

From: email redacted
Sent: Tuesday, March 24, 2015 10:54 AM
To: WorldClassPatentQuality
Subject: Input for Patent Quality Initiative - Corrected

Attached is a corrected sheet that should replace what I just sent in the last message.

I meant to say "Do *not* increase or charge fees for interviews" in the document.
Christine Kennefick
-----Original Message-----

From: [email redacted]
Date: Mar 24, 2015 10:21:17 AM
Subject: Input for Patent Quality Initiative
To: WorldClassPatentQuality

Attached is a 1-page input for the Patent Quality Initiative.

Thank you for the opportunity to send feedback and suggestions--

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Applicant, application 14/516536 (allowed March 2015)
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Patent Quality Initiative Input

Automated Search Tools

New tools can be used as an aid, but do not resort to complete automated scan-and-search because:

1. A single keyword can have many different meanings. In software patent applications, applicants often give words definitions that are distinct and pertinent only to that document.
2. One piece of prior art, around which I wrote my claims in a recent application, was found with a key phrase *that could not be found anywhere in the abstract, summary, description or claims.*

Compact Prosecution

Keep this concept. The key is to identify Allowable Subject Matter before mailing a First Office Action.

But do not resort to fee-for-reply to keep prosecution short. Some applicants or assignees will be able to use cash and time to keep an application pending. Other applicants will risk not having their applications examined properly because of lack of cash to pay for enough responses. After a first or second action, perhaps use a longer length of time on a docket before the next action to discourage lengthy prosecution.

Consider eliminating Final Rejections. If it is evident that an application has large problems early in examination, perhaps the applicant should be encouraged to close the application and simply file a new and better application.

Interview Practice for Compact Prosecution

Although I have done 3 in-person interviews, these sessions can be brief and over the phone. Having examiners routinely conduct in-person interviews will get expensive. Many applicants might not even be near a public library large enough to have the meeting rooms someone suggested.

Do not increase fees or begin to charge extra fees for interviews.

For a brief interview to lead to compact prosecution, one or more of the following 3 elements already occur in many interviews, and are suggested as a set of 3:

1. The applicant might tell the examiner what the applicant is trying to protect. Saying what is being invented could lead to a description of 30 or more parts of the invention. What the applicant is trying to protect, in contrast, can be described briefly in 1 or 2 sentences, such as "The way someone would use this tool to more easily...", "The coupling of this device to to make.....more efficient", or "The specific steps and output product of this computer program..." What is important is that if an applicant gets too many claims rejected for what they want to protect, they will eventually resort to continuations, appeal boards, new filings and RCEs, all of which lead to backlogs and long prosecution.
2. Based upon an examiner's search, the examiner might state which are the key piece(s) of prior art around which claims need to be drafted. Before the initial filing, the applicant or representative has probably drafted claims over art known to the applicant.
3. After the interview, based on information in steps 1 and 2 above, the applicant or representative should be able to edit, draft or rewrite claims that put the application in or very near a condition for allowance.