

From: Tomas Prieto [email redacted]
Sent: Wednesday, May 20, 2015 7:03 PM
To: WorldClassPatentQuality
Cc: Robert Fish
Subject: Comments on Enhancing Patent Quality Initiative

Dear Sir/Madam,

Attached please find a PDF containing comments on the Enhanced Patent Quality Initiative, by Robert Fish and Tomas Prieto. A copy of the comments is also included within the body of this email, below.

Thank you,
Tomas A. Prieto

COMMENTS ON THE ENHANCED PATENT QUALITY INITIATIVE

Robert Fish and Tomas Prieto

We are grateful for the opportunity to respond to the request by the USPTO for comments regarding the USPTO's Enhanced Patent Quality Initiative. The following are some comments and suggestions regarding various aspects of prosecution practice with the goal to increase the quality of the examination process both in terms of the quality of patents issued and the quality of the interactions between the Examiner and the Applicant. The opinions and suggestions contained herein are those of Robert Fish and Tomas Prieto, and do not represent the views or opinions of any organization with which the individuals may be associated.

I. Further Refine and Formalize the Requirements for "Valid" Complete Office Action

A common complaint about the current examination practice is that the quality of examination is inconsistent across the Examiner corps. Part of this inconsistency arises from a lack of precision in the requirements for a valid rejection and a lack of enforcement of the existing requirements for a *prima facie* rejection and for other aspects of the Examination process. One anecdotal example is with regard to prior art rejections where the citations to the references are broad and lack precision as to how the Examiner is applying the reference (such as, which element within a reference is asserted as being taught for a particular element in a claim). This is especially prevalent in the computer- and business methods technologies where references are often very lengthy and the terminology used can be very generic. Other examples include the lack of clarity with regard to 101 rejections following *Alice*, where the rationale has not been clearly articulated regarding the determination of the abstract idea.

Another factor that contributes to the inconsistency in examination and also to a lack of clarity in the record is that Examiners are overly reliant on the form paragraphs without properly applying the form paragraphs or understanding *why* the form paragraph is applicable. Consequently, the Examiners miss applying additional reasoning or explanation in situations where it is required or at least advisable. An example of this is in response to arguments, where the rejection cites a new reference in an obviousness rejection but still uses references previously used in the prior rejection to which an Applicant has presented arguments. In these situations, Examiners have simply used the form paragraph that the arguments are "moot because the arguments do not apply to any of the references being used in the

current rejection” (form paragraph 7.38) and not responded to those arguments that are applicable to references still being used.

In theory, an existing recourse is appeal. In practice, appeal is often not a realistic option because the deficiencies in a rejection may be in a first action stage, the cost and time for an appeal may not be justified or feasible for certain Applicants to fight improper rejections that, even if victorious, merely results in the PTAB effectively instructing the Examiner to do their job properly (and thus, the application is right back where it started).

Our recommendation to help address these issues is to further formalize the requirements of what has to be included in an Office action for it to be “complete”, and for incomplete Office actions to be grounds for subsequent non-final actions on the merit. Some examples include:

- For any factual assertions not explicitly mentioned as inherent, evidentiary support **must** be provided.
- For prior art rejections, required specificity for the assertion of and citation to references and sections of references to the claims and claim elements. For example, citations to specific elements in the cited reference as corresponding to claim elements rather than general citation to sections unless it is absolutely clear where the structural (or process, for method steps) correlation between the claim element and its counterpart in the citation exists.
 - Where combinations of references overlap, an indication of where each reference is not being asserted (or conversely, is cited as overlapping).
- For all rejections – clear identification of what **MUST** be included to constitute a *prima facie* rejection, such that the failure to meet the requirements is immediately evident upon reading the rejection.
- For response to arguments, listing Applicant’s arguments that are/are not applicable due to their being moot, and responding completely to those that remain valid.
- For advisory actions, requiring a response to arguments that are applicable to the rejection despite any amendments.

While the USPTO is constantly providing additional Examiner training, our suggestion is to provide additional training regarding the notice requirement of 35 USC 132 and what *prima facie* means on a practical level and what constitutes new grounds of rejection.

II. Abbreviated Appeal for “Final Issues To Be Resolved”

For certain applications that are after final, the USPTO could institute an abbreviated appeal process that allows for a speedier resolution of appeals where there is one single issue that is being appealed (i.e., only one rejection). This would encourage the Examiner and Applicant to resolve outstanding rejections as much as possible and save the appeal as a ‘last resort.’ A variation of this can be to have a program for abbreviated appeal where the Examiner and the Applicant each independently indicate that following the appeal, the prosecution of the application will not be reopened. In other words, the Examiner indicates that, but for the issue at appeal, the application is otherwise in condition for allowance. On the Applicant side, in exchange for a quick resolution to the outstanding issues provided by the abbreviated appeal, the Applicant agrees to abandoning the application if the Applicant does not prevail on appeal.

III. Confidential Feedback From Applicants, Reviewed by an Independent Group/Panel

The USPTO is making efforts in increasing the metrics through which the effectiveness and quality of an Examiner's work can be measured. However, there is only so much analysis that can be performed from production numbers and quantified data such as appeals, RCEs, Office actions per disposal, etc., because the numbers may not be an accurate reflection or representative of the Examiner's work quality. Thus, our recommendation is to allow for applicants to submit confidential feedback regarding an Examiner, with a certain degree of specificity to identify the reasons why the Applicant is providing positive or negative feedback for the Examiner or aspects of the Examiner's work. This feedback would be reviewed by a panel (such as a panel of SPEs or QASs) independent of the Examiner's Art Unit to avoid any potential subjectivity (positive or negative) on the part of the SPE or Primary that knows the Examiner to identify whether the feedback of the Examiner are indicative of any problems that may need to be addressed. For example, if an Examiner has a large amount of RCEs because it's common in a particular technology area, and the comments are generally positive or neutral, then it would not be indicative of a problem with the quality of the examination. However, if an Examiner has a large amount of RCEs (again, in a technology where it is common) but the comments from Applicants consistently indicate a particular complaint in the Examiner's work or methodology, then that would be something for the panel to investigate further (such as by review of the Office actions).

IV. Provide Additional Incentives To The Examiners That Perform High-Quality Work

Understanding that this may be a matter that is beyond the USPTO's ability to regulate (due to Federal employment structure and policies), one way to improve the patent quality is to simply remove the barriers that prevent exemplary Examiners from doing more work. Due to limits on earnings imposed by the wage schedule and the structure, exemplary Examiners that may be willing and able to take on more work are not incentivized to do so. Thus, the USPTO should provide avenues for those exemplary Examiners to exert their expertise in more cases if they are willing to do so, and thus contribute to reducing the backlog while providing high-quality examination.

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