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From: David Testardi [mailto:datestardi@earthlink.net]

Sent: Monday, February 08, 2010 2:28 PM

To: patent\_quality\_comments

Subject: Response to Request for Comments on Enhancement in the Quality of Patents

Attn: Kenneth M. Schor and Pinchus M. Laufer

Sirs/Madams,

Attached please find my comments, in response to the Federal Register notice dated Dec. 9, 2009, in the PDF file named: comments-uspto.pdf

Sincerely,

David Testardi

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

February 8, 2010

RESPONSE TO REQUEST FOR COMMENTS ON  
ENHANCEMENT IN THE QUALITY OF PATENTS

Mail Stop Comments--Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTENTION: Kenneth M. Schor and Pinchus M. Laufer

Dear Sirs/Madams,

In response to the Federal Register notice dated December 9, 2009 regarding comments solicited to improve the USPTO's performance in identifying relevant prior art, I have three words of advice for USPTO management:

**Classification, Classification, Classification**

Without better classification, and the trained use of classification tools which already exist, U.S. Examiners will never find the relevant prior art that their European and Japanese counterparts now find with relative ease.

The beauty of classification is that a document need only be classified once\*, with one time-consuming review (e.g., as part of examination), and then it can be found quickly the next hundred times it may be relevant to any patentability determination. Without classification, each of the hundred Examiners would need to find it (if he/she can) from scratch (e.g., using an imperfect keyword search that inherently has a high "miss" rate) and then review and understand the document, often to the same extent that the initial Examiner did (who examined the claims), lest he/she misconstrue a reference that may have "false positive" keywords. **A little classification time up front can save untold examination time down the road for the agency, while increasing patent quality.**

I could go in depth into the neglectful state that has hamstrung U.S. Classification since the early 1990s, but the whole ordeal is so well documented that another rehashing could not do any good. It will suffice to say that in 1990, no Examiner wanted to switch to the IPC because U.S. Classification was infinitely better. Today, the only way to find all relevant U.S. published applications in a particular technology is to search by using the IPCs (or other non-USPC schema) assigned by the EPO (or other third party sources). This neglectful state, not only of the USPC breakdowns themselves but also of the very classification of documents (e.g., as applied to PGPUBS by contractors), is utterly woeful.

Domestic classification of U.S. patents is the single most important function that needs to be addressed if the exponentially increasing amount of prior art is to continue to be searchable, in any practical sense, by the agency in the future. The domestic classification may be harmonized with other offices (and perhaps now should be), but that harmonized function cannot be left solely to the other offices' Examiners (as it is today). Only by classification of new inventions (and newly published scientific literature) can U.S. Examiners attain the technical expertise that is essential to the examination of patent claims.

Given the current state of domestic classification and the entire revamping that will be necessary due to the neglect of the previous two administrations, it is suggested that, *as a mere stopgap measure*, U.S. Examiners begin using, along side the USPC, the following classification systems:

1) **The European Patent Classification System (EPC)** - this is currently being used in only a very few U.S. arts, but should be used in all. For example, Examiners in Classes 360 and 369 can search by EPC breakdowns by using U.S. Class G9B. (NB: It is ludicrous that the USPTO doesn't just use the EPC breakdowns in G11B, and perhaps some contractor got rich off the alphanumeric-to-numeric G11B-to-G9B conversion, but the functionality of USPC G9B appears to be substantially equivalent to that of EPC G11B.)

The EPC, as already applied by EPO examiners, currently covers all patent documents, foreign and domestic (though the Japanese coverage is limited to examined or applied documents), and also a very significant amount of literature. The quality (both in the subclass breakdowns and the placement of documents) is orders of magnitude better than the current USPC. **This classification scheme should be applied to all documents in EAST, and the literature already classified by the EPO should be added to EAST.** (NB: EAST does have an EPC field, but any alphanumeric breakdowns more precise [i.e., detailed] than the IPC have been purposefully stripped from the EAST field; of course, it is these precise breakdowns which have been stripped away from the classification data [by a paid contractor?] that are, or would be, the most valuable - what irony!)

2) **The Japanese Patent Classification System (FI and F-Term)** - it is possible that no U.S. Examiners (or only a very few) are using this classification scheme. FI is similar to the EPC in the specificity of subclass breakdowns, while F-Terms are an order of magnitude more precise than any other classification. (NB: If you want to see how a good classification system can be arranged, study the F-Terms in classes where the Japanese are prolific.) In technologies where the Japanese are prolific (e.g., semiconductor manufacturing), it is impossible to thoroughly search Japanese art without using FI and F-Terms. And one can almost say that it is accordingly impossible to determine whether a U.S. claim is in fact patentable without searching FI and F-Terms.

The FI and F-Term Classifications, as already applied by JPO examiners, currently cover all Japanese patents and publications (including utility models). Since the work has already been done by the JPO, **the FI and F-Term classification schemes should be applied to all Japanese documents in EAST, and Japanese Utility Models should be added to EAST.**

3) **The German Patent Classification System (DEKLA)** - it is possible that no U.S.

Examiners (or only a very few) are using this classification scheme. DEKLA is similar to the EPC in the specificity of subclass breakdowns, with particular emphasis in technologies where German is strong (e.g., automotive, manufacturing). Because DEKLA's "search file ICP" classification is applied to virtually all worldwide patent documents by German examiners, including U.S. patents and German Utility Models, it adds yet another avenue (besides EPC) to pinpoint relevant prior art that might be e.g. misclassified in the U.S. or have no corresponding English abstracts.

Since the work has already been done by the DPMA examiners, **the DEKLA "search file ICP" classification scheme should be added to all documents, foreign and domestic, in EAST.**

4) **DERWENT Manual Codes (EPI and CPI)** - Derwent Classifications are already available in the EAST Derwent file, and cover virtually all worldwide patent documents in the electrical and chemical arts. These can be effective in helping to find relevant prior art in cases where the USPC has become or been made ineffective (e.g., by neglect of the breakdowns or improper application to documents).

Classification is certainly not the "end all" of good searching, but it most certainly is the foundation of *all* good searching, and a necessary first step without which effective quality searching at the USPTO cannot be attained. (Validity rates since 1994 can attest to this.) Once the USPTO has its classification "house" in order, advanced search techniques can be implemented (e.g., some F-terms let you search by "image" type, combining full-text searching with F-terms yields super-high precision) and then USPTO patent quality will perhaps again be the strong backbone that U.S. industry can rely on.

Thank you.

Sincerely,

/David Testardi/  
David A. Testardi  
Reg. 33,639

\*Reclassification will always be necessary as new fields develop; in some hot technologies, reclassification can become necessary in 10 years or less. But the need for quality reclassification in hot technologies should not be spurned (as it was in a previous administration), lest the U.S. Patent System drag down a hot U.S. technology through invalid issuances.