

**From:**  
**Sent:** Monday, March 08, 2010 11:20 PM  
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Dear Sirs:

In response to the U.S. Patent and Trademark Office's "Request for Comments on Enhancement in the Quality of Patents," 74 Fed. Reg. 65093 (December 9, 2009), we present the following comments and suggestions.

Respectfully Submitted,

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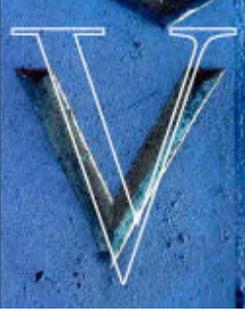
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## Response to Request For Comments

United States Patent and  
Trademark Office, Commerce

March 8, 2010

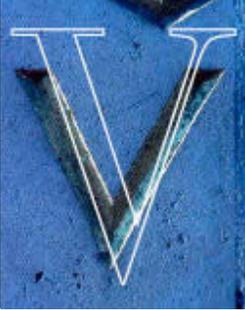
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## Introduction

In response to the U.S. Patent and Trademark Office's "Request for Comments on Enhancement in the Quality of Patents," 74 Fed. Reg. 65093 (December 9, 2009), we respectfully present the following comments and suggestions.

As a preliminary matter, we agree with the U.S. Patent and Trademark Office (USPTO) that the most effective way to enhance quality and reduce pendency is by monitoring progress and intervening if necessary early in prosecution. Identifying and clarifying issues raised by Examiners and applicants early in the process allows prosecution to proceed efficiently toward closure. Unfortunately, it is difficult for the USPTO to control the action of practitioners; but, by proper training and oversight of Examiners, and by providing tools and mechanisms to clarify and focus issues, the USPTO can help the practitioner/applicant to effectively address areas that need to be resolved to show patentability in the response. In turn, when the practitioner/applicant provides such a focused response, the Examiner can more efficiently evaluate the position, and more effectively respond. This can help effectuate closure of prosecution, either by allowance or focused appeal, or provide a basis for amendments that advance prosecution.

While there are a number of areas that can be used to facilitate the improvements, we have chosen to focus our comments on three proposals that could enhance efficiency and benefit the USPTO and its users – the inventor community.

Enhancements in Examiner legal training could positively impact patent quality by providing a better understanding between Examiners and practitioners. Although Examiners come to the office well equipped to handle technical issues, there is often a gap when applying legal principles to technical arguments. Filling this gap would improve working relationships with practitioners, who often present arguments and evidence based on the law and its changing landscape rather than strict application of rigid rules and procedures. Areas that are ripe for application of proper legal standards include: recognizing allowable subject matter, rather than only searching for a basis for rejection; recognizing legally effective arguments, rather than summarily dismissing arguments based on the law; and legally evaluating sufficiency of evidence submitted to support allowability. Proper legal training will promote cooperation between Examiners and practitioners, allow for more streamlined, effective and efficient resolution of issues and reduce pendency.

Review of work product, on the part of both Examiners and practitioners, is another area that can be modified and improved. A mechanism is proposed that would allow for review and evaluation of a much broader range of activities before the office – from the initial application, to office actions, to responses and appeals. Allowing an essentially anonymous and streamlined evaluation method with high participation rate can allow for rapid feedback, identification of systemic errors, and modifications of the process as different areas in need of improvement are identified. We propose a system with a finite number of metrics to be evaluated which can measure quality parameters simply, quickly and accurately. Information can be made publicly available which would enhance and accelerate suggestions for improvements.

Modifications of the current First Action Interview pilot program could make the program universal, although applicants could opt out if desired. The modifications include an initial action based on an early search of independent claims identifying either patentable subject matter or areas where there is a significant amount of art. This will allow for an early identification of what are likely to be the primary issues and, where appropriate, early claim amendments that allow the Examiner and the applicant

to focus rapidly on points of contention. Providing for an early interview encourages cooperation between the Examiner and applicant at the beginning of the process before positions become too engrained. Evidence that could be provided to support patentability can also be identified and submitted before substantive prosecution begins. The result of this early initial action and response is a more efficient and effective narrowing of the gap between opposing positions.

