INTRODUCTION

My testimony is based upon my over 33 year career at the U.S. Patent and Trademark Office (“PTO”) and my subsequent nine years in private practice as a patent attorney. I am aware of the recent allegations of patent examiners abusing the current telework program. As developed below, I believe we should take this opportunity to evaluate and strengthen this valuable program to avoid future abuses and to make it as robust as possible. In so doing, I will explain that, while not condoning abuse, the historic and current “compact prosecution” patent examination system and the manner in which patent examiners productivity is measured create an atmosphere which can foster and present the opportunity for patent examiners to inadvertently or purposely abuse the system. In addition, I will set forth constructive suggestions on how the telework program can be strengthened as well as to how the historic compact prosecution system and examiner count system urgently needs to be modernized. Modernization of compact prosecution and the examiner’s count system will significantly increase patent quality and lessen pendency.

PERSONAL BACKGROUND

I joined the then-Patent Office in September of 1972 fresh out of engineering school. I progressed through the ranks and achieved the rank of Primary Examiner in 1972. Prior to becoming a Primary Examiner, I was awarded a Master’s Level Ranking in the art area for which I was principally responsible—Papermaking. Subsequent to becoming a Primary Examiner, I achieved a Generalist Rating which is indicative of being able to capably examine patent applications in diverse art areas.

1 Mr. Smith is Of Counsel for Baker & Hostetler, LLP. The views presented herein are those of Mr. Smith and are not to be attributed to the firm or to the firm’s or his clients.
I was appointed as an Administrative Patent Judge (“APJ”) on the now Patent Trial and Appeal Board. I served in that position until my retirement from the PTO in December 2005. Upon retirement, I transitioned my career to the private sector, first joining Clements Bernard, an IP boutique in Charlotte NC, and then Woodcock Washburn LLP, another IP boutique, which merged into Baker Hostetler on January 1, 2014, where I am now employed.

During my service in the private sector, I have prosecuted many patent applications and interacted with many patent examiners. I have many friends from my days at the PTO that I keep in touch with and keep up to date on issues that involve the patent examining system and patent examiners. I am also active in AIPLA and IPO and have served as Vice Chair of the IPO U.S. Patent Office Practice Committee since 2009. I give CLE presentations to various IP associations and bar groups around the country and interact with the attendees to find out how satisfied they are with current state of the patent examination system.

I lived in South Carolina my last year of service as an APJ and telecommuted to the PTO Alexandria Campus at my own expense. The telework plan I was under required me to be physically in my Alexandria office 16 hours a week. Subsequently, I have been a teleworker at each of the law firms for which I have worked.

I believe my work and telework experience inside and outside the PTO provide me with a relevant background to testify regarding today’s issues.

HISTORIC PTO WORK SCHEDULES

Like most federal employees, the patent examiners’ work schedule involves the two week pay period or bi-week. Each patent examiner is expected to be working for 80 hours each

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2 This and the following sections on compact prosecution, the patent examiners’ count system and supervisory review of patent examiners’ work product are meant to be a high level view to provide a background for the subsequent discussion of the issues at hand.
bi-week and during the bi-week fills in a time and attendance report to account for activities performed each day and/or being on approved leave status. When I joined the PTO in September 1972, the patent examiners worked an 8.5 hour day from 8:30 am-5:00 pm, Monday-Friday with 40 hours worked in each week of the bi-week. When paid overtime was authorized, patent examiners could work on Saturdays. There were no sign in sheets for attesting to the hours worked each day.

The PTO initiated “flex time” in the 1980’s which allowed the patent examiners to work alternative work schedules. The work day hours were expanded to 6:30 am-6:00 pm. In time, patent examiners could sign up for work schedules that allowed them to work more than eight hours a day with the extra hours being credited to a flex day(s) off in the same bi-week. Sign in sheets were placed in the reception area of each Technology Center where the patent examiners were expected to attest to their work hours by signing in and out on an honor system.

