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RE: NYIPLA Comments in Response to “Request for Comments on Enhancing Patent Quality,” Federal Register Notice, February 5, 2015, Vol. 80, No. 24 (80 FR 6475).

Introduction

The New York Intellectual Property Law Association (“NYIPLA”) is a professional association comprised of over 1,500 lawyers interested in Intellectual Property law who live or work within the jurisdiction of the United States Court of Appeals for the Second Circuit, and members of the judiciary throughout the United States as *ex officio* Honorary Members. The Association’s mission is to promote the development and administration of intellectual property interests and educate the public and members of the bar on Intellectual Property issues. Its members work both in private practice and government, and in law firms as well as corporations, and they appear before the federal courts and the United States Patent and Trademark Office (“USPTO”). The NYIPLA provides these comments on behalf of its members professionally and individually and not on behalf of their employers.

The NYIPLA applauds the USPTO for the work it has done and its efforts in enhancing patent quality. The Federal Register published a “Request for Comments on Enhancing Patent Quality,” in the Federal Register on February 5, 2015, 80 FR 6475 (Vol. 24) (hereinafter, “Patent Quality Initiative”), wherein the USPTO requested comments on six proposals relating to patent quality, and also solicited comments relating to patent quality beyond the specific questions and proposals raised in the Federal Register Notice. The NYIPLA welcomes and appreciates efforts

by the USPTO to improve patent quality, including specifically soliciting comments from the public. The NYIPLA is pleased to provide these comments in an effort to improve the quality of patent examination by the USPTO.

Background

It is appreciated that the USPTO is not faced with an easy task given the number of patent applications filed each year. In the Patent Quality Initiative, the USPTO set forth three “pillars” of patent quality and set forth six specific proposals grouped according to these three “pillars.” The three pillars of patent quality are “Excellence in Work Products,” Excellence in Measuring Patent Quality,” and “Excellence in Customer Service.” The six proposals, grouped by pillar, are set forth in the chart below.

“Pillars”	Proposals
1: Excellence in work products	1. Applicant Requests for Prosecution Review of Selected Applications
	2. Automated Pre-Examination Search
	3. Clarity of the Record
2: Excellence in measuring patent quality	4. Review of and Improvements to Quality Metrics
3: Excellence in customer service	5. Review of Current Compact Prosecution Model and the Effect on Quality
	6. In-Person Interview Capability with All Examiners

The NYIPLA provides comments in response to the six proposals presented by the USPTO.

The USPTO also requested comments relating to patent quality outside of the specific questions posed in the Federal Register notice. The NYIPLA would like to take this opportunity to provide its view on the requisites for quality examination of a patent application.

Discussion

The NYIPLA provides comments below on each of the six (6) proposals submitted by the USPTO, but first provides some general comments on patent quality and some suggestions for the USPTO to consider.

1. Omnibus Comments

The NYIPLA is of the view that a fundamental prerequisite to patent quality is a quality search and a patent examiner who can properly apply the prior art to the applicant's invention as recited in the applicant's claims. Most of the situations where the quality of patent examination suffers arise when one of those two criteria is not met. We outline two specific proposals which arise from this concern.

It is our experience that the Examiner does not consistently find or apply the best prior art in the first office action. This may be the result of the Examiner not fully understanding the invention, misconstruing the scope of certain claim terms, or not appropriately searching the prior art. For these and other reasons, the first "non-final" office action is at times poorly crafted.

In response to the non-final office action, the applicants amend the claims to further define the aspects of the invention. The Examiners respond by issuing a second "final" office action necessitating the filing of a Request for Continued Examination ("RCE") to allow the entry of additional claim amendments and declarations to further advance prosecution on the merits. This traditional approach to prosecuting a patent application is inefficient to applicants, the USPTO, and the patent system as a whole, and hopefully is changed as part of the USPTO's response to its Patent Quality Initiative. The NYIPLA believes that the quality of examination

can be improved by the Examiner conducting a quality search at the outset and applying the best prior art in a first non-final office action.

Even with some enhanced “after final” procedures implemented by the USPTO in the last couple of years, such as the USPTO’s After Final Consideration Pilot 2.0, the ability for applicants to amend claims and have declaration evidence entered “after final” is very limited. The USPTO has suggested, in Proposal 5, to make a second non-final office action available upon payment of a fee. As an initial point, the NYIPLA fully supports the USPTO issuing a second non-final office action as this approach will improve the efficiency and the quality of examination. If this proposal is implemented, applicants will be permitted to amend the claims and submit declaration evidence in response to the second non-final office action. However, the NYIPLA believes that applicants should receive a second non-final office action without paying an additional fee if the Examiner cites new prior art in the second office action to reject the claims, especially if any amendments to the claims in response to the first office action were trivial in nature. Alternatively, to the extent the USPTO charges a fee for issuing a second non-final office action, such fee should be at least half of what the first RCE fee is to make such an approach viable.