Innovation is the cornerstone of American commerce and culture. A properly functioning patent system promotes innovation, advances science and the useful arts, and benefits the public. In order to perform properly, the patent system should promote the issuance of quality patents with claims that withstand the scrutiny of the public, the courts, the prior art, and time. The USPTO's request for public input on enhancement in patent quality, and on patent office operations, is an excellent first step toward improving our patent system. The USPTO and its users should together strive to critically evaluate proposals from the user community that best understands the strengths and weaknesses of the current system. Then, together, the USPTO and the Patent Bar should actively implement those proposals that can positively impact the USPTO, innovators, science and the public good.

## **I. PATENT EXAMINER LEGAL TRAINING**

### **Introduction**

A principal responsibility of the U.S. Patent and Trademark Office (USPTO) is to properly administer the patent laws. While Examiners enter into employment with the USPTO having technical competency, most have little or no legal training. Thus, Examiner legal training is a critical component in the ability to administer the law, as well as in realizing consistently high quality products and services. Raising the level of legal competency of the patent examining corps will result in a more comprehensive and cooperative process during patent prosecution, will lead to the issuance of high value and high quality patents, and will decrease overall patent pendency.

Currently, the USPTO provides a comprehensive training program, the *U.S. Patent Training Academy*, for first year Patent Examiners that includes an initial legal training curriculum. However, this initial legal training of Examiners is limited only to general instruction in statutory law, i.e. 35 U.S.C. §§101-103 and 112, and a few major Supreme Court cases, e.g., *KSR v. Teleflex*, *In re Bilski*, etc. Further, although the USPTO currently offers continuing education courses and Technology Center level legal training courses to all Examiners, it is unclear how comprehensive or frequent these internal training courses are, or how many Examiners avail themselves of such instruction.

Efforts have been made by the USPTO to provide more rigorous legal training to Examiners over the last two decades. These efforts have been largely unsuccessful. In 1996, the USPTO implemented a *Juris Masters Certification Program (JMCP)* as a voluntary after-hours program for non-attorney patent professionals seeking to improve their legal knowledge. Although the program enrolled 192 students in its first year, the program appears to have been discontinued after 1996. A comparable *Non-Duty Legal Studies Program*, a voluntary program established to provide reimbursement for additional legal training, was suspended in 2009 due to reductions in fee collections.

### **Enhancements to Training**

Therefore, we respectfully propose that substantive and continuing legal training should be required of all Examiners at the USPTO. Further, such legal training should be provided at regular intervals in view of the dynamic nature of patent law. Unlike previous approaches where Examiners could enroll in additional legal training outside of work, we propose that Examiner legal training should be on the USPTO campus and during regular work hours. Further, the Examiners' work quota requirement should be proportionally reduced to allot time for legal training. This would demonstrate that the USPTO is serious about improving legal training and providing Examiners with the resources to do so.

Enhanced Examiner legal training will promote a more comprehensive and cooperative process between the Examiner and patent practitioner during patent prosecution. There is often a disconnect between the Examiner and the practitioner based on each party's use and understanding of the law. A patent practitioner seeks a patent which will later have value to a client in litigation, sale or licensing. For this reason, patent practitioners closely follow District Court, Federal Circuit and Supreme Court cases, as well as proposed and newly enacted legislation, for guidance on how to best protect the integrity of their client's patent portfolio. In contrast, Examiners typically have a narrower view of the law, as they are not sufficiently exposed to new legal precedent, and are unable to effectively respond when patent practitioners raise new legal issues. Legal arguments made by patent practitioners, based on case law, are frequently not properly considered by an Examiner due to this disconnect of legal knowledge between the parties.

Similarly, when Examiners are trained in the law, it is often in the context of what is not patentable, with a focus on providing reasoning in an Examiner's rejection. This one-sided approach leads to Examiners who are unable to recognize allowable subject matter, legally effective arguments, and submission of evidence sufficient to support allowability. This often results in the issuance of unnecessary and premature final rejections, requests for continued examination, continuing applications, appeals, and reversals after Pre-Appeal Brief Review conferences, all of which contribute to increased patent pendency.

