

**From:** Pomper, Brian [email redacted]  
**Sent:** Wednesday, May 06, 2015 2:38 PM  
**To:** WorldClassPatentQuality  
**Subject:** Response to the Request for Comments on Enhancing Patent Quality

Please find attached the submission of the Innovation Alliance in response to the Request for Comments on Enhancing Patent Quality, 80 Fed. Reg. 6475 (February 5, 2015). Many thanks.

**Brian Pomper**

**AKIN GUMP STRAUSS HAUER & FELD LLP**

1333 New Hampshire Avenue, N.W. | Washington, DC 20036-1564 | USA | Direct: +1 202.887.4134 | Internal: 24134  
Fax: +1 202.887.4288 | [email redacted] | akingump.com | Bio

---

The information contained in this e-mail message is intended only for the personal and confidential use of the recipient(s) named above. If you have received this communication in error, please notify us immediately by e-mail, and delete the original message.



May 6, 2015

The Honorable Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Via email: [WorldClassPatentQuality\[at\]uspto.gov](mailto:WorldClassPatentQuality[at]uspto.gov)

**Re: Response to the Request for Comments on Enhancing Patent Quality,  
80 Fed. Reg. 6475 (February 5, 2015)**

Dear Under Secretary Lee:

The Innovation Alliance (IA) is a coalition of research and development-focused companies that believe in the critical importance of a strong patent system that supports innovative enterprises of all sizes. Our members make frequent and great use of the United States Patent and Trademark Office (USPTO) and, as a result of the strong patent protections offered by the United States patent system, employ thousands of persons in the United States. IA appreciates the opportunity to submit comments on the United States Patent and Trademark Office's "Request for Comments on Enhancing Patent Quality" published in the February 5, 2015, Federal Register, 80 Fed. Reg. 6475 ("Request").

The Request seeks comments on six broadly defined proposals organized under three pillars of patent quality, namely, (1) excellence in work product, (2) excellence in measuring patent quality, and (3) excellence in customer service.

IA applauds the USPTO's efforts in soliciting input on enhancing patent quality and is pleased to submit the following comments and observations.

**Pillar I – Excellence in Work Product**

Proposal      Applicant-Requested      Applications

Presently, the Office of Patent Quality Assurance (OPQA) is the only party able to initiate a quality review of a patent application. This first proposal would permit an

Applicant to request OPQA review. According to one potential aspect of the proposal, the OPQA would then randomly select for review a subset of the applications in which such a request was submitted.

IA believes that this proposal has potential merit and warrants further consideration. IA believes that significant thought should be given to whether an Applicant should be (i) prohibited from, (ii) permitted to, or (iii) required to identify one or more specific issues that form the basis for the request. Assuming that grounds for the request are permitted or required, then not only could this proposal potentially assist in the quicker resolution of particular cases, but it also can be used by the USPTO to identify "problem areas", be they specific areas of substantive law or procedure where Applicants and/or the Examiners are having difficulties or specific segments of the examining corps (Technology Centers, Art Units, individual Examiners, etc.) that are having particular difficulties in specific substantive or procedural topics (as evidenced by above average numbers of Applicant requests for OPQA review relating to those topics).

The USPTO could then target topics for which it could create enhanced guidelines or select segments of the examining corps for enhanced training programs.

Significant issues that would need to be addressed in any further consideration of this proposal are whether the fact that an Applicant requested OPQA review or the fact that OPQA review was, in fact, conducted will be made part of the public record. There are at least two significant concerns with making the requests or reviews part of the public record. First, if an Applicant's request for OPQA review were to be made part of the public record, there could be a risk that it could later be used as a form of file history estoppel (FHE) to unfairly suggest that the Applicant believed the examination of the application was subpar. This is particularly concerning if the Applicant identifies the issue(s) that caused the Applicant to request OPQA review. Applicants perceiving that a request for OPQA review comes with a high risk of unfair FHE are not likely to use the process, thereby defeating its purpose. It is also possible that Applicants may perceive the risk of unfair FHE to be present for only certain types of issues. In that case, Applicants likely will avoid using the process in connection with those types of issues, thereby skewing any statistical data with regard to identifying problem areas.

Conversely, there is a possibility that public record of an OPQA review could later be used as an indication of enhanced quality of such patents. If so, it should be considered whether that is a desirable or undesirable effect.

