

January 30, 2012

Azam Khan
Deputy Chief of Staff
United States Patent and Trademark Office
Mail Stop Office of Undersecretary and Director
P.O. Box 1450
Alexandria, VA 22313-1450

Email: satelliteoffices@uspto.gov

Re: Request for Comments on Additional USPTO Satellite Offices
for the Nationwide Workforce Program 76 Fed. Reg. 73601, 11/29/2011

Dear Mr. Khan:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the “Request for Comments on Additional USPTO Satellite Offices for the Nationwide Workforce Program” as published in the Federal Register (76 Fed. Reg. 73601) on November 29, 2011 (the “Notice”). The Notice is directed to gathering information on potential locations for future U.S. Patent and Trademark (USPTO) satellite offices that the USPTO is directed to establish, subject to available resources, under Section 23 of the America Invents Act (AIA).

AIPLA is a U.S.-based national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property.

The Notice requested input on a number of questions, including establishing satellite offices that will:

1. Increase outreach activities to better connect patent filers and innovators with the USPTO,
2. Enhance patent examiner retention,
3. Improve recruitment of patent examiners,
4. Decrease the number of patent applications awaiting examination, and
5. Improve the quality of patent examination.

Given the geographic diversity of AIPLA's membership, we are not suggesting any particular locations for new satellite offices, but rather are providing certain suggestions and issues to consider in selecting and establishing sites for the satellite offices.

If the satellite offices are spread out over multiple time zones, the USPTO should consider the impact this time difference may have both to the internal functioning and interaction of the various offices and to applicants also spread out over multiple time zones. Such considerations include training, supervision, oversight and mentorship of the workforce at the new satellite offices, public accessibility to these offices, as well as fostering effective interactions among examination staff both within particular locales and across geographic boundaries.

Given the need for a well-educated workforce in enhancing high quality examination, the USPTO should consider not only the need to ensure that requisite talent can be hired for the particular locations, but also the need to retain such a workforce. In regard to the latter, consideration should be given to local availability of continuing technical and legal educational opportunities, including part-time and evening programs in technical fields as well as law schools, especially those with emphases in intellectual property, contract, and business law. Also, in view of the USPTO's recent efforts to include hiring experienced practitioners, locations having a significant number of registered patent attorneys and agents may be helpful to consider.

Locations having existing Federal Centers that can either accommodate additional federal employees or provide administrative support services for the USPTO satellite office may be a helpful factor to consider. Selection factors should focus on locations where it is highly desirable to live and work, where the cost of living is not excessive, and where the locale supports nearby high technology centers.

Consideration should be given to the logistics of effectively and efficiently running the new satellite offices, as well as the impact on applicants. For example, in assigning patent applications to particular examiners, the USPTO should consider continuing to assign patent applications for examination based, in significant part, on an examiner's technical and experiential "specialty" rather than geographic location *per se*. A distributed workforce could disperse patent applications directed to similar technologies and decrease both quality and consistency. In addition, the USPTO should endeavor to minimize redundancy when dispersing examiners across geographic boundaries, potentially diluting expertise and experience.

Given the long history of in-person interviews and their capacity to aid in efficient and effective prosecution, the establishment of new satellite offices should include reasonable and effective alternatives to requiring applicants to travel to multiple, diverse sites for in-person interviews. Potential solutions to address the challenges for improving in-person interviews include establishing and enhancing state-of-the-art video conferencing capabilities between the applicant's office site and the examiner's office. Desirable video conferencing or equivalent capabilities may also include the ability for multi-party participation.

Alternative staffing models also should be considered. Rather than dispersing the examining corp(s) *per se*, dispersing other functional or administrative divisions may be desirable. For example, placing administrative functions such as finance, document scanning/EFW preparation, or IT staff in satellite offices might be preferable. Also, units that do not directly or regularly interact with the public might be well suited to a distributed workforce including, *inter alia*, the Office of Quality Review, legal administration, or members of the Board of Appeals.

Given the inherent uncertainty in considering and addressing the issues raised above, as well as other criteria raised in the Notice, we suggest strictly limiting the number of satellite offices to the number that the AIA requires. Over time, experience gained from the satellite offices can be used to improve the scope and operation of the satellite offices.

Thank you for allowing AIPLA the opportunity to provide comments on this important initiative.

AIPLA looks forward to further dialogues with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,

A handwritten signature in black ink, appearing to read "William G. Barber", with a long, sweeping horizontal line extending to the right.

William G. Barber
AIPLA President