



Technology Center 2800
Semiconductor Workgroup

Rolf Hille, Director
703-306-3431

Tom Thomas, SPE
703-308-2772 AU 2811

Olik Chaudhuri, SPE
703-306-2794 AU 2814

John Niiabling, SPE
703-308-3326 AU 2812

Chad Bowers, SPE
703-308-2417 AU 2813

Eddie Lee, SPE
703-308-1690 AU 2815

Carl Whitehead Jr., SPE
703-308-4940 AU 2822

Wael Fahmy, SPE
703-308-4918 AU 2823

David Nelms, SPE
703-308-4910 AU 2818

Richard Elms, SPE
703-308-2816 AU 2824

Matthew Smith, SPE
703-308-1323 AU 2825

Nathan Flynn, SPE
703-308-1323 AU 2826

United States Patent &
Trademark Office
Crystal Plaza Four, 8D19
Arlington, Virginia 22202

SEMICONDUCTOR CUSTOMER PARTNERSHIP

The Fall 2000 Semiconductor Customer Partnership Meeting was held on October 31st, 2000 at Advanced Micro Devices in Sunnyvale, California. It is fitting that Advanced Micro Devices hosted the meeting since Dick Roddy, Chief Patent Counsel for AMD, has been an enthusiastic supporter of the Partnership since its inception. The Partnership was established in June 1999 to provide a forum where customers learn about policy changes and process improvements, as well as an opportunity for USPTO to hear customer concerns.

More than sixty attorneys and industry representatives attended the Fall meeting. Rolf Hille, Director, Technology Center 2800 chaired the meeting and Hiram Bernstein, Senior Legal Advisor, Office of Patent Legal Administration, provided an extensive briefing on the recent rules change packages. Brad DeSandro of Workman, Nydegger & Seeley P. C. presented an overview of USPTO's newly developed Electronic Filing System that allows customers to file patent applications online. T. Rao Coca, IP Counsel, IBM Microelectronics Division; Douglas Goldhush, Partner, Arent Fox Kinter Plotkin and Kim PLLC; and Richard T. Ogawa, Partner, Townsend and Townsend and Crew briefed participants on specific issues and concerns their organizations have with the current patent process.



Rolf Hille



Richard Roddy

Dick Roddy welcomed participants and served as gracious host for the meeting. In his opening remarks, Rolf Hille briefed participants on the state of the semiconductor workgroup in Technology Center 2800, particularly increased filings and the initiatives to address the additional workload. Mr. Hille noted that filings in the semiconductor workgroup have doubled to over twelve thousand applications in the last four years. Despite the tight labor market the semiconductor workgroup has hired about 90 new examiners in the last two years to cope with the increased workload. He further provided an overview of expanded desktop search capabilities that allow examiners to search full text of U S patents issued since 1970, as well as foreign patent and non-patent databases.

Hiram Bernstein devoted considerable time to the rule change packages under the American Inventors Protection Act of 1999. Specifically he provided an overview of the changes in practice resulting from the final implementation of the Patent Business Goals and USPTO's implementation perspective of the AIPA on the USPTO. Mr. Bernstein provided a helpful grid that summarizes the rules affected by the various rule packages (Interim Request for Continued Examination, Final RCE, Patent

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Hiram Bernstein

Business Goals, Patent Term Adjustment, Eighteen-month Publication, and Inter Partes Reexamination), as well as the USPTO contact for each rule. A copy of the Correlation of Rule Packages with Specific Rules may be obtained from Tom Thomas (tom.thomas@uspto.gov).

T. Rao Coca shared with the participants feedback from the 27 attorneys in his division. Since IBM earns significant income from its IP portfolio, their perspective on the patent examination process was of considerable interest to the participants. IBM's objective is to rank for the 8th consecutive year as number one in terms of number of patents obtained on a yearly basis. More importantly, IBM wishes to maximize the quality of the patents they obtain. Mr. Coca noted that the cost of obtaining patents is getting prohibitively expensive.



T. Coca Rao

Mr. Coca acknowledged that, like USPTO, IBM faces the challenge of recruiting and retaining IP professionals. One way of addressing this issue is the formation of a virtual law firm, which allows practitioners to work from their homes at their convenience. The virtual law office business environment was of considerable

interest to the USPTO employees at the Partnership Meeting as the Patent Business moves aggressively to conduct business in an e-commerce environment, with the objective of improving internal processing times, as well as, increases in the quality of products and services. Mr. Coca provided helpful suggestions to improve Office actions and enhance the lines of communications between attorney and examiner.

Mr. Coca also noted that the overall response time has improved, and that more examiners are willing to grant interviews and consider amendments. He also stated that IBM is pleased with the USPTO web site, and that IBM will participate in electronic filing, which has worked well in Japan.

