POPA NEWS
Patent Office Professional Association

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Congressional Testimony Echoes POPA Petitions and Survey

Patent Community Joins Examiners in Opposing Search Outsourcing

The day after more than 1,000 patent professionals began signing a petition urging "Congress to ensure that the prior art search remains part of our examination duties," members of the patent community testified to Congress about their serious concerns and opposition to outsourcing the prior art search.

The following week POPA delivered the petitions, its own written testimony and the results of a POPA membership survey on the USPTO 21st Century Strategic Plan to the same House subcommittee that held the hearing.

POPA took the petitions—signed by 1,080 patent examiners or nearly one-third of all examiners—to the House Judiciary Subcommittee on Courts, the Internet, and Intellectual Property on July 25. In addition to asking for congressional action, the petition stated, "It is our experience that searching the prior art is an integral and inextricably linked part of the patent examining process and cannot be separated without significantly reducing the quality and efficiency of the U.S. patent system."

Many, including POPA, who commented to the House subcommittee on the USPTO plan criticized many facets of the agency's "reform" and fee schedule adjustment.

"It seems to me that conducting thorough searches is an integral part of the PTO's examination role," stated Rep. John Conyers (D-Mich), a member of the subcommittee.

Charles P. Baker, chair of the American Bar Association Section of Intellectual Property Law, stated emphatically that "the search is part of the examination, and if the examiner does not do the search, it will not be done as well, which

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POPA Continues Campaign for Work at Home

POPA in July delivered to key members of Congress more than 1,000 patent professionals' signatures on a petition asking Congress to urge the USPTO to reinstate the Work at Home telecommuting program. POPA also handed over the results of membership surveys on Work at Home issues and the commuting patterns of Work at Home participants, both of which support the union's position.

The petition and survey results had an impact on Capitol Hill. Subsequent calls from congressional offices to senior USPTO officials likely helped prompt USPTO Director James Rogan to comment to POPA that he is committed to a "permanent" and "expanded" Work at Home program. Rogan said that when he was a congressman he had voted for Rep. Frank Wolf's telecommuting law, which states that 50 percent of all eligible federal employees should be offered the option of telecommuting in 2002. POPA is optimistic that the director's commitment will fuel productive negotiations to reinstate a permanent program.

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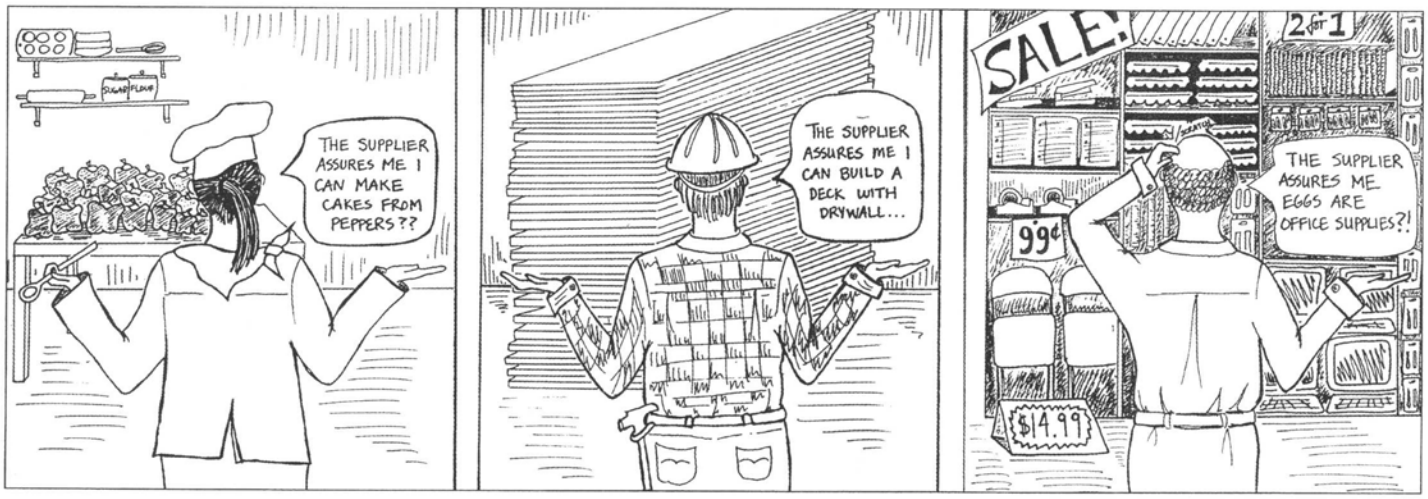

An examiner with no control of the search is like a chef with no control of the ingredients. Could others do business as the USPTO proposes?