Second, the current rules allow for third-party submission of prior art in an application that has been published within a limited time window during prosecution. However, the rules prohibit the third-party from making any comment on the patentability of the claims. The third-party is merely allowed to identify the location in the submitted prior art where the claim limitations are found, *i.e.*, a correspondence between the prior art and the claim limitations. For example, a third party cannot point to motivation or rationale to combine the prior art. Any submission containing a statement that goes beyond identifying correspondence between the

claims and the prior art (*i.e.*, identifying the location in the prior art where the claim limitation appears), will be rejected.

The NYIPLA proposes that the rules be changed to allow a third-party to make more detailed comments regarding the relevance of the submitted references to the patentability of the pending claims, such as, for example, comments regarding a rationale for combining the submitted references with each other or with other art of record. By permitting the third party to provide information on patentability, including the reasons and motivation to combine the submitted references, the Examiner will be able to make better use of the submitted information.

The NYIPLA is cognizant that the initial prosecution is *ex parte* and the concern that opening up the rules regarding third party submissions might (1) result in a dramatic increase in argument and increase Examiner work load, and (2) circumvent the *ex parte* nature of patent examination. One way of limiting and focusing such third-party comments might be accomplished by limiting the comments to a particular length, *e.g.*, by word count, page length, or number of prior art references per submission. For example, the submission could be limited to four references per independent claim, 10 pages in total length, and/or 100 words per reference. By using appropriate limitations on the number of references cited, the total length of the submission, or the length of discussion of each prior art reference, the USPTO will be able to ensure the submission of concise, informative and useful third-party submissions during initial examination of a pending patent application. The NYIPLA notes that support for this limited approach can be found in a number of USPTO programs where, for example, the USPTO only allows a five-page submission in a pre-appeal brief and requires that each pre-issuance submission include no more than 10 references.

2. NYIPLA Comments in Response to Six Proposals Presented in the Patent Quality Initiative

A. Proposal 1, Under Pillar 1: Applicant Requests for Prosecution Review of Selected Applications

The NYIPLA believes the examination of a patent application by both a USPTO Examiner from a group art unit AND a representative from the Office of Patent Quality Assurance ("OPQA") will likely lead to a higher quality patent. The issuance of such high quality patents benefits both the applicant and the USPTO as such a patent will have a greater likelihood of withstanding any invalidity challenges in a U.S. District Court or USPTO PTAB proceeding. However, the NYIPLA needs further information with respect to proposal 1 as it is not clear what criteria will be used by the USPTO to select an applicant's patent application after the applicant decides to enter the "pool of applications" as described in the Federal Register notice or otherwise how the program will be implemented. Furthermore, it is the NYIPLA's understanding that OPQA only includes 50-60 individuals so it is too thinly staffed to handle a significant amount of applicant requests, thus the impact of such an approach may be negligible. It would be helpful if the USPTO can provide information to the stakeholder community on the criteria it plans on using to select patent applications from the pool of applications, how it plans to implement the program and any proposed staffing changes to the OPQA to conduct such enhanced reviews.

B. Proposal 2, Under Pillar 1: Automated Pre-Examination Search

Under proposal 2, the USPTO is contemplating having automated, linguistic based, pre-examination searches performed. Specifically, an algorithm would analyze the patent application for frequently used terms and generate a list of U.S. patents and applications that frequently use the same terms. The NYIPLA is aware of the results that can be achieved through

use of linguistic searches as such tools are being used in the market place. The NYIPLA believes that there could be benefits to using the automated pre-examination search. However, we are concerned that the USPTO Examiner would rely *only* on these searches and not conduct a separate, thorough search based on the scope of the claims and the terminology as used in the claims, not necessarily the entire specification. The USPTO is fully aware that a patent application may include a description of multiple embodiments of an invention that can lead to the issuance of a number of patents based on an effective use of continuation and divisional filings. However, the scope of the claims in an application should be the focus of any pre-examination search and not necessarily the entire patent application.