Flex time turned into a telework program where patent examiners were authorized to work from home for at least a portion of the 80 hour bi-week. As the PTO hired large numbers of patent examiners in the last decade, space in the Alexandria campus became limited. Thus it behooved PTO management to implement a more robust telework program to relieve the strain on space. As understood, the telework program started out as a hoteling program where the patent examiners could work some hours at home but were required to be at the Alexandria headquarters for a defined number of hours. In time, the requirement to be at the Alexandria headquarters was removed and the patent examiners were allowed to move to any location in this country with no requirement to be at the Alexandria campus or any of the new regional offices for any specific time period.
COMPACT PROSECUTION

The U.S. patent examination system has been operating under the tenets of “compact prosecution” for over 40 years. Prior to the advent of compact prosecution, the productivity of patent examiners was measured by the number of office actions they mailed each bi-week without regard to how substantive the underlying work product was. Thus, a patent examiner could be perceived as being “productive” by issuing meaningless office actions that kept the case moving in a non-substantive manner. That system measurably increased the pendency of patent applications as it could be months or years after a patent application was first taken up for action before a serious conversation between the patent examiner and applicant occurred.

Compact prosecution was introduced in the late 1960’s-early 1970’s. The main tenet of compact prosecution is that, after the first exchange of a rejection from the patent examiner and response from applicant, if the case is not allowed, the second office action will normally be made final. Applicant’s response to a final rejection is not entered as a matter of right and is entirely within the discretion of the patent examiner. Prior to the introduction of the Request for Continued Examination (“RCE”)3 program in 1999, applicant’s options upon receiving a final rejection were to file a notice of appeal of appeal, final abandonment of the application or resume prosecution by filing a continuation or divisional application with the subsequent abandonment of the first application. Importantly, each continuing or divisional application received a new application number and counted as separate new application for certain statistical purposes including measuring patent examiner productivity. Thus, the PTO’s bookkeeping was nice and tidy in that the agency could document pendency per application and once the tenets of compact prosecution kicked in, the PTO could correctly proclaim that pendency per application had been reduced. However, missing from the PTO’s analysis was

3 An applicant files an RCE simply by filing a request therefore with the appropriate fee in a patent application. In essence, applicant is paying to reopen prosecution, i.e., remove the finality of the previous rejection so that prosecution can be resumed in the same application.
the understanding that compact prosecution did not necessarily reduce the time it took for the patent examiner to resolve the patentability of the claims under review, only that the examination process was now spread over many individual cases of shorter duration instead of a single application that had a long pendency. This was the beginning of the patent examiner’s duties being viewed as piece work instead of a continuous conversation with applicant to find patentable subject matter.

Compact prosecution did not change when RCEs came into inception in 1999 in that the second office action was still expected to be a final rejection, thus interrupting the flow of the case, despite the new program that allowed “continued prosecution.” However, the PTO did have to change the patent examiner count system to take into account that the patent application was not actually abandoned when an RCE was filed, just that the RCE reopened prosecution in the same application. RCEs were initially docketed as an amended case, as in fact they are, which meant the case had to be picked up for renewed consideration by the patent examiner within two months of filing.

THE PATENT EXAMINER COUNT SYSTEM

With the advent of compact prosecution, the examiner’s productivity metrics were changed. Each patent examiner was assigned a “balanced disposal” time goal, termed hours per balanced disposal. Balanced disposals in a given time period were determined by adding the number of new patent applications initially examined on the merits by the examiner with the number of cases disposed of by way of an allowance or abandonment of a patent application or the writing of an Examiner’s Answer in a case that was appealed during the relevant time period and dividing the sum by 2. The time aspect of the goal was determined in the late 1960s and early 1970s and is meant to represent the average amount of time the patent examiner is
expected to spend from the time the case is first taken up for review to its final conclusion of allowance, abandonment or appeal.  

A patent examiner's productivity for a bi-week is determined by first determining how many hours in the bi-week were spent on examining activities as opposed to non-examining activities like time spent in training or on approved leave, then dividing the number of examining hours by the number of balanced disposals credited to the patent examiner during the bi-week.

As an example, assume a patent examiner’s productivity metric is 12.0 hours per balanced disposal. If that patent examiner has 72 examining hours in a given bi-week, he or she would need to be credited with 12 counts, i.e., a combination of 12 first office actions on the merits, allowances, abandonments and/or examiner’s answers. Dividing the 12 counts by 2 gives a productivity of 6 balanced disposals in that bi-week which when divided into the 72 hours of examining time gives 12.0 hours per balanced disposal.

