

February 11, 2016

Valencia Martin Wallace
Deputy Commissioner for Patent Quality
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Re: Response to Request for Submission of Topics for USPTO Quality Case Studies (80 Fed. Reg. 79277, 12/21/2015)

Dear Madam,

Please find below three topics for possible studies. Please note that these topics are provided herein as my personal opinion and may not reflect views of my current employer.

Title 1: Pre-Search Telephone Discussion (PSD) with Applicant

Proposal for Study: Would a telephone discussion with Applicant about the general nature of the disclosure and claims before an initial prior art search result in more efficient prosecution?

Suggested Methodology: USPTO should study whether having Examiners initiate a relatively short (e.g., between 15-30 minutes) telephone discussion with Applicant about the general subject matter of an application and its claims before an initial prior art search results in more efficient prosecution and improved quality.

Explanation: Effective initial searching by Examiner is likely to apprise Applicant of the most relevant prior art, thereby allowing Applicant to accurately assess the scope of protection to which Applicant is entitled and to present amendments/arguments that will likely to advance prosecution.

- Conducting better initial searches may allow responses to First Office Actions to address the most relevant prior art.
- In the past, Examiners sometimes informally have made such calls. It would be worthwhile to determine whether such calls have made beneficial effects on prosecution.

Title 2: Enhancing Clarity and Providing Full Written Explanations in Office Actions

Proposal for Study: Would more clearly and completely written Office Actions result in more efficient prosecution of patent applications?

Suggested Methodology: USPTO should conduct a study to determine whether there is any correlation between the number of Office Actions require to dispose of Application and clarity of those Office Actions.

Explanation: More clearly and completely written Office Actions can minimize claim

misinterpretation, disagreements over teachings of art, and etc.

- Rejections in Office Actions are occasionally too short and/or poorly written (e.g., in terms of grammar, unclear or absent mappings of claim features to the prior art, and etc.). This may cause the bases of rejections to be misunderstood.

- Reducing these issues at the outset may help to focus prosecution.

- This might lead to shorter overall prosecution and result in greater clarity in issued patents.

Title 3: Improving Section 101 Rejections

Proposal for Study: Would a uniform definition of “abstractness” improve the quality by consistently applying Section 101 across different examining groups?

Suggested Methodology: USPTO should study whether developing a uniform definition of Section 101 “abstractness” to be applied across different examining groups would help to improve the quality.

Explanation: Rejections based on Section 101 “abstractness” often rely on an overgeneralized characterization of a claim as belonging to one of the currently existing categories of invention deemed to be ineligible for patent protection (e.g., an idea of itself). Such rejections often are followed by a statement that other claim limitations do not provide “something more” that confers patentability. This type of rejections results in inconsistent applications of Section 101 because they are based on how a claim is viewed by a particular examiner.

Dear Ms. Spyrou and Ms. Wellington,

Thank you again for meeting with me a few weeks ago and for encouraging me to make comments on this important matter.

Regards,

Anthony Kahng

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