

**From:** Paul Cole [email redacted]  
**Sent:** Wednesday, May 06, 2015 8:32 PM  
**To:** WorldClassPatentQuality  
**Subject:** RE: Testimony Responsive to "Request for Comments on Enhancing Patent Quality"  
**Importance:** High

Apologies for troubling you – please use this version with a few important corrections

**Paul Cole**  
*Chartered Patent Attorney*  
*European Patent Attorney*

**Lucas & Co.**  
w: [www.lucas-uk.com](http://www.lucas-uk.com)  
e: [email redacted]  
t: +44 (0)1883 626211  
f: +44 (0)1883 622997

The partners and other professionally qualified members of Lucas & Co. are all European and/or UK registered patent and/or trade mark attorneys. They are regulated in the UK by the [Intellectual Property Regulation Board](#) and adhere to its [Code of Conduct](#) and if applicable to the [Rules of Professional Conduct](#) of CIPA and/or the [Code of Conduct](#) of the EPI. For further information about this please refer to the [Legal Notices](#) page of our website.

The information contained in this email message may be privileged and confidential. If the reader is not the intended recipient, or the agent of the intended recipient, any unauthorised use, disclosure, copying, distribution or dissemination is strictly prohibited. If you have received this communication in error, please notify the sender immediately.

**From:** Paul Cole  
**Sent:** 07 May 2015 01:22  
**To:** [WorldClassPatentQuality \[at\]uspto.gov](mailto:WorldClassPatentQuality[at]uspto.gov)  
**Subject:** Testimony Responsive to "Request for Comments on Enhancing Patent Quality"

Hon. Michelle K. Lee  
Under Secretary of Commerce  
U.S. Patent and Trademark Office  
Alexandria, Virginia

Please find attached my comments.

Kind regards

Paul Cole

**From Paul G. Cole  
Chartered Patent Attorney  
Lucas & Co  
135 Westhall Road  
Warlingham  
Surrey CR6 9HJ  
United Kingdom**

Hon. Michelle K. Lee  
Under Secretary of Commerce  
U.S. Patent and Trademark Office  
Alexandria, Virginia

via email: [WorldClassPatentQuality\[at\]uspto.gov](mailto:WorldClassPatentQuality[at]uspto.gov)

Re: Request for Comments on Enhancing Patent Quality, 80 Federal Register 6475  
(February 5, 2015)

Dear Ms Lee

I am writing to support comments made by Harold G. Wegner today especially with regard to simplification of the Manual of Examining Procedure and the need for improvement in techniques of patent drafting, which could be more positively and widely taught with a cooperative effort between the USPTO and the profession.

I entered the UK profession in 1968, qualified as a UK patent attorney in 1973 and have been in full-time professional practice ever since that time. The majority of my professional work has centred on drafting and prosecution, but I have also been involved in a number of litigations in the UK courts, some of which progressed to full trial and appeal and that aspect of my work has fed back into my day-to-day prosecution and drafting practice. The legal and academic aspects of the patents profession have fascinated me from almost the beginning of my career and I have written and published extensively since 1976, founding a newsletter *Intellectual Property Decisions* in the late 1970's, publishing numerous papers especially on the issue of inventive step, and publishing through the Chartered Institute of Patent Attorneys a book entitled *Fundamentals of Patent Drafting* which has become a standard UK reference work and is provided free of charge to every student who enters our profession. In addition I have been for some years an editor of the *CIPA Guide to the Patents Acts* published in London by Sweet and Maxwell. Teaching has always been an ancillary part of my work and I am a visiting professor in IP Law at Bournemouth University. US patent law and practice is of great interest and I have attended AIPLA meetings for many years and greatly benefited from discussions with US colleagues.

Experience with the CIPA Guide well demonstrates the problems which arise with a work such as MPEP which Wegner aptly describes as a tertiary source. The work started as a relatively slim volume shortly after the UK Patents Act, 1977 came into force, but is now challenging what is possible for a single-volume. Its word count

now amounts to some 16.5 PhD theses, assuming that a PhD has some 80,000 words. The difficulty is that the law is added to continuously so that it is always desirable to add new material, but few are prepared to take the responsibility for crossing anything out. The late Peter Rosenberg of the USPTO wrote an excellent short guide to US patents some decades ago, but that has also expanded into a multi-volume work. Although these sources are invaluable as references, the editors and contributors hope that they will be read by students and practitioners, but the longer the work the less likely that is to happen. Books live on bookshelves, from which they stray only infrequently, and the larger and longer they are the less likely they are to be actually read and studied.

The MPEP contrasts sharply with the EPO Examination Guidelines <https://www.epo.org/law-practice/legal-texts/guidelines.html> which it is submitted are shorter and more accessible. The UK IP Office also publishes a Manual of Patent Practice

[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/416890/manual\\_of\\_patent\\_practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/416890/manual_of_patent_practice.pdf)

which at 972 pages is not a model of brevity but which is nevertheless accessible to readers. One of the advantages of the MOPP is the way in which it is divided into individual chapters each dealing completely with a single section of the Act. Thus a reader can consult 001 patentability, 002 novelty, 003 inventive step, 014 the application and find relatively concisely much of the background information needed for patent drafting.