POPA Survey on Restructuring

(continued from page 1)

would weaken the presumption of that validity.

"That presumption gives certainty to U.S. patents, and without a reasonable level of certainty, investors will not invest to develop new technology and create new jobs," said Baker. "The best testament against separating the search function and an examination function is the fact the European Patent Office, which has had such a system for years, has recently decided to abandon it."

POPA stressed that search and examination are "sovereign functions of the United States." If examiners have to rely on foreign patent office search results as the basis for patentability determinations, then a U.S. sovereign function "has been indirectly delegated to a foreign power."

While the Intellectual Property Owners Association commented, "We do not oppose separation of search and examination if such separation can pass the quality, speed, and cost effectiveness filters," the IPO added, "To permit the applicant to work with a private company in determining the nature and scope of the search to be performed could create opportunities for manipulating the system that would diminish the level of public confidence in patents and increase patent litigation."

POPA commented that the agency's proposed quality initiatives are "designed to increase control rather than enhance quality." The union stated that the idea of recertification testing "is not the accepted way of maintaining professional standards in the private sector and neither should it be at the USPTO."

While requiring continuing education credits for continued professional accreditation is standard, continued testing is not. "No amount of review or automation can ultimately improve patent examination without first providing examiners with the necessary time and resources to properly do the job," stated POPA.

"Unless examiners are given the additional time commensurate with the Agency fees for additional examination services," added the POPA testimony, "both existing and proposed fees for additional claims and other services represent nothing more than another hidden tax on inventors rather than a payment for examination services rendered."

Forceful Survey Comments

Many POPA members added written comments to their surveys about the agency restructuring:

■ "What if we know of a better reference? Do we use it or look the other way?"

■ "...the only time an examiner relies mainly on the IDS is when they don't understand the invention well enough to formulate their own queries that go beyond the literal words of the claims."

■ "While searching I read and become familiar with references and formulate my rejection."

■ "If the strategic plan takes effect I will probably look for another job. The stress of trying to do quality work with insufficient hours per case is too much."

■ "The greatness about the USPTO is our classification system. It is essential to searching."

■ "More examination time is required to both improve quality *and* pendency. If people have more time per case, first actions will be of better quality, resulting in *fewer* actions per disposal, ... shorter overall pendency... ."

■ "If the applicant is required to contract a search, demand for searchers will increase and examiners may very well leave the Office to become highly qualified, in-demand public searchers."

■ "This survey uses questions that appear to be very loaded."

■ "Being recertified is insulting. Any 'problem' examiner would be uncovered by the review process already in place. ... People should be given a chance to attend refresher courses to correct their deficiencies."

■ "Most patent examiners take real pride in doing a good and useful job. This will no longer be possible."

The results of POPA's July 17 membership survey, in which 55 percent of the membership participated, strongly backed the union's position on the USPTO restructuring plan:

1. Do you believe examiners can issue valid patents and protect the public from unwarranted patents without doing the search themselves or having the search under their control?

Yes—5%
No—95%

2. Do you believe that if search and examination functions are separated, overall quality will go up or down?

Quality will go up—1%
Quality will go down—96%
Quality will stay the same—3%

3. Do you think the responsibility for doing the search should be placed under the control of the applicant?

Yes—4%
No—96%

4. Do you believe that the private sector should be in charge of the classification schedule for the patent system?

Yes—3%
No—97%

5. In new applications where an IDS (information disclosure statement) is filed, approximately how often do you need to apply additional references when making a rejection in the application?

almost all the time—74%
most of the time—17%
some of the time—7%
almost never—2%

6. Do you trust management to objectively re-certify the competence of primary examiners?

Yes—7%
No—93%

7. In new applications containing foreign search reports, approximately how often do you need to apply additional references when making a rejection in the application?

almost all the time—69%
most of the time—22%
some of the time—7%
almost never—2%

POPA's Work at Home Campaign

(continued from page 1)

Survey Results Support Union Stance

The following results of the survey/vote at POPA's July 17 membership meeting overwhelmingly favor the union's position on Work at Home:

1. Do you want POPA to agree to a work at home program that ends after one year?

Yes, a yearly termination date is OK—5.6%
No, we need a permanent program—94.4%

2. Do you want POPA to agree to a program that is limited to 350 primary examiners (or equivalent) on Work@Home for the entire program?

