

From: Allen E. Hoover [mailto:AHoover@fitcheven.com]
Sent: Wednesday, February 17, 2010 12:45 PM
To: Fawcett, Susan
Subject: 0651-0033 comment

This is a comment for myself only, not for any other person or entity, on the February 9, 2010 Federal Register Notice re post allowance and refiling matters.

Some of the estimated times for response listed in the Notice are far too low.

For "reissue documentation," the notice indicates an estimated time of two hours. This is way too low; at a minimum, this estimate is too low by a factor of 20. The planning of a reissue application is very time consuming. One must consider prior art, competitive positions, etc. After preparing the reissue application, it might take a couple of hours just to assemble and file it, but the preparation of reissue application -- which involves claims drafting, identification of errors, analysis of prior art, and so on -- takes much more effort.

Also, once the reissue application is on file, the PTO will issue office actions, and the applicant will have to prosecute the application, and perhaps even appeal. Especially upon consideration of subsequent prosecution efforts, the 2 hour estimate is far too low.

Using the 2 hour estimate figure, and an average attorney cost of \$325 per hour, then a reissue application should cost less than \$650 in legal costs (presumably a paralegal would prepare some of the paperwork, and some of the paperwork burden would be felt by the client). This figure does not comport with reality. A simple reissue easily could cost \$10,000 in legal fees.

For preparation of a supplemental reissue declaration, the notice estimates 1.8 minutes. This again is way too low. It can take 1.8 minutes just to download and print a patent office communication. Analyzing a defect notice and preparation of a response, forwarding the response and revised declaration to the client (sometimes through a central legal or patent department), receiving the response, reviewing the response for accuracy, filing the response, and docketing the filing will take much more than two minutes.

If the defect is easily corrected, at a minimum I would estimate an hour's effort. But some defects in reissue declarations are not easily corrected. Sometimes the response will require detailed analysis and effort. See *Ex parte Tanaka* (BPAI December 9, 2009) (discussing what errors might or might not be correctable by reissue). Sometimes the matter requires legal research. In *Tanaka's* case, the matter required an appeal to the Board, with the filing of appeal briefs and oral argument. These efforts cannot be completed in 1.8 minutes.

Re EFS, the notice states "The USPTO estimates that it will take 5 seconds (0.001 hours) to print and retain a copy of the acknowledgment receipt." This is far too low, to the point of being silly. A two-page acknowledgment receipt might take five seconds to feed through the printer, but it will take more time to download, print, and docket the receipt. Someone usually reviews the acknowledgment receipt for accuracy. This effort might take only five or ten minutes in total, in which case the PTO's estimate would be off by a factor of at least 60. If there are problems with the acknowledgment receipt, correction will require more time. Since problems sometimes do arise, this raises the average time required re the receipt.

Payment of an issue fee will take at least an hour (including the time required in EFS or in preparing envelopes for mailing). An attorney or experienced paralegal usually reviews the file in detail to ensure that the case is ready for issuance.

The consent of the assignee will take longer than six minutes, because someone must route this to the client (again, often through a legal department), who must execute and return the document.

The other estimates mentioned in the notice are also low.

Thank you for considering these comments.

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