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Sent: Wednesday, May 06, 2015 6:22 PM
To: WorldClassPatentQuality
Subject: Comments by FICPI U.S. Section on Enhancing Patent Quality

Attention: Michael Cygan
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Dear Mr. Cygan,

Attached are comments submitted on behalf of the U.S. Section of FICPI, as well as a cover letter.

Kindly acknowledge receipt of this e-mail.

Sincerely,

Andrew D. Meikle, President of U.S. Section of FICPI

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May 6, 2015

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ATTN: Michael Cygan
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Subject: Submission by FICPI U.S. Section of Comments on
Enhancing Patent Quality

Dear Mr. Cygan:

Enclosed please find written comments by the U.S. Section of FICPI in response to the "Request for Comments on Enhancing Patent Quality" announced in the Federal Register Notice of February 5, 2015 (Vol. 80, No. 24, pp. 6475-6481).

On behalf of FICPI, I would like to thank the USPTO for organizing and running the Quality Summit on March 25th and 26th earlier this year. Initiatives such as this Summit and the invitation for comments on patent quality will hopefully provide a variety of ideas that can indeed enhance patent quality in the future.

Sincerely,

Andrew D. Meikle
President, FICPI U.S. Section

Comments by the U.S. Section of FICPI on Enhancing Patent Quality

Introduction

The U.S. Section of FICPI, the Fédération Internationale Des Conseils En Propriété Intellectuelle (International Federation of Intellectual Property Attorneys) provides its comments in response to the United States Patent and Trademark Office “Request for Comments on Enhancing Patent Quality” as announced in the Federal Register Notice of February 5, 2015 (Vol. 80, No. 24, pp. 6475-6481). The U.S. Section of FICPI sets forth below its responses to the specific questions posed in the Federal Register Notice.

Founded over 100 years ago, FICPI represents IP attorneys in private practice internationally with almost 5,500 members in 86 countries and regions, including all major countries. FICPI has strong U.S. and European memberships and has recent and growing sections in India and China.

FICPI aims to enhance international cooperation amongst IP attorneys, study reforms and improvements to IP treaties and conventions with a view to facilitating the exercise by inventors of their rights, increasing their security and simplifying procedures and formalities, and promote the training and continuing education of its members and others interested in IP.

Pillar 1 - Proposal 1: Applicant Requests for Prosecution Review of Selected Applications

Summary Response: A proposal for the Office of Patent Quality Assurance (OPQA) to provide prosecution review of a limited number of applications can potentially be beneficial to applicants. The OPQA review should be limited to applicants or practitioners with standing in the application. Feedback from the review program can provide valuable information to the U.S. Patent and Trademark Office ("Office") to insure consistency in examination standards and inform examiner training procedures, as well as provide valuable information to applicants about proper Office prosecution standards.

Detailed Comments

A program providing for an Office of Patent Quality Assurance (OPQA) prosecution review could be useful for applicants who have concerns about positions that U.S. Patent and Trademark Office ("Office") examiners have taken with respect to interpreting the scope of patent claims, interpreting the scope of the prior art, complying with case law decisions, complying with Office policies such as subject matter eligibility requirements, or complying with Office procedures. However, if applicants conclude that such OPQA reviews tend to be biased in favor of the position of the examiner, such as repeatedly interpreting claim scope or the scope of the prior art overly broadly, then applicants will likely have reservations about using such a program.

Applicants or practitioners with standing in the application should be the only ones allowed to submit requests for OPQA reviews under this proposed program. Third parties should not be allowed to participate in this program, because this would become another avenue for third parties to attack or raise issues against pending applications. Third parties already have the option of Third-Party Preissuance Submissions under 35

U.S.C. §122(e) for the purpose of raising prior art issues against pending applications and should not be given an additional, non-statutory option.

It seems reasonable to limit requests for OPQA reviews. For example, requests could be limited such that: (1) at least two substantive Office actions had issued which indicated the issue of concern by applicant, and (2) applicant has conducted an interview with the examiner that reached an impasse on the issue. The timeframe for submitting requests for OPQA reviews could also be limited relative to the date of the second Office action that repeated the issue.

Preferably examination is suspended so that no further Office action is issued before a conclusion is drawn based on the OPQA review, unless applicant requests the examiner to proceed pending the review.