In addition to Examiner legal training, the USPTO could establish a "legal core" team to assist Examiners with legal issues during prosecution. This may be simply a change in or expansion of the role played by Special Program Examiners (SPREs). For example, Examiners could be encouraged to consult with the legal core team to quickly check whether a practitioner's point in a response has merit or not. The legal core team would not help the Examiner write the office action or provide the Examiner with a detailed memorandum, rather the legal core team would (a) confirm the Examiner's suspicion that the practitioner's point is essentially groundless or (b) indicate to the Examiner that the practitioner's point has merit and direct the Examiner to an appropriate resource, e.g., MPEP, a case, or a review article, which the Examiner should consult to better understand the practitioner's argument. Under this legal support method, an Examiner need not become an expert on all developing aspects of patent law, only a portion of which he might apply in his or her practice. Further, individual members of the legal core team could have different areas of expertise in patent law. We suggest that salary or other compensation factors be structured for the legal core team to make this an elite group toward which Examiners might aspire and which would be respected within and outside of the Examiner corps.

For these reasons, Examiners should be trained in the law to better understand both what is patentable and what is not patentable. Examiners require sufficient knowledge to provide strong legal reasoning for rejections, as well as to recognize correct and incorrect legal arguments made by patent practitioners. A better understanding of the law by both Examiners and patent practitioners will allow parties to communicate more effectively and efficiently with one another.

In addition to training for Examiners, it would be useful for practitioners/applicants to have a better understanding of how the patent office is applying the law. One direct way this can be accomplished is by providing more detailed rationale in decisions from Pre-Appeal Brief Review conferences. At present, these decisions only indicate whether the case is remanding to the Examiner or will continue to appeal. By providing more substantive rationale, practitioners/applicants will learn how the office is applying legal standards. This will also advance prosecution and be instructive to Examiners in providing details in misapplication of the law when cases are remanded.

Legal issues can often arise in, for example, the context of rejections under 35 USC § 112, second paragraph, especially with respect to enablement; application of references in rejections under 35 USC § 103 to establish *prima facie* obvious; and evaluation of showings of secondary considerations, e.g. unexpected or superior results, to rebut a showing of *prima facie* obviousness. The standards for each of these cases rely less on the technical application of prior art than on application of legal standards, frequently derived from the courts, to a particular set of facts. The outcome in such cases is that an Examiner may maintain a rejection when a proper and legally sufficient showing has been made. Without proper training, Examiners focus on maintaining grounds of rejection although patentability has been demonstrated under the law. When Examiners have a more complete legal knowledge, they can work better with applicants in developing suitable showings to overcome rejections and avoid debates that a showing is insufficient, which wastes time for both the practitioner and the applicant, decreases quality and increases pendency.

### **Metrics**

The outcome of incomplete legal knowledge manifests itself in a number of results that can be monitored to assess quality and to develop suitable metrics. In general, the lack of understanding hampers communications between the Examiner and practitioner, making it difficult to arrive at patentable subject matter with a scope acceptable to the applicant. Also, because legal issues are commonly unrelated to the technical aspects of the references themselves, the same references, or at least the same primary references, tend to be cited repeatedly in consecutive office actions. This can result in unnecessary Requests for Continued Examination where application of the law to the same references is the only issue raised afterwards. Finally, of course, misapplication of the law can become evident when an application is remanded to Examiner following Pre-Appeal Brief Review.

Accordingly, there are a number of points during prosecution where application of the law can be evaluated, and a number of metrics that can be used to determine whether Examiners have sufficient knowledge of application of the law. One point for quality review is at final rejection. If a final rejection is proposed either after submission of evidence or where no new art is applied, there could likely be a misunderstanding between the practitioner/applicant and the Examiner that is based on legal interpretation. Such cases should be evaluated for proper application of legal standards. This evaluation should not be conducted by primary Examiners, but rather by SPEs or legal specialists (SPREs). Importantly, Examiners, at least those below primary Examiners, should not be reprimanded or penalized for errors in application of the law, but should be instructed in proper application.

