

Neifeld IP Law, PC

4813-B Eisenhower Avenue
Alexandria, Virginia 22304

Tel: 703-415-0012
Fax: 703-415-0013
Web: www.Neifeld.com
Email: general@Neifeld.com
(See web site for attorney list)

April 8, 2008

TO:
The Honorable Arlen Specter
United States Senate
Washington, DC 20510

Re: S. 1145 AND THE PROPOSED "Applicant Quality
Submissions (AQS)"

Dear Senator Specter:

I write in response to the USPTO's continued attempts place the burden of patent examination on the applicants. **I oppose any such attempt.**

I am a patent attorney specializing in patent prosecution and related matters. I am in the best position to assess the impact of such requirements on applicants. In my opinion, such requirements would be very detrimental to inventors, their assignees, and detrimental to the public at large.

As you know applicants are under a duty to disclose information that they know is material to examination of applications. Failure in that USPTO imposed duty has dire consequences. Members of the patent bar generally take that duty seriously. They notify applicants and submit information within the knowledge of applicants, as required by that duty.

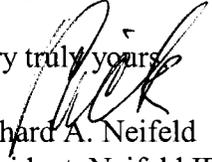
The AQS submission requirement would however go far beyond that. It would require substantial efforts by inventors and applicants that would at best be duplicative of the searches conducted by USPTO examiners. Moreover, USPTO examiners and the USPTO have the resources and specialized knowledge to conduct such searches; inventors and their assignees generally do not.

Requiring AQS submissions in the form contemplated by the USPTO Director is a bad idea. Granting the USPTO authority to require such submissions is therefore also a bad idea.

In fact, the USPTO has now published statistics showing just how bad an idea it is. Attached please find web pages from the USPTO.gov web site showing that only 40 percent of patent applications filed with accelerated examination petitions (AE petitions) had those requests granted. That is, 60 percent of the patent applications for useful inventions never got to an examination of the claimed invention - - they were derailed due to the procedural requirements of the AE petition process. Since the AE petition requirements and what the USPTO proposes for AQS submissions are identical, extrapolating results in the conclusion that 60 percent of the patent applications would never be examined on the merits. In fact, this is probably an under

estimate because the inventions for which AE petitions have been filed were done so voluntarily, selected from the most important and time sensitive inventions, and with the applicants knowing the consequences of failure. Anecdotally, one of my colleagues told me that his firm filed an application with an AE petition, and the search for the prior art in support of the petition costs \$80,000.00. Their petition was dismissed requiring them to refile it. Their application is still hung up in prosecution because of issues relating to the AE petition. My colleagues assessment of the AE petitions process based upon his experience is that it is a failure, actually delaying patenting of inventions instead of speeding up the process. And at enormously increased costs.

Very truly yours,


Richard A. Neifeld
President, Neifeld IP Law, PC

cc: Jon Dudas, Director of the USPTO
Mail Stop - Congressional Relations
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

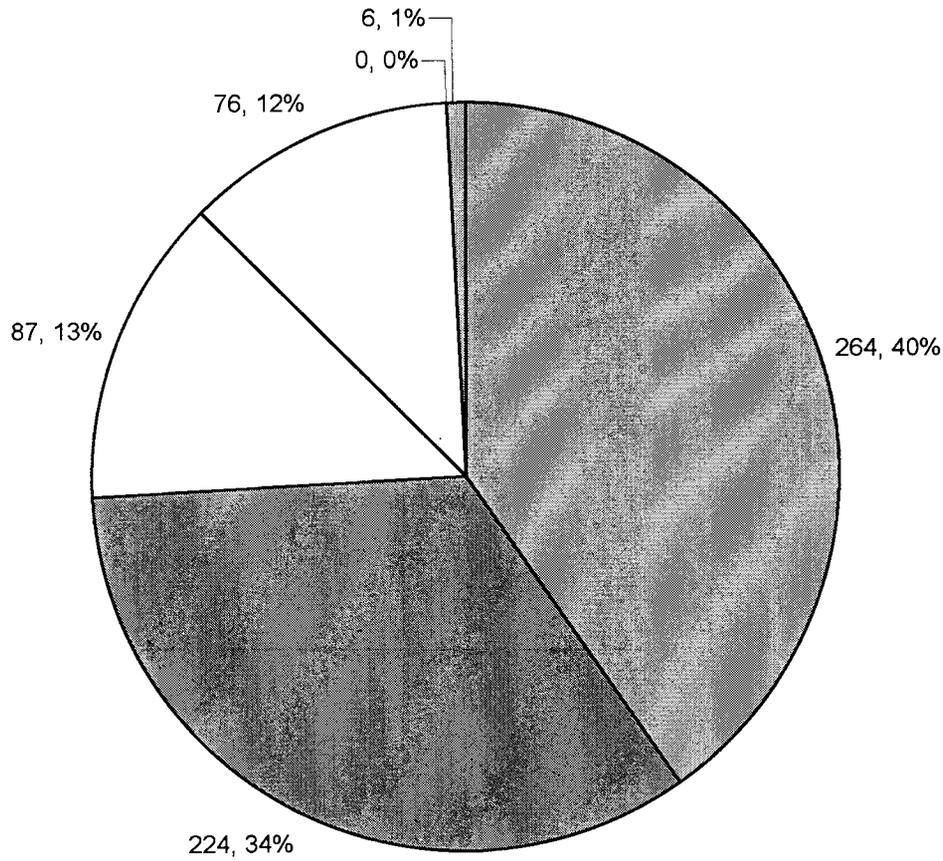
cc: The Honorable John Warner
225 RUSSELL SENATE OFFICE BUILDING
WASHINGTON DC 20510

cc: The Honorable Jim Webb
144 RUSSELL SENATE OFFICE BUILDING
WASHINGTON DC 20510