Of course patent applications are not fungible, some are harder to understand and examine and patent examiners will spend examining time on applications for activities during the bi-week that do not result in a count. These vagaries are allegedly captured in the hours per balanced disposal metric.

**SUPERVISORY REVIEW OF THE QUALITY OF THE PATENT EXAMINERS’ WORK PRODUCT**

A primary examiner is authorized to issue each office action and allow patent claims solely on his or her signature. In the normal course of business, the work product of a primary examiner is not significantly reviewed in real time. However, that work product may be reviewed

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4 The average time spent on an application metric has not proportionately increased with the increase in the complexity of many technologies and the additional duties patent examiners have been required to assume over the decades.

5 This section discusses only the day to day manner in which a patent examiner’s work product is reviewed and does not discuss the various in-house quality review programs the PTO has in place.
in a delayed manner by way of an appeal to the PTAB or if a patent applicant files a petition to have an office action reviewed on procedural grounds. Thus, a primary examiner can work in isolation without input from peers or supervisors as to the quality of their work product for significant stretches of time.

A non-primary examiner on the other hand must have each office action reviewed and signed by either a primary examiner or supervisor. As the non-primary examiner progresses through the ranks, their work product is expected to improve and, thus, is subject to less review by the signing superior.

As discussed above, each patent examiner’s productivity metric is measured and reported on a bi-weekly, quarterly and fiscal year basis. However, a patent examiner may not produce their office actions evenly over a bi-week or quarter. This can happen due to the luck of the draw of the difficulty in the cases drawn during that time period or a lack of effort during the early part of the bi-week or quarter. This unevenness can result in an “end loading” problem in that, for non-primary examiners, they may hand in a large number of office actions for review and signature at the end of the bi-week or quarter. Over time, the concept of “Count Monday” was created.6 As the emphasis increased on patent examiners to meet their productivity goals each bi-week, the PTO and the patent examiners’ union, Patent Office Professionals Association (“POPA”), agreed that supervisor’s will review all office actions handed in by non-primary patent examiners in a given bi-week by a time certain on the first Monday of the following bi-week. Thus, if patent examiners turn in work late in a bi-week, especially on the last weekend of a bi-week, a supervisor may have a large number of office actions needing to be reviewed and approved on Count Monday. In considering the effects of Count Monday, it must

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6 A recent discussion of Count Monday appears at the POPA web site at http://popa.org/2507/.
7 Primary examiners must also have their office actions in by the appointed time on Count Monday. Thus, those primary examiners who procrastinate and are also end loaders exacerbate the problems that the PTO systems have with processing office actions on Count Monday.
be kept in mind that the supervisor’s own performance rating depends in large part on each assigned patent examiner meeting their individual productivity quotas and that they are reviewing the proposed office actions electronically without a complete paper file available. Thus, there may be a built in bias for the supervisor to allow suspect work products to go forward as it benefits themselves and their patent examiners.

POPA saw need last year to caution patent examiners about “Work Credit [Count] abuse.⁸ Even POPA recognized that office actions are issued that are not complete, either by intention to defraud the system by receiving count credit for purposely incomplete office actions, or through a poor quality examination. In my experience, which is consistent with the feedback I receive from practitioners over the last eight years, there are too many initial office actions being issued that are incomplete and lack credibility. An incomplete initial office action sets the whole prosecution timeframe off as it typically needs 1-2 RCEs to put the case in a posture where it should have been from the beginning. Applicants have no meaningful way to obtain an independent review on the merits of egregious cases during the examination process. This poor quality initial examination has resulted in the large number of RCEs being filed and ex parte appeals pending at the PTAB.⁹

RCES

Compact prosecution could have, but did not, significantly change when RCEs came into being in 1999. However, as mentioned, the PTO had to change the patent examiner count system to take into account that the patent application was not actually abandoned, just that the RCE served to reopen prosecution in the same application. The PTO and POPA agreed to modify the existing system where the patent examiners were awarded a phantom abandonment

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⁸ http://popa.org/2165/
⁹ As of September 30, 2014, 25,506 ex parte appeals were pending at the PTAB, up from around 1,000 pending appeals circa December 2005.
count whenever an RCE was filed even though the underlying case was not, in fact, abandoned and RCEs were initially docketed as an amended case, as in fact they are. This created a system where the case had to be picked up for renewed consideration by the patent examiners within two months of filing.

