

# BUTZEL LONG

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Mail Stop Interference  
Director of the USPTO  
P.O. Box 1450  
Alexandria, Virginia 22313

Via E-Mail to [BPAL.Rules@uspto.gov](mailto:BPAL.Rules@uspto.gov)

RE: PROPOSED CHANGES TO USPTO RULES OF PRACTICE BEFORE THE  
BPAI (Document ID PTO-P-2009-0021-0002)

Dear Sir,

The law firm of Butzel Long, P.C. appreciates the opportunity to comment on the proposed changes to the rules governing *ex parte* appeals before the USPTO's Board of Patent Appeals and Interferences, Document ID PTO-P-2009-0021-0002.

The proposed changes to the *ex parte* patent appeal rules suggest creating a presumption of examiner correctness<sup>1</sup>. In our view, such a provision unduly shifts the burden of proof to the appellant in an unbalanced manner, and may actually detrimentally affect the quality and correctness of the patent prosecution process.

First, no evidence exists to create an arbitrary and inappropriate presumption of correctness since, under the current system, many cases on appeal are reversed. A large segment, and perhaps even a majority, of examiners lack sufficient experience and technical expertise to elicit impartial confidence in a presumption that depends upon the accuracy of an examiner's examination. To presume correctness is to presume the examiner's examination has *per se* yielded the right result on the basis of a correct analysis. However, it has been reported that 50% of examiners have less than 3 years of experience, no in-depth knowledge of the technology being examined, and no in-depth knowledge of law and procedure. Indeed, nearly 33% of new patent examiners leave the USPTO within one year of hire and nearly 70% of patent examiners leave within five years<sup>2</sup>. Moreover, it is estimated that 30 to 40 examiners per month leave

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<sup>1</sup> Proposed § 41.37(o) reads: "Argument. The 'argument' shall explain why the examiner erred as to each ground of rejection to be reviewed. Any explanation must address all points made by the examiner with which the appellant disagrees. **Any finding made or conclusion reached by the examiner that is not challenged will be presumed to be correct.** Each ground of rejection shall be separately argued under a separate heading." (*Emphasis added*).

<sup>2</sup> [http://www.associatedcontent.com/article/410755/gao\\_study\\_patent\\_office\\_attrition\\_increases.html](http://www.associatedcontent.com/article/410755/gao_study_patent_office_attrition_increases.html)

the USPTO, which further erodes the collective experience of the examining corps<sup>3</sup>. Exacerbating the deficiency of examiner experience further is the high attrition rate of examiners having advanced degrees, such as law degrees, and doctoral or master degrees in science and/or business—these individuals tend to leave the USPTO within their first two years to pursue careers in the private sector. Yet, according to the USPTO, the skill of patent examination is a profession learned through 5 to 7 years of on-the-job training reinforced by classroom training<sup>4</sup>.

Second, examiners are under enormous time constraints and production pressures which may also have a debilitating impact on the quality and correctness of examiner decisions, particularly rejections. For example, examiners are given an inadequate amount of time to perform the onerous task of examining a patent application, let alone the time to thoroughly comprehend a patent application and also thoroughly search the prior art. Examiners often tell practitioners that they had not reviewed the specification as time will not allow them to read the dense documents thoroughly. Typically, the examiner reads the claims, searches key terms, and studies the figures. This, coupled with a quota system that focuses on quantity or counts, rather than quality, instills the need of an examiner to maintain productivity at the expense of quality and correctness. The patent office is constantly battling a growing backlog of applications that emphasizes the final disposition of applications as timely as possible. Moreover, there are limited, if any, negative ramifications in doing so. Under such circumstances, a presumption of examiner correctness offers no confidence when examiners have insufficient time to accurately perform the patent examination process.

Moreover, a standardized review process for rejected cases is not in place to ensure higher quality examination. Basically, there is no check against the examiner in rejecting a case besides the appeals process. This creates an unfair imbalance between allowed and rejected cases and creating a presumption of correctness further tips the scales towards unfairness against the applicant. In short, it is difficult to have confidence in a presumption of examiner correctness when a majority of examiners lack the requisite experience and technical expertise to accurately perform the patent examination process. Further still, the examiner's rejections are not being reviewed by a more experienced senior examiner or quality review board to warrant a blanket

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<sup>3</sup> <http://www.ipwatchdog.com/2009/12/24/uspto-to-rehire-former-patent-examiners-to-attack-backlog/id=8050/>

<sup>4</sup> [://www.uspto.gov/patents/resources/methods/afmdpm/transition.jsp](http://www.uspto.gov/patents/resources/methods/afmdpm/transition.jsp)

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presumption. Thus, the appeal process can be the lone recourse for the applicant who feels that he is being treated unfairly and wants to have an independent, impartial, and objective evaluation of his application on the merits, perhaps for the first time.

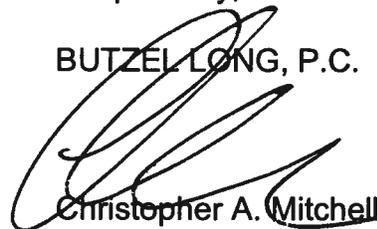
The USPTO's own statistics lend credence to the notion that the presumption of examiner correctness is not a sound standard. According to the data available for Fiscal Year 2009, the BPAI affirmed 52.6% of appeals<sup>5</sup>. In other words, approximately 1 out of every 2 examiner decisions was *not* affirmed. Essentially, the examiner's decision was deemed to be incorrect almost half of the time. This fact alone suggests that a presumption of correctness is just as unjustified as a presumption of incorrectness.<sup>6</sup>

It is further noted that the current appeals process is already expensive and exhaustive for applicants. Often, for financial and other reasons, applicants choose against filing appeals despite recommendations from their representatives that they are likely to win on the merits. This already skews the statistics of the listed rate of affirming the examiners.

In conclusion, neither the BPAI appeal statistics nor the experience and expertise of examiners support a presumption of examiner correctness in rejecting cases. Increasing the daunting burden on the applicants further stifles innovation and discourages individuals from seeking patent protection.

Respectfully,

BUTZEL LONG, P.C.



Christopher A. Mitchell

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<sup>5</sup> <http://www.uspto.gov/web/offices/dcom/bpai/docs/receipts/fy2009.htm>

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