Since an inventor of a patent application can be his own lexicographer, and since there are often numerous, interchangeable terms available for description, linguistic searching may result in the most pertinent references being over-looked. Also, inventors, members of the patent bar and drafters of patent applications, knowledgeable of such search efforts may utilize different language in their patent applications to minimize the success of such searching efforts. It is the view of the NYIPLA that automated searches may encourage examiners to use word matching to reject claims, which would lead to poor quality office actions. Such searches may lead Examiners to become too reliant on the automated search and lead to less thorough initial searches by the examiners.

Linguistic searches should be but one tool used by Examiners to uncover the best, closest prior art, and the USPTO should invest in upgrading and improving such tools. The NYIPLA has concerns with an algorithm-based pre-examination search becoming the only initial search performed by Examiners. Perhaps a pilot program in certain art units where such linguistic

programs would likely have the most accurate and useful results would be worthwhile to ensure that the NYIPLA concerns are addressed.

Proposal 3, Under Pillar 1: Clarity of the Record

The third proposal is directed to increasing the clarity and completeness of the examination record before the USPTO. We initially note that this proposal garnered significant debate by members of the NYIPLA responsible for preparing this response. We note that the USPTO and NYIPLA are not alone with respect to questions concerning the appropriate measures to improve the “clarity of the record” as even the U.S. Supreme Court dealt with this issue in June 2014 when it rendered a decision in the *Nautilus, Inc. v. Biosig Instruments* case. In *Nautilus*, the Supreme Court stated that “... we read §112, ¶2 to require that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with *reasonable certainty*, while recognizing that *absolute precision is unattainable.*” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129, 189 L. Ed. 2d 37 (2014) (Emphasis added). The NYIPLA recommends that the USPTO further study the *Nautilus* case and its progeny for guidance on this topic and refer to it in any future Federal Register notices dealing with this topic.

In general, the NYIPLA agrees that clarity of the record is important to the quality of issued patents. A complete and clear record provides a higher quality patent and one which the patent owner, competitors, the public and the courts can better understand, and appreciate its boundaries. The NYIPLA also believes that highly qualified and properly trained examiners will assist in providing a clear record and higher quality patents. The USPTO cites several exemplary procedures under consideration to improve the clarity of the record.

One proposal the USPTO describes is “making claim construction explicit in the record, including the scope of claim terms, claim preambles and functionally defined clauses.” The NYIPLA does not believe that it is practical to explicitly define each and every claim recitation. This approach would be unduly burdensome to applicants and offer only limited value to the public because, as the Supreme Court said in *Nautilus*, “absolute precision is unattainable.” *Id.* Instead of making claim construction explicit in the record, the NYIPLA believes it is important for the USPTO to re-emphasize some basic points. First, it is a basic tenet of patent law that an applicant can be his or her own lexicographer. The Supreme Court reiterated this point in the *Nautilus* case when it stated that “the patent drafter is in the best position to resolve the ambiguity ... in patent claims.” *Id.* To the extent that the applicant does not define the terms used in the claims with “reasonable certainty” then the applicant runs the risk of the patent being found invalid for not satisfying the Section 112 requirements. Second, the Examiner has the responsibility of examining the patent application and raising any Section 112 rejections based on the understanding of such claim terms as understood by a person of ordinary skill in the art. In general, the NYIPLA believes that higher quality patents will issue if USPTO Examiners focus on Section 112 concerns related to the clarity of the record. This is a point that should be emphasized in any USPTO Examiner training classes.

Clearly defining and making explicit in the record all terms used during prosecution will entail great effort and unnecessary expense by all parties – the Examiner, the USPTO and the applicant. During examination, an Examiner gives the claim terms and claims as a whole their broadest reasonable interpretation. Moreover, in many instances the terms in the claims have their plain and ordinary meaning, and the terms and language are chosen by the applicant because they best fit and describe the invention. To further explicitly define the terms chosen by

the applicant, which the Examiner has given the broadest, reasonable interpretation, would only serve to unnecessarily narrow the intended breadth and scope of the invention. Requiring explicit construction of terms not in contention may lead to an applicant unwittingly and unnecessarily narrowing the claims to less than they are entitled. Very specifically defining the scope of claim terms also may result in a patent covering less than that to which an applicant is entitled because after-arising technologies may not be properly covered by the claims. Importantly, inventors with less financial resources would most likely be disproportionately affected by requiring explicit claim construction of all terms used. For these reasons, the NYIPLA does not recommend explicit claim construction for all terms as it is unnecessary and may be detrimental to the patenting process.