The level of detail that should be provided to OPQA in describing the issue for which review is sought should clearly identify each issue of concern and indicate how the examiner's action is inconsistent with appropriate standards based on references to applicable statutory authority, case law, and/or Office rules (Code of Federal Regulation), as well as applicable policies or Office guidelines that may be indicated in the Manual of Patent Examining Procedure (MPEP).

OPQA selection of submitted cases can be based on sampling in order to address recurring issues. If the reviewer is blind to the issues, then OPQA cannot achieve at least this goal. The scope of review can be limited to the issues identified to OPQA by applicant, but can extend to a typical review of quality issues, depending upon the burden that OPQA faces if this program is created.

Practitioners would expect feedback from OPQA including at least: (1) an indication that the application was not selected for review and the reason why it was not selected; and (2) an indication that the application was selected for review together with the reasons that the OPQA reviewer agrees with or disagrees with the position taken by the

examiner. Practitioners can use the feedback to inform their decisions going forward in the prosecution of other patent applications. The Office and OPQA can use the results of the review decisions to inform the Office on current trends in examination and for future examiner training, as well as to allow for the Office to take any necessary steps to ensure consistency in examination standards.

Pillar 1 – Proposal 2: Automated Pre-Examination Search

Summary Response: An automated pre-examination search can provide additional helpful information to applicants and examiners. There do not appear to be any substantially negative consequences of providing this information in the official record of the application. This information can better inform applicants during the prosecution process as well as with respect to future filing strategies.

Detailed Comments

A pre-examination search conducted by the Office not long after the application is filed would further promote a higher quality examination for all applications. Both examiners and applicants can conduct prosecution more efficiently if the best prior art is made available. Increasing the probability of uncovering the best prior art early helps examiners and applicants candidly assess the differences between the scope of the patent claims and the scope of the prior art. Uncovering the closest prior art early in prosecution allows applicants to assess how best to go forward including: how best to amend patent claims and develop helpful evidence that can be submitted into the record in support of patentability.

An automated pre-examination search should probably be conducted before the examiner picks up the application for examination, likely about three to six months after the application filing date. This allows applicant a chance to use the information from the search before the Examiner begins substantive examination. With respect to

priority establishing applications, it would be particularly helpful to applicants if the search results became available within one year (the priority year) so as to provide more information that can be used to determine a filing strategy going forward and/or in discussing newly uncovered prior art in a subsequently filed application.

Providing automated pre-examination search results on the record, in and of itself, does not appear to raise any significant negative legal implications since an independent prior art search does not affect an applicant's "Duty of Disclosure" in the USPTO and only provides additional prior art for consideration by applicant and the examiner. Of course, if applicant decides to amend the patent claims in view of the search results, it is possible that prosecution history estoppel could arise, though such a decision would depend upon the applicant and the search results. Along the same lines, however, the search results may implicate Applicant's duty to disclose to a foreign examination authority the references found, depending on the disclosure rules of states into which Applicant has filed for IP rights.

A pre-examination search should provide, at a minimum, the same types of information provided in a typical PCT International Search Report (ISR), including, for example, an indication of the relevance of the cited prior art to the claimed invention and whether the cited prior art pre-dates any earlier-filed priority application.

If possible, a pre-examination search should include prior art found in searches conducted earlier on any corresponding applications filed outside the U.S.

Assuming that a pre-examination search provides a comparison between the application and the prior art, it appears that the best type of comparison would compare: (1) the claims and specification of the application; and (2) the disclosure of the prior art. This type of comparison would provide more information than merely a comparison between the application claims and the prior art. Ultimately, applicant will have an opportunity to comment upon or submit any corrections to such a comparison,

such that there do not appear to be any significant negative ramifications to providing such a comparison.

Pillar 1 - Proposal 3: Clarity of the Record

Summary Response: A prosecution record that included a more extensive and legally correct claim construction analysis by the examiner, optionally informed by the applicant, would appear to be, on the whole, beneficial to applicants, as well as to the public, by providing a clearer starting point for claim construction of the granted patent by the Office in post grant procedures, federal court patent litigations, and third parties concerned about potential infringement. A more extensive claim construction analysis could also allow applicant to more clearly understand the positions taken by the examiner during prosecution. On the other hand, an attempt to introduce more clarity into the record by recording or transcribing examiner interviews would likely reduce the benefits of the give and take nature of examiner interviews and possibly convert this process into a more costly, formal and/or rigid interaction.

