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Subject: quality summit proposal

PATENT QUALITY PROPOSAL

QUALITY FROM THE USPTO

In my view, the Three Pillars and the Six Proposals are all pointed in the wrong direction. They scrutinize the Examiner's workflow and the "quality" of the patent. It's just more of the same, only the measurements are more obscure in their ways to close loopholes. The inventors are brought in only in minor areas to make them feel like they are involved but really just to increase pressure on the Examiner. Sorry, but these are the messages I get when I read them. It should not be that way.

The patent system is a process which is enormously important to so many people. It controls the flow of commerce. It changes careers. And the Patent Examiner is at the crux of the patent system. It is a position to be supported, not squeezed.

Most people believe the Examiner's product is a patent. It is not. His real product is Justice. Every inventor wants a patent on his invention. None, however, want an invalid patent. All they really want is Justice. If you want to improve quality, improve the Justice dispensed by the Office and especially the Examiners. "Quality" is improved, when inventors trust the USPTO will give them an accurate, unbiased answer to their most pressing question, "Is my invention patentable or not?"

The Examiner's sole job is to examine patent applications, lay out a complete search, consider the art in the search area thoroughly, accurately apply the search results in view of the law as expressed in the statutes and in the court decisions, render an unbiased legal decision, all the while being ever aware that the outcome is Justice. Help the Examiner do that. Remove unnecessary distractions and peripheral chores. Delegate grunt work to assistants. But most of all, change the atmosphere within the Patent Office so that everyone knows it and appreciates it.

When an inventor first encounters the Patent Office, whether as a visitor, researching his invention, filing an application, or prosecuting one, the Office he sees and feels is the United States Patent Office, not the United States Rejection Office nor the United States Registration Office. The atmosphere of the Patent Office is not adversarial. It is one of respect, concern, and helpfulness. Legally, it projects the concept of fairness, one of impartiality, promoting pro-invention and pro-patent but only according to the law. The focus is on the inventor. How best does the USPTO serve him?

After the inventor files a patent application and interacts with the Office as an applicant, the inventor needs to see the treatment he receives from the government is the same for everyone, is free from bias, and is just. All inventions are equally valuable and receive the same thorough examination. The USPTO creates the quality, but ultimately, the agent who communicates the quality is the patent Examiner, and he does so through the prosecution of the patent application.

First and foremost, the Examiner always treats the inventors and their representatives with respect, giving courtesy to them while making it clear from his demeanor that the final decision is his, and like a judge it is subservient to the law. Visibly putting the inventor first is a major component of the quality of the Patent Office. When the inventor is confident he is being protected by the agency from which he is seeking help, he will be more comfortable, open, and will accept adverse decisions with more understanding and good will.

COMPACT PROSECUTION

Compact Prosecution is necessary to keep up with the pace of technology. I propose the following to increase the quality to the examination as well.

PRIOR TO FILING

Prior to filing of the application, the inventor is encouraged to conduct his own search and file the results with his application. This is for the inventor's benefit. The inventor will be better able to write a more intelligent application and more meaningful claims, if he has a feel for the prior art and how his invention stands relative to the prior art. This is not for the Examiner's benefit. The Examiner knows the art and its classifications much better than the inventor. The inventor is not required to do this. It is to give the inventor a running start at appropriate claims.

FIRST OFFICE ACTION

The Examiner concentrates on the search in the first Office Action. The goal of the first Office Action is to put all of the pertinent prior art in front of the inventor, so that the inventor can write final claims which are in proper perspective to the field as a whole. The attorney representing the inventor does not want to be surprised with new art in the second Office action, have the door slammed shut, and the client is left hanging. The attorney looks incompetent, and the inventor loses. He would rather see all of the pertinent art while he still has time to modify the claims. To accomplish this end, the Examiner reads the application in detail, understanding every nuance of the invention. He lays out a complete search in all the areas in which the disclosed ideas are stored, and searches the invention, not the claims, looking for the combinations, the subcombinations, the functions, and any new elements. He pulls the necessary art, representative patents from virtually identical patents, and makes all of the pertinent prior art of record, placing them all on the table in front of the inventor, giving him a realistic overview of how his contribution fits within the art. The claims are broadly rejected in view of the best art of the heart of the invention. The Examiner is to be liberal in citing court decisions which are likely to become issues in the case.

APPLICANT'S AMENDMENT

The inventor is expected to consider all of the art of record and write claims which he considers are allowable in view of them and the cited court decisions. If the inventor believes different court decisions are controlling, he is to cite them and point out their superiority. Citations of court decisions to identify and justify positions is encouraged. The inventor is legally entitled to claims which provide his invention with as much scope of protection as the prior art will permit, and it is his responsibility to control the scope of the claims. He is also expected to write claims of differing degrees of scope.

SECOND OFFICE ACTION

The second Office Action is decision time. The current standard for the Examiner is a binary judgment, patentable or not, allow or reject. The Examiner again reads the application thoroughly, renewing his understanding of every nuance of the invention. Every decision cited by the attorney is read, and where desired, copied, and stored for use in future examinations. The prior art cited is compared to the disclosed invention, and the claims are either allowed or rejected. Every argument from the inventor is read and weighed. The reasons for any disagreements are explained in detail with citations.

While the scope of the claims is the inventor's responsibility, the Examiner must take care not allow claims with more scope than the inventor is entitled. On the other hand, he is not to demand the scope be unduly limited to be "on the safe side" in allowing claims.

The second Action is either an allowance or made Final.

AFTER FINAL INTERCHANGES

The inventor can either cancel the rejected claims or appeal them. If the Examiner feels that an amendment of a rejected claim does not materially change the grounds for rejection, he should enter the amendment. The Rules are to help the inventor get the best patent on his invention that he is entitled, not as a weapon to help the Examiner save time and make his goals. If prosecution needs to be reopened, however, then the amendment is refused entry.

ALLOWABLE BUT UNCLAIMED

It is suggested that a protocol be developed which will allow an Examiner to work with the inventor or inventor's attorney to allow subject matter which the Examiner is convinced is allowable but which is not claimed as yet. The Examiner should explicitly be allowed to write suggested claims, if practicable. The final decision as to accepting any such new claims always rests with the Examiner, however.

Respectfully submitted,

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