

# LITIGATORS CORNER: Another Look at PTO Examiners



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In a previous column, *What's Wrong With the Patent Office?* (June, 2003), I wrote about two PTO reexaminations that were conducted badly, and with special sloth (the opposite of special dispatch). I didn't imagine that I would be returning to that subject so quickly, but here I am.

Describing himself as a commentator on software patents, Mr. Gregory Aharonian recently circulated another email about the reexamination of a patent owned by TechSearch, one of our clients: the Rozmanith patent. Mr. Aharonian said at one point in his earlier commentary that the "PTO flushes Rozmanith patent down the toilet."

Everyone's entitled to his opinion. But you should know how the PTO is doing the "flushing" here, because it is not being done with the impartial professionalism that a patent system requires, or with the special dispatch mandated by law for reexaminations. The Rozmanith patent does not deserve the shabby treatment it is getting by the Patent Office. The Patent Office's examiners are quasi-judicial officials; competence, and the appearance and fact of impartiality, are essential.

The trouble began at the beginning. After the reexamination request was filed in June, 2000, it was assigned to an examiner who, our client

later learned, had a website. In one interview, this examiner, speaking about the Rozmanith patent, said that no conceivable set of claims could ever be patentable in the reexamination. That was pre-judgment. It also was a plainly inaccurate pre-judgment, because there were no prior art citations against some of the claims. The examiner said that his reasoning was a reflection of his personal experience in maintaining a server at his home, and that his personal experience, not the prior art, was the basis for his position.

We checked out this examiner's website. The site appeared unofficial, but used his email address at the PTO, and included references to technologies that appear related to the subject matter of the types of applications normally examined by him. The website also had a link to another website, <http://www.bustpatents.com>, Mr. Aharonian's site. After our client's request to meet with a supervisor to discuss the assigned examiner's remarks was rejected, our client petitioned to have the examiner disqualified. The petition was granted, and the reexamination was reassigned, but time was lost. Nevertheless, in an office action, the new examiner used the same, nearly verbatim rejection employed by the disqualified examiner; no suggestion of a fresh look there.

By June, 2002, the reexamination was still going on. The new examiner, however, gave no sign that he had ever considered evidence of commercial success and the date of the invention provided by our client in a response six months earlier. Dealing appropriately with such evidence is a major part of an examiner's job. Our client was justifiably concerned, and said:

The Request that led to this re-examination was filed on June 9, 2000. Notwithstanding the requirement that re-examinations be conducted with "special dispatch," and despite the pendency of patent infringement litigation involving this patent, little or no progress has been made during the more than two years that has elapsed since the commencement of this re-examination. The Examiner has cited scores of alleged prior art references not even mentioned in the re-examination request – many of them mere advertisements with essentially no technical content, as explained in the Declarations of Dr. Koopman. Even now, two years after the request was filed, the Examiner continues to cite still more new alleged prior art references. An applicant who cited so much alleged "prior art" would be accused of acting inequitably by trying to bury pertinent art

in an avalanche of marginally relevant or irrelevant references.

Applicants respectfully submit that the purpose of re-examination is to address any substantial new questions of patentability identified in the Order granting re-examination, not to conduct an apparently unlimited search for additional references, with no end in sight, after Applicants have distinguished the references already cited.

The examiner objected to our expert's declarations, which constituted technical evidence from a Ph.D. associate professor in electrical engineering at Carnegie Mellon University, with twenty patents of his own. This examiner, like the examiners I mentioned in my earlier article, had trouble with grammar when he denigrated our expert: "It is generally not clear, as to why Dr. Koopman insist [sic] that one of ordinary skill in the art would be mystified by the rather basic technique of using existing compression algorithms."

Another year has passed and, of course, the reexamination is not yet over. It is now in its third year. As I pointed out in my earlier article, the requirement of special dispatch applies in practice to the patent owner, but not to some PTO examiners.

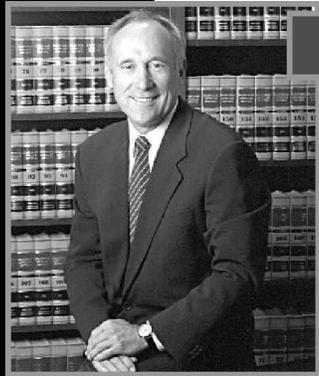
Piling on was apparently the order of the day. The examiner kept adding prior art references throughout the examination. After one group of prior art references was dealt with, the examiner came up with a bunch more. The re-examination request cited only one U.S. patent. During the reexamination, however, the examiner cited hundreds more; many were advertisements. Some were undated; others bore dates making it impossible for them to be prior art. In the final action, the examiner dredged up fourteen more, bringing the total to two hundred and sixteen references.

