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To: BPAI Rules

Subject: Rules Changes

The problem creating the backlog at the BPAI is not the rules; it is the Examiners who have become less and less able to understand or comprehend fundamental patent principles and who have become deathly afraid to allow even the most clearly novel, non-obvious claims lest they get reversed by their QUAS. For the first fifteen years of my practice, I prided myself on getting things accomplished at the Examiner level, either by getting the case allowed with appropriate arguments and/or amendments, or abandoning the case when it truly merited abandonment. In the last four years, however, I think I can count on one hand the number of cases that I have gotten allowed. The nonsense the Examiners are putting forth these days in support of their steadfast refusal to allow cases -- feeling carte blanche to do so in light of KSR -- is appalling! I've been told that torque is the same thing as speed; that the completely different operating environment of a refrigeration compressor (as compared to the operating environment of a gas turbine compressor) can be accommodated by modifying the material of the compressor to make it more comfortable (whatever that means); that I can file a response to a Final Office Action on a date that is eight months after the mailing date of the FOA (no Notice of Appeal had been filed) and that was two weeks prior to the date I was told I could do so (and that was by a primary, nonetheless); that applying the brakes on a truck is analogous to stopping the outboard motors of a boat from turning; that it does not matter what the apparatus claims specify if the same overall effect is (allegedly) accomplished. I get restriction requirements -- not election of species, restriction requirements -- among the fifteen dependent claims in a group. I am told that an overhead crane assembly in a manufacturing plant is the same thing as a wiring harness. I was told that "chemical polishing" reads on wiping one's hand across a surface, since there are chemicals in the oils on one's palm that can remove materials. I was told that I had to amend a claim to specify a roller THAT ROTATES because the comparative example in the specification where the roller was prevented from rotating (in order to demonstrate the benefit of the invention) would cause one of skill in the art to be confused as to what a roller is. I invariably get examiners tossing out "broadest reasonable interpretation" as if it were some talisman that lets them do or say anything, not understanding that the standard is broadest reasonable interpretation in light of the specification as understood by one of skill in the art. And on and on it goes.

Simply put, the problem is at the Examiner level, and that problem is exacerbated by the fact that the folks moving up to the supervisory roles often don't know what they're doing themselves. By and large, the Examiners' ability to communicate in writing is dreadful! It is painfully ironic that often they can hardly express themselves clearly in writing, yet they are tasked with passing judgement on the clarity of what we write. Further still, it is painfully clear that they have little training in how to follow and, if possible, respond to an argument.

As for amendments after a non-final rejection, it is the rare case indeed where an Examiner recognizes that they did not necessitate a new ground of rejection, but rather it was the Examiner's own misunderstanding of the invention and/or the art that necessitated it such that the next action should not be final. As for after-final practice, there seems to be an absolute knee-jerk response refusing to enter even the simplest amendment because it allegedly raises new issues. It is just plain becoming impossible to get an Examiner to reconsider and change his or her mind on anything!

Director Kappos has -- thankfully -- indicated a desire to move things in the right direction, and part of that is reducing the number of counts Examiners get for various tasks. That change theoretically would remove some of the incentive Examiners have to "turn the crank" and "churn" applications, but I seriously question whether it will be enough. Instead, I suggest penalizing examiners when they are reversed on appeal (e.g., by docking counts) instead of by a QUAS. That, I submit, would be far more effective in reducing the backlog than any of the other proposed modifications.

Thank you for your consideration.

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(this email reflects my own personal experiences and opinions and should not be construed in any way as representing or reflecting the views of the Firm with which I am affiliated.)