

February 10, 2016

Via Electronic Mail

TopicSubmissionForCaseStudies@uspto.gov

Attention: Michael Cygan, Senior Legal Advisor
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in response to "Request for Submission of Topics for USPTO Quality Case Studies", 80 Fed. Reg. 244 (December 21, 2015)

Title: Efficacy of Alternative Prosecution Programs

Proposal for Study: Evaluate the effectiveness of alternative prosecution programs on pendency to help Applicants manage their patent pipelines

Explanation:

IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to submit topics for USPTO quality case studies. We appreciate the Office's continuing commitment to enhance patent quality.

We recognize and appreciate the Office providing alternative prosecution options Applicants may use to control pendency of patent applications. Applicants have various interests regarding the use and protection of intellectual property and may operate under strict budget constraints. Providing a variety of tools to allow Applicants to manage their patent pipelines has significant value.

IBM recommends that the Office study the effectiveness of each of the alternative prosecution programs in controlling pendency. In particular, IBM is interested in acceleration prosecution programs including Track One, Accelerated Examination, and the Patent Prosecution Highway and their relative effectiveness in reducing pendency. We ask the Office to study and quantify the pendency benefits of each program and provide that information to Applicants so they can make informed decisions on utilizing each of the alternative prosecution programs. We also encourage the Office to compare the pendency benefits of these alternative prosecution programs to the pendency benefits of examiner interviews conducted prior to, or during, substantive examination.

We respectfully request that the Office evaluate the quality of examination of applications in each of the alternative prosecution programs using traditional quality metrics. For example, the Office could evaluate if applications that have accelerated examination generally include more or less examination errors than

applications that undergo a typical examination. Further, IBM suggests that the Office study the clarity of the record of applications examined under each of the accelerated examination programs. For example, the Office could determine if applications with accelerated examination include more detailed reasons for allowance than applications that undergo a typical examination. As discussed in our previous comments¹, IBM has noticed a positive correlation between shortened pendency and a detailed summary of reasons for allowance. We ask the Office to confirm such a correlation and explore why it exists.

IBM supports the continued use of these accelerated and deferred examination programs and encourages the Office to study and enhance their effectiveness to allow Applicants to control their patent pipelines as they see fit. We support all efforts to increase patent quality, including the Office's Enhanced Patent Quality Initiative, and we thank the Office for considering this particular submission as a case study in its new pilot program.

Respectfully submitted,

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¹ See IBM Comments dated April 30, 2015 in response to "Request for Comments on Enhancing Patent Quality," 80 FR 6475.