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From: willepaul@att.net [mailto:willepaul@att.net]

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To: patent_quality_comments

Subject: [Docket No.: PTO-P-2009-0054]

Comments on Improving the Quality of Patents

Category I – Quality Measures Used

1. Don't confuse quantity with quality.

Trying to “measure” the quality of examination is like measuring the quality of a painting. “Metrics” are artificial, not real. “Clearly erroneous” is a pretty low standard for review. How can someone unfamiliar with a technology evaluate a search or a rejection? The number of sub-classes searched is no indication of quality. What if the prior art is primarily in publications, particularly in books, rather than in patents? How does the measurer know where the most relevant prior art is likely to be found?

2. Give the Examiners more time to do their jobs.

Even a small sample of patent applications reveals signs of haste; e.g. copying and pasting inappropriate paragraphs, unintelligible sentences, typos and grammatical errors, duplication of text, mischaracterization of the prior art (not difference of opinion stuff but describing the prior art as saying the direct opposite of what is actually disclosed). Hours per disposal is not a measure of quality.

I was an Examiner when Commissioner Brenner introduced “compact prosecution” (two office actions and then either appeal or abandon or issue). Some applications that I have prosecuted in recent years have had five or six Office Actions. Forty years after introduction, the idea is still a joke. It will continue to be a joke because the process hinges on the adequacy of the initial examination. Without enough time, the initial examination is more of a pro forma exercise to avoid having the oldest case in the group.

3. Make supervisors supervise.

At a minimum, a supervisor should read the Office Actions of his subordinates. The supervisor can evaluate quality. Ideally, references to the text of the cited prior art are checked for whether or not the alleged disclosure exists. Reference to more than five lines of printed text should be a flag that the Examiner is faking it. It only takes one or two sentences to disclose a fact; e.g. a process step or an electrical connection. A rejection should also be questioned when there are no specific (column and line) references to the prior art. The word “inherent” should be a large flag that the Examiner is likely substituting hope for evidence.

The many sound-good activities in pursuit of quality could be eliminated if the supervisors were held accountable for seeing that their subordinates did their jobs

properly. Just because an Examiner has full signatory authority does not mean his work should not be reviewed. Reviewing work for the first time in an appeal conference is too late.

Having had 11 out of 14 applications allowed immediately after a brief was filed. I tried a pre-appeal-brief conference. The PTO held there was an appealable issue. I filed a brief and the application was immediately allowed. Another sound-good, bad-in-reality idea that drains resources. Why was there no honest review of the final Office Action? An unwillingness to have ones work see the light of day (i.e. re-opening prosecution rather than appeal) should be a flag that something is wrong, that the examination is defective, that quality is lacking.

4. The Notice in the Federal Register defines “quality” in a way that ignores the examination process and is vague. “A thorough and complete examination” is a thought process that would be burdensome to document, if it could be. The definition is also inconsistent with the “clearly erroneous” standard mentioned elsewhere in the notice. There is a vast gulf between “thorough and complete” and “clearly erroneous.” “Proper scope” is another vague term. “Patentable over the prior art of record” is the goal.

The Office’s job is to issue patents that, at a minimum, are not ridiculed by the public (e.g., a patent on a method for swinging on a swing; 6,368,227) or by those in the relevant art (“How did that get patented? Don’t they know ...?”). Beyond the minimum, the allowed claims should be patentable over the prior art of record and the prior art in the areas searched by the Examiner. It would be nice if the Office’s goal were to issue patents that could withstand litigation but that is too much to expect. Thus, two measures are (1) not ridiculous and (2) patentable over the prior art of record.

Category II – Stages of Monitoring

1. Classic problem: “Quis custodiet ipsos custodes” (who guards the guards themselves)? I thought that supervisors monitored their subordinates. Now the PTO has “monitors” to watch the supervisors or, worse, do their jobs. What is next, people who monitor the monitors? Instead of adding layers to the cake, why not cure the problem by making supervisors do their jobs? That way, all stages of prosecution are “monitored.”

2. Apparatus exists: petitions under Rule 181 might be a big clue that something is wrong, particularly petitions under Rule 181(a)3. Don’t sidestep the matter or get

defensive, cure the problem. The existing apparatus also covers all stages of prosecution.

2. "Actions by applicant" are governed by the statutes and Rules of Practice. Anything outside of the statute or rules is not the business of the PTO, which has more than enough to do minding its own business.

Category III – Pendency

1. Give the Examiners more time to do their jobs.

(comments above apply here)

It all hinges on the initial examination.

Don't measure hours per disposal. If the PTO must create numbers, measure hours per disposal after the first Office Action.

Category IV – Pilot Programs

1. Stop looking for a magic bullet.

Expect people to do their jobs properly (most people want to), give them the time and means for doing their jobs properly, and hold them accountable. Help Civil Service develop more concern for serving the public than for protecting turf.

2. Stop adding overhead.

Ask yourselves how much of a distraction a pilot program is going to be. Avoid ideas, such as the pre-appeal-brief conference, that waste resources, especially time. Stated conversely, if there is enough time for pilot programs, there is enough time to add to the initial examination.

Category V – Customer Surveys

1. The PTO surveys frequent filers, not those who give up in disgust. Are the results of the survey valid?

2. Has the cost/benefit of the surveys been evaluated?

Category VI – Tools for Achieving Objectives

1. Give the Examiners more time to do their jobs.

(comments above apply here)

2. Stop wasting resources on “business” patents. Patents relate to science. Business is not science. “The invention, to justify a patent, had to serve the ends of science — to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific knowledge” A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147 (1950). With all due respect to Prof. Federico, under whom I studied patent law, “anything under the sun that is made by man” is overly broad or, at least, is being misconstrued. A limit on patentable subject matter is science and the scientific method, i.e. predictable and reproducible results. This is codified in 35 USC 112, “to enable any person skilled in the art ... to make and use the same”; that is, to reproduce the results obtained by the inventor. Measured with this standard, business patents are clearly invalid.

3. Enforce 35 U.S.C. 33 (Unauthorized representation as practitioner) against those who represent themselves as “intellectual property” lawyers but are not registered patent attorneys.

The generic term “intellectual property” includes patents. Using the term implies that the person is registered and qualified to file and prosecute patent applications. The public is not sophisticated enough to appreciate distinctions, a fact relied on to the benefit of those using the generic term. Inappropriate use of either the generic term or the specific term, “patent attorney” (or “patent agent”), should be prosecuted. This will improve quality by eliminating the unqualified.

4. Make plagiarism unethical

Representing as your own the work of another is plagiarism. A person who did not actually write an application, amendment, etc. but signs as the attorney/agent is a plagiarist. The identity of the author(s) should be indicated.

Respectfully submitted

Paul F. Wille
Reg. No. 25,274
Paul Wille, P.C.
(a solo practice)