That changed however under Director David Kappos who came into office with a mandate to reduce the unexamined case backlog. In an agreement with POPA, the PTO changed the count system so that a first office action in an RCE received less than a full count credit in order to incentivize patent examiners to take unexamined new cases from the backlog up for action instead of renewing examination in RCEs. In addition, the agreement changed the manner in which RCEs are docketed to patent examiners. Instead of being docketed as amended cases which meant the patent examiner had to take it back up for action in two months, RCEs were docketed as special new cases which meant the patent examiners only had to take one up for action every 1-2 months.

The consequences of these changes were dramatic. The unexamined new case backlog decreased as intended, but the backlog of unexamined RCEs mushroomed, reaching over 111,000 pending RCEs in early 2013 with an attendant delay of patent examiners taking RCEs up for action, which in some cases stretched into 2-3 years. In response to the criticism received for causing the large backlog of RCEs and the delay in taking them back up for action, the PTO recently re-incentivized patent examiners to take up for action more RCEs than their performance plan would require. As a result, the backlog of RCEs has dropped to just over 40,000 as of September 2014.¹⁰

¹⁰ The PTO has a finite capacity under the present management systems to be “productive.” One need only to ascertain the total number of counts the present Examining Corps, currently over 8,000 patent examiners, is expected to produce each year. Picture that number as an inflated balloon. When one redirects the patent examiners’ work efforts to decrease one aspect of the balloon, the balloon will necessarily bulge outwards in a different area as the total volume of the balloon was not expanded.
DISCUSSION

The alleged time and attendance fraud allegations under current discussion are not surprising as this has historically been an issue with some patent examiners. Having said that, the vast majority of patent examiners I knew and worked with were honest with their timekeeping and I believe that to be the case today. However, if a patent examiner wants to work the system, the historic and current compact prosecution and patent examiner count systems are rife with opportunities for them to take advantage.

When you measure an employee’s productivity solely by a quota system, you are telling too many employees how little work they have to do. If someone is expected to produce 12 widgets in an 80 hour bi-week and through the luck of the draw they produce the twelve widgets in the first 60 hours of the bi-week, what are they expected to do with the other 20 hours of examining time? Some patent examiners work ahead knowing that the work to do in the next bi-week may be harder. Some patent examiners struggle to make their productivity quota and put in extra, off the books hours, in order to make their quota numbers. Others will work to the quota number and carefully tailor their productivity and counts to match the expected numbers of hours worked on examining activities that bi-week to meet their assigned quota regardless of whether they could have been more productive. Others, unfortunately believe that they accomplished what they are paid to do and can, in essence, take the rest of the time off.

These behaviors existed throughout my career at the PTO regardless of what work schedule was in place. In the rigid 8:30-5:00 regime, those patent examiners who wanted to abuse the system simply “disappeared” during work hours to do errands and other non-work activities or read at the office while waiting the clock out. There were those that ran personal businesses from the office during the day. During that era, some examiners would sign in for overtime on Saturday and disappear to take in the matinee at the local movie theater. It was
easier for patent examiners who wanted to abuse the system to do so during the flex time regime as they were not necessarily expected to physically be in the office at any given time.

Throughout my career at the PTO, supervisors have tended to look the other way when it came to time and attendance issues involving high producers since it was in their best interest to accept the extra work production. Thus, there were those patent examiners who understood that if they sufficiently exceeded their production quota, the boss would not be looking for them during the day, nor, typically reviewing the quality of their work product closely.¹¹

I am unaware of any specifics that underlie the current controversy. However, it is not surprising that the allegations exist since, because of the anachronistic management and time accounting systems that patent examiners continue to work under, there are those patent examiners that can appear on paper to be abusing the system when, in fact, they are not or there are those who are in fact abusing the system. The solution is not to dismantle the current PTO telework program but, rather, to modernize compact prosecution and the patent examiner count systems to create a more positive work atmosphere and allow for more efficient monitoring and management of the workforce.

