

Carlyle Move Deja Vu

USPTO employees who moved to the new Carlyle campus six months ago are packing up their offices to move again, some even within their own building. The agency hasn't provided any meaningful explanation as to why it didn't foresee the need for this costly and disruptive second move.

Precipitating this office shift is the major move of 200-250 employees in Tech Center 2600 from Crystal City to the Jefferson Building at Carlyle. To make room, the agency is uprooting and relocating approximately 400 professional staff already in Carlyle, packing a larger number of employees in the same amount of space, causing crowding and much frustration.

Some of the needed space to house the incoming employees is being taken from areas now used by technical support staffers, who have voiced disappointment that they're being removed from offices and placed in open areas. As initially assembled, their new workstations provide no privacy. The agency has said that it is purchasing privacy panels and that the workstations will be converted to cubicles.

The open areas occupied by the technical support staff were previously used for examiner search files. These areas were made available by moving the search files to the concourse—or basement—level, making their use by examiners more difficult. To compensate for the extra time necessary to

travel to the files, examiners are entitled to receive up to an hour every second biweek.



Domino Effect

Complicating the process is the USPTO's preference for the practice of locating all employees within an art unit in close proximity to one another. This practice made sense when examiners used only paper files and didn't have e-mail and electronic file sharing, but it's not required in today's workplace. Some art unit supervisors and managers already have set a precedent by suc-

cessfully operating with their art units split between floors, in both Crystal City and in Carlyle.

Insisting on locating art units together exacerbates the domino effect begun by crowding and displacing employees in some offices. The groundless requirement to keep art unit

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Post-grant Opposition: Getting It Right the Second Time

The USPTO count system so compromises patent quality - by rewarding "overburdened" examiners for granting patents - that only patents that have undergone the opposition process should be presumed valid, according to congressional testimony by Google legal counsel in June.

"There is general agreement that patent examiners need more time to examine applications," stated Karl Sun, patent counsel for Google, Inc., before a hearing on post-grant review by the House Judiciary Subcommittee on Courts, the Internet and Intellectual Property. "Current estimates for the total time an examiner spends per patent application from start to finish range from 8 to 25 hours on average. Moreover, patent examination is conducted as an ex parte process between an examiner and an applicant, with no third party involvement. Finally, examiners are rated according to a

'count' system that creates incentives for granting patents. Patents which are issued by an overburdened PTO without inter partes safeguards as to quality should not be accorded a presumption of validity by the courts."

As one of his proposed remedies, Sun proposed that Congress "increase funding for the PTO so that examiners' workloads may be reduced to allow an adequate amount of time for considering patent filings." He also recommended that the USPTO count system be modified "to remove artificial incentives to grant patents. ...A system that provides neutral incentives with respect to allowance versus rejection should be implemented."

Members of Congress and other witnesses at the hearing spoke in favor of revising the current ex parte and inter

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employees together is forcing some examiners to pack up and move just for the sake of maintaining art unit proximity.

The USPTO's allocation of window offices among the Carlyle professional staff also has created the perception of arbitrariness and unfairness. The Carlyle buildings have fewer window offices available for professional, non-management staff compared to the Crystal City buildings that were vacated. With more outside offices in Crystal City, a larger percentage of primary examiners got window offices, including all senior primaries.

At Carlyle, some art units with more senior primary employees will find that they haven't enough window offices for them all, while art units with fewer primaries will be able to place a junior primary examiner in a prime window office. This creates the impression of unfair treatment among the more senior employees.

Separating art unit members, in some cases moving them to other floors—or leaving some while moving others, would enable the agency to assign window offices on a seniority basis across art units within a building. This generally creates no hardship because examiners consult easily via phone and e-mail and share documents electronically.

However, the agency's lack of foresight is now water under the bridge. These problems can be solved through a common-sense approach of working with employees to determine their preferences, according seniority its due, and spending a little extra time on planning to create the least disruption.

A new plan would give priority to placing the most senior employees building-wide in window offices and cut down on the number of office moves. The USPTO can achieve this parity by ending the goal of keeping individuals in art units all together.

The USPTO's quick resort to high-density office usage within the examining corps in Carlyle indicates that the agency will either soon exceed its promised limit of 7,100 employees and contractors at Carlyle or that it plans to build very spacious offices for nonexamining employees at the yet-to-be completed Madison Building, or both.

"Proximate" Technical Libraries?

The USPTO is reneging on its own proposal in its agreement with POPA to place technical center libraries "proximate" to the technical center offices being served.

In the design area, more than 80 professionals are moving from the second floor of the Jefferson Building to the fifth floor of the Remsen Building. The design library, which had been with the design examiners on the second floor of Jefferson, is being squeezed into the first floor of Remsen within the biotech area library.

"Proximate," by most dictionary definitions, means adjacent, nearby, adjoining or contiguous—not four floors away. When a reference library is proximate it is easier to use, and therefore employees are more likely to use it. If it is too difficult to get to and use, then they won't. This will have a subtle, negative impact on quality. ▼

Getting It Right *(continued from page 1)*

partes procedures to allow post-grant opposition. Rep. Rick Boucher (D-Va.) called the inter partes reexamination process "a white elephant" that few use because of its limitations and called for "a more meaningful process."

USPTO General Counsel James Toupin noted in his testimony that during the nearly five years that the process has been available, inter partes reexamination has been requested only 46 times.

Under current law, reexamination does not permit cross-examination of witnesses or discovery, yet it makes the result of the process binding on the initiating third party. Because it's binding, the third party deserves those recourses.

Michael Kirk, executive director of the American Intellectual Property Law Association, cited the National Academy of Sciences report earlier this year that recommended the creation of an "open review procedure" to provide "more timely, lower cost, and more efficient review of granted patents."

Kirk outlined the AIPLA proposal for creating a new post-grant opposition process, including:

- Allow opposition requests only within nine months post-issuance.
- Identify the real party of interest, but allow its name to be kept confidential until justice and fairness require disclosure.
- "Front-load" the requester's evidence supporting the opposition to expedite proceedings.
- Allow the patent owner to respond with evidence and amend the claims at least once.
- Limit discovery to cross-examination of affiants, but allow broader use exceptions in the interests of justice.
- Limit review time to one year, start to finish, but allow extensions to no more than 18 months in appropriate cases.
- Allow for oral hearings, brief filings, reconsideration, and court appeal by all parties to the opposition.
- Bar later inter partes reexamination by the opposer and concurrent reexamination proceeding until the opposition terminates.

Kirk cautioned that adopting any post-grant opposition system "would be of limited value unless the necessary resources are dedicated to its implementation." He cited that the European Patent Office (EPO) granted 59,992 European patents in 2003 with 2,634 patents, or approximately 4.4 percent, opposed. Using the same percentages, the USPTO's 189,597 allowed patents in 2003 would translate into over 8,000 oppositions. With 900,000 patents issued in the last five years, the number of oppositions could create a huge initial load that could require massive expenditure of agency resources to manage. Even a much reduced U.S. percentage would create a flood that would overwhelm the USPTO Board of Patent Appeals and Interferences.

If the USPTO were to reallocate its funds significantly to bolster post-grant opposition instead of increasing time for examination, it would be banking on getting patent quality right only the second time around. Absent changes

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