

Select '**Print**' in your browser menu to print this document.

Copyright 2010. ALM Media Properties, LLC. All rights reserved. National Law Journal Online

Page printed from: <http://www.nlj.com>

[Back to Article](#)

PTO proposes first changes to examiner performance standards in nearly 25 years

Sheri Qualters

June 17, 2010

Patent lawyers say the U.S. Patent and Trademark Office's proposal to change patent examiner performance standards is one of several promising innovations the agency has rolled out or floated in recent weeks to cut the massive application backlog.

On June 16, the PTO announced that a task force of patent officials and representatives of the examiners' union have crafted a sweeping overhaul of examiner performance standards. If the union, the Patent Office Professional Association (POPA), approves the changes, it would be the first major revision of the performance standards since 1986.

The proposed ideas include revising the standards to focus on the quality of an examiner's work, not just the quantity, and giving examiners incentives to interview applicants.

POPA members are expected to vote on the plan in July. If it passes, it could take effect as soon as the 2011 fiscal year, which begins Oct. 1.

The spirit of cooperation between PTO management and the union "has helped to create a new [performance plan] that we feel is beneficial to the examiner while also setting the agency on a more direct path to shorten pendency while maintaining high quality examination," said POPA President Robert Budens in a statement.

"This is an important step forward that will help create a foundation for future USPTO success," said PTO director David Kappos in a statement.

A more routine use of interviews between the examiner and the filing attorney should help boost the quality of the PTO's examination work, said Debra Milasincic, a partner at Boston intellectual property shop Lahive & Cockfield.

That policy would also dovetail nicely with the recent changes to the examiner count system, she said. Last October, POPA approved the PTO's overhaul of the patent examiners' deadline system and the count system for evaluating examiners' work.

"People were very excited about the revamping of the count system," Milasincic said. "We see that [as] removing a major impediment to the granting of patents, which has been very apparent over the past five to seven years."

In the current system, the examiners are "working on very strict guidelines with some bias to reject applications," said Scott Kamholz, a patent and trademark associate at Boston's Foley Hoag. "I feel they can now get back to the job of examining applications in a fair and impartial way."

The proposed performance standards and other recent changes "all help maybe in a little way to attack the backlog," he said.

"What I see is that [Kappos] is paying attention to every area of the patent prosecution process that could benefit from some tweaking," Kamholz said. "I do not expect to see any dramatic change from any one of these programs, but overall, there should be lightening [of the backlog] and some improvement."

Earlier this month, the PTO proposed a [three-track system](#) for patent applications to help with the [backlog](#), which totaled 735,961 applications at the end of fiscal year 2009. The proposal would allow applicants to pay for fast-

track review, opt for regular processing or choose to have their application delayed for 30 months.

In May, the agency made three changes designed to attack the backlog. First, the PTO opened its so-called application exchange program, which allows inventors to get fast-track treatment of one application if they abandon another, to all applicants. The PTO [first announced](#) a pilot exchange program for inventors from small organizations last November.

The agency then eliminated the fee for "patent prosecution highway" petitions. The PTO has rolled out numerous so-called highway agreements with foreign patent agencies since 2006. The agreements allows applicants who obtain a ruling on at least one claim in a patent application submitted to one participating agency to request that other participating agencies fast-track examination of the patent.

Also last month, the [PTO expanded](#) the green technologies eligible for accelerated patent application review since a December pilot.

The most important change is "to align the interests of the office with the examiners' interests," said Peter Lando of Cambridge, Mass.-based Lando & Anastasi. "If everyone is pulling in same direction, that's the greatest chance for success."

Sheri Qualters can be contacted at squalters@alm.com.