Detailed Comments

In the past, applicants have received Office actions that contained comments by examiners which construed at least the most significant claim terms or phrases. While applicants have not always agreed with the position taken by the examiner, applicants are free to articulate a counter-position in the record. It is submitted that this dialog in the prosecution record is ultimately beneficial over an absence of any specific discussion concerning claim construction. At least the applicant has an opportunity to influence claim construction that may ultimately occur at an Office post grant procedure, such as an Inter Partes Review, or in a federal district court litigation. While the "broadest reasonable interpretation" (BRI) standard employed by the Office¹ differs somewhat

¹ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005).

from the narrower claim construction standard used by federal courts², it is likely that the interpretation of some terms and/or phrases under BRI can influence federal judges in their claim construction efforts. This may be especially true if the applicant and examiner agree in the official record upon a specific interpretation of a claim term or phrase. It becomes more likely if the prosecution record of a patent application contains a more extensive claim construction analysis, this analysis will inform and influence the positions taken by Office in a post grant proceeding or a federal district court in construing the subsequently granted patent. A more extensive claim construction analysis in the record can also serve a public notice function, since third parties may have additional information upon which to base their claim construction decision and conclusions concerning possible infringement.

Since applicants often desire to know the opinion of the examiner with respect to the scope of a patent claim, it would be helpful for the Office to require examiners to provide in the prosecution record an explicit claim construction at least of the independent claims under examination. The Office could provide guidelines that require the examiners to make an explicit claim construction of at least the independent claims being examined in the first substantive Office action. In reality, examiners constantly make claim construction decisions but often do not make explicit in the record many of these decisions. Applicants would benefit by more clearly understanding the various claim construction positions taken by the examiner and would have the opportunity to comment on or criticize the claim construction positions taken by the examiner in the prosecution record.

While it may be helpful to record and transcribe a more formal oral interaction such as an oral argument before the U.S. Patent Trial and Appeal Board (PTAB), this is not the case with respect to an examiner interview which is a much more informal oral interaction. From an applicant's perspective, examiner interviews often serve the

² *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

purpose of providing the applicant with an opportunity to run some proposals by the examiner or to clarify the examiner's position on various issues. Applicant and examiner often work cooperatively during interviews, and may share with each other various proposals, including those spontaneously brought to mind. Neither party wants to be tied down to a spontaneous proposal that seems helpful upon first consideration but which, upon reflection, appears otherwise. Formalizing the interview process would chill the opportunity for such cooperative brainstorming and also limit the flexibility of the parties involved to suggest or tentatively adopt new positions. Applicants would likely not be satisfied with any increase in cost due to the recordation or transcription. The present system of having the examiner summarize the key points of the interview in a subsequently issued communication is working well. An attempt to transform an examiner interview into a more formalized procedure could reduce flexibility and raise costs for applicants.

In any Office action following an interview, at least for the patent claims that were further discussed during the interview, the examiner should make clear the reasons as to why the claims are or are not allowed even if the Office action is a notice of allowance. This allows the public to understand more clearly from the prosecution record why an earlier objection has or has not been overcome.

Concerning pre-appeal and appeal conference decisions not to re-open prosecution, it can only be helpful if the Office could require at least a summary explanation of the reasons that prosecution was not re-opened. Applicants appreciate at least some feedback, since such information could possibly convince the applicant that the evidence in the record is deficient to the point that filing a Request for Continued Examination (RCE) with additional evidence would be the better course of action over pursuing an appeal. Presently applicant is provided no feedback at all.

Probably the best time for an examiner to provide reasons, as to why a patent claim is allowable, is in the Office action that conveys the indication of allowability.

Traditionally, some examiners have waited until the Notice of Allowability to provide this information. However, an explanation earlier in the prosecution would help applicant to more clearly understand the examiner's position concerning what is required for allowability. In order to aid in determining the scope of later-granted patent claims, the reasons for allowability should address at least the most significant feature(s) in the claims contrasted to the most significant failing(s) of the prior art, along with any other evidence in the record supporting patentability or other factors taken into consideration by the examiner.

Pillar 2 - Proposal 4: Review of and Improvements to Quality Metrics

The Office is encouraged to re-evaluate and improve the "Quality Composite Metric", as well as to find ways to enhance examiner training. No additional comments are provided in this submission.