A second significant concern is whether the fact that an Applicant requested OPQA review should be made known to the Examiner or Supervisory Patent Examiner (SPE). Several stakeholders at the Patent Quality Summit held on March 25-26, 2015 (Summit) mentioned the potential reluctance among practitioners to use the process if it would be known by the Examiner that the Applicant had requested OPQA review. The primary concern in this regard was the possibility that it could damage the relationship between the Examiner and the Applicant or practitioner.

## Proposal 2 – Automated Pre-Examination Search

Presently, Examiners can request an automated pre-examination search. This second proposal seeks public input on new technological tools that the USPTO may be able to employ to provide better automated pre-examination searches.

IA supports efforts to provide superior searching functionality to Examiners, and believes that identifying the most relevant prior art at the earliest stages of examination will lead to both improved patent quality and greater efficiency in the patent prosecution process. While IA is not in a position to suggest specific research products or technologies for the USPTO to consider, we suggest that care be given in selecting technologies and products that, in addition to being effective in identifying relevant prior art, meet at least the following criteria. First, the pre-examination search tool(s) should be unbiased in the sense that they should be uniformly utilized and applied equally across all technological fields. Second, they should not be sponsored, created, or sold by any party with an actual or potential conflict of interest.

## Proposal 3 – Clarity of the record

The USPTO is seeking comments on procedures to improve the clarity and completeness of the record, and has proposed three specific ideas for discussion, namely, (1) making claim construction explicit in the record, (2) providing greater detail in the recordation of Examiner interviews, and (3) providing a more detailed statement of reasons for allowance when such reasons are appropriate.

### (a) Making Claim Construction Explicit in the Record

IA opposes mandating explicit claim construction in the record. Rather than enhancing clarity of the record, requiring explicit claim construction (beyond that which is already typically inherently performed under the current system) has the potential to actually decrease clarity, increase the burdens on Examiners and practitioners, increase prosecution costs, and delay the issuance of patents.

The goal of providing a clearer record would be better served by improving examining corps training to make the current protocol more effective, as opposed to any fundamental change in the manner in which claim terms are addressed during prosecution. Many Examiners are highly skilled in expressly identifying claim terms whose meaning might require clarification and alerting the Applicant to the issue early during prosecution (e.g., in the first office action). However, some are less skilled and could benefit from enhanced training. The key to increased clarity of the record is efficiency and clarity in identifying and resolving the important claim issues during prosecution, rather than adding requirements on Examiners. The focus should be on creating a better file history, not necessarily more file history, as adding words in the absence of better reasoning and clearer articulation of that reasoning is likely counterproductive.

Currently, claim terms that require construction generally are identified and clarified through the normal process in which the Examiner and practitioner debate the meaning of the claims, the prior art, and their interrelationship in determining which claims are patentable and which are not. Such discussions almost always focus on a small number of the most important claim terms. Any dispute as to the meaning of a claim term is discussed and resolved, just like disputes about what is disclosed by a prior art reference. Thus, to the extent that the meaning of a claim term is in dispute, the current regime already should effectively result in an express understanding of the disputed term.

Requiring explicit construction of claim terms beyond that already naturally performed under the current regime would be counterproductive insofar as it would add time, expense, and effort with no intrinsic benefit and, in fact, significant potential for detriment, as discussed in more detail below.

It is not practical for Examiners to provide an explicit construction for all claim terms. See *In Re Jung*, 637 F.3d 1356 (Fed. Cir 2011) (“There has never been a requirement for an Examiner to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed invention in order to make out a prima facie rejection. This court declines to make such a burdensome and unnecessary requirement.”). Hence, a practical protocol would need to be employed to identify those claim terms that will be explicitly construed. However, it is difficult to see how any workable regime for identifying those claim terms would differ significantly from the current protocol.