In addition to review of final actions, difficulties or errors in application of the law can be indicated by the presence of repeated office actions (and responses) where no additional art is cited. In cases where applicants submit a showing in the form of a declaration, a measure can be made of how frequently such cases move to allowance as opposed to a rejection being maintained. Allowance in such situations indicate that Examiners and the practitioner/applicant are working together to move toward allowance. A natural indicator of application of the law is by measuring the results of Pre-Appeal Brief Review. A large number of remands as compared to decisions upholding the Examiner's rejection indicates that the law is not being applied properly by the Examiners.

### **Conclusion**

Strong legal training for Examiners will lead to an increased quality of issued patents. Patent quality is related to the quality of the patent application, the quality of the search and examination, and the quality of the prosecution. To increase quality in each of these areas, it is imperative that both Examiners and patent practitioners possess a strong comprehension of the law. Patent quality will be greatly enhanced by fewer rejections and appeals based on miscommunication or misunderstanding of the law, and will also lead to a reduced overall patent pendency at the USPTO.

## **II. VERTICAL REVIEW OF WORK PRODUCT**

### **Introduction**

Quality in the patent prosecution process ensures that patentable inventions are patented and unpatentable applications are rejected in an efficient and timely manner. High-quality patent prosecution requires more than meeting the statutory minimum requirements, and maximizing the quality of deliverables at all stages of prosecution should be the goal of the USPTO and the Patent Bar. The current emphasis within the USPTO on production numbers encourages speedy examination over quality examination, and has not resulted in improvements in overall pendency. An emphasis on prosecution quality rather than production, and using quality measurements will result in increased efficiency and decreased patent pendency over time.

To maximize the efficiency of the prosecution process, quality must be measured and improved upon at every step of the process, from initial applications through office actions and responses to appeals. Measuring and improving quality allows all parties to address core issues faster; overcome rejections by amendment or traversal; improve interviews, and indicate allowable claims. This reduces the number of Requests for Continued Examination (RCEs), unnecessary continuations, and other delays. Through such measurements, quality issues can be addressed and the process can be improved. Over time, measurement and accountability throughout the process will result in high efficiency and decreased patent pendency.

### **Discussion**

While all of the information for assessment of quality is already contained within the office actions and responses for each prosecuted application, it would be an insurmountable task to cull the files and extract the data. A mechanism for measuring quality and reporting the data that is simple, fast and accurate is required. This would allow analysis on the quality of 100% of the deliverables into and out of the Office. To do this, metrics must be carefully defined, a method of reporting and collection must be provided and analysis must be focused on improvement rather than retribution.

#### **Metrics:**

Accurate analysis of quality and establishing accountability and improvement demands careful definition of the metrics used in that analysis.

It is imperative that the USPTO and the Patent Bar work together to define the attributes and defects that contribute to the quality of an application, an office action, an office action response, and any other documents involved in the prosecution stream. These attributes may include, but are not limited to, the elements of the document that are statutorily defined. For example, an identified type of defect in an application may be a § 112 error – statutorily defined. But poor grammar or excessive spelling errors are also quality considerations that may be candidates for analysis. The objective is to define a finite list of discrete attributes or defects, for each type of document in the prosecution process, that can easily be determined as present or absent. Over time, the list of metrics will change – new issues will be identified, the laws will change, old issues will be minimized. It is important to keep the list of collected metrics alive and malleable.

#### **Collection:**

Once a finite list of metrics is determined, a mechanism is needed for collecting the information 100% of the time, without unduly burdening the process or the participants. It is essential that the data collected does not become part of the file wrapper – it should be submitted, at all steps, off the record for

use by the USPTO for quality improvement purposes only. Here, the list of attributes or defects can be indicated with check boxes on transmittal sheets or as an additional question for electronic filers.

