

Response to request for comments on Patent Quality Enhancement, 37 CFR Part 1, Federal Register Number 2015-02398.

I am writing in response to the USPTO's request for comments on Patent Quality Enhancements, particularly Proposal 1 under pillar 1: *Applicant Requests for Prosecution Review of Selected Applications* and Proposal 5 under pillar 3: *Review of the Current Compact Prosecution Model and the Effect on Quality*. In looking over the USPTO's proposals for improving patent quality there came to me two suggestions I would like to submit.

As to proposal 1, the proposal as stated is for "a mechanism for an applicant to request OPQA prosecution review of a particular application where the applicant believes that the application contains an issue that would benefit from further review." I would suggest that the USPTO should expand this to include third-parties. By this I mean allow for third-parties to request review of a particular application when that third party believes that the application contains an issue that would benefit from further review. This would allow third parties to raise concerns that fall outside of the realm of anticipation or obviousness which is already provided for 35 USC 122(e).¹ This includes questions raised regarding patent eligible subject matter under 35 USC 101 and in particular the judicial exceptions, which have seen a substantial increase in use following the Supreme Court case of *Alice Corp. v. CLS Bank*.² By allowing third parties to bringing these kinds of request there is a potential to cut back on the number of post-grant review or reexamination requests either by preventing the issuance of patents that should not be issued, or dissuading third parties from pursuing claims already considered twice.

I believe that such a proposal will better meet the USPTO's goals of excellence in work product as third-parties seem even more likely to request such reviews than the applicants themselves. There may even be a potential that random selection of applications for OPQA prosecution review would no longer be required if enough requests were filed. However, such a proposal carries with it the risk of gamesmanship by competitors who see no real issue but simply wish to delay issuance. Therefore, I would further suggest that the ability to request review by third parties be limited by charging a fee. In addition I would suggest requiring third parties to file formal statements specifically setting out what issues the application contains that merit further review.³ Finally I must admit my own uncertainty as to whether this suggestion would constitute a protest or opposition as prohibited under 35 USC 122(d), though I believe that it does not.⁴

As to proposal 5, the proposal in essence is for a means of modifying the current compact patent prosecution model. The USPTO has seemed to indicate at least a willingness to consider

¹ 35 USC 122(e), which concerns third party submissions of prior art, could however provide the basic framework for implementing this suggestion with regard to time of filing, fee, and additional filings required.

² A brief survey of which can be found online. Robert R. Sachs, A Survey Of Patent Invalidations Since Alice, Law360 (January 13, 2015, 10:25 AM), <http://www.law360.com/articles/604235/a-survey-of-patent-invalidations-since-alice>

³ Such a requirement would function much like 35 USC 122(e)(2)(A). With the inclusion of language similar to 35 USC 122(e)(2)(C) frivolous request could further be dissuaded or possibly even sanctioned.

⁴ This is based primarily on the idea that such a request for review does not denote a desire that the patent not be issued but rather that the issuance be free of potential defects. A third party interested in licensing a patent currently under application for instance may want greater assurance that it will survive challenge after issuance.

elimination of the current model, specifically eliminating final office actions.⁵ This view appears to be the ideal solution for at least some. Some commenters would suggest taking this even farther to include increasing the number of opportunities to amend claims or introduce new evidence among other changes in addition to eliminating final office actions.⁶ I would not suggest to go so far as that.

Instead, I suggest allowing a patent applicant to file for a “second opinion” letter from the patent examiners office following the first non-final Office action. This would basically entail a second patent examiner receiving the same application and returning what was in substance identical to non-final Office action but did not function as one. The patent applicant would thus receive one formal non-final Office action and one informal second opinion letter. The applicant would be required to include the second opinion letter in the response to the formal non-final Office action and thus would be advised, but not required, to respond to the second opinion letter as if it were a formal office action. Further, to the extent that the second opinion letter differs from the formal non-final Office action, say by having a slightly different understanding of the patent or providing different prior art, the applicant could employ the second opinion letter to develop the response and ensure that all of the potential issues with the patent are found.

Alternatively, the second opinion letter could be issued concurrently with the formal non-final Office action. Here the patent application would, upon request, be reviewed by multiple examiners from the beginning with one being designated the primary and the others being secondary. The secondary examiners would state their findings in an informal office action as before which would be read by the primary and used to help him create the formal non-final Office action which would then go to the applicant.

Under either scheme there is designated a primary examiner, either the examiner who first receives the patent in the first scheme or the one who is so designated under the second scheme. The primary patent examiner is the one who ultimately produces the formal non-final Office action. In other words, a patent applicant would not be able to forum shop between examiners, even though he is essentially requesting examination from multiple different examiners. The primary examiner could dismiss the second opinion letter, in part or in its entirety, and the second opinion letter would have no legally binding effect save for what parts the primary examiner chooses to adopt into the formal non-final Office action. However, having the second opinion letter would undoubtedly help the patent examiner to make his final decision and would also prove useful to the applicant in making his arguments in his response. Also the primary examiner would be the one who maintained communication with the applicant and who would be solely responsible for receiving the applicant’s response and producing the final office action. The secondary examiners would only have to produce one non-final Office action type document and then be done with the patent. Thus, this would not create a significant burden on the system as it currently exists.

The purpose of this method would be to create as many opportunities as possible for ferreting out potential patentability issues. A single examiner might fail to catch all the issues, even if

⁵ As seen in the Proposal 5 Brainstorming Questions. Patent Quality Summit, <http://www.uspto.gov/patent/initiatives/patent-quality-summit> (last visited Apr 8, 2015).

⁶ Such an argument may be considered here. Courtenay C. Brinckerhoff, *Compact Prosecution 2.0 -- Changing The U.S. Patent Examination Paradigm*, PharmaPatents. (September 25, 2013) <http://www.pharmapatentsblog.com/2013/09/25/compact-prosecution-2/>

they did have the opportunity for multiple examinations. Having multiple examiners looking over the same application however allows for a better chance of spotting potential flaws. Further, different examiners might have slightly different understandings of the nature of the invention and thus approach the search for prior art differently. This would have the effect of increasing the likelihood that the best prior art will be brought before the patent examiner faster. Finally, there is always going to be some conflict between a patent applicant and the examiner on what the invention really is. This method would allow for a higher likelihood that one of the examiners is of one mind with the applicant over the actual nature of the invention.

For the reasons I have outlined above I believe that this might help the USPTO achieve its goals of increasing the quality of the communication between applicant and examiner during prosecution and focus prosecution on resolution of any and all patentability issues thus improving the quality of patents that do issue. There are several more considerations that I would like to briefly address. First, this suggestion leaves open the number of second opinion letters that might be garnered. Obviously limiting this in some way would be necessary. I would suggest a fee schedule that increases with the number of second opinion letters requested until an eventual cap is hit. Second, the primary benefit from this system comes from the use of different sets of eyes looking over the same material, this would be somewhat lost if the different examiners communicated with each other or otherwise influenced each other's decision prior to making their own conclusions. Thus, each second opinion letter would have to be created by an examiner who was not in communication with the primary examiner.

I hope these suggestions may be of some benefit to the USPTO. Thank you for your consideration.

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