Pillar 3 - Proposal 5: Review of the Current Compact Prosecution Model and the Effect on Quality

Summary Response: The current compact prosecution model is overly restrictive because it is only in the final, second Office Action that applicant first receives the examiner's response to applicant's claim amendments and arguments in favor of patentability over the applied references. The finality of the second Office Action severely limits applicant's ability to then reply to the examiner's response and necessitates an RCE. The number of cases allowed after the first RCE strongly supports a modification to the current model. If applicants could have the option of "converting" the final Office action to a nonfinal Office action, then applicants could submit claim changes and/or submit evidence and/or conduct an interview without having to resort to filing an RCE. Alternatively, abolishing "final" Office actions and requiring applicants to pay a fee for

each non-final Office action could be another way to avoid the problems of the current compact prosecution model. It is submitted that more interactions between the Office and applicant can only enhance prosecution efficiency and quality.

Detailed Comments

The current compact prosecution model achieves “final” disposition in two substantive Office actions a very large majority of the time. This is not necessarily beneficial to applicants in situations where only a few additional relatively small changes to the patent claims and/or some easily obtainable additional evidence is needed to resolve the remaining issues and place the application into allowable condition. Because a final Office action has issued, applicant must now file a Request for Continued Examination (RCE) in order to have the claim changes or evidence entered into the record and considered by the examiner. Often in the final Office action, the examiner cites new prior art references and articulates new arguments in support of the rejections which applicant must now address for the first time. While the examiner has now substantively reviewed the application for a *second* time and issued a final Office action, applicant has had only *one* opportunity to address the concerns of the examiner. The compact prosecution model can be considered efficient because it achieves the goal of reaching an early final disposition, but should be modified to allow applicants some additional flexibility, especially if an applicant must address new prior art and/or new arguments raised for the *first* time in the final Office action.

It would clearly be beneficial if applicant could have an additional non-final Office action before final disposition is reached. It would also be beneficial to have the chance to interview the examiner before or after a second, non-final Office action. There are several reasons that these options would be beneficial. Because the applicant has now learned for the first time the position the examiner has taken regarding: the patent claims as amended in the first response, any evidence submitted or identified in the record, and/or applicant’s arguments supporting patentability, applicant has a much

more complete understanding of the examiner's position. Applicant is in a much better position to address the concerns raised by the examiner after the examiner's second substantive review of the application and applicant may desire to have the option of doing so without having to resort to filing an RCE. Also, having the opportunity to conduct an interview with the examiner before or after the second, non-final Office action could allow applicant to address these concerns.

It would be difficult for applicants to identify applications that would benefit from an additional Office action at the time that applicant submits a response to the first Office action (i.e. before close of prosecution). Again, in most cases applicant has not yet seen the examiner's position with respect to the amended claims or evidence or arguments supporting patentability provided in the first response. On the other hand, if applicants could have the option of "converting" a final Office action into a second, non-final Office action by submitting an appropriate fee for example, this would allow applicants an opportunity to review the second Office action in order to determine whether it could be helpful to file additional claim changes or evidence without having to resort to filing an RCE. It is often true that resolution of the substantive issues arising during prosecution requires applicant to file more than one response which includes claim changes and/or evidence supporting patentability. This additional flexibility of allowing an applicant to file a second substantive response without having to file an RCE would likely be beneficial to applicants in a good number of circumstances.

As a procedural alternative to the proposal of allowing applicant the option to convert a final Office action into a non-final Office action, the Office could require that if the examiner cites any new prior art, the examiner must issue a "pre-final" Office action, perhaps with a suggestion for an interview, so that applicant would have a chance to discuss these issues with the examiner with a chance to resolve at least some issues before a final disposition is reached.

Regarding the proposal to completely abolish the practice of issuing final Office actions so as to allow for more give and take between the applicant and examiner, it is submitted that this is may be a reasonable proposal. If applicants were required to pay a fee for every reply after the first response to the first Office Action, this could be one reasonable way to incentivize applicants to close prosecution so as to avoid endless prosecution scenarios. Alternatively, the fee for replies could be progressive in nature, starting at no fee for a filing similar to those permitted in the AFCP 2.0 program, and approaching that of an RCE for situations in which the addition of new claims necessitates a substantially new search.