Examples of items that might be included in an Examiner's comments on application or response quality could include:

- Grammatical issues
- Deviation of language from that generally used in the art
- Specific 112 issues

Examples of items that might be included in an practitioner's comments on office action quality could include:

- Failure to address all claims or limitations
- Failure to consider parts of reference that teach away from an invention
- Improper finality

Quality items should include positive and negative indicators and can be identified without additional evaluation; these items merely reflect what is in the accompanying document and provide a simple means by which the data can be collected. In the case of electronic submissions, the data can be fed directly into the analysis system. Paper filing would require data entry and it may be desirable to collect the information on a separate form rather than as part of a transmittal form to facilitate that process, and to ensure that the quality-related data do not become part of the file record. It is important that this information be collected for each and every deliverable – 100% participation.

### **Analysis:**

Once collected, the data must be analyzed with an eye toward process improvement. It is not intended that the data would result in any benefit to a specific case or that it would be used to reprimand a particular individual for a particular incident. Following a Total Quality Management approach, the data should be evaluated for trends, standard deviation, variances, performance outliers and the like. Using this approach it will be easy to identify issues in need of improvement, such as: 1) problems with a particular practitioner or Examiner; 2) incidences where an individual consistently reports the same defects, perhaps inappropriately; or 3) where a particular art unit exhibits the same quality deficit or excellence. From such information, the Office can take steps to improve the process such as: supplemental training; attorney advisories; employment action; rule modification; performance awards; etc. Every participant in the process should provide the requested feedback honestly and fairly, but exceptions and outliers will become apparent in the data analysis, and may be taken into account. In addition, everyone from the practitioners through the all levels of Examiners should be measured. The effectiveness of quality improvement efforts can also be evaluated using the data generated. Further, it is important that all practitioners, participants, USPTO supervisory personnel and Examiners have access to the information generated by the analysis and are empowered to take steps toward improvement.

Throughout the process, it is important that the data and its analysis be visible to all participants; however, publicly available data should not be identifiably tied to a particular Examiner, practitioner or application. The collected data (attributes and defects) should be public, and open to comment from participants to ensure that quality measurements remain relevant and current. In this way, it can be utilized to correct problems, improve quality and ultimately decrease application pendency.

In addition, there is another related metric that should be added to the process. Too frequently, in the Office Action-Response cycle, there is a break down in the interaction between the practitioner and the Examiner. Discussions come to a standstill with an endless "is too – is not" argument. When this happens,

the practitioner or the Examiner should have an opportunity to request a second examining set of eyes on the case, whether that is another Examiner or supervisor. This could be effected with a simple form or in the electronic filing system. This request would provide another tool for quality analysis, and may be used to answer certain questions to improve quality and accountability. For example, question that may be answered include: 1) does the same practitioner consistently request secondary review; 2) does the same Examiner consistently have cases referred for secondary review; 3) are secondary reviews disproportionately requested in a particular art unit? Using such a request mechanism would eliminate unfair costs incurred to the applicant of a full appeal. It would also reduce the pendency of the case where a secondary observer can cut through the standstill that would only result in remand on pre-appeal or appeal. Alternatively, truly unpatentable submissions may be averted from going to appeal.

### **Conclusion**

These proposals are intended to increase the quality of prosecution, by all participants, by easy and rapid generation of data that may be used to measure prosecution quality. The data are intended to be used by the USPTO to improve oversight, training and accountability at the USPTO, and provide guidance to the Patent Bar to improve application and response quality. High-quality prosecution ultimately decreases examination costs to clients and speeds final disposition. Improved examination quality improves the prosecution record, and ensures that any issues are overcome quickly and cleanly, resulting in faster prosecution, and decreased pendency.

### **III. REDUCING PATENT APPLICATION PENDENCY BY IMPLEMENTING AN AMENDED “FIRST ACTION INTERVIEW” PROGRAM**

The U.S. Patent and Trademark Office (USPTO) is currently administering a “First Action Interview” pilot program (herein, FAI). However, relatively few Applicants presently use this program. We provide an analysis and recommendations for developing this program, so that pendency is further reduced, the time burden on Examiners is minimized, and more Applicants take advantage of the process. These recommendations as a whole are referred to as the First Action Interview Amendments (herein, the Amendments).

