

From:
Sent: Monday, March 08, 2010 11:27 PM
To: patent_quality_comments
Cc: Khaled, Dina; Hallie Finucane; Timothy Bianchi; Greg Gardella
Subject: MIPLA comments responsive to patent quality notice

Messrs Schor and Laufer – Attached please find the comments of the Minnesota Intellectual Property Law Association responsive to the Request for Comments on Enhancement in the Quality of Patents (74 Fed.Reg. 65093). If you have any questions regarding these comments or would like to discuss them in further detail I would be happy to make myself available at your convenience.

Greg H. Gardella

Fish & Richardson P.C. | Principal | 60 S. Sixth Street, Suite 3200, Minneapolis, MN 55402 | Phone: (612) 337-2594 | Fax: (612) 288-9696 | gardella@fr.com | www.fr.com

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

IRS CIRCULAR 230 DISCLOSURE: Any U.S. tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein. (FR08-i203d)

**Minnesota Intellectual Property Law Association's
Response to the Request for Comments on
Enhancement in the Quality of Patents**

March 8, 2010

In response to the United States Patent and Trademark Office's Request for Comments on Enhancement in the Quality of Patents, published in the Federal Register at 74 Fed.Reg. 65093, the Minnesota Intellectual Property Law Association (MIPLA) hereby offers the following comments. The deadline for submission of comments was extended to March 8, 2010 by the supplemental notice published at 75 Fed.Reg. 5040.

I. The Office should permit deferred examination in exchange for payment of annuity fees

MIPLA proposes that the Office allow deferral of examination so that resources may be focused on the applications considered most important by applicants. Permitting applicants to remove less important cases from the examination queue will reduce pendency for non-deferred applications. It will also allow applicants to defer expenditures associated with the prosecution of applications of lesser or questionable commercial value. As to the latter category of applications, in many situations further developments in the marketplace or related technologies will bring into sharper focus the potential value of the innovations. Based on this additional information applicants will be able to make better decisions concerning which applications warrant investment of further resources.

From a macroeconomic perspective such a system would optimize the value generated by the market's aggregate investment in United States patent protection by eliminating inefficiencies associated with continued investment in intellectual property of marginal commercial value. The corollary proposition, also true, is that this system would increase the likelihood that any given dollar invested in United States patent protection will further the development of intellectual property that is likely to have significant commercial value.

II. Examiners should be required to propose claim amendments and potential declaration evidence where appropriate

As MIPLA suggested at the January 20th roundtable concerning the appeals rules, examiners should be encouraged, perhaps required, to propose clarifying amendments, identify new limitations that could be added to the claims to distinguish the art, suggest potential declaration evidence, or indicate that none of the foregoing appear likely to overcome the proffered rejections. For instance, where an examiner has broadly construed an arguably vague claim term and for that reason found the claim unpatentable in view of one or more references,

the examiner if applicable should propose claim amendments that find written descriptive support in the specification which could distinguish the prior art. As another example, where an applicant disputes that two references could or would be combined in the manner suggested, the examiner could propose that the inventor submit a declaration setting forth the particular reasons why one skilled in the art would not have combined the references in that way if such a declaration was considered likely to put the claims in condition for allowance.

Adoption of this practice would encourage early collaboration between examiners and applicants, consistent with the Office's push toward "compact prosecution." That, in turn, will tend to reduce pendency by facilitating the identification of patentability issues as well as the subject matter within an application that is most likely to be patentable.

Associated quality assurance processes should focus on instances where examiners take the position that no amendments or declaration evidence could be suggested. Analysis of these cases might indicate that patentable subject matter was originally missed by both the examiner and applicant and that pendency was unnecessarily prolonged. The analysis might also surface training opportunities, such as by identifying examiners or art units in which early suggestions concerning patentable subject matter are not made with sufficient frequency or in sufficient detail.

To facilitate examiner participation in this process the Office could permit examiners to make suggestions concerning claim amendments and evidence during an applicant interview in lieu of a written action. Making such suggestions during live discussions might be equally or more effective and doing so would allow examiners to save the time associated with typing the suggestions into a written action.

III. Expand First Action Interview Program to all art units and applications

The Office should expand the First Action Interview (FAI) Program to all art units and applications. MIPLA believes that, as a general matter, pre-action interviews substantially reduce pendency and increase the likelihood that the applicant and examiner will reach an agreement on allowable subject matter.

Expansion of the FAI Program dovetails with MIPLA's recommendation, above, that examiners be required to suggest claim amendments and declaration evidence where appropriate. Such examiner recommendations would be particularly useful and effective if made in connection with pre-action interviews. Moreover, requiring examiners to offer such suggestions during pre-action interviews will necessitate consideration of the most relevant prior art during the interview – one of the expressly stated objectives of the FAI Program.

FAI Program quality assurance processes should evaluate the average time-to-disposal and appeal rate for matters in which pre-action interviews occur. Analysis of the data will reveal whether pre-action interviews are, in a given art unit, effective at ferreting out patentable subject matter early in the prosecution process. If, for instance, there is no substantial reduction in the number of appealed rejections after pre-action interviews then the FAI process should be evaluated to determine why the early communications are not facilitating the identification of patentable subject matter.

IV. Modification of office action forms or database portals to enhance data collection

The USPTO should modify office action forms or the database portals (e.g., PALM) to facilitate collection of data concerning the types of rejections levied against each application. For example, the office action forms could be modified to include check boxes that respectively indicate whether the examiner has rejected any claims under section 101, section 102, section 103, section 112, etc. Alternatively, the PALM system or PAIR could be modified to include such fields and examiners could be required to enter the corresponding data for any action rejecting claims and for any appeal brief.

Collection of this data will permit an overall statistical evaluation of each type of rejection without the need for manual review and coding of the bases for rejections in a sampling of cases. The data collected using such a scheme could be reported, for example, by art unit, in order to document potential trends over time or differences among art units. Other trends of interest could include rejection types and rates for applications claiming priority beyond a given number of years. The data could be used to identify and explain rejection rates in given technology areas which could in turn increase public awareness that the Office is allowing only appropriate and patentable subject matter.

March 8, 2010
Dated

/Greg H. Gardella/
Greg H. Gardella
Fish & Richardson, P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(612) 335-5070

On behalf of
Minnesota Intellectual Property
Law Association
5353 Wayzata Blvd., Suite 207
Minneapolis, MN 55416
952-564-3051