From: Tom Adams [mailto:tadams@rennerotto.com]
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To: patent_quality_comments
Subject: Suggestions

Regarding the USPTO Request for Comments on Improving Patent Quality, I offer the following:

1. **MOST IMPORTANT:** A quality review for rejections, parallel to the quality review of allowances, should be instituted, and must include some sanction for poor rejections. We have seen far too many poor quality rejections and continued examiner obstinacy in refusing to withdraw the poor rejections, or in repeatedly citing "newly discovered" references and issuing repeated rejections. At present there is no sanction for this activity. There is no sanction for an examiner losing on appeal. The exact same sanction, or even a more severe sanction, should be enforced against examiners who issue poor, legally insupportable rejections, as for examiners who allow cases deemed incorrect by the quality review board. As matters now stand, an examiner can continue to reject ad infinetum with no sanction whatsoever. The Office's system presently encourages this behavior by rewarding the obstinate examiner with more and more counts as applicants attempt to get their cases allowed, and by punishing examiners who allow cases later deemed to be improvidently allowed.

2. During prosecution, to improve quality, the most attention should be paid to obviousness rejections. Today, it is all to easy to simply invoke KSR and reject everything as obvious with no real consideration of whether the asserted combination would have been obvious. The mere fact that elements of an invention exist in the prior art, even for the same types of uses, should not be sufficient ground to support an obviousness rejection, but all too often that is exactly how it is done. And, once the examiner has decided something is obvious, all too often there is nothing the applicant can do to overcome it.

3. A high rate of rejections does not equate to a high level of quality. While it is true that there can be no poor quality patent if no patent is issued, the purpose of the Office is not to deny patents, but to grant patents. The Office should be reminded of the preamble of Section 102 - "A person shall be entitled to a patent unless -".Thus, the presumption is that a person is entitled to a patent unless the Office can prove that the person is not so entitled. All too often, this presumption is reversed.

4. As the Office must be well aware, every word written in a Reply to Office Action by the applicant or attorney, including argument, is "carved in stone" and has effect as an estoppel in future litigation. Despite this, the Office routinely dismisses attorney statements and arguments on the basis that it is "mere attorney argument" and therefore unworthy of full credit. This is simply wrong. We are bound by what we say, and the Office should credit what we say to the same extent.

5. Patent examiners must be trained and must act as the quasi-judicial persons that they are, as opposed to being bureaucrats. As examiners, the goal should be to help applicants indentify and claim allowable subject matter, and to reject applications only when necessary. All too often, examiners act like bureaucrats in which the only way a person feels like they are doing anything with their power is to say "no".

Thank you for this opportunity to offer some comments.

Best regards / Mit freundlichen Grüßen / Sincères salutations / Keigu / Med vänliga hälsningar / S pozdravem

Tom

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Thomas W. Adams
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44115
216-621-1113
216-621-6165 (fax)
www.rennerotto.com
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