

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**





# **TC 2600**

# **Customer Partnership Meeting**

John Barlow  
January 17, 2018

UNITED STATES  
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# The Office of the Commissioner for Patents



**Drew Hirschfeld** – Commissioner for Patents



**Andy Faile** – Deputy Commissioner for Patent Operations



**Jack Harvey** – Assistant Deputy Commissioner for Patent Operations



# Meet the TC 2600 Directors



John LeGuyader  
Director  
2610 | 2660



John Barlow  
Director  
2620 | 2690



Diego Gutierrez  
Director  
2630 | 2640 | 2670



Derris Banks  
Director  
2650 | 2680

**TC 2600**  
**Unique Issues**  
**Points of Contact**

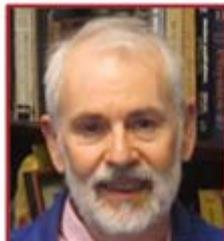
# Meet TC 2600 Quality Assurance Specialists (QAS)



Doris To



John Peng



Daniel Swerdlow



Michael Horabik



Wellington Chin



Kenneth Wieder

TC 2600's QAS provide advice and assistance in interpretation of rules, law and policy to the TC. In addition, our QAS shop review applications, host Quality Enhancement Meetings with assigned Work Groups, draft petition decisions, develop and present training and also coordinate signatory and master level reviews.

# Derivation Proceedings

A derivation proceeding is a trial proceeding conducted at the Board to determine whether

- (i) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application, and
- (ii) the earlier application claiming such invention was filed without authorization.

## PCT

International application filing / reports related to TC 2600.

## Interference

Though First to Invent Interference will eventually fade away, Mike is still the POC for older applications invoking Interference.

TC 2600 POC



Mike Horabik

571-272-3068

TC 2600 POC



Dan Swerdlow

571-272-7531

## 35 USC 101

- Abstract ideas

## 35 USC 112

- (a) Enablement, Written Description
- (b) Clarity, Indefiniteness
- (f) Invoking, Broadest Reasonable Interpretation

# MPEP / Policy Procedures

TC 2600 POC



Wellington Chin

571-272-3134

Two of our more senior staff, both having over 34 years of experience with the Office. They are very familiar with the Manual of Patent Examination Policy, Practice and Procedures therein.

TC 2600 POC



John Peng

571-272-7272

TC 2600 POC



Doris To

571-272-7629

## Pre-Appeal / Appeal / Petitions

For general purpose questions related to TC 2600 pre-appeal / appeal process, interfacing with the Patent Appeals Center or for general TC related petition questions.

# Accelerated Examination

Under the Accelerated Examination Program, an applicant may have an application granted accelerated examination status provided certain conditions are met.

## Prior Art Submissions

- Rule 290 Third Party Submissions
- Rule 291 Protests
- Rule 501 After Patent Grant

TC 2600 POC



Ken Wieder  
571-272-2986

# Technology Center 2600 Customer Partnership Meeting

TC 2600 Customer Partnership Meetings provide an opportunity to interface with Management and Examiners within the TC, learn more about how and why examiners make decisions they do, share ideas, experiences, and insights with attendees and management from TC 2600 in an effort to improve our working partnership.

TC 2600 POC



Catherine Perez  
571-270-7874



Dwayne Bost  
571-272-7023

# Ombudsman

TC 2600 POC



Rafael Perez-Gutierrez  
Art Unit 2642

571-272-7915

The Patents Ombudsman Program enhances the USPTO's ability to assist applicants or their representatives with issues that arise during patent application prosecution. More specifically, when there is a breakdown in the normal application process, including before and after prosecution, the Patents Ombudsman Program can assist in getting the application back on track.

## QPIDS (Quick Path IDS)

A quick path IDS is a method to allow applicant submissions of prior art after a Notice of allowance has been mailed.

# AFCP 2.0

The purpose of the pilot is to determine if a limited amount of additional time for consideration of after final responses will increase the number of applications that are allowed at that point in the prosecution. The program is intended to assist in achievement of our pendency reduction goals, encourage compact prosecution, and improve stakeholder satisfaction

## Post Prosecution Pilot (P3)

The Post-Prosecution Pilot (P3) Program, which is one of the evolving programs of Patent Quality, was developed to test its impact on enhancing patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal

TC 2600 POC



Will Boddie

571-272-0666

# TC Interview Specialist

TC 2600 POC



Claire Pappas

571-270-1051



Kamran Afshar

571-272-7796

Interview Specialists are subject matter experts in each Technology Center (TC) on interview practice and policy to assist both applicants and examiners in interviews, as needed, including facilitating interviews by assisting with technical issues which may arise (e.g. WebEx problems, public interview room setup) or helping to ensure that the interview goes smoothly

