

From:
Sent: Monday, March 08, 2010 4:38 PM
To: patent_quality_comments
Subject: 3M IPC Comments

Dear Mr. Schor and Mr. Laufer:

The attached comments from 3M Innovative Properties Company are in response to the "Request for Comments on Enhancement in the Quality of Patents."

Thank you for considering them.

Thomas M. Spielbauer
Intellectual Property Counsel
3M Innovative Properties Company
Telephone: (651) 736-9814
E-Mail: tmspielbauer@mmm.com

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The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

Attn: Kenneth M. Schor and Pinchus M. Laufer
Senior Patent Attorney, Office of the Deputy Commissioner for Patents

Re: Request for Comments on Enhancement in the Quality of Patents
74 Fed. Reg. 235 (December 9, 2009)

Dear Under Secretary Kappos:

The United States Patent and Trademark Office (PTO) requested input regarding the “Enhancement in the Quality of Patents.”¹ 3M Innovative Properties Company (“3M IPC”) has long been a supporter of the PTO’s ongoing efforts to address patent quality issues, and we appreciate this opportunity to provide input. As the owner of more than 10,000 pending and issued United States Patents covering a wide range of technologies, including medical devices, chemical compositions, information systems, software, adhesives, abrasives, cleaning products, office products, optical films, reflective sheeting, semiconductor processing materials, dental implants, orthodontic appliances, RFID readers and electronic materials, 3M IPC provides these comments based on its experiences, views and interests spanning a wide variety of art units.

Category 1 – Quality Measures Used

and

Category 2 – Stages of Monitoring

When the PTO issues a patent, both the patent holder and the public benefit from a clear record. This record should reflect the art and issues considered when allowing the patent, as well as the impact of these considerations on the scope of each allowed claim. To ensure the quality and efficiency of the process leading to this record, we believe the PTO should monitor interactions between the PTO and applicants at multiple stages of patent prosecution, as opposed to focusing its quality checks at the point where the examiner has indicated that the case is ready for allowance. Such quality checks might take the form of all or some of the reviews set out below.

1. Office Actions

3M IPC supports the selective internal review of Office actions. The review should focus on whether there is (i) a sufficient basis and explanation for each ground of rejection; (ii)

¹ 74 Fed. Reg. 235, pp. 65093-65100 (December 9, 2009).

for each claim element, identification and support for elements of the prior art believed to correspond to the claim element; (iii) clear support and rationale for the rejection of all rejected claims, including each dependent claim; and (iv) identification of patentable subject matter, if applicable.

2. Final Office Actions

In addition to the items listed above, final Office actions should be reviewed to ensure that making the Office action final was not premature. In addition, the review should consider whether the PTO's interpretation of the claim scope is proper, the basis for each ground of rejection is legally sound, and that all of applicant's arguments have been considered and properly addressed.

3. Allowance

The Patent Office, applicants, and the public share the same goal of having patents issue with valid claims providing clear notice of the protected scope. Internal review by the PTO after an examiner's decision to allow claims should align with this goal. Thus, the record should be reviewed to ensure that the reasons for allowance and rejection are clearly reflected in the record, and that the allowed claim scope is consistent with this prosecution history. Of course, the PTO should continue to review allowed claims to ensure that clearly invalid claims are not issued. However, just as it is inevitable that some valid claims will be improperly denied protection, some invalid claims are bound to issue. The review at this stage should place equal consideration on whether patentable subject matter has been rejected. By focusing the review on the clarity and sufficiency of the record and the proper correspondence between the allowed claim scope and this record, the PTO can strike a proper balance between both types of errors and provide applicants and the public with the information needed to correct them.

4. Pre-Appeal Conference

The current pre-appeal conference offers an efficient way to address some issues without the need for appeal. However, other issues could be addressed with the same efficiency. For example, in addition to looking for clear legal errors, the pre-appeal conferees should confirm the meaning and scope of the claim terms, the examiner's application of the prior art, and applicant's arguments.

