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May 24, 2016

Commissioner for Patents
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTENTION: Mr. Michael T. Cygan, Sr. Legal Advisor
Office of Patent Legal Administration

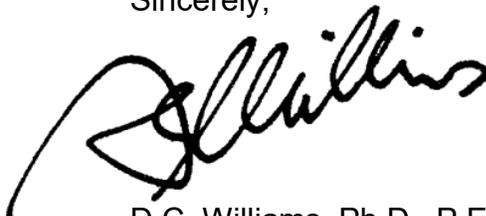
RE: Docket No. PTO-P-2016-006
Patent Quality Metrics for Fiscal Year 2017

Dear Mr. Cygan:

Enclosed please find comments in the above-referenced matter in response to the request from your office for same. Thank you for the opportunity to participate in this proceeding.

In the event of any questions, clarifications, or in the event further information may be helpful, please feel free to contact me at your convenience.

Sincerely,

A handwritten signature in black ink, appearing to read 'D.C. Williams', written in a cursive style.

D.C. Williams, Ph.D., P.E.
USPTO Registration No, 72,082

Enc: Comments of D.C. Williams, Ph.D., P.E., Consulting Electrical and Forensic Engineer

Comments of D.C. Williams, Ph.D., P.E., Consulting Electrical and Forensic Engineer

The following comments in the matter of USPTO Docket No. PTO-P-2016-006 (Patent Quality Metrics for Fiscal Year 2017) represent the views of the undersigned and selected clients on whose behalf the undersigned has appeared as the registered practitioner of record before the United States Patent and Trademark Office. The undersigned has previously served as a director of intellectual property management in Fortune 500 industry, is a Registered Professional Engineer in numerous states, and has represented clients in private practice and in more than one thousand technical matters before various U.S. government agencies for the past 40 years.

The Office is to be applauded for its ongoing effort to improve patent quality, particularly with a stated focus "on the correctness and clarity of Office actions . . . using a standardized review form that will permit data from a significantly larger number of finished product quality reviews". Further, the Office states that "the review process will apply the new quality metrics and standardized form to increase the accuracy, consistency, transparency, clarity, and simplicity of USPTO quality review procedures." While commendable, the undersigned believes that the Office's stated objectives will not be effectively realized unless significant additional steps are taken beyond those expressed in the RFC document.

While the scope of this RFC appears to be limited to large scale (macro assessment) metrics directed toward long term evolutionary change, the undersigned believes that more could and should be done to identify specific cases (micro assessment) in the present term where wholly substandard patent examination continues to occur and then to respond with immediate corrective action. Fire prevention is a noble endeavor but extinguishing fires now burning is a significant step that could and should be taken immediately without expectation that the ongoing damage will somehow be mitigated by long-term evolutionary improvement. If the Office is sincere about its attempt to improve patent examination quality, it should rededicate such efforts to include immediate correction of circumstances that give rise to repeated substandard performance by a small segment of examiners.

The undersigned agrees that "the clarity of the examiner's determinations and the rationale underlying the decisions made in Office actions is an important part of overall patent examination quality and should be emphasized in reviews of USPTO work product". The vast majority of the examining corps are highly qualified, attentive, conscientious, and thoughtful men and women who make significant positive contributions to patent quality on a daily basis. However, as with any group, a percentage of its members are far less proficient than its exemplary members.

In the recent past, the undersigned has personally experienced severely and obviously substandard work product from more than one examiner. The most egregious examples have originated from the same examiners on a repeated basis. To exacerbate the situation, the Supervisory Patent Examiners in each case have generally supported the fundamentally defective office actions of their examiners. On occasion, the SPEs have acknowledged and corrected the deficiencies but expressly refuse to take actions necessary to prevent reoccurrence, ostensibly because their own performance is evaluated based on the perceived performance of examiners under their charge and they are largely compelled to support, rather than rebuke, them. These repeated incidents cause unnecessary delays and expense for patent applicants. This is unacceptable.