TC 2600 POC



Srilakshmi Kumar

571-272-7769



Mike Horabik

571-272-3068

# Technology Fair Team

TC 2600 POC



Greg Tryder

571-270-7365



Kim Vu

571-272-3859

- The Technology Fair Team routinely seeks assistance from technologists, scientists, engineers, and other expert: from industry and academia to participate as guest lecturers and provide technical training and expertise to patent examiners regarding the state of the art, prior art and industry practices/standards in areas of technologies where such lectures would be beneficial.
- Guest lecturers have the option of presenting a lecture in-person or virtually from their own location. In-person presentations can be made at our Alexandria, Virginia headquarters or at one of our regional offices in Dallas, Texas, Denver, Colorado, Detroit, Michigan and Silicon Valley, California. Training delivered at each location will be broadcast to patent examiners across the entire USPTO.
- Our next scheduled Technology Fair is March 12-13, 2018

TC 2600 POC



Wesley Kim

571-272-7867



Ernestine McCombs

571-272-3265

# Technology Fair Team



Wesley Kim

Wesley Kim heads up the Communications portion of the team, covering Work Groups  
2630 – Digital & Optical Communications;  
2640 – Analog Radio Telephone, Satellite, Transceivers, Bluetooth;  
2650 – Video & Telephonic Communications, Audio Signals, Digital Audio Data  
Processing, Linguistics, Speech Processing, Audio Compression;  
2680 -Telephony & Code Generation, vehicle & system alarms, Selective Communication,  
Dynamic storage



Greg Tryder

Greg Tryder heads up the Computer and Equipment portion of the team, covering  
Work Groups  
2610 – Computer Graphic Processing, 3D animation, Display Color  
Attribute, Object Processing;  
2620/90 – Selective Visual Display Systems  
2660 – Digital Cameras, Image Analysis, Pattern Recognition, Color  
& Compression,  
2670 – Facsimile, Printer, Color, Halftone, Scanner

# Technology Fair Team



Kim Vu

Kim Vu coordinates with Wesley and Greg and interfaces with our Regional Office Outreach personnel to find speakers that correspond with the topics of interest for all Work Groups, as well as coordinating presentation accommodation and hosts at the Regional Offices.



Ernestine McCombs

Ernestine McCombs is responsible for all logistics including, Conference Services, WebEx, Audio/Visual Support, Security notification, Administrative Services, Printer, etc.

# Patent Examiner Technical Training Program (PETTP)

TC 2600 POC



Daniel Swerdlow

571-272-7531



Mohammad Ghayour

571-272-3021

- PETTP is a White House Executive Action aimed at encouraging innovation, strengthening quality, and improving accessibility of the patent system by giving technology experts the opportunity to provide relevant technical training and expertise to patent examiners.
- Scientists, engineers, and other technology experts volunteer their time and travel expense to speak with USPTO employees. Presentations are made at the USPTO headquarters in Alexandria, regional offices in Dallas, Detroit, Denver and Silicon Valley as well as via Webcast from the presenter's own location
- PETTP is an umbrella program for individual Technology Fairs, but not limited to specific dates of individual TC Technology Fairs.

TC 2600 POC



Doris To

571-272-7629



Dwayne Bost

571-272-7023

# USPTO TC2600 Customer Partnership Meeting

## January 17, 2018

### AGENDA

8:30–9:00 a.m. Morning Network

9:00–9:30 a.m. Introductions: TC Contacts for Procedural Issue

- TC 2600 Director: John Barlow

9:30–10:30 a.m. Presentation: [Determining Obviousness and 103 Clarity Improvement](#)

- SPE: Ke Xiao
- SPE: Barry Drennan

10:30–10:45 a.m. Morning Break

10:45–11:45 a.m. Presentation: [Review of Examiner's Work Product](#)

- SPE: Ilana Spar
- SPE: Roberto Velez

11:45 a.m.–1:00 p.m. Lunch

1:00–2:15 p.m. Workshops

2:15–2:30 p.m. Afternoon Break

2:30–3:30 p.m. Presentation: [Examiner Interview Trainings and Practices](#)

- SPE: Claire Pappas
- SPE: Marivelisse Santiago-Cordero

3:30–4:00 p.m. Director Panel Q&A

- TC 2600 Directors

<https://www.uspto.gov/about-us/events/technology-center-2600-customer-partnership-meeting-0>

# Polling Instructions

We are introducing live polling to our Customer Partnership Meeting

To initiate polling, either:

- text "**uspto1**" to 22333 once, or
- in a web browser enter:  
**[pollev.com/uspto1](http://pollev.com/uspto1)**

Polling:

Let's go ahead and test your connection with an introductory polling question.

# What Super Power would you most like to possess?

Being able to Fly. **A**

Invisibility. **B**

Teleportation. **C**

Incredible Strength. **D**

Other. **E**

# Determining Obviousness

35 U.S.C. 103

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# The Examiner as Fact Finder

- Examiners act as fact finders when resolving the *Graham* inquiries.
- Examiners must articulate findings as to the scope and content of the prior art as necessary to support the obviousness rejection being made.

