

From:  
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To: patent\_quality\_comments  
Subject: Ways to Enhance Patent Quality

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March 8, 2010

To the US PTO:

Pursuant to your request for comments on ways to enhance and recognize patent quality, I offer the following.

Ways to Enhance:

In my 28 years of experience as a patent attorney / agent / examiner I have been involved with thousands of patent applications prosecuted before the US PTO. My comments are based on such experience.

1. Make sure that Examiners sufficiently read the application to have at least a basic understanding of the inventions disclosed / claimed in an application, particularly the point(s) of novelty emphasized in the application and the problems being addressed by the invention, prior to issuing a first Office Action, and in the first Office Action indicate any subject matter which may be patentable, even if not initially claimed.

2. Many new Examiner's have a poor understanding of the requirements under 35 USC 112, first and second paragraphs, and they present far too many rejections for alleged violations of such requirements which really have no merit under current law and become an improper focus of the Office Action, when all that was really needed was (at most) an objection to claim language and possible suggestion to make the claim more appropriate. I strongly recommend that new Examiner's get more extensive training in the practical realities of 35 USC 112, first and second paragraphs, so that they will issue fewer improper / unnecessary rejections under these laws and stay focused on merit of the claimed inventions.

3. Currently many large corporate applicant's are looking to reduce the cost of their IP programs in terms of prosecution costs, maintenance fees, etc. It seems a great opportunity for US PTO Examiners to initiate more telephonic contacts with attorneys when

the Examiner's feel that they could allow a given claim / application if certain amendments are made to the independent claims. Applicants are more likely to agree to such suggestions today than they were in the past.

4. I see for too many rejections under 35 USC 103 where Examiners assert an obvious modification of a primary reference based on features set forth in a secondary reference which have nothing to do with the primary reference, and where the Examiner does nothing to show why the modification would be obvious other than to recite some advantage achieved in the secondary reference (which, again, has no relationship to the primary reference) or to paraphrase an advantage of the claimed invention being rejected. It seems the Examiners should have a better understanding of standards actually discussed by the Supreme Court in the KSR v. Teleflex and Graham v. John Deere cases, and be required to clearly articulate why the standards are met relative to a given rejection. This would advance patent prosecution in a meaningful way.

5. My recent experiences with Reexamination (Ex Parte) were extremely disappointing / disheartening to me (personally) not only because my client (who was challenging the validity of issued patents) lost, but because I felt that the US PTO was either corrupt (the Examiners and/or the personnel directing them were being paid off by the patent applicant) or really did not give a damn if they issued (re-certified) patent claims that were certainly anticipated and/or obvious to anyone with any minimal understanding of patent law (or common sense), e.g., the Examiners accepted the applicant's arguments on analogous art that were directly contrary to the patent disclosure. I really lost faith in the ability / honesty of the US PTO through these experiences (a faith yet to be restored). Fortunately, the CAFC had little difficulty in finding the patents invalid on the same prior art as considered by the Examiners, but it cost my client \$750,000 to get an answer that should have been apparent to a junior Examiner with one year's experience.

Hence, my suggestion is that all reexaminations should be Inter parte, and that there should be serious explanations extracted from the Ex Parte Examiners after they re-certify patentability of a patent later found invalid by a court based on the same art as considered by the Examiners. This could apply to all patents, not just to reexamined or reissued patents

Sincerely,

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