By all means keep MPEP because tertiary sources are a vital reference and the work of compiling them is the work of generations and should be respected. But a shorter guide accessible to and likely to be actually read by new examiners and new attorneys is clearly something to be desired. If you need a model, the rarely consulted PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES, <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf> would be a good starting point, especially Chapters 4 and 5.

One of the points raised in the Supreme Court in the *KSR* decision was that the approach to inventive step requires common sense, and in the same way as organizations look for loyalty up and loyalty down, I feel that we as attorneys should apply common sense up in our submissions to the USPTO and are entitled to receive common sense down in examination reports and other communications from the USPTO. Sometimes what we receive from the USPTO strays from common sense because of a phenomenon that Professor Diane Vaughn has called “the normalization of deviance”, and sometimes that lack of common sense is adopted by the judiciary. One startling example is the opinion of the Federal Circuit *In re Bigio* where hairbrushes and toothbrushes were held to be a common field of endeavour, to the amusement of generations of my students. A slide that I have used for teaching says it all:

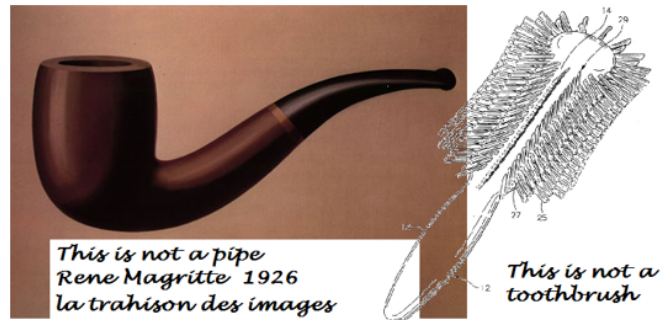
## In re Bigio (CAFC, 2004)

Hairbrush bristle invention

Alleged common field of activity for hairbrushes and toothbrushes  
(hand-held brushes with a handle segment and a bristle segment)

Toothbrush bristle art therefore citable against a hairbrush

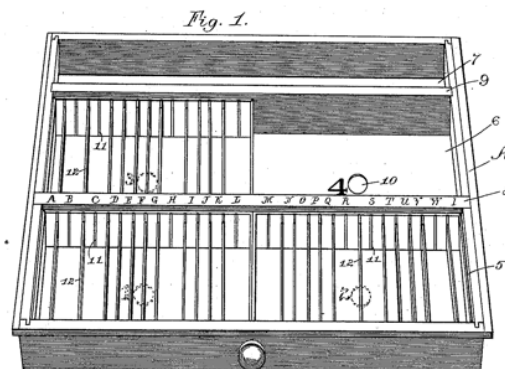
Europeans have trouble understanding this decision



Likewise the Victorian merchant's drawer in *In re Klein* mysteriously morphed into a mixing jug when it was a matter of common sense that it had nothing to do with mixing jugs, again see the slide below:

## In re Klein (CAFC, 2010)

This is not a mixing jug



It is respectfully submitted that nonsense of this kind has nothing whatsoever to do with patent quality and indeed detracts from patent quality and places an unfair burden on applicants. Indeed much is made of “broadest reasonable interpretation”, which alas is only too liable to degenerate into “broadest unreasonable interpretation”, the objectives of “correct interpretation” or “accurate interpretation” which are often lost from sight.

It would be possible to go on at great length about obviousness and combinations of references, and there is not time to do so here. But when I started in the profession, if a new function or result could be shown not clearly foreseeable from the references when read in combination, it was highly likely that a patent would issue. Both attorneys and examiners were on the same playing field and both knew the

rules, so that an agreed outcome could be reached within reasonable effort on both sides. Some of that has been lost and should be regained. In practice before the EPO we both know the rules, and although we may disagree sharply our differences are within a manageable range and outcomes are broadly predictable.

Harold Wegner emphasizes teaching, and the USPTO could play a part in this and help to collect and assemble judicial advice from various cases. For an example, much sage advice can be gleaned from the 1997 opinion in *Sage Products v Devon Sharps*, see also *Festo* on foreseeability.

Improvement in patent quality is a cooperative effort demanding contributions from both USPTO and attorneys. In UK and Europe, drafting and amending of specifications are examined with detailed question papers, and past UK Patent Examination Board papers are available on the CIPA website – you should look under P3 and P4

<http://www.cipa.org.uk/pages/PEB-Past-Exam-Materials>

All of us in UK and Europe would agree that examinations of this kind are desirable and necessary and improve patent quality by encouraging our students to reach an appropriate standard early in their careers. At an AIPLA session that I chaired some years ago, Jonathan Grant, a US patent attorney, lamented the absence of similar questions in the USPTO test for qualification. Famously in *Mayo v Prometheus*, the claim in issue started “a method for optimising...” and then went south. The court and witness time that could be consumed in construction of the term “optimising” and the difficulty for enforcement arguably defy description. Drafting and prosecuting patent applications is one of the great professional skills and we all need to cooperate to raise standards and widen access to good teaching.

With thanks for your time and good wishes for your efforts.

Yours sincerely

Paul Cole