Yes—4.0%
No—96.0%

POPA in early July surveyed the actual participants in the terminated Work at Home program about their commuting patterns during the program. More than 45 percent of those surveyed responded:

- 75 percent stated that their commuting by single occupancy vehicle decreased.
- 23 percent stated that their commuting by single occupancy vehicle did not change because most already used public transportation, car pools or other commuting means.
- 2 percent indicated that their commuting by single occupancy vehicle increased. Each of these respondents indicated that they needed to drive to/from work occasionally due to the volume of the application files worked on at home.

Employees Speak Out

One 30-year patent examiner told his member of Congress that "telecommuting was definitely a factor" in his family's decision to move to Fauquier County last October. The Work at Home shutdown has been "very disappointing, to say the least," he added.

The USPTO's latest action has made this examiner wary of signing back onto the program if and when it's reinstated. "Going on and going off is too stressful," he said. "There's no guarantee that the Office wouldn't yank it again, especially if we have to go through it [renegotiations] every year. The Office can exact more and more work from examiners every year."

Many examiners surveyed on Work at Home added written comments:

- "I was a participant in the Work@Home pilot. Prior to termination of the pilot, I was not surveyed on my experiences or opinion, or informed of any problems. ...Wouldn't it make sense to make participants aware of problems and solicit ideas for solutions?... it seems premature to make changes before the pilot experience data is collected."
- "Eligibility should be much broader than any proposals I've heard. I would not limit [it] to primary examiners. Level 3 should be open to a lot more people, simply to take home some work, not requiring search tools or even a computer."
- "1) I would like you to push for part-time employees to be eligible. There is no reasonable explanation for excluding us. 2) The sharing of offices/computers is completely unacceptable. 3) The ability to end the program each year is unacceptable."

Work@Home: No Joking Matter

The following is a copy of an Aug. 5 letter sent to the editor of The Washington Post.

Dear Editor:

I was very surprised to discover that the press office of the U.S. Patent and Trademark Office told the Federal Diary [Aug.4] that USPTO Director James Rogan and I engaged in "some good-natured banter" on the agency's shutdown of the popular employee telecommuting program.

In fact, there was no kidding around in my talk with Director Rogan. Rogan emphasized that he had told his staff that he wanted an expanded, permanent "Work @ Home" telecommuting program as provided by law. He pointed to the fact that while he was in Congress he had supported and voted for the provision on telecommuting sponsored by Rep. Frank Wolf. When one of my colleagues noted that his staff had not taken a position consistent with his direction, he assured us that he had clarified his directions to his management team.

I was very conscious of the fact that he was speaking as the head of the agency and I considered this a breakthrough in our negotiations.

Ronald J. Stern
President
Patent Office Professional Association

Senate Committee Supports Examiner Retention Initiatives

A July 2002 report from the Senate Appropriations Committee on the fiscal year 2003 USPTO appropriation stated: "The Committee recommends the following targeted funding increases: (1) $29,200,000 to hire 750 new patent examiners to help improve patent quality and reduce patent pendency; (2) $47,775,000 for an e-government initiative. ...$29,500,000 is provided for the PTO's e-patent initiative to ensure that the new system is fully operational by the end of fiscal year 2004; (3) $4,700,000 is to implement the PTO's information technology initiative; and (4) $30,149,000 for a retention initiative focused on the patent examiner corps that is intended to reduce attrition and improve the quality of patent examination."

The committee recommendations are presently unfunded. USPTO representatives have explicitly stated to POPA that the agency has no intent to spend funds for programs to retain patent examiners.

Public Paper Files to be Destroyed Starting Aug. 26

The USPTO will begin removing the public paper patent files Aug. 26, despite very strong testimony that the move is premature and will prove costly and harmful to the patent system, stated seven of the eight patent expert witnesses speaking at a USPTO public hearing May 16.

