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Sent: Wednesday, November 25, 2009 2:56 PM
To: Ombudsman Program
Subject: Comments on Patents Ombudsman Pilot Program

Dear Ms. Fleisher,

On behalf of The Boston Patent Law Association, I submit herewith the Association's Comments in response to the Request for Comments published at 74 Fed. Reg. 55212 (Oct. 27, 2009). We thank the Office for this opportunity to provide our thoughts.

Sincerely,

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November 25, 2009

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Re: Patents Ombudsman Pilot Program, in Response to Request for
Comments at 74 Fed. Reg. 55212 (Oct. 27, 2009)

Dear Ms. Fleisher:

The Boston Patent Law Association (BPLA) thanks the U.S. Patent and Trademark Office (USPTO) for the opportunity to comment on the USPTO's Request for Comments on Patents Ombudsman Pilot Program (hereinafter "the Notice"). We appreciate the effort that was involved in developing the Ombudsman Program, and we acknowledge the benefits of having a dedicated resource available to applicants to help advance prosecution. The BPLA offers the following comments regarding the Ombudsman Program, in a desire to assist the Office. Our comments generally fall into two categories: (a) defining the role of the ombudsman, and (b) clarifying unclear or unaddressed issues in order to encourage participation.

The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws in the Boston area. These comments were prepared with the assistance of the BPLA Patent Office Practice Committee.

These comments are submitted solely on behalf of the Boston Patent Law Association (BPLA) as its consensus view. The stated arguments, contentions, or positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member.

I. Role of the Ombudsman

The stated objectives of the Ombudsman Program are to further prosecution and to enhance the prosecution process when applicants feel that examination has stalled and that their efforts to move applications forward through the normal channels have not been effective. However, to accomplish these objectives, the ombudsman should be both qualified and be given the power to solve problems, remove roadblocks, and advance the prosecution process. BPLA urges that the ombudsman be given the influence and authority to bring resolution.

A Qualifications

The ombudsman should be qualified to resolve applicants' procedural concerns from both an examining perspective and a legal perspective. He or she should therefore have the following qualifications:

- An ombudsman should be legally trained and exhibit an unquestioning loyalty to the rule of law. For example, an ombudsman should understand that if an examiner's "requirement" is not supported in a document that has force of law, the PTO may not apply it against applicants.
- An ombudsman should understand the importance of procedural law, and the binding nature of applicable law, rules, MPEP, and guidance documents requiring the PTO to take some action or provide some procedural protection to an applicant.
- A working knowledge of key substantive and procedural case law would be helpful to resolve the typical concerns that create disproportionate inefficiencies in prosecution. As the BPLA reads the Notice, the ombudsman would be a quasi-clerical person, potentially lacking authority or understanding of appropriate legal issues necessary to compel resolution of the problem.
- The ombudsman also should have an understanding of the internal workings of the examining corps, e.g., internal Patent Office "policies" and how these conform with or deviate from applicable laws, rules, etc.
- The ombudsman should also be independent of T.C. Directors and other line managers whose compensation depends on production numbers.

The experience of many of BPLA's members is that many of the issues that stall prosecution are already addressed in the MPEP and 37 C.F.R. § 1.104, and that all that stands in the way of efficient examination and prosecution is an efficient and effective way to obtain enforcement of the rules and procedures to which the PTO has bound itself. An ombudsman who could ensure that existing PTO rules and procedures are faithfully observed would ensure a more fluid prosecution process for all.

B Powers

An ombudsman should have the power to further prosecution and enhance the prosecution process. Typically, to make substantive progress during prosecution, the examiner and applicant must communicate directly, under a common set of expectations. Therefore, if the Ombudsman Program is to help applicants and examiners make substantive progress (and not just be a "listening therapist" with no role in advancing an application), the ombudsman must have either (1) some power to stand in the place of the examiner to make decisions about advancing prosecution, and/or (2) the power to police examiners and to compel examiners to address applicants' inquiries in conformance to applicable law, rules, MPEP and other guidance documents.

