

**From:** Greenberg, Robert A [email redacted]

**Sent:** Wednesday, May 06, 2015 6:05 PM

**To:** WorldClassPatentQuality

**Cc:** Chappell, Tina M

**Subject:** Re: Intel Response to Request for Comments on Enhancing Patent Quality [Docket No.: PTO-P-2014-0043]

May 6, 2015

The Honorable Margaret A. Focarino  
Commissioner for Patents  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22313

Michael T. Cygan  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22313

Dear Commissioner Focarino,

Attached please find Intel's response to the PTO Request for Comments on Enhancing Patent Quality.

If we can assist in any way, please let us know.

Sincerely,

Robert A. Greenberg  
Assistant Director of Patents  
Intel Corporation



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Submitted to: [WorldClassPatentQuality@uspto.gov](mailto:WorldClassPatentQuality@uspto.gov)

**Re: Intel Response to Request for Comments on Enhancing Patent Quality [Docket No.: PTO-P-2014-0043]**

Dear Commissioner Focarino:

Intel Corporation (Intel) submits this letter in response to the United States Patent and Trademark Office's (USPTO) request for comments on enhancing patent quality. *See* 80 Fed. Reg. 6475 (Feb. 5, 2015). We appreciate the opportunity to comment on these critical proposals.

Intel has a deep interest in patent quality. We invest more in Research and Development than nearly any other company in the world—more than \$10 billion annually. To protect this investment, Intel perennially appears on the lists of top U.S. Patent filers and U.S. Patent owners. At the same time, we have had our share of battles against patents of dubious validity and uncertain breadth. Intel urges the USPTO to continue its work strengthening patents through the patent examination process and, simultaneously, to prevent the issuance of more suspect patents.

We focus our comments below on three proposals dealing with automated pre-examination searches, record clarity, and quality-based examination metrics.

**I. Pillar 1/Proposal 2: Automated Pre-Examination Search**

The benefits of improving the quality of examination searches using modern search techniques seems undeniable, and we encourage the USPTO to improve search databases and tools. We suggest,

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however, that in doing so, the importance of references submitted to the USPTO in Information Disclosure Statements (IDSs) in its search results must not be overlooked. References listed in IDSs tend to be particularly germane. These references often include material that can form the basis of high quality obviousness rejections. Thus, we suggest that any search tool should rank references submitted to the USPTO in IDSs very highly. That is, IDS submitted references merit additional algorithmic weighting. While an improved search system will cast a better technological net at prior art, it should not come at the expense of close attention to the art submitted by Applicants.

## II. Pillar 1/Proposal 3: Clarity of the Record

Intel enthusiastically supports increasing the clarity of the patent record. At a time when many claims suffer from vagueness and unjustified “elasticity,” a complete and accurate file history can act as an important and reasonable restraint on “nose of wax” recitations. Intel also agrees that capturing the contents of interviews is vital to completing the patent record. In interviews, many representations of the art and claims are made, and many Examiner concerns and Applicant rebuttals are aired. Yet only a small fraction of these ever are recorded in the file history of the patent. Such omissions rob the public of clarity in the precise metes and bounds of the claim language and can permit claim interpretations in litigation that would be unwarranted if this unwritten communication came to light.

We suggest the requirements for documenting interviews should, at least, be bolstered beyond merely identifying the arguments that overcome a rejection, as proposed by the USPTO. Arguments that fail to overcome a rejection are of equal interest, just as an unpersuasive Office Action response forms an important part of a file history. Perhaps a recording system, like those of customer call centers, will one day record and store Examiner-Applicant interviews and ensure the full capture of the many representations made during an interview without undue burden on Examiners. Until then, Examiners and Applicants should both be required to detail all telephone discussion of claim term meanings, characterizations of prior art, and arguments advanced by the Applicant.

Likewise, we strongly support reinvigorating 35 U.S.C. § 112 as a way to improve the clarity of the patent record. Our patent system is currently infested with many vague and *indefinite* patents that enable and facilitate abusive litigation behaviors. Weak enforcement of § 112 is the root cause. Examiners must make and stand by § 112 rejections until the record has been sufficiently clarified. But a recent article<sup>1</sup> indicates that is rarely the case: §112 rejections are among the least appealed and the least affirmed by the Patent Trial and Appeal Board (PTAB). At a time when Intel and other manufacturers have been beset by litigation based on amorphous patent claims, this data suggests a systematic difficulty in vigorously and correctly applying §112 to patent claims.

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<sup>1</sup> Gaudry, Kate S., "Appeals and RCEs – the Frequency and Success of Challenges to Specific Rejection Types", *Intellectual Property Today*, Web, November 2011.

### III. Pillar 3/Proposal 5: Review of Current Compact Prosecution Model and the Effect on Quality

In reviewing the current Examiner count system, we noted the absence of any clear reward to Examiners for simply being right and standing by their convictions on appeal. We recommend providing counts to Examiners for having their rejections affirmed by the PTAB during examination. Many examination metrics focus on quantity rather than quality. To improve patent quality we need to increase quality-based metrics and rewards. Providing an affirmance incentive will reward Examiners for their investment in the quality of their examination and alleviate Examiner concern over time spent participating in the appeal process. While such a count would need to be calibrated to prevent the PTAB from being inundated with appeals, we believe the dispassionate analysis provided by the PTAB is both an important component of quality and an opportunity to provide Examiners with institutional recognition for their quality-focused efforts.

#### Conclusion

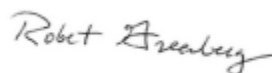
Intel is a data driven company. Data trumps anecdotes, despite the tempting appeal of the later. We laud the USPTO's attention to this principle in Pillar 2 and encourage the USPTO to make data-based evaluations for all quality proposals. For example, the USPTO proposes increasing in-person interview capabilities (Pillar 2/Proposal 4). Certainly, interviews can facilitate understanding between an Examiner and Applicant, but they also, at times, can be merely a mechanism for making critical, but unrecorded, arguments about claim scope—arguments that would restrain later litigation positions if they were only recorded and known. To determine whether increasing interviews would enhance quality, we recommend focusing on concrete data, such as whether cases with interviews have a higher rate of survival in Inter Parties Review. The aggregate USPTO examination data, the Inter Parties and Post Grant Review data, and the PTAB appeal statistics likely provide the best gauge to what enhances quality and what does not.

We commend the USPTO for seeking ways to improve patent quality and offer our continued assistance to the USPTO in support of these vital efforts.

Sincerely,



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Associate General Counsel  
Director of Intellectual Property Policy  
Intel Corporation



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