In addition, under the current procedures, applicants receive little useful feedback from the panel when it deems that the application should proceed to appeal. We suggest that the process be altered to at least require a more detailed explanation of the panel's decision, responding to each issue raised in the pre-appeal brief. In addition, applicants should be allowed to participate in the conference to ensure that they continue to understand the PTO's positions on validity. To provide a clear record, a conference summary should be included to record the substance of the discussions at the pre-appeal conference, as is currently done with interview practice.

Category 3 – Pendency

1. Background

Based on data obtained in the past five years (January 1, 2005 through December 31, 2009), 3M IPC filed 1,512 RCEs in 1,127 cases, with between 250 and 350 RCEs filed per year. Of these cases, about 60% were allowed, about 20% are still pending, and about 20% were abandoned. In that same time period, 3M IPC filed 550 Notices of Appeal in 471 cases, with about 100 Notices of Appeal filed per year. Of these cases, 33% were allowed, 38% are still pending, and 29% were abandoned.

Although some RCEs and Appeals always will be necessary to resolve well-defined disagreements between the Patent Office and applicants, the number of RCEs and Appeals filed by 3M IPC suggest to us that improvements in the earlier stages of the patent prosecution process might serve to lessen the use of these late stage procedures. We suggest some of these potential improvements below.

2. Claim Interpretation

We believe that advancements in the quality and efficiency of prosecution, as well as improvements in the clarity of the prosecution record and hence the public notice function of issued claims, could be achieved by providing additional mechanisms for the applicant and examiner to reach a mutual understanding of the scope of the claims.

During prosecution, examiners are to give each claim term its broadest reasonable interpretation.² Generally, examiners attempt to give the words of the claims their plain meaning, unless that plain meaning is inconsistent with the specification.³ But this meaning arrived at in the mind of the examiner often is not communicated to the applicant. As a result, the efficiency and quality of early office actions and responses may be severely hindered by a misunderstanding of the claim scope. That is, the examiner's arguments may be entirely valid, but only when viewed in the light of the examiner's claim interpretation. Similarly, the applicant's arguments may be valid based on his or her understanding of the claim terms, but unpersuasive in view of the examiner's understanding of those same claim terms. Therefore, 3M IPC suggests the following as options to help facilitate clearer communication between examiners and applicants

² MPEP § 2111.

³ See, e.g., In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

A. Pre-Search Interview.

3M IPC suggests that applicants be allowed an opportunity to conduct an interview with the assigned examiner after the examiner has read the application, but prior to any search. The scope of the interview would be limited to achieving a mutual understanding of how the claim terms will be interpreted for purposes of the art search and subsequent prosecution. Prior art might be discussed, but only in the context of explaining the meaning of the claim language, e.g., by establishing or distinguishing the intended scope of a claim term from terms used in the prior art. Prior art from a patentability point of view in terms of 35 USC §§ 102 and 103 would not be discussed.

The process used to inform applicants of their opportunity to request a pre-search interview could be similar to current restriction requirement practice, whereby the scope of the search is also defined. That is, the examiner would contact the applicant after having reviewed the specification and claims and prepared a restriction requirement, if appropriate. The applicant would then have a fixed period of time to request and conduct this preliminary interview. In addition, the examiner could request the interview if he or she believes additional clarity of the scope and meaning of claim terms is required. Consistent with the needs to interpret claims broadly during prosecution and to provide clear public notice of the claim scope, a pre-search interview summary should be required, and applicants should be permitted to file claim amendments resulting from such an interview, if necessary.

This approach would provide a sound basis for a more focused search, and consequently reduce the examiner's search burden. This approach should also reduce the need for subsequent searches and RCEs that are caused by applicant's need to make amendments solely to reconcile differences between the intended meaning of a claim term and its broadest reasonable interpretation as determined by the examiner. Finally, by starting from a common understanding of the claim scope, the subsequent prosecution should be more effective and efficient.