The Office should set expectations in written guidance, to explain what will occur when the ombudsman cannot resolve an applicant's concern. According to the Notice, if the ombudsman is unable to resolve an issue, the issue will be forwarded to, e.g., Technical Support Staff, Technical Center Director, SPE, or other business unit, and the ombudsman will request that he or she be notified when there is a resolution. However, while the Notice states that the Office intends that all issues be considered and treated within ten business days, it is not clear that the ombudsman will have the authority to ensure that the Technical Support Staff, Technical Center Director, SPE, or other business unit provides a timely resolution. If an ombudsman's inability to satisfy a concern triggers the need for the case to be forwarded to another business unit, the Office should specify when the applicant could expect a response, from whom the applicant can expect a response, and a period by which a resolution will be reached. The ombudsman should have the authority to ensure that timely action is taken, and that the business unit complies with the PTO's legal obligations. BPLA also suggests that the PTO provide applicants with a mechanism to request a status update on their query, for example, a dedicated phone line and/or a separate web site or database link for this purpose.

In this regard, BPLA also suggests that provision be made to obtain same-day assistance from the ombudsman for urgent matters. In some instances, particularly when prosecution cannot be moved forward through the usual channels, time-sensitive issues arise for which applicants require immediate assistance. The ability to submit an urgent request by phone or through the proposed web site would be an important resource to help resolve such circumstances, and an important role for the ombudsman program.

II. Areas Requiring Clarification

While the Notice provides a great framework for an alternative avenue to move prosecution along, it leaves several questions unanswered or in need of clarification.

A Protecting the Written Record

One such issue raised by the Notice is how applicants will be able to take advantage of the Ombudsman Program and still maintain their duty to protect the written record. The Notice states that once an applicant initiates use of the Ombudsman Program, the ombudsman will call the applicant to obtain a full description of the issue. Once obtained, the description will be recorded in a database. Initially, the Notice states, the description will contain enough information to (1) ensure that all requests for assistance are addressed; (2) identify and use trends to develop targeted training for employees as appropriate; and (3) enhance customer service. However, the Notice further states that once the Ombudsman Program is underway, the Office will reassess whether additional information should be recorded and where the record should be made.

In order to make applicants more likely to take advantage of this new avenue to advance prosecution, the Office should make clear precisely what will be recorded, where it will be recorded (e.g., an internal Patent Office database, public or private PAIR), and who will have access to the record (e.g., the public, all Patent Office personnel, or just ombudsmen personnel) before any communication takes place. Moreover, specific examples of the type of information recorded would be helpful as well. Perhaps at least broad, general descriptions in the form of an interview summary should be documented in the record in order to protect the applicant or the public. Furthermore, there should be a provision in transferring all (or perhaps the relevant parts) of the Ombudsman's database on the matter into the written record on resolution of the issue, e.g., in the form of an Interview Record or similar entry.

If applicants are to be candid with ombudsmen and utilize the Ombudsman Program to the fullest, the program will need to be clear about what type of information will be put in the record, and who within the USPTO and public will have access to that information.

B Examples of When Using the Ombudsman Program is and is not Appropriate

The Notice states that the Ombudsman Program is intended as a resource for situations in which examination has stalled and efforts to move applications forward through the normal channels have not been effective. However, the program is not intended as an alternative forum for resolution of disagreements between applicant and examiner that are currently resolved via appeal or petition. The Notice provides no further guidance regarding when using the Ombudsman Program is and is not appropriate, and what specific assistance the ombudsman could provide. Therefore, it would be helpful to have specific examples of when using the Ombudsman Program is appropriate, and when it is not, and what action the ombudsman would

take to resolve exemplary situations or ensure that the situations were addressed following referral to the Technology Center or other business unit. Without such specific guidance, applicants may be hesitant to participate in the program.

It would also be helpful to understand the anticipated scope of the Pilot Program, including who will be eligible to participate initially, and when a full-scale program is expected.

Thank you for consideration of our comments.

Sincerely,

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