

Congressional Testimony Echoes POPA Petitions and Survey

Patent Community Joins Examiners in Opposing Search Outsourcing

The day after more than 1,000 patent professionals began signing a petition urging “Congress to ensure that the prior art search remains part of our examination duties,” members of the patent community testified to Congress about their serious concerns and opposition to outsourcing the prior art search.

The following week POPA delivered the petitions, its own written testimony and the results of a POPA membership survey on the USPTO 21st Century Strategic Plan to the same House subcommittee that held the hearing.

POPA took the petitions—signed by 1,080 patent examiners or nearly one-third of all examiners—to the House Judiciary Subcommittee on Courts, the Internet, and Intellectual Property on July 25. In addition to asking for congressional action, the petition stated, “It is our

experience that searching the prior art is an integral and inextricably linked part of the patent examining process and cannot be separated without significantly reducing the quality and efficiency of the U.S. patent system.”

Many, including POPA, who commented to the House subcommittee on the USPTO plan criticized many facets of the agency’s “reform” and fee schedule adjustment.

“It seems to me that conducting thorough searches is an integral part of the PTO’s examination role,” stated Rep. John Conyers (D-Mich), a member of the subcommittee.

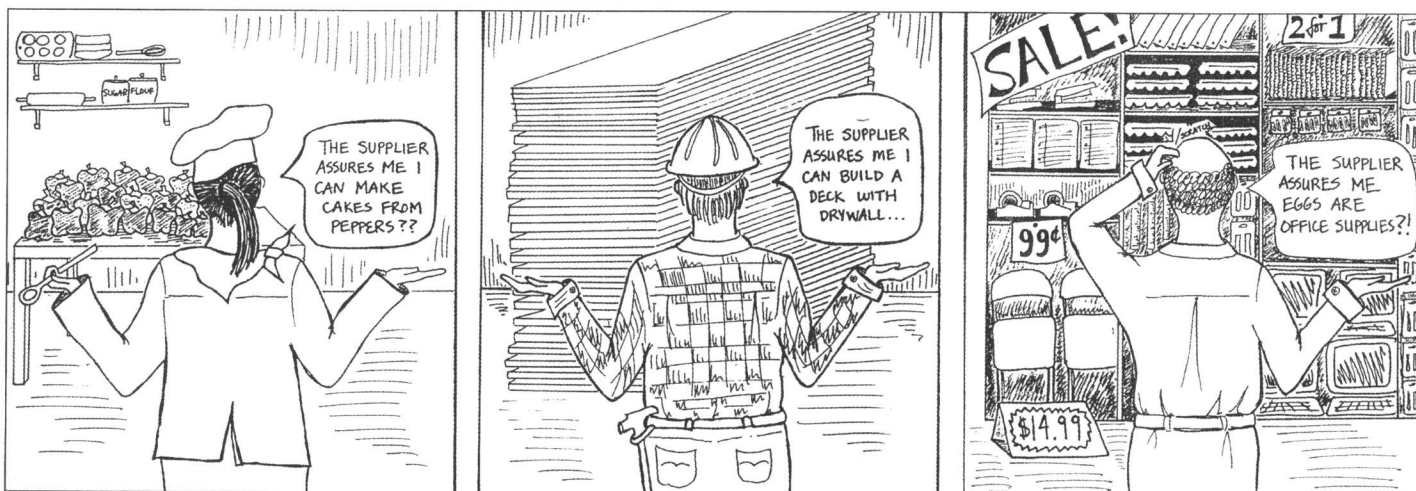
Charles P. Baker, chair of the American Bar Association Section of Intellectual Property Law, stated emphatically that “the search is part of the examination, and if the examiner does not do the search, it will not be done as well, which
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POPA Continues Campaign for Work at Home

POPA in July delivered to key members of Congress more than 1,000 patent professionals’ signatures on a petition asking Congress to urge the USPTO to reinstate the Work at Home telecommuting program. POPA also handed over the results of membership surveys on Work at Home issues and the commuting patterns of Work at Home participants, both of which support the union’s position.