B. Detailed Citations in Office Actions.

As a further aide to ensuring a common understanding of the examiner's interpretation of both claim terms and corresponding elements in the prior art, the examiner should provide specific citations indicating what elements in the cited references he or she believes correspond to each claim term. This step may seem unnecessary; particularly where the reference and the application being examined use the same word. However, even when the examiner provides a citation to a portion of the specification or a drawing, it is often difficult to determine precisely which element he or she is relying on.

In addition, the examiner should indicate where the reference describes these elements, aiding the applicant in understanding why the examiner concluded the element of the prior art corresponds to the claim term. Again, in some cases this step may seem unnecessary. However, it can be unclear whether the examiner is intending to rely on an identical element used for the same purpose, the identical element used for a different purpose, or an obvious variant used for the same or a different purpose. Without knowing why an examiner is relying on a particular teaching as evidence of obviousness, an applicant's arguments can be entirely misdirected, causing delays and inefficiencies. Obviously the ultimate question of patentability must be decided on the basis of the claim as a whole. However, providing more detail about the specific elements relied upon in each reference would provide a common understanding for subsequent prosecution.

Category 7 – Incentives

1. Background

3M IPC believes that current quality review procedures and incentives are overly focused on preventing the allowance of what is perceived to be an unpatentable claim. Although the allowance of invalid claims is clearly undesirable, the current system has over-compensated, likely resulting in an increase in the number of novel and nonobviousness claims being held unpatentable lest a decision of patentability be reversed during quality review.

2. Balanced Quality Review

As described above, we support the use and expansion of internal quality review processes. However, these processes should be balanced to address errors of allowance and of rejection. As such, the quality review process should focus its attention on ensuring that, when valid claims are present, patents are timely granted and that those claims provide the public with clear notice of the protected scope.

Miscellaneous Comments Regarding Quality Improvement

1. Training

3M IPC believes that the PTO could avail itself of the opportunity to engage the patent community in the creation of programs for cross-training of applicants, practitioners, and examiners. A greater understanding of the objectives, procedures, and concerns of each group will lead to more efficient communication and exploration of solutions. For example, an examiner may not appreciate why an applicant concerned about obvious design-arounds does not simply narrow a claim to overcome a rejection. Similarly, an

applicant or practitioner may not understand how examiners balance the need to interpret claims in light of the specification, without reading limitations into the claims, when arriving at the broadest reasonable interpretation.

As but one example of possible opportunities for mutual training, companies such as 3M, industry organizations, and others could host seminars, videoconferences, webcasts or other events to provide information to examiners about certain industries or technologies, enabling more efficient prosecution of applications in such areas. Other means might be used to ensure that examiners, applicants and practitioners have a common understanding of a technology field, the state of the art in that field, and the terminology used in that field and which often appears in patent specifications and claims directed to that technology.

2. Understanding the Causes for Filing RCEs

3M IPC recommends the PTO consider gathering information on the “root causes” of RCEs. This information could then be used to devise a more efficient way to address the various issues that lead to RCEs, rather than trying to devise a one-size-fits-all procedure for RCEs in general.

For example, some RCEs are filed simply to cite new prior art references. For example, new prior art may be cited during prosecution in a related foreign patent application. Often, these RCEs do not include claim amendments or additional arguments, and are mainly filed to stave off any allegation of a failure to comply with Rule 56. 3M IPC recommends consideration of a way to expedite or provide an alternative path for resolution of RCEs that are not filed to present claim amendments or additional arguments for patentability.

Summary

3M IPC appreciates the opportunity to provide these comments and thanks the PTO for considering them. We stand committed to continuing to work with the PTO to address common concerns regarding the quality, efficiency and speed of the patent prosecution process.

Sincerely,



Melissa Buss, Reg. No. 47,465;

Kevin Rhodes, Reg. No. 42,102; and

Thomas M. Spielbauer, Reg. No. 58,492

on behalf of 3M Innovative Properties Company