The first significant change that must be made is to do away the current attitude that the main job of the patent examiners is to get their counts and that they are doing a good job simply because they are making their numbers. The fallacy of that attitude, i.e., "I have to get my counts," reduces the job of a patent examiner to a piece work, assembly line, position where they are paid to simply get a case to a final rejection so they can force applicant to file a RCE to get the second count and pick up the next case to get another count. In essence, anyone can make their numbers if they do not care on how well the work is done.

¹¹ There was a saying during my tenure at the PTO that a patent examiner never got fired for doing bad quality work, as long as they did a lot of it.
In announcing the current DOC IG investigation to the patent examiners, POPA stated: “[w]hile we know that no wide-spread systemic telework and time abuse problems exist at the USPTO (our performance metrics for 2014 show us to be a very high-producing agency)….”\textsuperscript{12} It is this attitude that, if we are making our numbers, we are necessarily doing a good job, that needs to change. How does one “know” that there is no wide-spread abuse simply by looking at the counts? Working to a number should not be the end all of a position as complex and difficult as being a patent examiner. Making a patentability determination of a pending patent claim requires a unique blend of legal and technical skills and should not be reduced to a number. The current management systems need to change from the current assembly line style where successful performance is measured in the main by how many counts a patent examiner posts, to one where bringing the case to a successful, ultimate conclusion is the goal and appropriately incentivized

The second significant change that must be made is to modernize compact prosecution to eliminate final rejections and the attendant after final practice that serves to interrupt the ordinary course of a complete examination of a patent application. The current system in which issuance of final rejections plays such a large part in order to achieve the quick counts that accrue when an applicant files a RCE only creates artificial stops in the patent examination system. This is so because applicants cannot have an additional amendment/evidence entered into the record after a final rejection is issued as a matter of right. Rather, it is solely within the discretion of the patent examiner whether an after final amendment/evidence will be entered.

A significant accomplishment of Director Kappos’ administration was to emphasize the use of applicant-patent examiner interviews. Such interviews have long been a staple of patent prosecution and generally advance prosecution as a direct exchange of ideas can be more productive than trading paper. As understood, patent examiners were authorized non-

\textsuperscript{12} http://popa.org/2526/
examining time\textsuperscript{13} to prepare for and conduct interviews and the interview program has become more robust. A consequence of the current teleworking program is that many teleworking patent examiners are physically located such that an in-person applicant-patent examiner cannot be had. History informs that the most productive interviews are held in-person where each side can exchange papers, mark up documents and have a frank conversation in real time. While the PTO is implementing software for interactive web interviews, the fact remains that actual face time is important in moving cases forward in a positive direction. The current telework program frustrates in-person interviews as there is no requirement for telework in patent examiners to physically be at any PTO facility to participate in such an interview.

It is a common occurrence for an applicant to only fully understand a patent examiner’s position once it is explained in a final or subsequent rejection. It is also common for an applicant-patent examiner interview to occur after the issuance of a final rejection where great progress can be reached and perhaps a tentative agreement is reached that additional claim amendments/evidence are needed to place the case in condition for allowance. The current system means that applicant will spend the resources to prepare an after final submission, knowing that in the vast majority of cases the patent examiner will not use their discretion to enter the submission into the record, thus necessitating the filing of an RCE.\textsuperscript{14} It should be noted that patent examiners do not receive a count for the time spent in considering an after final submission.

Meaningless after final submissions wastes applicant’s resources as well as the PTO’s as patent examiners must take the time to consider the submission and issue the paper, that in

\textsuperscript{13} Non-examining time can be simply seen as time in which a patent examiner is off the production clock.
\textsuperscript{14} The PTO has begun a pilot program to incentivize patent examiners to consider more after final submissions by giving the patent examiners more time to do so.
http://www.uspto.gov/patents/init_events/afcp.jsp It should be noted that this pilot program is also discretionary with the patent examiner as instituting it as a mandatory program would require management negotiating with POPA.
a significant number of cases, informs the applicant that the submission will not be entered and that an RCE must be filed for the patent examiner to consider the submission on the merits. The artificial “dead zones” the present system creates where no meaningful activity is ongoing in an application is illustrated in a paper I co-authored as follows:

These two dead zones typically result in an initially examined application sitting idle for 2.5-19.5 months.