The petition and survey results had an impact on Capitol Hill. Subsequent calls from congressional offices to senior USPTO officials likely helped prompt USPTO

Director James Rogan to comment to POPA that he is committed to a “permanent” and “expanded” Work at Home program. Rogan said that when he was a congressman he had voted for Rep. Frank Wolf’s telecommuting law, which states that 50 percent of all eligible federal employees should be offered the option of telecommuting in 2002. POPA is optimistic that the director’s commitment will fuel productive negotiations to reinstate a permanent program.
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An examiner with no control of the search is like a chef with no control of the ingredients. Could others do business as the USPTO proposes?

POPA Survey on Restructuring

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would weaken the presumption of that validity.

"That presumption gives certainty to U.S. patents, and without a reasonable level of certainty, investors will not invest to develop new technology and create new jobs," said Baker. "The best testament against separating the search function and an examination function is the fact the European Patent Office, which has had such a system for years, has recently decided to abandon it."

POPA stressed that search and examination are "sovereign functions of the United States." If examiners have to rely on foreign patent office search results as the basis for patentability determinations, then a U.S. sovereign function "has been indirectly delegated to a foreign power."

While the Intellectual Property Owners Association commented, "We do not oppose separation of search and examination if such separation can pass the quality, speed, and cost effectiveness filters," the IPO added, "To permit the applicant to work with a private company in determining the nature and scope of the search to be performed could create opportunities for manipulating the system that would diminish the level of public confidence in patents and increase patent litigation."

POPA commented that the agency's proposed quality initiatives are "designed to increase control rather than enhance quality." The union stated that the idea of recertification testing "is not the accepted way of maintaining professional standards in the private sector and neither should it be at the USPTO."

While requiring continuing education credits for continued professional accreditation is standard, continued testing is not. "No amount of review or automation can ultimately improve patent examination without first providing examiners with the necessary time and resources to properly do the job," stated POPA.

"Unless examiners are given the additional time commensurate with the Agency fees for additional examination services," added the POPA testimony, "both existing and proposed fees for additional claims and other services represent nothing more than another hidden tax on inventors rather than a payment for examination services rendered."

Forceful Survey Comments

Many POPA members added written comments to their surveys about the agency restructuring:

- "What if we know of a better reference? Do we use it or look the other way?"
- "...the only time an examiner relies mainly on the IDS is when they don't understand the invention well enough to formulate their own queries that go beyond the literal words of the claims."
- "While searching I read and become familiar with references and formulate my rejection."
- "If the strategic plan takes effect I will probably look for another job. The stress of trying to do quality work with

The results of POPA's July 17 membership survey, in which 55 percent of the membership participated, strongly backed the union's position on the USPTO restructuring plan:

1. Do you believe examiners can issue valid patents and protect the public from unwarranted patents without doing the search themselves or having the search under their control?

- Yes—5%
- No—95%

2. Do you believe that if search and examination functions are separated, overall quality will go up or down?

- Quality will go up—1%
- Quality will go down—96%
- Quality will stay the same—3%

3. Do you think the responsibility for doing the search should be placed under the control of the applicant?

- Yes—4%
- No—96%

4. Do you believe that the private sector should be in charge of the classification schedule for the patent system?

- Yes—3%
- No—97%

5. In new applications where an IDS (information disclosure statement) is filed, approximately how often do you need to apply additional references when making a rejection in the application?

- almost all the time—74%
- most of the time—17%
- some of the time—7%
- almost never—2%

6. Do you trust management to objectively re-certify the competence of primary examiners?

- Yes—7%
- No—93%

7. In new applications containing foreign search reports, approximately how often do you need to apply additional references when making a rejection in the application?

- almost all the time—69%
- most of the time—22%
- some of the time—7%
- almost never—2%

insufficient hours per case is too much."

- "The greatness about the USPTO is our classification system. It is essential to searching."
- "More examination time is required to both improve quality and pendency. If people have more time per case, first actions will be of better quality, resulting in fewer actions per disposal, ... shorter overall pendency..."
- "If the applicant is required to contract a search, demand for searchers will increase and examiners may very well leave the Office to become highly qualified, in-demand public searchers."
- "This survey uses questions that appear to be very loaded."
- "Being recertified is insulting. Any 'problem' examiner would be uncovered by the review process already in place. ... People should be given a chance to attend refresher courses to correct their deficiencies."
- "Most patent examiners take real pride in doing a good and useful job. This will no longer be possible." ▼

