Perspectives on Becoming a Successful Examiner

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Thank you for inviting me.

My roots are here at the PTO. And those roots go back quite a way. In fact, I started so long ago that it was not merely before the PTO moved here to Alexandria, but before the PTO moved into Crystal City. When I began, the PTO was based in the Commerce Building itself.

I want to talk to you a little about my career and why I consider my experience as an examiner an important part of my life. And then I want to share with you my perspective on what it takes to be an outstanding examiner and how you can both improve the quality of your skills as an examiner and at the same time simplify your job.

My career, which now spans more than four decades, has come full circle. I started as an examiner, moved into the private sector, and have returned to government service in my current position. I have seen incredible change over the years and have learned much about the patent system and the importance of patents to our economy.

When I started as an examiner in 1965, a career in government, particularly in the federal government, was viewed quite differently from what it is today. Many positions in the executive were considered quite challenging, and came with a decent – almost competitive – salary, with great security and a robust package of fringe

benefits. The Patent Office, as it was known in those days, was a particularly interesting place to work. The technology was interesting, but not necessarily overwhelming in complexity. The pace was modest and easily managed. The law was stable and for the most part understandable.

But things are not the same now as they were back then. Your job is much harder now than it was for me all those years ago. The technology of today's inventions is immensely more complex than ever before. The length and breadth of applications is greater. The volume of prior art is much larger. The legal issues are more intricate and harder to comprehend. And the law is in a continual state of change. Compounding all of this is the perception among some individuals that the work of the PTO in general, and the examiners in particular, is somehow of secondary importance and questionable quality. It is commonly said that the real action in patents is in private or corporate practice.

Let me set the record straight right here and now. The work of the PTO and of the many extremely talented and capable examiners who serve in this agency is by no means secondary in importance or lacking in quality. And this is the first point I would like you to remember. The work of the Office is important, challenging and is central to the continuing vitality of our information-based economy. Your role is not just important. It is critical. Just as the decisions of the Federal Circuit affect all patents, so too, the decisions you make as examiners will affect every issued patent. And it is essential that the examinations you conduct are effective, efficient, and based on sound judgment, consistent with the high standards the public has come to expect from the Office.

When a patent is assigned, licensed, or litigated, the history of proceedings before the PTO is subject to careful and thorough scrutiny. Why? Because the actions you take and the work you do matters. It matters a great deal. The patent, the prior art cited by the examiner, and

the history of the patent's prosecution are the principal exhibits in every patent infringement litigation, and the search for the meaning of every limitation in every asserted claim is at the center of both the infringement and validity side of the case. The intrinsic record, including the prosecution history, is among the first things considered, and the examiner's actions are always relevant to that search for meaning.

35 U.S.C. § 101 says that "whoever invents or discovers any new and useful" process, machine, etc. "may obtain a patent therefore" "subject to the conditions and requirements of this title." In making that determination, you are the judge. You play the key role. Your judgment is the judgment of the executive branch of the United States Government in fulfilling its responsibility of administering the patent laws promulgated in accordance with the U.S. Constitution.

§ 102 of the Patent Act says that "a person shall be entitled to a patent unless…" This sounds like an examiner's job is negative— just to say "no"—with no opportunity for creativity or for the exercise of reasoned judgment. Not true. Your job is to grant patents—valid patents. And that takes a combination of skills, reasoning and informed judgment. The Examiner's task is to assess the patentable merits of each invention, as presented, and to grant patents where patents are due. No applicant wants an invalid patent. Similarly, no examiner wants to grant an invalid patent. Thus, both the applicant and the examiner play parallel and complementary—not contradictory—roles in seeing to it that valid patents are issued.

To succeed as an examiner, you need not only a mastery of the patent statutes, the PTO rules, and the MPEP. You also need an understanding of how to apply those statutes, rules and guidelines to the cases before you. That is a very difficult thing to do and requires judgment and the making of difficult decisions. Finding references, interpreting claims, evaluating the disclosures and teachings of the prior art, and formulating rejections that are

reasonable and sustainable are very hard things to do. And to do that well is virtually impossible if all you know are the statutes, the rules and the MPEP in the abstract.

