From Eugene_Palazzo@mc.xerox.com Tue Oct 15 09:00:58 1996
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From: Eugene_Palazzo@mc.xerox.com
To: regreform@uspto.gov
Cc: Jean_Hough@mc.xerox.com, Paul_Morgan@mc.xerox.com,
    John_Beck@mc.xerox.com
Subject: PTO Proposals For Misc. Amendments To The Rules

The numerous extensive proposals as published in the PTCJ, Volume 52,
No. 1295, September 26, 1996 will require substantial study, thus
those affected, such as the public, patent attorneys, and others need
more time for study than the PTO November 22, 1996 proposed deadline
for comments. Moreover, the continued PTO focus on revisions of the
rules without first fully considering and attempting to resolve many
major PTO problems is misplaced. Also, Patent Attorneys and members of
the Public affected should be members of any team that is considering
changes to the Rules.

A brief review of the PTO proposals indicates that in a number of
instances the proposals simplify and reduce PTO efforts and paper
work, while increasing applicants efforts, paper work, and costs. I
would like to suggest more focus on improved training for new
Examiners, that is less than 5 years with the PTO; better Examiner
monitoring; the proper Examiner technical background; the full timely
investigation of complaints against Examiners; Examiners need to
function less as an adversary and more as an aid to applicants; the
Examiners need direction and need to relax their views, especially
for lengthy chemical 112 rejections, the submission of more than two
Official actions, citation of new prior art in the Examiner's reply to
an appeal brief, allowing applications after the appeal brief is
filed: and the PTO and Examiners must treat applicants as customers.
Comments by some Examiners with Master degrees, and PhD's indicate
that they are of the view that nothing is patentable, and these
Examiners unnecessarily consume substantial time of applicants and
significantly discourage inventors. The substantial PTO delays in
deciding appeals, up to four years in chemical cases, needs to be
addressed, and the percentage of appeals (about 70 percent) decided
against Appellants, in full or in part is much too high and the PTO
Board process and makeup needs to be considered in depth, and revised.
Petitions to the Commissioner need to be reviewed and acted upon
promptly and not placed in the file with no action. Status inquiries
need to be timely and fully responded to by a qualified Examiner and
not by clerks with a form letter.

Examiners must permit more person- to- person interviews, and at
least telephone interviews, and Examiners must review all the claims
and indicate those claims that are allowable and those that are not.
The barriers, especially the substantial prosecution barriers between
the PTO and applicants need to be reviewed and eliminated or minimized.