This examiner also had the same trouble with complete sentences as the examiners I described in my earlier article. Here is one sentence fragment, followed by a sentence that isn't punctuated correctly:

As the reference supplies more documentation on RISC or CISC based computers, than the instant patent. Is this Dr. Koopman [sic] expert testimony on the enablement of the instant patent?"

When our client said that a reference – one of the hundreds – cited by the examiner did not support his rejection, and tried to learn from the examiner where in the reference the invalidating information could be found, his response was not to point to it, but instead to blow smoke: "The referenced section is courtesy [sic] to the patentee, with an expectation that the reference be read in its entirety if necessary. The entire reference is cited for the teaching."

In June, 2003, our client appealed. The fun isn't over. A group director refused to accept the brief for filing and demanded that "discourteous" remarks be removed. The remarks he com-

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plained of were those about the first examiner's biased statement, at the outset, that no conceivable claims could ever be allowed. The group director said our client had failed for two years to bring these remarks to light. But the group director was wrong. The remarks were described in, and were one of the bases for, the successful petition to disqualify, made two years earlier, in June, 2001.

This isn't right, folks. The Patent Office and its examiners have a job to do: examine patent applications to see if they meet the statutory standards, and consider factual evidence, especially declarations, submitted by the applicant or patent owner. As Sergeant Joe Friday used to say, "Just the facts, Ma'am, just the facts." Then examiners are required to apply their unbiased skill and judgment, and to write an office action that meets minimum standards of English. I don't know what the right result is on this patent, but I do know the "process" isn't a process at all.

So read Greg Aharonian's emails if you like. But read this column, too. Then, and only then, should you decide whether a patent owner is being given fair, competent, and impartial treatment. We hope what happened to our client doesn't ever happen to any of your clients. But I'm not so optimistic. This is the third reexamination I have seen where the examiners made fundamental errors, where the reexamination was prolonged, and where an appeal was necessary. (The other two are over: we won an appeal on both.)

I'd like to finish by quoting part of the appeal brief commenting on the bulk, and lack of merit, in the examiner's work in the Rozmanith case:

"Another damned, thick, square book! Always scribble, scribble, scribble! Eh! Mr. Gibbon?"

[William Henry, Duke of Gloucester, upon receiving from Edward Gibbon a copy of Volume II of his The Decline and Fall of the Roman Empire (1776-1788).]

In this re-examination, notwithstanding the requirement for "special

dispatch," the PTO has taken three years since receipt of the anonymous "request for reexamination" on June 6, 2000, to arrive at its "Final Rejection." In the process 216 individual alleged prior art references totaling 4,252 pages were cited (not to mention repeated references to unspecified "understanding" of "persons of ordinary skill"), creating a record that exceeds 5,400 pages in length . . . . The text of the Final Office Action (mailed April 15, 2003) alone totals 265 pages, not including 14 new references (90 pages) cited therein for the first time.

\* \* \* \*

The end result is a disgrace. The record of this three-year-long re-examination is already more than twice as long as the 2,537 pages of Gibbon's The Decline and Fall of the Roman Empire and almost four times as long as the 1,456 pages of Tolstoy's War and Peace (1902), though without the literary merit of either work. The length of the record – which is mostly repetition and endless quotations of evidence supplied by Applicants, without any acknowledgment of the actual content of Applicants' evidence – does not translate into quality. What it does reveal is a conscious attempt to create a stack of paper so forbidding that effective review on any appeal will be impossible, or at least very difficult.

Applicants respectfully submit that the purpose of re-examination is to address any substantial new questions of patentability identified in the request for re-examination. It is not to conduct an apparently unlimited search for additional references, with no end in sight, after Applicants have distinguished the hundreds of references already cited. Yet, that is what has happened in this re-examination.

Oh, and by the way, Mr. Aharonian's premature email says: "I win my lawsuit and beat the Great Niro Scavone Law Firm!!!" No, not really. Did you notice that the docket entry says "Techsearch has no objection to the motion" and that the dismissal is "with leave to reinstate" if the Board rules differently? Here is Techsearch's response to the motions to dismiss:

TechSearch has no objection to dismissal of this action without prejudice and with leave to reinstate given the extraordinary period the PTO has taken to conclude the reexamination these defendants supported. In this way, TechSearch will not be prejudiced should the patent issue from reexamination, since the originally filed case and claim for damages can be reinstated.

In other words, our client told the Court the same thing it told the Patent Office: this reexamination has been unjustly prolonged; it should have been over with, one way or the other, years ago. But the reexamination process here has failed, both with respect to special dispatch and reasonable adherence to good standards of examination.

As I said, everyone's entitled to his opinion. Me, too. When a patent is lost because the examiner does a two-step instead of his job, the patent system suffers. Whatever your views about a particular patent may be, we all need an agency that has the respect of the public. Otherwise, inventions won't be patented; they will go into hiding as trade secrets, or inventors will figure that prosecuting an application – or trying to protect an invention through a costly and time-consuming lawsuit – isn't worth it. Then we all lose. 