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To: External Examination Time Study <ExternalExaminationTimeStudy@USPTO.GOV>

Subject: Response to Qs

Questions Concerning Examination Time Goals

(1) Do you perceive a difference in the quality of examination performed in complex technologies compared to less complex technologies?

Yes

If yes, which do you perceive as higher quality and why? In what aspect(s) is the quality of examination higher?

Much higher quality in less complex tech. The examiners seem to be unable to understand the invention adequately in complex, probably because they don't spend enough time examining it.

(2) What factors do you consider when estimating the amount of time needed to take various steps in prosecution, such as preparing responses to Office actions or preparing for interviews? In particular, if you prosecute applications in a variety of technology areas, how do those factors vary among the technologies?

I charge more if the tech is complex and if there are several rejections. I give high a ball-park estimate of the number of hours and make a refund if I spend less time than the high estimate.

(3) Are the applications you prosecute more or less complex than in the past, e.g., 10 years ago?

Yes.

What factors contribute to the increase or decrease in complexity?

Advancing technology.

Do you believe the increase or decrease in complexity has affected the amount of time it takes to prosecute the applications?

Yes.

If so, by how much?

About 25% to 50% more time to prepare and prosecute most complex inventions.

Do you believe the increase or decrease in complexity has affected the quality of examination?

Yes.

If so, how?

Far lower quality of examination in complex cases.

(4) In order to increase the quality of examination, do you believe that an increase in the time allotted for examination should be designated for specific activities, such as interviews, or left to the discretion of the examiner?

Left to discretion but I would like greater supervision of examiners' work so that they will not send out poorly examined OAs, which cost my clients a lot of money needlessly. I know it is wishful thinking, but I would like the PTO to take some financial responsibility for poorly examined cases.

What activities would you prioritize and allocate more time to?

Reviewing the application, searching, writing the OA, and review of the OA.

(5) Are there any portions of Office actions which you feel do not add value or quality to the examination? If yes, what are they?

Quoting the statutes, rules, and MPEP

(6) What other activities beyond examining, such as research or training, could examiners spend time on that would add value? Why do you believe these activities could add value?

Train examiners to review some poor OAs and explain the unnecessary burden that such poor work creates for the clients. Train examiners to be helpful and suggest claims where there is allowable subject matter.

(7) While the focus of this request for comments and the roundtables is to find the appropriate amount of time for examination, cost and pendency are also contributing factors. Do these factors raise a concern that should be considered?

Yes. But I think it would take less time (for appeals, interviews, etc.) if examiners would do a good job the first time and work with the attorney to issue a good patent. This was done under the leadership of previous Commissioner Q. Todd Dickinson.

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