As illustrated, modernizing compact prosecution by eliminating final rejections and after final submissions, patent applications are before the patent examiner in a more continuous

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15 Smith et al., “IN ORDER TO FORM A MORE PERFECT PATENT EXAMINATION SYSTEM—IT IS TIME TO UPDATE COMPACT PROSECUTION TO COMPACT PROSECUTION 2.0” available at http://www.ipo.org/index.php/publications/member-articles-journal/member-article-journal-patent-section/. Copy attached as Exhibit A. AIPLA and IPO each recently urged the PTO to modernize compact prosecution in their recent comments submitted in response to the PTO’s “Request for Comments on Optimum First Action and Total Patent Pendency,” Federal Register, Vol. 79, No. 131, July 9, 2014, pp. 38854-55. AIPLA’s submitted comments are attached as Exhibit B and IPO’s submitted comments are attached as Exhibit C.
manner. The time a patent application spends in a dead zone is wasted and contributes to longer overall pendency. It must be kept in mind that a number of applications go through more than one RCE and, thus, are subject to being placed a dead zone with each subsequent final rejection.

Thus, eliminating final rejections and the attendant after final practice will put life into the RCE program as each application will now receive “continuous” examination with no dead zones. As explained more fully in Exhibit A, this modernization can be easily implemented since the PTO can now set its own fees. It is imagined that the RCE fee will increase if prosecution is not brought to an early conclusion. Eliminating these dead zones will improve the overall pendency of a patent application by keeping it in active prosecution at all times. Patent quality will also expectedly increase since applicant and the patent examiner will be continually engaged in a conversation to find patentable subject.

A key to improving both pendency and quality by eliminating the dead zones is to have each response from applicant docketed to be picked up for review by the patent examiner within two months of filing. This is critical, especially after an applicant-patent examiner interview is held. The case should be available for immediate action to finalize any understandings reached during an interview and permit applicant to prepare and submit any needed amendment/evidence. Currently, a productive interview can be held, an RCE filed and the case is not taken up for action again by the patent examiner for months or years. The momentum achieved by way of the productive interview is lost.

**SUGGESTIONS**

1. First, do no harm. The ongoing investigation should continue and any transgressors should be appropriately treated. However, the investigation must keep in mind the actual systems that patent examiners are working under and how reality may significantly differ from the story told from the reviewed records.

2. As needed, change the patent examiners’ timekeeping system to where examining time is tracked by individual application numbers and specific examining activities, e.g., searching, reviewing application, drafting office action etc. To the extent patent examiners are simply entering examining time without documenting which application was under review and which activities were performed, the system is rife for abuse as there is no record as to how the patent examiner was actually spending the time. By
changing the timekeeping system to one that tracks time by application number and activity, a more complete record will be created that will allow remote supervisors a more accurate glimpse of how a patent examiner is actually spending their time. Such a system will also provide management with a robust data set that can be mined to study and provide feedback as to how effective and efficient a patent examiner. For example, if a patent examiner’s average search time per application is disproportionately more or less than their peers in the same art area, managers should investigate and determine whether that patent examiner is inadvertently or purposely cutting corners on the searching aspect of their job or wasting time by over searching or inefficiently using the search tools. The same considerations apply to how much time patent examiners take to write an office action. Such data will give managers a real time opportunity to see how the patent examiners are spending their examining time and provide corrective training as needed.

3. Reduce the emphasis of counts in determining a patent examiner’s productivity. In a perfect world, the present count system would just disappear. However both management and POPA have too much invested in the status quo for that to be a reality. Management, POPA and stakeholders should work in concert to develop new productivity metrics that emphasize the ultimate conclusion of an examination through an efficient and effective, modernized compact prosecution system instead of merely reaching a final rejection. We must work to change the mindset that a successful patent examiner is one that merely makes his/her counts without regard to how well the underlying work product is. It is simply too easy for patent examiners to rush through incomplete office actions to achieve needed counts at the end of a bi-week, quarter and/or fiscal year. One metric that should be considered is the number of actions per ultimate disposal, not per RCE. Patent examiners should be invested and incentivized to reach the ultimate conclusion of each case by having a continuous conversation with applicant with no dead zones.