The Amendments suggested include an initial non-final Office Action and an initial Examiner interview followed by at least one full non-final Office Action before an Applicant could receive a final Office Action. The addition of an initial non-final Office Action and an initial Examiner interview, which will only focus on essential issues of patentability, will allow for the early identification of the most pertinent prior art and misunderstandings regarding the scope and nature of the invention before a full non-final Office Action is received. The early identification of these two issues will enable both the applicant and Examiner to focus on essential issues more quickly so that a determination of patentability can be reached more quickly resulting in fewer Office Actions issued and fewer Requests for Continued Examination (RCEs) filed.

#### **The Amendments**

Under the Amendments, all newly filed non-provisional utility applications, including applications under 35 U.S.C. 111(a), national stages under 35 U.S.C. 371(c), continuations, and divisionals would be examined under the Amendments unless the applicant expressly opts out of the program at the time of filing or before the receipt of an initial non-final Office Action. For those Applicants who do not opt out, the Examiner will prepare an initial non-final Office Action based only on the first three independent claims of the application. If a patent application contains fewer than three independent claims, the Examiner must address each independent claim but may not be responsible for addressing any dependent claims. The remaining dependent and independent claims will be addressed in a second full non-final Office Action, which is discussed below. There is no limit to the number of claims an application can have under the Amendments, although excess claims fees apply as under regular examination. By contrast, FAI requires an eligible application to be limited to twenty claims, with a maximum of three being independent.

Within, for example, a compressed time period of nine months from filing, the Examiner performs an initial search and provides an initial non-final Office Action to the applicant on the patentability of only the first three independent claims. The Examiner is encouraged to suggest modifications that may render the claims patentable. The limited number of claims examined under the Amendments shortens the search time expended by the Examiner from that required by FAI (under which as many as three independent and twenty total claims must be searched) and accomplishes the goal of identifying the most relevant prior art quickly. In exchange for preparing the initial non-final Office Action, the Examiner may be entitled to a full or partial count.

Upon issuance of the initial non-final Office Action, the applicant has the opportunity to conduct an Initial Interview with the Examiner and/or submit an Amendment and Reply to the initial non-final Office Action in compliance with 37 C.F.R. § 1.111. The shortened statutory period for response may be the same as or shorter than the present period (typically 3 months) to respond to an Office Action. The initial interview and/or the Amendment and Reply to the initial non-final Office Action will provide the

applicant with the opportunity to clarify points the Examiner may not have understood and help the Examiner focus their prior art search prior to a full non-final Office Action. Likewise, the Examiner can explain the reasoning underlying any rejection(s) and suggest modifications that may render the designated claims patentable. In exchange for participating in the initial interview, the Examiner may be entitled to a full or partial count. The availability of a full or partial count may also provide the Examiner with an incentive to fully participate in the program.

Following the Initial Interview or in place of the Initial Interview, the applicant can submit an Amendment and Reply that may amend or cancel any of the claims contained in the application, add new claims, and/or argue for the patentability of any of the claims contained in the application. Amendment to claims which have not been reviewed should be entered and will not impose an additional burden on the Examiner as they have not been previously reviewed.

After an initial interview is conducted and/or an amendment and reply to the initial non-final Office Action is received, the Examiner completes the search for the remaining claims, and prepares and issues a full non-final Office Action that considers all aspects of patentability for all pending claims. This full non-final Office Action may be issued within four months of the filing of the applicant's amendment and reply to the initial non-final Office Action. Regular examination procedure then follows. If, between the time of filing and the receipt of the initial non-final Office Action, an Applicant opts out of the program, that application will not receive an initial non-final Office Action or be eligible to conduct an initial Examiner interview.

### **Benefits of the Examination Expedited by under the Amendments**

Implementation of the Amendments as an opt-out program results in the following benefits. Applicant participation is increased, justifying the USPTO's devotion of resources necessary for examination under the Amendments to succeed. And with greater participation, any systemic issues in the Program should arise quickly, which will allow them to be addressed and resolved quickly, increasing the overall quality of the Program.