Brad DeSandro presented an overview of the Electronic Filing System (EFS). Mr. DeSandro reviewed the EFS process and capabilities. He stated that the software is now available to applicants via the Internet. The EFS software assemblies all application components (including figures), calculates fee information, validates application contents, and compresses, encrypts and transmits the application to the USPTO. EFS is secure and encrypted both during uploading and downloading. Mr. DeSandro led participants through a virtual tour of the EFS process. He also provided an overview of the PAIR system, which allows customers to track their applications online.



Brad DeSandro

There was expressed a need for two encryption keys to access PAIR, one for the contract attorneys to access information for cases in their jurisdiction and one for the lead attorney to access the organization's pool of applications. PALM developers are aware of this desirable feature and expect to incorporate the dual encryption feature in a later version of the system.

Douglas Goldhush stated that his law firm Arent Fox filed about 1000 application in calendar year 2000, and about 20-25% of these were filed in Technology Center 2800. He noted that there is significant improvement in quality and responsiveness. He observed that searches appear to emphasize U.S. patent database. However, the latest enhancements to the search tools include concurrent searching capability of multiple databases. Mr. Goldhush stated that refresher training for examiners in treating functional language will be helpful. He also expressed a need for a more open policy for customer interviews after final Office actions. In response to Mr. Goldhush's comments about apparent inconsistencies in reviewing drawings, Mr. Hille stated that under pre-



Douglas Goldhush

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grant publications drawings will be published as filed. Further, for patent publication, the drafting people have been instructed to waive minor drawing informalities. However, there are some formality requirements that are essential, such as the width of the margins.



Richard T. Ogawa

Richard T. Ogawa reported out the feedback on office actions from the Bay area practitioners. He noted that respondents generally agreed that there have been improvements in clarity of office actions and search quality. Mr. Ogawa stated that their expectations are: improving responsiveness to

customers' needs in restriction practice, minimizing delays in prosecution, enhancing clarity of office actions, and fostering informal channels of communication.

Tom Thomas, Supervisory Patent Examiner, Art Unit 2811, provided a summary of the lectures presented to examiners during the year 2000 under the Training Partnership. He noted with appreciation the enthusiastic support from the industry partners for the technical training partnership. He related that the USPTO has a formal examiner training program for examination practice and procedure, but there is no formal training in the technology. The technical lecture series fulfills that need.

Recently, Dr. Harry Levinson of Advanced Micro Devices presented a tutorial on "Submicron Lithography" to an audience of over 160 examiners. [The next lecture on the topic of Progressive DRAM Technology by Brent Keeth, Micron Technology, is scheduled for January 22, 2001]. Mr. Thomas concluded

by soliciting volunteers to present to examiners topics of current interest in the semiconductor technology. He suggested that the following topics are of considerable interest to examiners: memory, including EEPROM and DRAM; submicron MOS technology; and CMP.

The meeting concluded with an open discussion of various topics of general interest. Mr. Hille initiated a discussion on the semiconductor workgroup's restriction practice, which was of considerable interest to the participants. Mr. Hille stated that about 13,500 first action on the merits were issued in the semiconductor workgroup during FY 2000 and about 33%, or 1 in 3 applications, received a restriction requirement. Mr. Hille suggested that the workgroup could put in place a pilot program whereby participants would give a letter stating that in the event of restriction they provisionally elect the first presented claimed invention with traverse. The letter could include language reminding the examiner of the option of rejoinder if claims are allowable. Mr. Hille stated that he would like to see the exam-

Acknowledgments

We thank Dick Roddy, Chief Patent Counsel, Advanced Micro Devices, for his continued active and enthusiastic support of the partnership. The Fall 200 meeting was held at facilities provided by Advanced Micro Devices. We thank Mr. Roddy and his staff for the hospitality extended to all participants.

The Semiconductor Workgroup in Technology Center 2800 wishes to acknowledge the assistance Arthur Steiner, McDermott, Will & Emery, and Michael Lynch, Chief Patent Counsel, Micron Technology in arranging technical lectures. Their assistance is greatly appreciated.

Next Partnership Meeting

The next meeting of the Semiconductor Customer Partnership will be held at USPTO in May 2001. You will receive the agenda for the meeting in the near future. Partnership meetings provide an opportunity for the continued exchange of ideas to improve the quality of the examination process as well as other PTO products and services. We are in search of presentations and topics for the agenda that would be of interest to the semiconductor intellectual property community. Your involvement in the planning process is critical to the success of the Partnership Meeting! Your suggestion is earnestly solicited. Please send your suggestions to Tom Thomas (tom.thomas@uspto.gov).

The Fall 2000 Meeting

Partnership Committee Members

IBM

T. Rao Coca

Micron

Michael Lynch

McDermott, Will & Emery

Arthur Steiner

Trop, Pruner, Hu & Miles PC

Tim Trop

Applied Materials

Larry Edelman

Hewlett Packard Co.

Dick Shulze

Nikaido, Marmelstein, Murray & Oram

Doug Goldhush

Advanced Micro Devices, Inc.