It is submitted that more interactions between the Office and applicant can only enhance prosecution efficiency and quality. For example, practitioners often find that conducting an interview with the examiner improves the understanding of the practitioner with respect to the examiner's positions concerning: (1) the scope of the patent claims; (2) the scope of the prior art; (3) the evidence or reasoning needed, according to the particular examiner, to establish patentability over the prior art of record; and/or (4) other non-prior art issues, such as the needed claim changes or evidence necessary to overcome written description or subject matter eligibility rejections. While Office actions provide detailed explanations of the positions taken by the examiner, the written word is very often not enough to clearly discern the above issues (1)-(4). During the give and take of an interview the examiner sometimes clearly spells out what applicant must do to overcome the outstanding rejection(s) and get to allowance. Most often, Office Actions do not focus on this issue. Increasing interactions with the examiner can only help to clarify this issue.

Perhaps the best time during prosecution for an interaction, such as an interview, is after the examiner has issued the second Office action, which today is typically a final Office action. At this point in the prosecution, applicant has had one opportunity to fully address the issues raised in the first Office action, and the examiner has had one opportunity to address applicant's first fully-articulated position. It is at this point in

the process that applicant can benefit most from an interview by focusing on what, in the opinion of the examiner, applicant must establish to overcome the outstanding rejections. Under the current system, interviews are generally discouraged after the final Office action, or the examiner often appears unmotivated to engage fully with applicant, often suggesting that applicant file an RCE since any claim changes or new evidence will not be considered otherwise after a final Office action has issued. Under the current system, applicants often file an RCE and then conduct an interview with the examiner. It would be more beneficial for applicants to have the interview *before* having to file an RCE since applicant could clarify earlier in the prosecution what type of evidence or reasoning is required by the examiner to overcome the outstanding rejection(s).

In conclusion, it is submitted from the viewpoint of many applicants that the present compact prosecution system encourages examiners to “rush” towards a final Office action, with the applicant having only one attempt to substantively address the examiner’s position. Applicants would benefit from a more flexible system that allows for more interactions with the examiner before a final disposition is reached.

Pillar 3 – Proposal 6: In-Person Interview Capability with All Examiners

Summary Response: Given the preference of some applicants to conduct in-person interviews rather than telephonic or video conference interviews, and given that some examiners are now located remote from the Office campus, it appears beneficial for the Office to set up an in-person interview program that accommodates examiners working in remote locations.

Detailed Comments

There are benefits of in-person interviews over video conference interviews. For example, an in-person interview allows for a more personal interaction during which the practitioner (or applicant) and the examiner can more effectively judge the conviction with which each holds to their positions. During an in-person interview, the practitioner can often more easily detect through body language whether an examiner is communicating a position that may be somewhat different than what the examiner has orally stated. A video conference, on the other hand, adds a veneer of opaqueness behind which the examiner or the practitioner can at least partially hide. In-person interviews allow for a deeper communicative interaction which can help the practitioner or the examiner to more effectively communicate his or her position. In-person interviews can also allow an applicant demonstrate how an invention embodiment works, especially in the case of mechanical or electronic devices. In addition, an in-person interview can demonstrate to the examiner that applicant considers the particular application to be a very important one and can leave a more lasting impression on the mind of the examiner as compared to the prosecution of other applications which did not include an in-person interview.

Conducting examiner interviews at locations remote to the Office campus could raise some transportation obstacles for the examiner and/or the practitioner (or applicant), but do not raise any other significant obstacles.

If the examiner and practitioner each have at least a laptop computer with the necessary patent application prosecution record (or a hard copy thereof) and an internet connection (for example, if other Office records or information must be accessed), this should be sufficient to conduct an effective interview. If an interview is to be conducted at a remote location, a reasonable notification time for scheduling and conducting the interview would be two to four weeks.

One way for the Office to fund an in-person interview program to recover costs for remote location interviews would be to charge a flat fee for all in-person interviews. This funding arrangement would allow applicants to have the opportunity of conducting in-person interviews at some reasonable cost, rather than placing the cost burden solely on applicants who have, through no fault of their own, been assigned examiners working at remote locations.

In gauging the effectiveness of the program, the Office can look to the volume of in-person interviews, as well as the proportion of in-person interviews as compared to other types of interviews. This could provide some gauge of the value applicants place upon in-person interviews.