

# PUBLIC SUBMISSION

**Docket:** PTO-P-2014-0043  
Request for Comments on Enhancing Patent Quality

**Comment On:** PTO-P-2014-0043-0001  
Patent Quality Enhancements; Meeting

**Document:** PTO-P-2014-0043-DRAFT-0015  
Comment on FR Doc # 2015-02398

---

## Submitter Information

**Name:** Richard Beem  
**Address:**  
53 W. Jackson, Suite 1352  
Chicago, IL, 60604  
**Email:** richard@beemlaw.com  
**Phone:** 3122010011  
**Organization:** Beem Patent Law Firm

---

## General Comment

Comment on Proposal 4 Under Pillar 2: Review of and Improvements to Quality Metrics

As indicated in the PTO proposal, quality applies not just to issued patents but also to search, examination, and office actions. Too often, improved quality is equated with more rejections-- anything to keep a patent from issuing. But poor quality rejections impose high costs on the PTO (including wasted time and effort, reduced productivity, and more backlog) and on applicants, many of whom simply cannot afford to pay legal fees and costs associated with protracted prosecution, RCEs, and appeals. Abandonment of a meritorious application is not a successful outcome.

Every patentable claim should be allowed (or indicated to be allowable if rewritten in independent form) as early in examination as possible. There should be more first office action allowances of meritorious claims. Present PTO practice is to reject routinely, applying a broad brush to all claims, often with poor reasoning, especially in a first office action, and frequently again (sometimes simply repeating the first rejection without addressing amendments) in a second office action, which is usually made final. All claims and all amendments should be addressed separately. Presently, far too many cases are pushed into RCEs and/or appeals. More

effort should be made by examiners to identify patentable subject matter and to work with applicants and attorneys to agree on allowable claims, commensurate with the scope of the invention.

About the submitter: Richard P. Beem is a registered patent attorney, No. 32,961, in private practice in Chicago for over 25 years.