Another problem with requiring explicit claim construction beyond the current process is that it is just as likely (if not more likely) to reduce rather than increase clarity. Because of the limited time available to Examiners for each application, it is likely that explicit claim construction would often be done hastily, especially for terms that do not appear at the time to be significant (but which may become very important later). Thus, not only will mandatory claim construction take away valuable time from the Examiners for performing other more important tasks, but hastily construed claim terms are highly likely to result in reduced, rather than increased, clarity. Specifically, there can be little doubt that, after issuance, parties will argue over the words in the prosecution history that inform the construction of claim terms just as vociferously as they would the actual claim terms. Defining terms of indeterminable significance at the time of prosecution (especially if done hastily) will often be counterproductive and could create additional file history (the significance of which will be highly debatable later) that will often be useless, confusing, or even misleading. Hence, regardless of how well such claim construction is performed, it will likely create an enormous amount of additional work, not only for Examiners during prosecution (as Examiners and Applicants spend additional time debating terms of unknown significance), but also for the general public after issuance (as they debate the meanings of the words in the claims as well as the words in the prosecution history meant to explain the words in the claims) with no intrinsic increase in clarity.

Perhaps most significantly, even under the best-case scenario, many practical factors dictate against any likelihood that explicit claim construction during prosecution would lead to enhanced patent clarity post issuance. For instance, the terms that require construction post-issuance will often be different than those construed during prosecution. It is common that the claim terms that need to be construed post-issuance (e.g., in litigation) are dictated in large part by the accused product, which typically is not known during prosecution. Thus, there is little guarantee that the claim terms selected for construction during prosecution would be the same claim terms requiring construction post issuance.

Moreover, the basic premise that claim construction performed in the USPTO would lead to greater clarity of issued patents could only possibly be the case if claims construed by Examiners would be equivalently construed by the courts. This is not the case for at least two reasons. First, courts use a different interpretation standard than the PTO, i.e., “plain and ordinary meaning to a person of skill in the art”, as opposed to broadest reasonable interpretation (BRI). Thus, the BRI analysis conducted by Examiners often has limited, if any, relevance in court. Second, courts need not give deference to Examiners’ conclusions in the first instance.

IA submits that improving clarity of the record would be better served by efforts that focus on enhanced Examiner training within the current regime to encourage creation of a prosecution history that reflects the examination process for any given application, rather than mandating explicit claim construction in the record.

#### (b) Recording of Examiner Interviews

At the Summit, there was significant resistance expressed against creating exact records or making electronic recordings of Examiner interviews. Particularly, the predominant view was that stakeholders believed that both Examiners and Applicants would be reluctant to be recorded or have a complete record of interviews. IA shares this view.

Thus, exact recording of Examiner interviews is not advisable as it will likely reduce the number of interviews being conducted, which will likely make prosecution even more difficult to conduct efficiently. Examiner interviews are an extremely beneficial mechanism of the prosecution process and are often necessary to advance the prosecution. Accordingly, they should continue to be encouraged and used extensively. Also, in what are often very complicated and technical discussions, there is substantial benefit to having an opportunity for an Examiner and Applicant to speak freely without having to craft every word meticulously to avoid the potential creation of unfair or misleading FHE.

Rather than exact recording of Examiner interviews, the Examiner and Applicant should be encouraged to collectively prepare a summary of the interview at the end of

the interview. If agreement cannot be reached, then each could write up their own summary.

### (c) More Detailed Reasons for Allowance

As stated in the rules, reasons for allowance should rarely be necessary and should be provided only if the Examiner believes that “the record as a whole does not make clear the reasons for allowing a claim or claims”. 37 CFR 1.104(e). As stated in the MPEP, “In most cases, the Examiner’s actions and the Applicant’s replies make evident the reasons for allowance satisfying the ‘record as a whole’ proviso of the rule”. MPEP §1302.14

The above-stated proviso should be adhered to strictly insofar as trying to summarize in a few sentences a prosecution history that two (or more) highly trained professionals have developed over years could be highly counterproductive with regard to clarity. Rather, it may be more productive to focus on training to better assure development of a prosecution history that make reasons for allowance unnecessary in the first instance.

## **Pillar II-Excellence in Measuring Patent Quality**

### Proposal 4-Improvements to Quality Metrics

With this proposal, the USPTO is seeking views on the effectiveness of the current composite Quality Metric and thoughts on how it might be improved.

IA generally supports the development of metrics that truly measure the quality of the work product of the examining corps, and particularly the final product (i.e., an issued patent). Hence, any quality metric should have a direct correlation to the quality of the work product as opposed to merely measuring productivity (volume of output) or adherence to process (following procedures). Obviously, both productivity and process are important and should be tracked for other purposes, but should not be confused or conflated with quality.