4. Modernize compact prosecution by eliminating final rejections, after final practice and the resulting dead zones to allow for a truly compact and efficient examination process. The original version of compact prosecution has become a parody where in too many cases it becomes a race to a final rejection and the concomitant RCE instead of a focused proceeding to find patentable subject matter in an efficient and effective manner.
5. Improve teleworking by having patent examiners live within commuting distance of the Alexandria campus or one of the regional offices and have a flexible requirement that they be in a physical office for a defined number of hours per bi-week. As a successful teleworker I can attest to the importance of maintaining a physical presence in an office. When I telecommuted from SC to the Alexandria headquarters in 2004-05, I found people waiting to see me at my office. In private practice, I travel significantly to our various offices as well to those of clients. Patent examiner’s need not have a travel schedule but they must be made available to applicants so that we can more readily have in person interviews. Implementation of this suggestion will add to robustness of the new regional offices and make them more useful to applicants.

Further, being in an office will make all patent examiners available for in-person training, mentoring and collaboration. I know that the in-person exchange of views can be more efficient than a telephone conversation. Patent examiners need to collaborate more, not less, in their work to insure that each office action is as complete and meaningful as possible.

6. Teleworking, pendency and quality will all improve if the PTO allows for increased management involvement on the merits of a case if cases drag on. As set forth in our paper, long pending cases are already to be treated special and involve supervisory input. But this rule is observed mainly in the breach. By having manager/supervisors become involved on the merits as a conferee in appropriate cases sooner rather than later, an informed discussion can be had by applicant, patent examiner and the conferee that should put the case on track for an earlier resolution than if the conferee did not participate. No one person has a monopoly on good ideas and it is easy for applicant and/or the patent examiner to become locked in to one’s beliefs and not clearly understand the other’s true position. Appropriate management intervention will provide real time feedback as to how a patent examiner’s is actually functioning and allow for additional training as needed. Such intervention will also aid applicant in understanding the true strength of their position and foster an understanding of where a compromise may be needed. This action is especially needed for primary examiners. As set forth above, the work product of a primary examiner is not reviewed to any degree in real time and too often a recalcitrant primary examiner will cause a needless RCE or appeal. Given the vast changes in law and technology over at least the last decade, it is naïve to
think that most primary examiners can be up to date on either to the extent needed to efficiently bring prosecution to a close.

In other words, events have overtaken all of the assumptions made when compact prosecution was implemented in the late 1960s-early 1970s. The world of patent examining is so very different and infinitely more complex now than then, yet the PTO and POPA keep nipping and tucking at an anachronistic system instead of taking an objective step back and understand that a significant overhaul is needed.

CONCLUSION

I sincerely hope that the ongoing investigation will not uncover widespread cheating by patent examiners. To the extent that such cheating is uncovered, the offenders should be subject to appropriate discipline. The Patent Examiner Telework Program is a valuable part of the PTO. As understood, the current agreement, in essence, has made the program an entitlement, not a right. By having patent examiners located within distance of the Alexandria campus or one of the regional offices, management can suspend the privilege as warranted if a patent examiner’s performance is not what it should be. Regardless of the outcome of the investigation, the DOC IG should also study the anachronistic examiner count and compact prosecution system as well as the degree of how patent examiner’s time is accounted for, as it is believed that there is ample room for improvement in all of these systems that will not only reduce the possibility of cheating in the future but move the patent examination system into the 21st century and reduce overall pendency and improve quality.

As mentioned, both PTO management and POPA have much invested in maintaining the status quo. Hopefully, this hearing will provide the message and impetus that PTO management and POPA have to enter into a meaningful conversation that includes the stakeholders with both sides committed to changing the systems in the significant ways needed in order to provide a modern efficient and effective patent examination system.