoken and written English. This language barrier can make it difficult to understand the nature of an examiner's objections or rejections, even after an examiner interview.

2. Changes to processing for particular patents.

NAPP expresses no opinion at this time regarding the potential for different patent "products" at varying cost levels, as it believes more specific information is necessary to fairly evaluate such a plan. NAPP does, however, support allowing an applicant to delay examination of an application (and payment of the examination fee), provided that safeguards are put in place to ensure that the public can view applications whose examination is deferred, to avoid tactical abuse of the procedure. NAPP believes that many applicants would choose this option were it available, and that in many cases examination would never be requested, thus reducing the burden on examiners.

3. Changes to the PTO's budgeting structure.

NAPP continues to support an end to fee diversion. NAPP believes that, because additional fees are the result of more applications, it makes sense to allow the PTO to keep all of the fees it receives, provided that the fees charged to applicants are commensurate with the expense of examining and otherwise processing applications. NAPP suggests that a "public utility" model of funding is appropriate, i.e., the rates charged by the PTO would be subject to some form of regulatory approval, but the PTO would be entitled to keep all fees it receives at such approved rates.

4. Changes to employee location requirements.

NAPP supports the PTO's efforts to recruit and retain highly qualified examiners. NAPP believes that "hoteling" and the concept of regional patent centers should be explored and given serious consideration. Given the electronic nature of most communications today, there is little need to require that all examiners live within commuting distance of Alexandria. Flexible scheduling, telecommuting, and regional patent centers would permit the PTO to attract and retain qualified examiners who are unable or unwilling to live and work in the D.C. metro area.

In conclusion, NAPP thanks the PTO for the opportunity to comment and offers to consult further or to provide whatever other assistance is needed in connection with further development or implementation of the strategic plan.

These comments were prepared by the government affairs committee of NAPP, lead drafter, Kevin W. Grierson, Esq.