



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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January 29, 2007

Douglas Patton and W. David Westergard
Members
Patent Public Advisory Committee of the United States Patent and Trademark Office

Gentlemen:

In response to the invitation in your letter dated January 19, 2007, the American Intellectual Property Association (AIPLA) is pleased to have this opportunity to clarify its views on potential changes to USPTO operations and procedures relating to revising recruitment, retention and examiner training policies; establishing regional offices; outsourcing searching functions; and, creating a "suite of examining products" as well as to offer new ideas.

AIPLA is a national bar association of more than 17,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. As such, our members represent both owners and users of intellectual property.

We note first that your letter requests our response no later than Monday, January 29, 2007. While this is not much time to reflect upon the issues raised and to develop and offer additional ideas, we have considered some of the issues you raise in your letter. We did this in conjunction with the request for comments on the USPTO's "Draft Strategic Plan for FY 2007-2012" published on August 24, 2006. In response to that request AIPLA did submit detailed comments to the USPTO on October 6, 2006. A copy of our comments is attached.

Our comments make it clear that we believe that the USPTO should have broad latitude in internal management matters, and that we would support related initiatives having clear goals and which have been proven effective through successful pilot programs. AIPLA believes that the quality and pendency problems confronting the USPTO cannot be addressed through proposed rule changes that seek to offload responsibility to patent applicants without, at the same time, addressing the adverse consequences that would result. Applicants want strong patents that will withstand later challenge when they are enforced. To that end, applicants would be prepared to work with patent examiners, but only if the Damocles sword of inequitable conduct is addressed. Without safeguards against this plague, applicants will not willingly step forward to cooperate with examiners and place their clients' rights in jeopardy.

The only real solution lies in continuing the current aggressive hiring and training program on which the Office has embarked. It took a decade of under-funding for the Office to sink to its current depths, and it will take a comparable period to climb out. There is no easy fix.

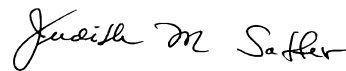
To the extent that the USPTO is experiencing difficulties in hiring and retaining the numbers and quality of examiners it needs, we reiterate our suggestion that the Office seek the necessary amendments to Title 5 USC to remove the limitations of the civil service salary structure so that the USPTO could offer patent examiners the type of compensation plans that attract and keep qualified examiners. We applaud the Office for searching for innovative solutions which hold real promise for long term fixes. One example is the proposal to try a regional office in western half of the country where the quality of life is higher and the cost of living is lower than the Washington, D.C. area. This concept should be piloted to see determine if it could offer part of the solution.

Regarding outsourcing of searching functions, AIPLA is particularly concerned that any outsourcing of USPTO responsibilities be done only in a manner that assures that patent applicants, who depend upon Office expertise, receive high quality work products. Consequently, we believe that outsourcing to non-governmental organizations must not take place until the quality of the resulting work product is fully proven by pilot studies as specifically provided by 35 USC 41(d)(1)(E). Furthermore, no outsourcing of searching functions should be undertaken unless high quality results are received which are accepted and employed by the examining corps. Outsourcing provides only the illusion of increased internal efficiency if the results are then ignored by the corps and duplicated during examination, as currently occurs, for example, with international searches.

Regarding the adoption of a "suite of examining products," AIPLA strongly opposes the proposals that have been advanced to date by the Office for this concept. Our specific objections are set forth in the attached comments but, in general, we would point out that many of the proposed tracks have been tried and demonstrated to be ineffective, and others raise serious problems with respect to their substantive effect and the implicit discrimination among applicants. While we stand ready to evaluate and comment on other specific proposals along this line, we believe that a unitary system of patent examination has served this country well and continues to provide the best balance of protection for applicants and third-parties alike.

Again, we appreciate the opportunity to provide information to the USPTO through the PPAC. We want to work with the USPTO as a partner to improve the patent examination process. We hope the comments above along with those set forth in the attached letter will contribute to this goal.

Sincerely,



Judith M. Saffer
President
AIPLA

Attachment:
As noted.



comments-uspto.pdf