After receiving clear public condemnation of the proposal, USPTO Director James Rogan wrote, "I certify that the implementation of the plan will not negatively impact the public," in a July 26 report to Congress. The report said that the agency addressed the nay-saying public comments, but the final implementation plan basically ignored the expert input.

The USPTO wrote in its *Federal Register* hearing notice, "...the paper patent and trademark registration collections are no longer needed for public reference because of the availability of mature and reliable electronic search systems in its public search facilities."

"There is NO EVIDENCE for such an assertion or conclusion," stated verbatim the written testimony of Joseph Clawson, a 25-year veteran examiner and currently a private patent consultant. "Only the robust classified U.S. search system provides an adequate basis for determining the differences between the prior art and the claims at issue... "

Flaws in EAST and Image Files

One patents witness echoed most of the others' distress about moving to a computer-only search system without a necessary paper file backup. "Every day, every one of us who uses the electronic system is faced with its flaws in the form of missing or corrupt data," said Randy Rabin, president of PatentArts, LLC.

Poor Data Quality

The USPTO has acknowledged that more than 100,000 patents since 1971 have been lost, according to Clawson and Robert B. Weir, testifying on behalf of the National Intellectual Property Researchers Association (NIPRA). The entire file of patents issued during October and November 2000 are also lost to the electronic search engines, he testified.

In its report to Congress, the USPTO wrote in response, "The patent text search database is not the replacement database for the classified paper copies of U.S. patents; the patent image database is the replacement database."

However, a recent NIPRA survey and the USPTO's obscuring response demonstrated the agency's attitude towards the quality of its patent and trademark databases.

The NIPRA study found a 52 percent error rate in the X-Search and TESS design code fields alone. A USPTO-commissioned independent assessment of that same data, conducted by PriceWaterhouseCoopers (PWC), indicated a 46 percent error rate in the initial data entered by USPTO contractors and a 36 percent error rate in the data after USPTO quality review.

The agency never publicly released the PWC study results.

The USPTO responded in its report that it subsequently did its own study and found a 19 percent error rate, which it acknowledged was still unacceptable. However, it said that only about 4 percent of the trademark files consist only of a design, "thus 96 percent of marks are routinely found doing searches for words, numbers or letters."

Factoring in its 19 percent error rate – and ignoring its own commissioned independent findings – the agency ultimately reckoned only a 3 percent actual error rate. This error rate still translates into 10,200 actual erroneously coded trademarks in fiscal year 2001 alone.

In the patents database, NIPRA found identical search queries returning different results and discrepancies between the number of patents filed in a particular subclass in the paper collection and in the electronic database.

The Commerce Department's Office of Inspector General stated in March 2001 that the electronic search systems were subject to: "1) ineffective management and monitoring ... 2) incomplete systems specifications, 3) poor communication with end-users, 4) poor acceptance testing, and 5) insufficient training," wrote Weir.

Paper Saves Money

While witnesses cited differing costs, they pointed to the savings from using the paper files. Rabin placed the cost to maintain one classified library at "conservatively" $5-7 million per year, including space, utilities, copies and staff. He compared this to the computer system, which has cost so far more than $1 billion, with $239 million in expenses for 2001 alone.

The USPTO did not address costs of maintaining either the paper public search files or the electronic system in its report to Congress.

Continued Classification is Vital

The U.S. classification system is "one very critical tool valued by examiner and searcher alike," said Rabin. Yet since automation, the classification system has languished. "The importance of classification must be reevaluated and its decline turned around before it is too late," urged Rabin.

Clawson agreed that the "enormous power and strength" of the U.S. classification system "cannot be duplicated by using the commercially available 'electronic' data or abstracts."

"Destruction of the classified paper search file," concluded Weir, "would form an undue, permanent, and irreversible hardship for the small and medium sized inventive entities."

In its report, the USPTO did not address the U.S. classification system.

Community Day Quiz Winners and Answers

As many people stopped by the POPA Community Day table last month, they also took the POPA quiz to light-heartedly test their knowledge on several patent topics.

Question 8 was taken directly from the April 2002 USPTO Patent Agent exam. On all of the completed quizzes, only 37 percent of respondents got the question 8 correct. Perhaps this is an early indicator of success if the agent's exam is used to certify or recertify patent examiners.

The two employees who answered all ten questions correctly were Albert Gagliardi in Art Unit 2878 and Jeff Fredman in Art Unit 1637. They each won $50 gift certificates to Outback Steakhouse for their efforts.