The Amendments decrease the pendency of applications and increase the quality of issued patents in several ways. The applicant receives a substantive initial non-final Office Action on the patentability of the first three independent claims from the USPTO within, for example, nine months from filing, in contrast to regular examination, under which the USPTO issues an Office Action, which may be a Restriction/Election Requirement that does not address patentability issues, at up to fourteen months (or longer) from filing. Additionally, the present FAI program does not necessarily provide the applicant with such early feedback, as Applicants do not receive a pre-interview communication in an accelerated manner.

Although the time for the Examiner to provide an initial non-final Office Action to the applicant is compressed under the Amendments as compared to the present system, the burden on the Examiner is not substantially or unfairly increased as the Examiner need only initially search and consider up to the first three independent claims. Also, Examiners could be given additional time and counts to prepare a quality initial non-final Office Action and would be motivated to conduct an initial interview.

The Initial Interview allows for the early identification of misunderstandings regarding the scope and nature of the invention and the early identification of the most relevant prior art, enabling both the applicant and Examiner to focus on essential issues more quickly. This allows the full non-final Office Action to be more focused on essential issues, as a result of the initial interview, than is the case under regular examination, so a determination of patentability can be reached more quickly, with fewer Office Actions issued and fewer RCEs filed.

Requiring the Examiner to review only the first three independent claims of an application decreases the USPTO's overall burden, for example, by allowing for a more efficient and focused initial search. Additionally, by only examining up to the first three independent claims, examination in accordance with the Amendments may be applied to expedite the prosecution of every patent application filed in the USPTO. This is in contrast to FAI, for which only a fraction of applications are eligible (e.g., those with no more than 20 total claims and 3 independent claims).

At the same time, the requirement to prepare the first three independent claims of an application of initial review by the Examiner forces the applicant to carefully consider which claim limitations actually relate to the inventive nature of important embodiments, and discourages the applicant from overloading the first three independent claims with unnecessary or redundant limitations. This may also encourage an applicant to draft at least one independent claim that could readily be found allowable and will help the Examiner focus the prior art search.

Under the Amendments, because both the Applicant and Examiner are encouraged to perform such focused and thorough preparatory work, during the Initial Interview the Applicant and Examiner are prepared to identify and clarify misunderstandings quickly, can rapidly proceed to productive discussion of essential issues, and are well-equipped to resolve those issues. Although the Examiner addresses only the first three independent claims in the initial non-final Office Action and initial interview, the applicant can use the information to amend other non-designated claims as well, prior to the issuance of a first full Office Action. Thus, the first Office Action may indicate that the entire claim set is allowable or provide instruction that allows the applicant to "polish" claims that are close to allowability.

By contrast, under the present FAI, if the applicant wishes to apply what he or she learned from the Pre-Interview Communication and the Interview, the applicant must forgo a first non-final Office Action to enter amendments, so that the second Office Action may be final. This lack of opportunity to subsequently amend claims under FAI can promote the filing of RCEs, lengthening pendency, and discourage Applicants from enrolling in the program. By contrast, the early resolution of substantial issues under the Amendments along with the applicant having two opportunities to amend or argue claims prior to issuance of a final Office Action will reduce the fraction of applications for which an RCE is filed.

For the above reasons, a full non-final Office Action issued under the Amendments will be of a higher quality than those issued under the current system, and prosecution as a whole will be more compact, with the need for fewer serial Office Actions, fewer Office Actions after the first Action that cite new art, and fewer RCEs.

### **Metrics for Evaluating Effectiveness of the Amendments**

The success of examination under the Amendments can be evaluated by tracking several easy-to-measure metrics. Total pendency, time between first Office Action and disposition, total number of Office Actions issued, number of RCEs filed, and number of new references cited after the first Office Action can be tracked. In addition to measuring the effect of the Amendments on pendency, several of these metrics can serve as reasonable proxies for quality. For example, a decreased number of Office Actions and a decreased number of RCEs indicate that issues are identified and resolved quickly, reflective of increased quality. Because the citation of new art is often associated with an Examiner's improved understanding of the invention, a decreased frequency of new-art citations reflects an earlier identification of essential issues and, therefore, increased quality.