# The Basic Factual Inquiries of *Graham v. John Deere*

- Determining the scope and content of the prior art.
- Ascertaining the differences between the claimed invention and the prior art.
- Resolving the level of ordinary skill in the pertinent art.
- Objective evidence, sometimes referred to as “secondary considerations” when timely presented by applicants must be evaluated.

# Key Points

- When making a rejection under 35 U.S.C. § 103, an examiner must articulate a reason or rationale to support the obviousness rejection.
- In formulating a rejection under 35 U.S.C. § 103, the rationale should be based on the state of the art and not impermissible hindsight, e.g. applicant's disclosure.

# Key Points

- Examiners need to account for all claim limitations in their rejections.
  - Either indicate how each limitation is shown by the reference(s) applied, or provide an explanation.
- Prior art is not limited to the references being applied.
  - Prior art includes both the specialized understanding of one of ordinary skill in the art, and the common understanding of the layman.
  - Examiners may rely on, for example, official notice, common sense, design choice, and ordinary ingenuity.

## ***KSR International Co. v. Teleflex Inc.***

- The Supreme Court reaffirmed *Graham v. John Deere Co.* as the controlling case on the topic of obviousness.
- The Supreme Court stated that the Federal Circuit erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. **KSR International Co. v. Teleflex Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007)**

# Rationales

Examiners must:

- Resolve the *Graham* inquiries.
- Articulate the appropriate findings as identified by the Examination Guidelines.
- Explain how the rationale leads to a conclusion of obviousness under § 103.

# Rationales

- One or more of the rationales set forth in the following slides may be relied upon to support a conclusion of obviousness.
  - Note that the list of rationales provided herein is not intended to be an all-inclusive list.
- Again, a key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious.

# Exemplary rationales – MPEP 2143

- A. *Combining prior art elements* according to known methods to yield predictable results
- B. *Simple substitution* of one known element for another to obtain predictable results
- C. Use of known technique to *improve similar devices* (methods, or products) in the same way
- D. *Applying a known technique to a known device* (method, or product) ready for improvement to yield predictable results
- E. "*Obvious to try*" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- F. Known work in one field of endeavor may prompt *variations* of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill
- G. A *teaching, suggestion, or motivation* in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

## **Rationale B. Simple substitution of one known, equivalent element for another to obtain predictable results**

Examiners must articulate the following:

- 1) a finding that the prior art contained a device which differed from the claimed device by the substitution of some components with other components;
- 2) a finding that the substituted components and their functions were known in the art;
- 3) a finding that one of ordinary skill in the art could have substituted one known element for another and the results of the substitution would have been predictable.

## **Rationale B. Simple substitution of one known, equivalent element for another to obtain predictable results**

Rationale: The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

# Rationale G. TSM

- Under the TSM test, a claimed invention is obvious when there is a teaching, suggestion, or motivation to combine prior art teachings. The teaching, suggestion, or motivation may be found in the prior art, in the nature of the problem, or in the knowledge of a person having ordinary skill in the art.
- According to the Supreme Court, the TSM test is one of a number of valid rationales that could be used to determine obviousness. It is not the only rationale that may be relied upon to support a conclusion of obviousness.

# Rationale G. TSM Test

Examiners must articulate the following:

- 1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) a finding that there was reasonable expectation of success.

# Rationale G. TSM Test

Rationale: The claim would have been obvious because a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.

# Predictability

- Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. **MPEP 2143.02**

# Applicant's Response

- If an applicant traverses an obviousness rejection under § 103:
  - The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action.
  - The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. See 37 CFR 1.111(b).

# Rebuttal Evidence

- Examiners should consider all rebuttal evidence that is presented by the applicant in a timely manner.
- Rebuttal evidence may include evidence of secondary considerations such as commercial success, long felt but unsolved needs, failure of others, and unexpected results.
- If the examiner nevertheless maintains the rejection after reweighing all of the evidence, he or she must clearly explain the reasons for doing so.

**Questions – Thank You**

# 35 U.S.C. 103 Clarity Improvement Guidance

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## Purpose ...

Help Examiners improve the clarity of 35 U.S.C. 103 Rejections by looking at:

- Review of 35 U.S.C. 103 and required elements for a prima facie case of obviousness.
- Specifically looking at:
  - Making the record clear
  - Properly addressing every limitation of the claims.
  - Presenting a proper Supporting Rationale



# 35 U.S.C. 103(a)- Conditions for Patentability: Non-Obvious Subject Matter- (Pre-AIA)

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.



## **35 U.S.C. 103- Conditions for Patentability: Non-Obvious Subject Matter (AIA)**

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.