In addition, the NYIPLA has concerns regarding the USPTO proposal to clearly define in the record the meaning of functional claim language as it relates to means-plus-function elements. If applicants have to define all of the means-plus-function elements very specifically, then applicants might find it better not to use functional claiming at all. In addition, as stated above, very specifically defining the scope of claim terms may result in a patent covering less than that to which an applicant is entitled because after-arising technologies may not be properly covered by the claims.

The USPTO also proposes that further detail be included in connection with interviews and other conferences, including specifically “identifying which arguments presented in the interview overcome individual rejections in the record.” The NYIPLA does not believe the interview summary needs to include significant detail about the scope of the interview and what, for example, arguments overcome rejections in the record. We note that the interview is an opportunity for the Examiner and applicant to have an open exchange of ideas with respect to the

scope of the invention in light of the prior art and it would be too burdensome to try to encapsulate all the different variables considered during such an interview. In addition, it has been our experience that Examiners will not admit during an interview that a certain claim amendment will overcome a rejection in an office action as the Examiner always has to conduct a further search and review of the amended claims after they are formally submitted in a response so such a USPTO requirement would not be beneficial.

The USPTO also requested feedback with respect to requiring a more detailed summary of the reasons for allowance. The NYIPLA believes “for clarity of the record,” there should be *some* record at the end of the examination, e.g., at the end of several years of patent prosecution and exchange of information between the applicant and the Examiner, that provides the public with at least one reason why the patent application was allowed and the closest prior art considered with respect to the allowed claims. It appears to be illogical that if a member of the public asked why a patent was granted, that they are told to review difficult to read claims and to consider quite possibly several hundred or more than a thousand pages of papers in the file history to determine why a patent was granted. However, we note that the NYIPLA members include a diverse group of practitioners, many of which believe that no reasons for allowance should be included because the Examiner’s reasons can be simply wrong or otherwise misleading as they can lead one to believe that the stated reason is the *only* reason the claims are allowable. There is also concern that providing but one reason for allowance, e.g. one difference between the prior art and the claimed invention, such as, a missing element, will improperly focus the Judge, competitors and public stakeholders on an elemental analysis instead of considering the “subject matter as a whole” as required. *See* 35 U.S.C. § 103. If such a proposal was adopted by the USPTO, the NYIPLA would recommend that the USPTO provide at least

one reason for allowance and the closest prior art. The USPTO should further note in such reasons that the reasons provided may not be the only reason and that the subject matter should be considered as a whole. Moreover, to the extent applicants disagreed with what the USPTO Examiner stated in the reasons for allowance, the applicant would be permitted, as they are currently allowed, to make a submission to the USPTO correcting the Examiner's statement or further clarifying the record.

C. Proposal 4, Under Pillar 2: Review of and Improvements to Quality Metrics

The fourth proposal seeks stakeholder guidance on the effectiveness of the current Quality Composite Metric and ways to improve it. The NYIPLA appreciates the USPTO efforts to measure quality and believes that such efforts are necessary. The NYIPLA also appreciates the complexity and difficulty of measuring the "quality" of patent examination. However, the NYIPLA notes that the composite metric may be beneficial for internal USPTO use but it is often confusing for practitioners.

D. Proposal 5, Under Pillar 3: Review of the Current Compact Prosecution Model and the Effect on Quality

Proposal 5 seeks assistance from the public on determining whether the current compact prosecution is effective. As discussed above, providing a second non-final office action without charging an additional fee would be of great benefit to applicants, and to patent quality, because it would allow for claims to be clarified after the first office action on the merits without immediately leading to cumbersome and inefficient after-final and RCE practice.

E. Proposal 6, Under Pillar 3: In-Person Interview Capability with All Examiners

It is the view of the NYIPLA that in-person interviews are important in certain cases. This should be possible for all applications. It is important that all applicants have equal

opportunity to avail themselves of an in-person interview and that the USPTO provide access to in-person interviews for all cases because selective availability, based on factors such as geographic location, would be unfair and prejudicial to applicants who did not have access to an in-person interview. The NYIPLA notes, however, that in-person interviews are quite often expensive and not always possible for logistical reasons so quite often interviews are conducted by telephone, and more applicants are utilizing the video conference interview capabilities that the USPTO has enhanced in the past couple of years.

3. Conclusion

Thank you for giving the NYIPLA the opportunity to provide feedback on patent quality initiatives. We look forward to providing the USPTO with additional feedback in the future on patent quality and other matters.

Respectfully submitted,

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