In addition, any measurement criterion is likely to encourage behaviors that increase scores under the metric, including ways of increasing scores that do not necessarily or directly increase the desired quality supposedly being measured. Accordingly, care must be taken in developing or fine-tuning any quality measurement metric to encourage desirable examination behaviors that lead to enhanced work product quality and minimize any side effect of encouraging behaviors that are designed to generate good scores, but do not actually lead to better work product quality.

## **Pillar III – Excellence in Customer Service**

### Proposal 5 – Review of Current Compact Prosecution

The current compact prosecution model provides only one non-final office action before requiring the filing of a Request for Continued Examination (RCE) or an appeal. The USPTO is seeking alternatives to current RCE and appeal practice to encourage communication between Applicants and Examiners. The USPTO specifically seeks comments on the idea of paying for an extra non-final office action.

IA supports the proposal of providing an option for an Applicant to pay for an extra non-final Office Action. Practice over the past few decades illustrates that the current compact prosecution model of providing only one non-final office action is insufficient to conclude prosecution in many (and perhaps most) cases across multiple diverse art units. Therefore, a model based on a premise that it is sufficient in all cases merits reevaluation.

Developing meaningful changes to the current compact prosecution model is a sizeable task that will require substantial further effort and the USPTO is only at the earliest stages of such a task. IA encourages the USPTO to give fair consideration to a broad range of concepts for revising the compact prosecution model, including those (i) expressed at the Summit, (ii) provided in the comments submitted in response to the Request, and (iii) otherwise received by the USPTO. Without endorsing any of those other ideas, some of the ideas discussed at the Summit that seem worthy of consideration included (1) eliminating final office actions altogether (e.g., pay as you go – pay per office action) and (2) providing two non-final office actions and a final office action per application before requiring RCE or appeal.

Finally, the current practice in connection with RCEs that allows some applications to wait for upwards of a year after the filing of an RCE before being picked up again by an Examiner should be reevaluated. This practice is immensely counterproductive to the goals of (i) producing high quality patents and (ii) efficiently conducting the business of the USPTO. Particularly, once an Examiner is familiar with an application, all reasonable efforts should be made to prevent the application from lingering untouched while fading from the Examiner's memory. The loss of current knowledge of the nuances of the prosecution of an application that is inherent in such delay is extremely detrimental to the efficiency of the USPTO.

### Proposal 6 – In-Person Interview Capability with All Examiners

Currently, in-person interviews are held only at the patent offices. The USPTO is seeking comments on the idea of providing means for conducting off-site, in-person interviewing with Examiners (specifically proposing the idea of using public libraries that are patent repositories as interview sites).

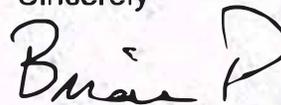
This proposal is worth further consideration. However, as with some of the other proposals, the logistics of offering off-site interviews that would need to be addressed are numerous and significant and the USPTO is only at the earliest stages of consideration. Accordingly, IA fully supports the USPTO's efforts to provide this option to Applicants and, without endorsing any specific procedure, notes the following issues that would need to be adequately addressed in any such program. First, there would need to be strong assurances of confidentiality since the subject matter of patent applications and interviews often is highly confidential. Second, there would need to be strong assurances of Examiner safety when off-site. Both of these concerns may be difficult to adequately address in patent repository public libraries or any facility lacking guarded entry, metal detectors and the like.

Third, there may be significant costs and inconveniences associated with Examiner travel to off-site locations for interviews. It will be necessary to determine how those costs will be controlled, who will bear those costs, and how the allocation of costs will affect the likelihood of stakeholders actually electing to use off-site interviewing. Fourth, it will be necessary to determine what facilities and equipment are necessary to effectively conduct interviews and how will they be provided and maintained. Such facilities and equipment may include internet access, printers, computers, large screen monitors, whiteboards, and sufficiently private, secure, and large rooms to accommodate models, exhibits, etc.

## **Conclusion**

The Innovation Alliance applauds the USPTO's decision to focus on the goal of enhancing patent quality and its efforts to allow public participation at such an early stage in the development of a plan to accomplish that goal. Given the early stage and the general nature of the proposals at this point, our comments also are commensurately general, but we welcome the opportunity to continue participating in this effort as it moves from these early concept development stages into more advanced stages.

Sincerely



Brian Pomper  
Executive Director  
Innovation Alliance