

Improving the Quality of Patents

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Defining Quality

- “Quality” is defined in terms of the validity of a granted patent, not the commercial value of invention.

Goal is to improve process efficiency and reduce uncertainty

- Reducing overall application pendency (real pendency= time from initial filing to grant or decision on appeal of all claims presented: pendency not limited to time to first office action) is an important aspect of quality
- Three elements of a Quality patent
 - Quality of the patent application
 - Quality of the search and examination
 - Quality of the prosecution
 - Each element needs defined and measurable indicia

Quality is a Shared Responsibility

- Quality improvements require behavioral modification by applicants and examiners
- “Quality” is not a euphemism for new examiner performance or production requirements although quality metrics can be used for training and performance reviews
- Quality can be improved without new rules
- Quality and certainty are improved when in process delays are minimized

Quality Indicia

- There are many possible indicia- the need is to select the minimum number of the most important criteria that drive desired behaviors of applicants and examiners
- We must not assume that initial metrics will be perfect – improving quality will require refinements in the metrics employed over time
- Focus on early stages of process- harder to improve quality as application prosecution time goes on

Quality in - Quality out

- Quality is improved when uncertainty is minimized
- Quality is improved when pendency is minimized
- Delays in providing useful feedback reduces quality
- Quality is improved when participants understand the metrics and receive clear and prompt feedback
- The quality of any patent application and granted patent is directly related to the adequacy of the disclosure:35 USC 112 compliance is critical to quality

Quality Search

- A thorough and complete initial search of the prior art is critical to quality and pendency
- Are examiners given right amount of time/credit to conduct initial search of all claims? Does requirement for restriction unduly increase pendency , backlog and search inefficiency?
- Worksharing with other offices on search is key to improving quality
- Can PTO provide incentives for applicants who conduct a search before filing ? Could applicant who identifies 5 most relevant prior art references receive priority for examination?

Quality Examination

- Quality should include goal of eliminating unnecessary continuing applications
- Premature final rejections cause continuation filing and longer pendency
- Examiner credits for continuing applications should be re-examined: consider conditions for examiner disincentives for continuing applications

Quality prosecution

- Reaching early closure on critical issue for patentability improves quality
- Interviews before and after first office action on merits can improve quality and reduce pendency: Build in incentives for examiners and applicants to conduct interviews.
- Would pre-appeal conferences reduce continuations and premature finals?
- Supervisory examiners should monitor examiner response times and open status requests

Next steps: Review Quality indicia

- What do you think are the 5 most important criteria that could drive improved quality and reduce pendency?
- Memo (see excerpt) identifies many possible indicia for application, search, examination/prosecution, but which do you think would have the biggest impact?
- PPAC and PTO should agree on 5 key metrics.
- PTO should then seek public input: forum focused on the metrics- not an open ended discussion of quality.

Examples of quality indicia

- **Indicia of a quality search and examination**
- **Were relevant prior art publications or patents cited in corresponding foreign applications not cited by the examiner?**
- How long did it take after the initial filing date for the examiner to issue the first substantive rejection in the case?
- Was there a restriction requirement in the case ?
- **Was the examiner available for an interview before or after the first office action on the merits?**
- Were new references cited by the examiner in a second office action?
- **Was the second office action properly made final?**
- Did applicant re-file as a continuation application without amendment?
- **How long did it take from filing until the claims, original or amended, were allowed , an appeal filed or application was abandoned without refill**
- **If the patent was litigated was the patent invalidated by a newly cited prior art reference and was that reference available to the examiner who examined the application?**

Examples of quality indicia (cont'd)

- **Indicia of quality prosecution**
 - Did the applicant amend and narrow claims in response to an office action?
 - Did applicant request extensions of time in response to any office action?
 - Did the applicant re-file the application without a preliminary amendment?
 - Did the applicant add new matter (cip) when refiling?
 - Did applicant submit a declaration under 37 CFR 131 or 132?
 - Did the applicant file a notice of appeal?
 - **Did the examiner re-open prosecution or allow the case after a notice of appeal or appeal brief was filed?**
 - Did applicant re-file the application after allowance?
 - **Was the allowed application re-examined?**
 - **Did an appeal affirm or reject the examiner's basis for rejection?**
 - Did a reexamination submission include new prior art not identified by the applicant or examiner?
 - Did the reexamination result in narrower allowed claims?
 - Did the reexamination result in the application becoming abandoned?
 - **How long did the appeal take- from notice of appeal to final decision?**
 - Did applicant appeal to the Federal Circuit?
 - **Did the Federal Circuit affirm or overrule the examiner or BPAI?**
 - Did the applicant unintentionally abandon and seek to reinstate the application?
 - **Did the patent office misplace any correspondence submitted during prosecution?**
 - Did any examiners amendment require further correspondence with applicant?
 - Were all the references cited during prosecution properly identified on the face of the issued patent?
 - **Was there a petition for patent term extension for pto delay?**
 - How long was the patent term extension and how long did it take to arrive at the correct term extension?
 - Was the patent involved in litigation?
 - **Were any allowed claims found invalid for prior art reasons during litigation?**
 - **On the basis of newly discovered prior art?**
 - On the basis of 35 USC 112?
 - On the basis of obviousness under 35 USC 103?
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