

**From:** Tom Streeter [Target Technology] [mailto:tstreeter@targettechnology.com]  
**Sent:** Thursday, January 28, 2010 1:56 PM  
**To:** patent\_quality\_comments  
**Subject:** Request for Comments on Enhancement in the Quality of Patents, OG of January 5, 2010

My name is Tom Streeter, Reg. No. 32,007. I am employed in-house by Target Technology Company, LLC, of Irvine, California. These remarks, however, are my own and should not be attributed to my employer.

The three best ways to improve patent quality are to:

1. amend Rule 56 to require the disclosure only of "non-public" information;
2. regularly publish, by Group Art Unit (and by every entity having a customer number), the start date and filing date of the oldest pending application at each stage of the prosecution process; and
3. regularly publish, at the end of each stage, by Group Art Unit, the results of the review conducted by Quality Assurance, both:
  - a. the percentage of claims which were allowed and shouldn't have been; and
  - b. the percentage of claims which weren't allowed and should have been.

### ***Amend Rule 56***

Rule 56 currently requires an applicant to disclose all material information of which he is aware. Every search for public prior art, and especially every electronic search, therefore generates an avalanche of very-marginally-material references. All of these references must be disclosed to forestall the inevitable inequitable conduct charge if the patent is ever litigated. This avalanche buries the truly material references.

The applicant cannot safely even point out what he considers to be the Top Three or Top Twenty references. Inevitably, at trial, some reference which didn't make the cut will turn out to be important. The fact that it didn't make the cut will be held out as evidence of inequitable conduct. The fear of such *ex post facto* evidence will cause the truly material references to remain buried during prosecution.

Rule 56 should be amended to omit the requirement of disclosing references which the examiner could have discovered without ever having left the Office's campus in Alexandria. In the words of *Ex parte Tenney*, 254 F.2d 619 (CCPA, 1958):

A foreign patent file, laid open for public inspection, is not a printed publication, because typewritten, while a printed publication, available to the public only in a Southern Rhodesian library, would be.

Both the laid-open foreign patent file and the Southern Rhodesian publication (if the applicant is aware of them) should be required to be brought to the attention of the examiner in the amended Rule 56. Both are in some sense "public", but neither is in any meaningful sense discoverable by the examiner.

This is not the case with the ordinary search on Google, on the Web-based Examiner Search Tool (WEST), or on the Examiner Automated Search Tool (EAST). These are

the tools, in the hands of the examiner, which generate a meaningful search. These are the tools, in the hands of the applicant, which generate the Rule-56-driven avalanche of very-marginally-material references, an avalanche which destroys any meaningful survey of the prior art.

There will usually be some references which the applicant will want to ensure consideration of. These references may be voluntarily disclosed (both under Rule 56 as it is now written and under Rule 56 as it is proposed to be amended) in order to provoke a determination that the claims are patentable over them. However:

- Rule 56 should be amended to expressly allow the applicant to withhold these references if the examiner could have discovered the reference using only the Office resources available to him; and
- each voluntarily disclosed reference should be accompanied by a fee sufficient to cover the costs of an examiner reviewing a reference which he presumably would not have reviewed otherwise.

Otherwise, the avalanche of references will continue.

What should not be withheld are references cited in:

- a foreign (including PCT) prosecution of an application in the same patent family; or
- litigation involving a patent in the same patent family.

It should be mandatory to disclose a copy of every foreign office action, and of every court pleading or motion, which attacks the validity of any claim in the same patent family. It should further be mandatory to disclose the response to such attacks.

What also should not be withheld are references which are not, in any meaningful sense, "public": possible on-sale bars, possible public uses, PowerPoint presentations, laid open applications in Southern Rhodesia, and the like. If an examiner could not have discovered a reference using only the Office resources available to him, then it is not effectively "public", and it should be disclosed.

### *Metric*

The proper metric for determining the effectiveness of the rule change is how *few* the number of disclosed public references are in comparison with the number of other references. Disclosing only a few references indicates that the applicant is focusing his attack rather than launching a broadside against the prior art. In focusing his attack, he also reveals where the strongest prior art lies.

