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Sent: Wednesday, May 06, 2015 1:01 PM
To: WorldClassPatentQuality
Cc: Gaudry, Kate; Gianola, Adam; Franklin, Thomas; Lezak, Angel; Almon, Rich
Subject: Patent-Quality Comment: Clarity of Record

To Whom It May Concern:

Thank you for accepting comments as part of your Quality Initiative. Please see the attached comment. This particular comment corresponds to Proposal 3: Clarity of Record. Please let me know if you have any questions.

Best,
Matt Kitces



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Comments for Submission

United States Patent and Trademark Office

Enhanced Patent Quality Initiative

Submitted to: WorldClassPatentQuality[at]uspto.gov

May 6, 2015

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Regarding USPTO Proposal 3: Clarity of Record

An efficient and effective examination process is critical to obtaining enhanced patent quality in the United States Patent and Trademark Office (USPTO). Clarity of the record is necessary to ensure everyone involved, including Examiners, Applicants, Applicants' Representatives, and anyone else providing substantive review or analysis of an application all understand the status of the application under examination and the rationale of one another. Whether or not there is agreement, without a clear, collective understanding of one another's rationale, it is extremely difficult to overcome an impasse or to accurately assess arguments, remarks, amendments, and the like.

Since the USPTO is tasked with examining and making substantive decisions regarding applications, it is crucial that clear and informing communication be integral to all substantive PTO decisions. Several small changes to improve clarity of the record can drastically improve examination effectiveness and efficiency.

Proposal: Written Summary with Rationale Should Accompany All Substantive PTO Decisions

As part of ensuring clarity of the record, it is imperative that when a patent office makes a decision on an application, it do so with transparency. Any substantive reviews performed by any patent office Examiners, panel members, or other individuals should be accompanied by a clear written summary of the review. At the very least, brief rationales should accompany any decisions made.

For example, currently, when an application is reviewed under the Pre-Appeal Brief Conference (PABC) Pilot Program, the record only shows that such a conference occurred, who participated in the conference, and whether the application will remain under appeal. Currently, there is no rationale or explanation given. It would be very helpful to Applicants and Applicants' Representatives to obtain a clear understanding as to why the panel members of the PABC came to their particular decision. Armed with the rationale behind the decision, Applicants and Applicants' Representatives can better assess how to proceed efficiently and effectively, which may include addressing concerns raised by the PABC panel members or opting to not file an appeal brief. Right now, the PABC decision provides extremely little substantive information, yet serves as the only record of a substantial, substantive review of the application.

Additionally, the USPTO from time to time reviews Examiners' decisions or other aspects of an application by non-disclosed panels or individuals. These "secret" reviews can have a substantive impact on the application and its examination, but are often not recorded on the public record. For example, the use of the Sensitive Application Warning System (SAWS) (now-discontinued), the 101 Panel, and Quality Assurance Specialists involved or currently involve substantive review of an application, but no record of these proceedings was or is provided. In order to ensure clarity of the record, and thus efficient, transparent, and effective examination, the USPTO must provide some record of each substantive decision made regarding an application. At the very least, the record should reflect that the application was reviewed pursuant to a certain program (e.g., the 101 Panel). Even better, the record should show who reviewed the application, what was reviewed, what decision was reached, and the rationale for the decision.

Additionally, these types of decision summaries can include a section to identify the relevant type of issue discussed. For example, in a Pre-Appeal Brief Conference decision, the summary can indicate that the panel agreed with a §101 issue, but did not agree with a §103 issue. This type of granular information can be leveraged to track Examiner and Art Unit quality with regards to individual issues. Additionally, this type of information can inform the public of the prevalence of certain issues and can inform Applicants and Representatives as to what issues generally share agreement amongst panel members.

This clarity of record that comes from a written summary with rationale accompanying all PTO decisions will help Applicants, Applicants' Representatives, and Examiners interact more efficiently and effectively on an application-by-application basis. Additionally, the data from these decision summaries can be used to assess Examiner quality (e.g., an Examiner who has been overturned by many PABC panels may need additional training). Finally, the overall impact of these types of records becoming available to the public will increase the efficiency, transparency, and effectiveness of the patent system as a whole, as more people will be aware of and will understand these substantive decisions made before applications are drafted and filed.

Proposal: Completeness of Office Actions

On numerous occasions, we have witnessed or become aware of incomplete Office Actions that have been issued by the USPTO. These incomplete Office Actions may be incomplete because they do not address all pending claims, they include form paragraphs that are not filled-in, or for other similar reasons.

For example, the following text was extracted from a recently-issued Office Action:

an abstract idea. The claim(s) is/are directed to the abstract idea of [1]. The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: [2]. Viewed as a whole, these additional claim element(s)

As is evident, incomplete Office Actions drastically reduce the clarity of the record and cause problems that can delay the prosecution process.

We propose that a system be put in place to ensure that all Office Actions are complete before being issued. If possible, an automated system that would scan the text of an Office Action to see if any claims have not been addressed and to ensure all form paragraphs are filled-in. Alternatively or in addition to an automated system, we propose that a periodic human review be conducted on random Office Actions, possibly before they issue, solely for the purpose of ensuring their completeness. Since the amount of time necessary to review an office action just for completeness (and not substance) would be relatively short, such reviews can occur on a more regular basis.

Completeness does not necessarily include that all substantive rejections are fully-formed (e.g., that all elements of a *prima facie* rejection are made), although that would be preferable.

Proposal: Applicants should be Notified upon Change in Examiner

During the pendency of an application, it is not unusual for a particular Examiner assigned to the application to leave the USPTO for one reason or another. Whenever a new Examiner is assigned to an application, it is not unusual for the Applicants to not find out until an Office Action or other substantive communication is issued. We propose that, whenever a new Examiner is assigned to an application, a notice be sent out in the case, such as a “Notice of Examiner Assignment.” Such a notice can be similar to a notice of acceptance of power of attorney or other short notice. By providing this notice, Applicants can remain apprised to changes in the individual responsible for examining the application.

For example, if a new Examiner is assigned to a case after Applicants have filed a response to a Non-Final Office Action, Applicants might not know that the new Examiner has been assigned until after the new Examiner issues a Final Office Action. If, however, the Applicant has received a “Notice of Examiner Assignment,” the Applicant has an opportunity to reach out to the new Examiner and set up an interview to explain the invention and catch the Examiner up to speed.

In another example, providing a “Notice of Examiner Assignment” can be helpful during an appeal process, which can take numerous years. If the appeal was requested due to an impasse between the Examiner and Applicant, such an impasse may no longer exist between the new Examiner and Applicant, who may be able to work together to find allowable subject matter. When a Notice of Examiner Assignment is received, an Applicant in such an appeal process could contact the Examiner to discuss the case and determine whether to voluntarily take the case out of appeal.

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