Encl: Printout of
http://www.uspto.gov/web/patents/accelerated/ae_stat_charts.pdf

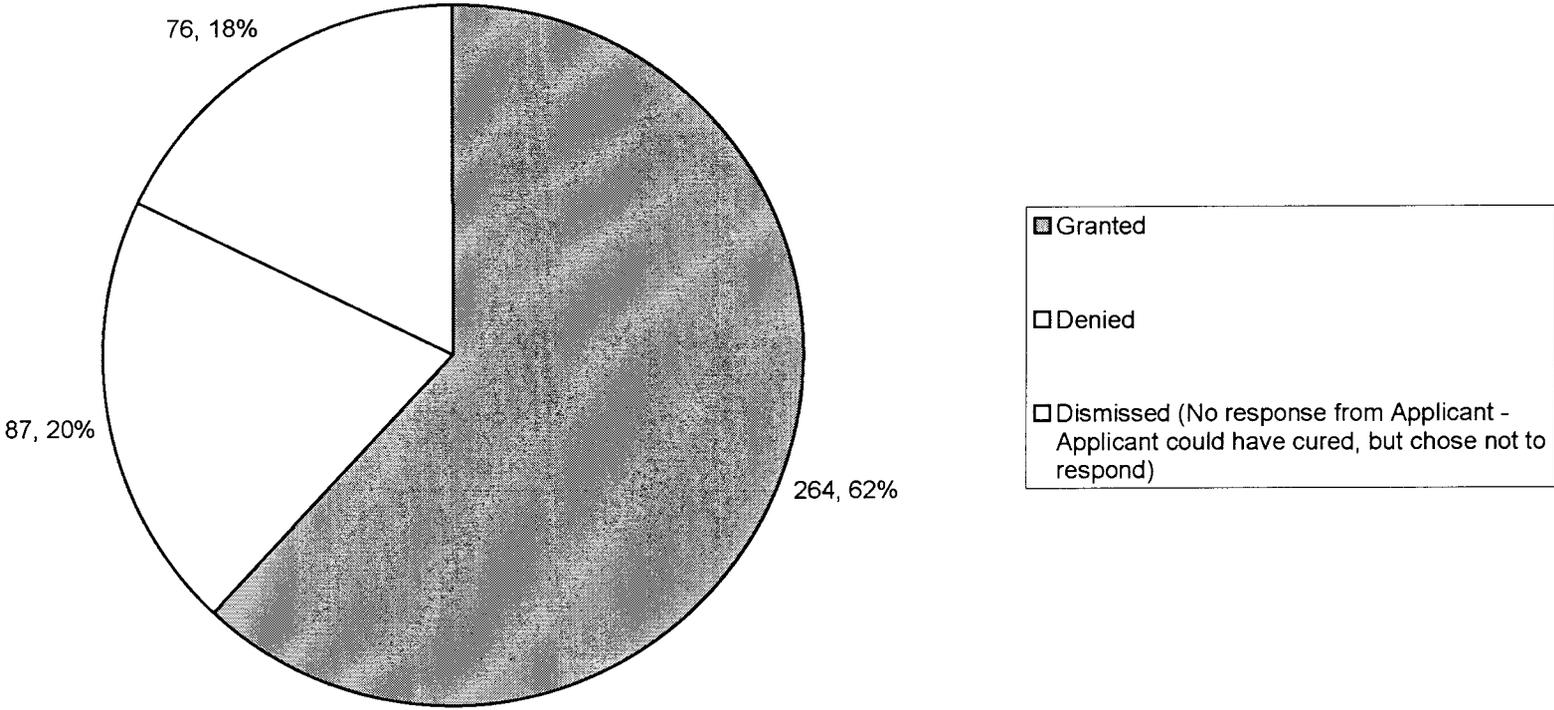
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AE Petitions Status
(all filed N= 657 as of 8/31/07,
Status as of 2/20/08)



- Granted
- Denied (Not Meeting Formal Requirements, such as application not being complete upon filing)
- Denied (Based on Merits)
- Dismissed (No response from Applicant - Applicant could have cured, but chose not to attempt)
- Pending (Undecided)
- Express Abandonments

AE Petitions Decided on Merits/Substance
(those that meet formal requirements, Applications filed through 8/31/07,
N = 427, Status as of 2/20/08)



AE Petition Status		
Petition Status	Number of Applications	Percentage
Granted	264	40.2%
Denied (Not Meeting Formal Requirements, such as application not being complete upon filing)	224	34.1%
Denied (Based on Merits)	87	13.2%
Dismissed (No response from Applicant - Applicant could have cured, but chose not to attempt)	76	11.6%
Pending (Undecided)	0	0.0%
Express Abandonments	6	0.9%
<i>Total</i>	<i>657</i>	

AE Prosecution Status		
	Number of Applications	Percentage
Total	264	100%
Pending	170	64.4%
Completed Prosecution	206	
Allowed	90	30.0%
Abandoned	4	0.9%

AE Final Disposition (as defined in the Fed. Reg. Notice)		
	Number of Applications	Percentage
Allowed	90	
Abandoned	4	
Final Rejection	112	
Total	206	78.0%
Pending Final Disposition	58	22.0%