The quiz questions and answers follow.

1) The USPTO has proposed a recurring recertification for primary examiners. Which profession has a requirement for a recurring recertification currently?

A) M.D.s B) Attorneys C) Judges D) Pharmacists E) Dentists
F) Professional Engineers G) CPAs
H) Patent Attorneys I) None of Above

Correct Answer: I

2) When was Patents Work at Home Program canceled?

A) 1981 B) when patent examiners became security risks C) 2002 D) 9-11-2001

Correct Answer: C

3) Approximately how much money is going to members of the POPA bargaining unit as a result of the FLSA (Fair Labor Standards Act) Grievance Settlement negotiated by POPA?

A) $458,000.00 B) $1,100.00 per examiner C) $3 Million D) $1.8 Million

Correct Answer: C

4) Who was President in 1964 when POPA became the exclusive bargaining representative for patent professionals?

A) Jimmy Carter B) Lyndon Johnson C) John F. Kennedy D) Richard Nixon

Correct Answer: B

5) In what year did USPTO management disband the Diversity Advisory Council?

A) 1964 B) during Clinton administration C) 1999 D) 2002

Correct Answer: D

6) What is the maximum recruitment bonus negotiated by POPA for 2002 and paid to newly hired electrical engineers, computer engineers, computer scientist and patent examiners in these specialties?

A) $2,100.00 B) 4.1% of yearly salary C) 12% of yearly salary D) 10% of yearly salary

Correct Answer: C

7) Which member of the House Subcommittee on Courts, the Internet and Intellectual Property is an inventor in over 30 U.S. Patents?

A) Howard Coble B) Darrell Issa C) Howard Berman D) John Conyers, Jr.

Correct Answer: B

8) The following question was taken from the April 2002 USPTO Registration Examination for Patent Attorneys and Agents:

Belle Bordeaux files a French patent application for a rejuvenating lotion in the French Patent Office on January 10, 2000. On January 10, 2001, she files a PCT Chapter I Request in the EPO Receiving Office, in which she requests that the European Patent Office act as the International Searching Authority. In her PCT application, Bordeaux claims priority to the French application, and indicates the U.S. as a designated state. Bordeaux makes an appointment to meet with you on June 8, 2001 to discuss filing a patent application in the USPTO on the rejuvenating lotion, in which she wants to claim priority not only to the PCT application, but also the French application. In preparing for your meeting with Bordeaux, you realize that she has several options here, and so you prepare an analysis of the various options, which are detailed below. Before entering the U.S. national stage, Bordeaux wishes to have an official international preliminary search report that indicates claims having the best chance of being patentable.

Which of the following will achieve Bordeaux's objective in accordance with proper USPTO practice and procedure?

A) Bordeaux should enter the national stage by filing an application under 35 U.S.C. § 371 on or before September 10, 2001.

B) Bordeaux should file an application under 35 U.S.C. § 111(a) on or before September 10, 2001 claiming priority under 35 U.S.C. § 120 to the PCT application, and claiming priority under 35 U.S.C. § 119 to the French application.

C) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then file a provisional application under 35 U.S.C. § 111 on or before September 4, 2001.

D) Bordeaux should first file a PCT Chapter II Demand in the USPTO on or before August 10, 2001, and then enter the national stage by filing an application under 35 U.S.C. § 371 on or before July 10, 2002.

E) All of the above

Correct Answer: D. This option would give Ms. Bordeaux the filing date of the PCT, specifically 1/10/01, as her U.S. filing date (for the purpose of determining whether information is prior art), it would give her a foreign priority date of 1/10/00, with no further need to provide the foreign priority document; it would also give her the full benefits of filing PCT applications, i.e., a search report and preliminary examination report on her invention(s) prior to filing a national application, so that she has an indication of which claims have the best chance of being determined to be patentable.

9) How do POPA dues compare with NTEU dues? POPA dues are:

A) lower B) a little bit higher C) the same D) double

Correct Answer: A

10) Which Patent Office is in the process of changing from separate search and examination to consolidated search and examination by the same examiner?

