

LITIGATORS CORNER:

What's Wrong With the Patent Office?



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In other columns, I've written about the unreasonable financial constraints on the Patent Office, which has lost funds meant for its operation because of diversions by Congress to other programs and agencies. But loss of money is not the only problem our Patent Office faces. Another equally serious problem is that an appreciable number of its examiners seem unable to do their jobs in a professional manner. Yet these folks are still there.

This is not meant to be a diatribe against the Patent Office, or against any individual person. There are, I am sure, many fine examiners; I spoke to one yesterday who has been consistently courteous and professional. But, unfortunately, there are also many bad examiners, and I want to describe a couple of them to you today, removing the names to protect the not-so-innocent. My experiences make me wonder why the Patent Office seems unable to do

something about those examiners who are not qualified to do their jobs.

The two problems I would like to address today are some examiners' lack of communication skills and their lack of familiarity with, and inability to follow, the rules.

Good communication skills are as important for a patent examiner as sharp eyes are for a pilot. Would you willingly get on an airplane piloted by someone with glasses having lenses that look like the bottoms of Coke bottles? Of course not. Similarly, communicating — orally and in writing — is essential to effective patent prosecution. Yet these very skills are sorely lacking in some examiners. Too many do not speak English well, and still others write poorly.

One experience occurred in the middle of a lawsuit involving two patents, both concerning relatively simple electronic devices. As intellectual property attorneys know, almost all communications with the Patent Office are written. Therefore, clear writing is essential. A reasonable vocabulary, and the ability to spell, are prerequisites to good writing, but are not all that is required. A person must also be able to read, and to construct a coherent sentence. Beyond the ability to read and write, examiners must understand the basics of patent law, and the special requirements of reexaminations.

In both of the reexaminations in our lawsuit, these examiner skills were missing. Neither of the reexaminations was conducted by an examiner who had an adequate command of written English, even though both examiners are native-born Americans. Both routinely left necessary words out of their sentences, and erratically omitted punctuation marks. Perhaps this was their way of achieving brevity. I don't know who types or who proofreads documents in the Patent Office; in the case of these examiners, I suspect the answer to the latter question is "no one." The examiners' writing would not have gotten a C in fifth grade English.

One examiner kept giving us erroneous figure references and page numbers for an article he was using to reject the claims as obvious. He repeatedly made such errors. The examiner referred to two patents by the same inventor by using only the inventor's name, without following that with the last three numbers of the patent. It is hard to imagine a more basic convention among patent lawyers and examiners than the "Jones '123 patent." Yet this examiner was too dull or too inattentive to do his job correctly. He had the Patent Office translate a Japanese patent, used it as a basis for his rejection, and then forgot to attach it to his office action.

We tried hard to avoid mentioning the errors because we were concerned that the examiner would be offended. Finally, though, we had to tell him that our ability to understand his arguments was adversely affected, because we simply could not follow his reasoning with certainty. The examiner reacted badly, and gave us the back of his hand. I quote him here exactly as he responded:

It is clear that the examiner cannot match the eloquence and clarity of applicant and his representatives. However, it is the references their teaching and their application which will carry the day and those alone will in the end determine the patentability of the claims.

This paragraph followed a sentence that said: "The examiner has not address each limitation in his remarks but such is not required." Lots of pique, but certainly little clarity from this examiner.

Nor would either examiner give proper weight to a declaration; indeed, one of them simply ignored a declaration, even though Section 716 of the Manual of Patent Examining Procedure (which these examiners appear to have re-titled "Book of Rules to Be Ignored") requires that a declaration must be "acknowledged and commented upon in the next succeeding action," and that declarations "should be scrutinized closely and the facts presented weighed with care." In our appeal brief, I quoted this examiner:

To assert that the Sweeney [sic] declarations have not been considered is not based on fact. Theses [sic] declarations were addressed in the previous actions. The examiners [sic]

"I know I should have called sooner, but..."



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position on the two Sweeney [sic] declarations has been established in the previous rejections.

The second Supplemental declaration of Sweeney [sic] filed with paper number 23 does not convince the examiner. Paragraph 3 is a mere opinion and not fact. The examiner does not agree with this "opinion." The declarant [sic] does not address the combination of claim limitations but rather the individual limitations.

As you can see, this examiner could not even misspell the inventor's name consistently.

In addition, neither examiner properly applied the test required for obviousness. To be fair, it is a tough test, one that lawyers and judges often don't apply correctly. But the law does require the test, and examiners should be good at it. Claims of the application in question cannot be used as a blueprint to find prior art. *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 2d 543, 551 (Fed. Cir. 1985) (improper to use claims as a frame, and use individual parts of prior art as a mosaic to recreate a facsimile of the invention). One of the Panduit cases says that "virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior

patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103."

But that is exactly what both of the examiners did. In granting the reexaminations, each slavishly adopted, even in the same order, the arguments of the requestor (the defendant in our lawsuit). The same non-thought was applied in the first office action.

Neither examiner adhered to the statutory requirement of special dispatch for reexamination proceedings. Section 305 of Title 35 governs the conduct of reexamination proceedings: "All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." Section 1.550 of Part 37 of the Code of Federal Regulations says the same, adding that the patent owner is to be allowed at least thirty days to respond to any office action. Section 2254 of the Manual of Patent Examining Procedure quotes both the statute and the regulation.

Quite unfortunately, there are no time limits imposed on the Patent Office for issuing an office action. There is a statutory requirement setting a three-month deadline for the Patent Office's decision whether to grant a request; see Section 303. Perhaps the examiners' workloads made compliance with the statute, regulation, and MPEP

impossible, but I don't think so. One reexamination required three years from the filing of the reexamination request until the reexamination certificate was issued. The other reexamination took over five years. In each case, the examiner routinely took as much as six or nine months to issue a new action after receiving a response. In one of the reexaminations, the decision granting the reexam was in August, 1995. But the examiner could not get off his duff and provide his first office action until June, 1996 — more than ten months later. That is why I laugh when I read, as I did today, that *inter partes* reexaminations will be very efficient, taking only about twenty months to complete. In both of our reexaminations, however, we were required to respond to any office action within thirty or sixty days. The rules were one-way.

I guess I am griping. But I was taught that knowing and following the rules and reading and writing were essential skills in life. In the Patent Office, they are even more important, because we are dealing — or perhaps trifling — with important intellectual property whose use can have great effects. It is not too much to expect examiners to have the basic tools, and those who do not should not be there. If this is what happens in reexaminations, I say no thanks, they aren't worth it. **IPT**