I know many of you are not lawyers and for that reason are not accustomed to reading legal decisions or following the opinions of the courts. But reading legal decisions, particularly those of the Board and the Federal Circuit, is not only the best way to learn how to make the tough decisions you are regularly called upon to make, but also the best way to make your job easier and more enjoyable. You might ask, "why should I bother to read decisions of the Board and the Federal Circuit? After all, I have all the guidance I need in the MPEP, and I don't have time to spend reading other cases that have nothing to do with me." The answer is that the cases bring to life the statutes and rules you are required to apply and give you real world examples of how those statutes and rules apply in similar cases. The MPEP has some guidelines, but they are just a sampling and cannot possibly reflect the full range of claims and circumstances you face every day. Keeping up with the law by reading decisions of the Board and the Federal Circuit will allow you to master your craft and will result in your standing out from your peers.

Don't run from it—embrace the challenge to learn and rise to the task of mastering the skills it takes to be a key member of the PTO team that is the envy of patent systems throughout the world. The practice of law is called a "practice" for a reason, and patent examination is much the same. The key is to keep up with ongoing developments in the law, to find the time to learn about what it is you are called upon to do, and to work hard at being the best you can be. And you will be surprised at how much easier it will be for you to evaluate claims and formulate rejections with the broader mastery of the law that only comes from reading cases on a regular basis.

The last point I want to make is to not forget about § 112. It has been a long time, but I can still remember

what it was like being an examiner. I remember the pressure to meet production levels and the difficulty of coping with hard cases. By hard cases, I mean not only cases with complex technology or voluminous specifications and claims, but also the simple cases for which you knew there was prior art but because it was so simple, you just couldn't find it written down anywhere.

As an examiner, I remember being challenged from time to time about questions of patent eligibility under § 101. Because of the nature of the art I examined, the questions in that area did not arise frequently, but when they did, they were always difficult and required tough judgment calls. As for novelty under § 102, the decisions themselves were not very difficult—either the art showed the claimed invention or it didn't—but nonetheless, I was always concerned about making a mistake on anticipation. As an examiner, the last thing you wanted was for someone else to find a dead ringer reference covering a claim you allowed. And, of course, the most common challenge, and the subject of most of the fighting, was § 103. Obviousness was then and continues today to be a hard question. So, I remember spending lots of time on § 103, § 102, and § 101, in that order of effort.

But in all of this, there was relatively little attention paid to § 112. It didn't seem to matter all that much—or so we thought. After all, it was the applicant's responsibility to draft claims, and if those claims were vague and indefinite or lacking in support in the written description, that was the consequence of the applicant's own actions. But it is not correct to trivialize or ignore these kinds of informalities. Indeed, these kinds of problems affect not only the applicant but the public as well in a significant way.

In case after case before my court, the central debate revolves around the meaning of claims terms that, for example, were added during prosecution and do not appear anywhere in the written description. For those cases, the meaning of the claim limitation has to be

inferred from other words, leaving the issue open to unnecessary dispute and leading frequently to protracted and costly litigation. You have the authority and the responsibility to not let that happen and to insist that applicants use words in the claims that find unambiguous and full support in the written description.

We also frequently hear cases in which the patent has only one embodiment but the claims use broad language. In such cases, there is often disagreement as to whether the single embodiment is merely exemplary of a broader invention or is co-extensive with the full scope of the invention. Without any clear explanation in the written description or prosecution history, courts and the public must infer the correct meaning to be given to otherwise broad recitations in the claims. Again, you have the authority and the responsibility to not let that happen and to make certain that the full scope of the invention recited in the claims is enabled by the written description. Bottom line—§ 112 does matter, and your actions in insisting on strict adherence by applicants to the statutory mandate to "particularly point out and distinctly claim" the invention will make a difference. The public's interest is well-served when the meaning of all of the terms used in the claims does not have to be inferred but is unambiguous and capable of discerning explicitly from the written description and prosecution history.

I am proud to have served as an Examiner. The three years I worked in the Office were formative years for me, and I wouldn't be where I am today if it were not for the things I learned, the experiences I had, and the people with whom I was associated in the Patent Office. You are fortunate to be a part of this organization and to have the opportunity to enjoy all that it offers. I commend you for your hard work, and I wish you all the best for continued success.

Thank you very much.