A) United Kingdom B) Indonesia C) JPO D) European Patent Office

Correct Answer: D

Backpay for Voluntary Overtime Arrives in Paychecks

Payments should have arrived in the paychecks of patent examiners and examiner/classifiers who worked uncompensated (voluntary) overtime as a GS-5 or GS-7 between June 12, 1994, and Dec. 2001. The payouts resulted from a grievance settlement negotiated by POPA and the USPTO. The payment average equaled $4,227; the total payout was $2,971,488.

If you deserve a payment and it has not yet been included in your regular pay, please e-mail *flsa@uspto.gov* with the relevant information.

Take a Stand for Patent Integrity

Tell Congress What You Think

The decision-makers in Congress need to know what's going on at the USPTO from the employees' perspective. While POPA has spoken loudly on your behalf, your voice adds weight to your association's position.

A good example is the following letter. For more information on contacting members of Congress about Work at Home and the 21st Century Plan, please go to *www.popa.org.*

Dear Chairman Coble:

My experience with the Patent Office is not very long, but I am a Ph.D. scientist with over 20 years of research experience, including work in industry and academia ... At the Office I found a friendly environment, professional people and exciting, challenging work. ... I work harder than I have worked before, often sacrificing my personal time to produce the best quality Office actions while, of course, giving the quantity required by the Office. This combination of goals is quite challenging to achieve.

However, all my good intentions seem useless now. ... the administration headed by Mr. Rogan gave no voice to the examiners, which are those most affected by the upcoming changes and those most involved in the process of examination.

The idea of separating the search and examination processes seems absurd, as the search is the core of examining. ...This search depends on the strategy chosen by the examiner, which is based on understanding of the art and application and is constantly changing during the examination process. If a reference does not satisfy the questions the examiner has, he/she searches more to find answers; there is no way someone else can do this for the examiner. ...

Most examiners are technically very experienced and knowledgeable in their art. The intention of the administration to put all examiners through endless testing and examination is unjustified and humiliating. ... How can someone lacking my experiences, knowledge and expertise, judge my work on very specific technical issues...?

Further, we are continually being trained on the legal issues that are relevant to our duties as examiners. The plan proposes continuously testing us on these issues. I know of no other profession that requires continuous "testing" to prove we have the knowledge and skills to successfully perform our job. This is not the way to attract and retain the best and brightest.

✉ LETTERS

USPTO Abandons Sponsorship of Many Diversity Events

The USPTO in May informed members of each Office of Civil Rights (OCR) subcommittee that they were no longer allowed to plan monthly USPTO diversity events. Since 1991, these volunteer subcommittees had worked with the OCR staff to plan events for celebrations such as:

- January: Martin Luther King Day
- February: African American History Month
- March: Women's History Month
- May: Asian Pacific American Heritage Month
- June: Lesbian Gay Bisexual Transgender Awareness Month
- Fall: Hispanic Heritage Month
- October: Individuals with Disabilities Month
- November: Veterans' Appreciation Month
- November: Native American Heritage Month
- December: World AIDS Day

Traditionally, these events have been used throughout the federal government to educate everyone about the unique contributions of the many communities that make up our workforce. These events also highlight workplace issues unique to each community. The events were always voluntary, always occurred during lunch hour, and non-production time was never granted to attend the events.

The official reason for this cancellation: The time that USPTO personnel spend attending these events detracts from the backlog of USPTO applications. Community Day in August will now serve as the single, three-hour long annual event for educating the entire USPTO community about the many facets that make up our agency. Ironically, Community Day is the only event for which attendees could deduct non-production time from their production quotas. [*Editor's Note: The USPTO granted one hour of non-production time per employee for Community Day in 2002.*]

In response to concerns that the USPTO would be the only federal agency not to honor its veterans with a monthly event in November, the Veterans and Individuals with Disabilities Subcommittee has been granted permission to stage an event. However, this exception was not granted to any other subcommittee or any other community.

While I applaud the recognition of our veterans, we will be the only federal agency that does not officially sponsor monthly, in-depth events specifically honoring African Americans, Hispanics, women or Asian Pacific Americans, among others.

These events serve an important purpose at the USPTO. We are a diverse workforce and we benefit from learning about each other and celebrating ourselves. The arbitrary withdrawal of official sponsorship of these events, as well as the muzzling of our Office of Civil Rights, detracts from an already low employee morale. This cannot benefit backlog reduction. —*Primary Patent Examiner David Fox*

Patent Office Professional Association

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