Richard Roddy

Townsend, Townsend & Crew

Richard T. Ogawa

Patent Agent

Larry Williams

Texas Instruments

James Brady

Schnader, Harrison, Segal & Lewis

Joan T. Kluger

Workman, Nydegger & Seely PC

Brad Desandro

Lucent Technology

Scott McLellan



These partnerships are designed and developed to be a forum to share ideas, experiences, and insights between individual users and the USPTO. The USPTO does not intend to use these customer partnership groups to arrive at any consensus. Invitations to participate will indicate that individual opinions are sought, rather than a group consensus and that the meetings are intended to be informal in nature and have varying participants. These customer partnership groups are formed with full recognition of the USPTO's responsibility under the Federal Advisory Committee Act (FACA), and that these customer partnership groups are not established as FACA compliant committees.

Special acknowledgement to Russ Adams of Art Unit 2851 and Sharlamar Taliaferro of Center for Quality Services

Meeting Participants:

Dick Roddy, Advanced Micro Devices, Sunnyvale, CA
Pamela Kee, Agilent Technologies, Palo Alto, CA
Larry Edelman, Applied Materials, Santa Clara, CA
Douglas H Goldhush, Arent, Fox, Kintner, Plotkin & Kahn PLLC, Washington, DC
T. Rao Coca, IBM Microelectronics Division, Hopewell Junction, NY
Eric B. Janofsky, Marvell Semiconductor, Sunnyvale, CA
Shuitsu Kita, Mitsubishi Electric Corporation, Arlington, VA
Ronald L Taylor, Mitsubishi Electric Corporation, Cypress, CA
John Clark, National Semiconductor Corporation, Santa Clara, CA
Joan T Kluger, Schnader, Harrison, Segal & Lewis, Philadelphia, PA
Jim Brady, Texas Instruments, Dallas, TX
Richard T. Ogawa, Townsend & Townsend & Crew, Palo Alto, CA
Brad DeSandro, Workman, Nydegger, Seeley P.C., Salt Lake City, UT
Jesus Juanos I Timoneda, Workman, Nydegger, Seeley P.C., Salt Lake City, UT
Raj Jaipershad, Advanced Micro Devices, Sunnyvale, CA
Mikio Ishimaro, Law Office of Mikio Ishimaro, Sunnyvale, CA
Derek Minhane, Altera Corporation, San Jose, CA
Sandy Loethen, Altera Corporation, San Jose, CA
Jum Vu, Altera Corporation, San Jose, CA
Robert Dinneen, C-Cube Microsystems, Milpitas, CA
Edel Young, Xilinx Inc, San Jose, CA
Mary O'Mally, Xilinx Inc, San Jose, CA
Isabelle McAndrews, Integrated Device Technology, Santa Clara, CA
Frank Weiss, Mountain View, CA
Michael Bak-Boychuk, Quirk & Tratos, Las Vegas, NV
Jeffrey Draeger, Intel, Santa Clara, CA
Martha Peralez, Intel, Santa Clara, CA
Peter Lam, Intel, Santa Clara, CA
Erin Williams, IPLG, San Jose, CA
Issac Winer, IPLG, San Jose, CA
Noel Hammond, Lariviere, Grubman & Payne LLP, Monterey, CA
Jurgen Vollrath, Arter & Hadden, San Francisco, CA
John N Greaves, Intel, Hillsboro, OR
James Whithers, Merchant & Gould P.C., Minneapolis, MN
Tong Wu, Merchant & Gould P.C., Minneapolis, MN
Ralph R Vesseli, LSI Logic Corporation, Milpitas, CA
Mark Matkin, Wells, St. John, Roberts, Gregory & Matkin P.S., Spokane, WA
Mark Porter, Mentor Graphics Corporation, Wilsonville, OR
Charles Quarton, Brinks, Hofer, Gilson & Gione, San Jose, CA
Larry Williams, Paten Agent, San Jose, CA
Edward B Weller, Limbach & Limbach L.L.P, San Francisco, CA
Eric Hoover, Limbach & Limbach L.L.P, San Francisco, CA
Robert McConnell, Limbach & Limbach L.L.P, San Francisco, CA
Michael Lynch, Micron Technology, Boise, ID
Alex Hsu, Excellerate.net, Pasadena, CA
Paul S Drake, Advanced Micro Devices, Austin, TX
Jonathan H. Schafer, Actel Corporation, Sunnyvale, CA
Kevin McAndrews, KLA-Tencor, Milpitas, CA
Scott Hewett, Santa Rosa, CA
Rolf Hille, Technology Center 2800, USPTO
Hiram Bernstein, Office of Patent Legal Administration, USPTO
Olik Chaudhuri, Technology Center 2800, USPTO
John Niebling, Technology Center 2800, USPTO
Carl Whitehead, Technology Center 2800, USPTO
Wael Fahmy, Technology Center 2800, USPTO
Sharlamar Taliaferro, Center for Quality Services, USPTO
Tom Thomas, Technology Center 2800, USPTO