A related example of deficient review is the Office's exclusive reliance on its own randomized assessments of examiner performance conducted by OPQA. With the large number of cases to consider, any attempt to cull deficient Office actions from a random sample of the whole and to use those results as the sole basis for self-assessment is hardly effective to "increase the accuracy, consistency, transparency, clarity, and simplicity of USPTO quality review procedures". Further, such process is far less likely to resolve immediate problems of examiner underperformance.

For these and other reasons, the undersigned respectfully submits that the Office's attempt to improve patent quality via an internal process of exclusively assessing the work product its own personnel is a severely compromised process from the outset. The Office has a vested interest in demonstrating a high level of proficiency and is, this writer's opinion, prone to institutional bias in its own favor. Further, it views and assesses the process from only one perspective and not from that of applicants.

The undersigned, and the applicant/clients sharing his frustration, respectfully request that applicants, through their registered practitioners, be provided access to contribute to the Office's patent examination quality assessment program. A mechanism should be established where practitioners who have experienced seriously defective Office actions can provide a written assessment of examiner's performance equivalent to that enabled by the proposed Master Review Form (MRF) to be used by the Office for its internal assessments. Admittedly, applicants cannot be expected to provide assessment of rejections that should have been made but were not, but they are certainly the best equipped to draw attention to absurdly defective work product for rejections and other content that were issued by examiners.

This mechanism should not be utilized for the purpose of reporting differences of opinion on the teaching of prior art or any of the other typical matters that arise during proper and attentive prosecution of patent applications. Resolution of those matters must remain within the domain of the existing patent application examination and appeal process. However, the proposed applicant participation mechanism would be invaluable in identifying instances where egregious errors have been made by examiners that fall well below the Office's normal examination standards. Some examples drawn from the direct experience of the undersigned include, but are not limited to:

- 1) an examiner failing to read the file history and completely ignoring papers and documents previously filed by the applicant, including petitions to make special;
- 2) an examiner completely failing to address arguments presented by the applicant in Office action responses without any mention or other indication that such argument was ever considered or even read;
- 3) an examiner asserting that a reference teaches an element in a claim of an application where said reference includes absolutely no mention whatsoever of said element or any equivalent;

4) an examiner performing a keyword search and citing an element from a reference against an applicant's claim simply because the reference and the claim happen to share a common keyword even though that reference clearly and plainly teaches against the context of that claim;

5) an examiner copying and pasting text from an unrelated Office action in another pending case, simply due to his inattention and carelessness;

6) an examiner who provides a claim objection on wholly unsubstantiated grounds without any citation of law, rule, procedure, or practice in support of said objection; and

7) an examiner who issues a requirement for restriction or an election of species without providing the applicant with the required basis and explanation as prescribed in the MPEP, despite repeated oral and written requests by the applicant for such information, thereby denying the applicant an opportunity to traverse said requirement on the merits.

If the Office believes that providing applicant's practitioners with this assessment opportunity would generate an excessive workload, the undersigned would assert that correcting these defects is well worth a certain amount of the Office's resources. Applicants presently bear the burden and expense of dealing with defective office actions, and the Office should recognize that it, too, should bear a share of the responsibility and the cost of correcting blatant errors committed by its own staff. To mitigate any additional expense, the Office should consider recruiting practitioners to participate in preliminary screening of other practitioners' assessments. Only those practitioner assessments deemed by a certain cohort of other screening practitioners to identify egregiously poor work product would be pursued further by the Office. The undersigned would be honored to be the first practitioner to volunteer as a screener and to participate in such a program.

In summary, any serious effort by the Office to improve the quality of Office actions in patent examination must, in the view of this practitioner, include assessment participation by applicants' practitioners. Failing to do so will doom that effort to just another large-scale long-term exercise in data aggregation with little or no tangible improvement. Fire prevention begins by extinguishing the fires now burning.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D.C. Williams". The signature is fluid and cursive, with a large initial "D" and "W".

D.C. Williams, Ph.D., P.E.
Registration No. 72,082