A reference is "disclosed" and "public", in this sense, if:

- the applicant discloses it to provoke a determination that the claims are patentable over that reference; and
- the examiner could have discovered the reference using only the Office resources available to him.

### ***Publication of Start Date and Filing Date***

The Official Gazette currently publishes, for each Group Art Unit, the *average* filing date of applications which have not yet received a First Office Action. This encourages examiners to work on the easy and fast applications, and to let the more difficult and

slow ones slide. This also allows a Group Art Unit to conceal its problem, and its need for additional resources, thereby perpetuating the problem.

The OG should return to its practice of publishing, for each Group Art Unit, the filing date of the *oldest* application (rather than of the *average* application) which has not yet received a First Office Action. This removes the incentive – indeed, the ability – to conceal problems. The OG should also return to its practice of publishing the name of the supervising primary examiner who heads each Group Art Unit. Nothing ever gets done until there is some one individual who is responsible for doing it.

The OG should not stop there. At every stage (second office action, third or subsequent office action, issuance of notice of allowance, issuance of patent, filing examiner's response of appeal, and every other stage) the OG should publish the "start date" of the oldest application which had not yet received the appropriate action for that stage by the Group Art Unit in question. The "start date" would be the date on which the stage began, that is, the date on which action was taken by the applicant (filing a response to the previous office action, or paying the issue fee, or filing an appeal brief, or the like).

The OG should also publish, for each stage, the oldest *filing* date for applications in that stage on which no action has yet been taken by the Group Art Unit in question. It doesn't do much good to measure only the pendency of "third or subsequent office action" if an application is subjected, seriatim, to a dozen such office actions. If the appropriate prior art can be determined and disposed of – whether by allowance or by final rejection – at an early time, then it will be determined exhaustively. With all of the prior art under consideration at the same time – and not spread out over several office actions and appeals – it will be considered better.

"Filing date" is easily determined for the first application in a patent family. Sometimes, however, a continuation or continuation-in-part will re-present, verbatim, a claim which was finally rejected in the parent application. In this case, the child application should keep the filing date of the parent application.

It is not enough to publish, as a raw number, the oldest application start date (and filing date) for a particular Group Art Unit. Is this number above average or below average? By how many standard deviations?

What's sauce for the goose is sauce for the gander. Every action by the Office starts a clock for the applicant. Publish the date of the oldest unresponded-to Office Action for every law firm and corporate patent department – indeed, for every entity which has a customer number. Publish the name of the senior attorney in each entity, just as the name of the supervisory primary examiner of each Group Art Unit is published. Publish how many standard deviations above or below the mean their numbers are.

Full implementation of this publication proposal will substantially increase the size of the OG. Publication on the Office's website might be logistically preferable.

### *Metric*

A short oldest-pendency-in-stage encourages – both for examiners and applicants – prompt processing through that stage. A short oldest-pendency-since-filing encourages – both for examiners and applicants – early consideration of all of the prior art.

### ***Publication of Quality Assurance Results***

At the end of each stage of the examination process, Quality Assurance spot-checks applications for:

- a. the number of claims which were allowed and shouldn't have been; and
- b. the number of claims which weren't allowed and should have been.

It is important that four results be published for each stage, for each Group Art Unit:

1. The total number of claims, for all applications, reaching the end of that stage (subdivided into total allowed claims and total rejected claims).
2. The percentage of claims, for all applications, sampled for review Quality Assurance (subdivided into percentage of sampled allowed claims and percentage of sampled rejected claims).
3. The percentage of sampled claims allowed in error and the percentage of sampled claims rejected in error.
4. How many standard deviations each of the foregoing percentages is above or below the mean.

Once the numbers are published, an informed debate can proceed about:

- which Group Art Units are too lenient and which are too strict;
- where Quality Assurance is oversampling and where it is undersampling; and
- which Group Art Units have "high" error rates and which Group Art Units have "low" error rates. Both Type I errors and Type II errors should be considered, although perhaps not merely summed.

Until the numbers are published, however, the debate will proceed in a vacuum, and nothing will be accomplished.

Respectfully submitted,  
Tom Streeter