From:
Sent: Thursday, June 17, 2010 5:24 PM
To: patent_quality_comments
Subject: ABA-IPL Section comments on Patent Quality

Please see the attached comments from the ABA Section of Intellectual Property Law on Enhancement in the Quality of Patents and on United States Patent and Trademark Office Patent Quality Metrics 75 Federal Register 22120 (April 27, 2010).

Mike Winkler
Section Director
Section of Intellectual Property Law
American Bar Association
321 N. Clark Street, 19th Floor
Chicago, IL 60654
tel: 312.988.5639
fax: 312-988-6800
winklerm@staff.abanet.org
www.abanet.org/intelprop

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Darla Brown
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Legislative Consultant
Washington, D.C.
gregoryh@staff.abanet.org

AMERICAN BAR ASSOCIATION

Section of Intellectual Property Law
321 North Clark Street
Chicago, IL 60654-7598
(312) 988-5598
FAX: (312) 988-6800
E-mail: iplaw@abanet.org
www.abanet.org/intelprop

Via Electronic Mail
Patent_quality_comments@uspto.gov

15 June 2010

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

Re: Comments on Enhancement in the Quality of Patents and on United States Patent and Trademark Office Patent Quality Metrics 75 Federal Register 22120 (April 27, 2010)

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request the United States Patent and Trademark Office (the "Office") published in the Federal Register on 27 April 2010 (PTO-P-2010-0038). These comments have not been submitted to or approved by the ABA House of Delegates or Board of Governors, and should not be considered as representing the views of the Association.

Before discussing the Section's comments on quality and quality metrics, I want to express the Section's appreciation for doing a comprehensive review of patent and patent process quality. Further, I want to thank you and the Office for the openness and constructive tenor of the discussions, as well as for the courtesy shown to me and Mr. Jones at the Quality Roundtables in Los Angeles and Alexandria. I will now turn to our comments.

Regardless of the program and the metrics used by the PTO to determine quality, the program should bring value to both the user-community and the public. The program and metrics to be measured must be implemented in a manner that is objective, transparent, reproducible, and in compliance with the rules and regulations governing the Office. Further, to ensure value to both the user-community and the public, the program must require the Office to conduct regular, periodic meetings with, at least, the user-community to present the results of the data collected, the conclusions drawn and any proposed actions based on the data and conclusions. Such meetings ideally will maintain the present constructive tenor to allow for feedback from, at least, the user-community.

Next, a clear Office definition of what is meant by the word "quality" is critical for determining the metrics used to evaluate any program. There are several points in the examination process for which the Section believes clearer metrics need to be identified. The first point involves searching. We recognize that it will be difficult to measure any

meaningful data at the time of search; however, one indication of thoroughness would result from comparing the US search with the searches of other offices (e.g., the EPO and JPO). The second point is the need for comprehensive office actions. At a minimum, they should clearly (1) explain any restriction requirement, (2) explain the relationship between the cited art and the claimed invention, (3) specifically address arguments made in response to earlier office actions – rather than merely state that the arguments were considered and found not to be persuasive; and (4) give detailed decisions to petitions. Further, the Section considers interviews important to resolve conflicts in examiners' and applicants' positions.

Many of the Section members have raised concerns that rules are applied differently in different art units. In particular, there are concerns about the Office's application of restriction requirements – especially regarding election of species. The Office should revise the present procedure to assure that it can be uniformly interpreted and measure the extent to which the issued restriction and election of species requirements are consistent with the procedures.

The Section recognizes that ultimate quality of a patent and the patenting process will necessarily be affected by the actions of the Office and applicants and/or their representatives. For example, if an applicant fails to claim all it could, one could say the applicant's action caused a patent of less quality than what could have been. However, the effect the Office can have on quality of issued patents is independent from the actions of the applicants. A quality examination can result in no patent, even though the applicant could have had a strong, broad patent if it had acted differently. In the past, the Office has often focused its patent quality conclusions on the behavior of applicants and/or their representatives. The Section believes that nothing is served by this focus. The Section believes that the program and the metrics applied by the program must focus on the Office's performance in examination – not whether the patent that issues from the examination is "high" or "low" quality because of the actions of applicants or their representatives.

Ultimately, quality of examination is dictated by the skills the Patent Examination Corps. The Section encourages the Office to develop training programs for the Patent Examination Corps to specifically address quality of process issues, as well as broadening the technical expertise of the examiners. Such training programs should include USPTO led class-room training and user-community lead class-room training in the developments of the technology in an art area. Further, allowing examiners to visit research facilities doing work in the examiner's art area is also important.

Many members of the Section noted the lack of involvement of supervisory patent examiners (SPEs) in the prosecution process. This was particularly true regarding interviews. Therefore, the Section encourages the Office to also develop training programs for the Supervisory Patent examiners to enable and encourage them to carry out their supervisory function and assist their examiners. The Section also encourages the Office to make

recommendations for incentives and measures in the USPTO's Examiner Performance Appraisal Plan (PAP) based on conclusions derived from the program.

The Section is, in general, supportive of the proposed metrics that were distributed for the Roundtable discussions. We have some comments on the specific proposals.

Our thoughts on metrics on final disposition errors have been set forth above. One additional comment is that in addition to a review of allowances and final rejections, the Office may also want to consider looking at non-final rejections for situations where an application is abandoned (expressly or by failure to respond) prior to the issuance of a final rejection.

Our thoughts regarding metrics on in-process review errors also have been set forth above. With respect to the proposals for complete application process review scoring and the quality index report, the Section will need to await more details to specifically comment.

With respect to the use of customer surveys and even examiner surveys, the Section in principle is supportive. The Section is aware that the EPO conducts customer surveys. Before implementation of such surveys, however, the Section would want to understand the cost of the surveys and the value that the Office believes can be derived from them.

The Section understands that, as mentioned at the Roundtables, the Office will now develop and refine specific metrics for the program. Our hope is that the Office will return to the user-community to fully vet the program and the metrics prior to any implementation. Further, the Section requests the Office to consult the user-community about costs and other burdens of implementation

In closing, thank you once again for taking on what the Section believes is a critical project. If you have any questions on our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

Don Martens
Section Chair
American Bar Association
Section of Intellectual Property Law