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Patent Office Moves West

by Emmett Berg

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IP attorneys in California are anticipating a transcontinental shift in the patent process thanks to the U.S. Patent and Trademark Office's announcement that it will create a satellite facility in Silicon Valley within the next three years.

The PTO has historically been located in the Washington, D.C., area. Inventors have traveled to the capital to seek patent protection since President George Washington was the signatory on applications in 1790 for candle making, flour milling, and a potash and pearl ash recipe.

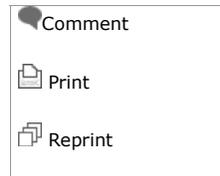
But the pace of technological innovation today has contributed to a backlog of applications at the PTO, with a potential wait of three to five years or even longer. Lawyers also say there's a sense that patent examiners based on the East Coast often fail to grasp the nuances of the latest Silicon Valley inventions without guidance by inventors and their attorneys.

"I wish we could pay them to go to Disneyland and do nothing, as opposed to issuing any more software patents," grouses Todd Smithline, the principal of Smithline PC. "It would be a much better use of taxpayer money."

A partner with Baker Botts in Palo Alto, Christopher W. Kennerly agrees that "Having the right technological experience has been a problem with the current patent office." But he and others caution that hiring patent examiners from Silicon Valley could be difficult given the local cost of living. And some of the best candidates for the new positions are likely to have extensive ties throughout Silicon Valley, raising the possibility of conflicts of interest, he says.

According to a PTO spokesman who insisted on anonymity, patent examiners presently "may" be asked to file a confidential financial disclosure report to "avoid real or apparent conflict of interest." "I know financial disclosure was discussed" as part of planning for Silicon Valley and the three other new regional PTO locations in Dallas, Denver, and Detroit, the spokesman said.

The move away from D.C. amounts to "a big step," according to patent attorney Steve R. Bachmann, of counsel with Lewis and Roca in Mountain View. "It'll be much easier for the inventors to get face-to-face with examiners to get them up to speed. Count me as one who sees a glimmer of hope."



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