## 35 U.S.C. 132(a) States:

(a) Whenever, on examination, **any claim** for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, **stating the reasons for such rejection**, or objection or requirement, **together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application**; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention. (emphasis added)



## 37 C.F.R. 1.104(c)(2)

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. [emphasis added]

# MPEP 707.07- Completeness and Clarity of Examiner's Action

## MPEP 707.07(d) Language To Be Used in Rejecting Claims

- Where **a claim** is refused for any reason relating to the merits thereof it should be "rejected" and **the ground of rejection fully and clearly stated**, and the word "reject" must be used. The examiner should **designate the *statutory basis*** for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. The burden is on the Office to establish any prima facie case of unpatentability (see, e.g., [MPEP § 2103](#)), thus **the reasoning behind any rejection must be clearly articulated**. [emphasis added]

Introduction

Authority

Example

Best Practices

# Making a 35 U.S.C. 103 Rejection

- Must address ***findings of fact*** as to the disclosures in the references
- Provide ***clear articulation*** of the appropriate ***findings of fact***
- Set forth ***How*** the references are combined/used together to address all claim limitations.
- Provide the ***rationale for combining or modifying*** the references.



## **Example of a Poor 103 Rejection**

Claim 2. The apparatus of claim 1, wherein the orientation of the apparatus is predicted by using a widget in conjunction with a step of using a statistical model, followed by a further step of using an output of a motion sensor....



# Example (*cont.*)

## Office Action

Claim 2 is rejected under 35 U.S.C. 103 as being unpatentable over Jones (US PG PUB 2014123456) in view of Smith (US PG PUB 2012123456) as applied to claim 1 above, and in further view of Williams (US PG PUB 2013123456).

As per claim 2, claim 1 is incorporated and Jones in view of Smith doesn't disclose but Williams discloses in which **the orientation of the apparatus is predicted by using a widget in conjunction with a step of using a statistical model, followed by a further step of using an output of a motion sensor** (Williams, [0038], where a widget is run to statistically predict the next location using accelerometers in three directions, then it is updated based on the actual measured orientation). ***NOTE: End of Examiner's Analysis.***

Introduction

Authority

Example

Best Practices

# Deficiencies in the Example

- No clear and accurate findings of fact.
- Lacking proper supporting rationale.
- Not properly addressing all limitations of the claims.



## Deficiencies in the Example (*cont.*)

- Have all claimed limitations been addressed?
  - A key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation** of the appropriate **findings of fact**
- Where is the “further step of using an output of a motion sensor”?
- What about **how** the references are combined together, and the **rationale for combining or modifying** the references?



# Addressing All Limitations - Best Practices

- Explicitly provide the correspondence of individual claim element(s) with element(s) taught in the reference(s) in a rejection.
- Any citation of a passage in a reference that includes more than one structure, action or function should be accompanied by explanation describing which item in that passage corresponds to the relevant claim element.
- Providing clear and precise citations from the prior art will make the record, taken as a whole, reasonably clear and complete and provide how the claims distinguish over the prior art.



# Addressing All Limitations - Best Practices (cont.)

## **NOT a Best Practice to include the following paragraph in an Office Action**

- “The examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider each of the cited references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage disclosed by the examiner.”
- ***The above illustrated “Statement” is insufficient grounds to factually support a prima facie conclusion of obviousness.***



***Thank you!***  
***Questions?***

# Review of Examiner's Work Product

January 2018

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# Agenda

- SPE Training on Examiner Work Product Review
- Examiner's Performance Appraisal Plan Standards in Quality and Documentation
- OPQA Review of Examiner's Work Product

# SPE Training on Examiner Work Product Review

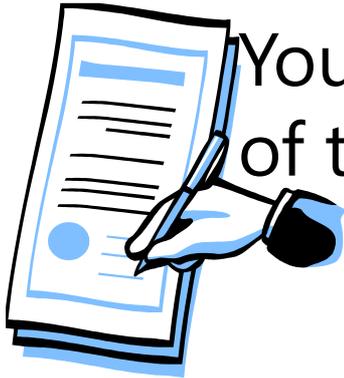
The SPE's responsibility for ensuring quality work in the unit

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# The SPE's Responsibility

You have been delegated the authority to represent the Agency by the Director of the USPTO



You are the final Agency reviewer of the Office actions you sign.

## **Be familiar with the level of quality of ALL examiners**

- Thoroughly review Office actions you sign
- Maintain a working knowledge of the quality of Office actions you don't review and sign
- Needed for:
  - Doing ratings
  - Recommending promotions
  - Providing timely meaningful feedback, both negative and positive
  - Developing/maintaining your working knowledge of the art area

# Reviews at Different GS Levels

- Junior Examiner
  - All actions must be signed by a supervisor or a primary examiner authorized to sign off on work
- Primary Examiner
  - Sign most actions on their own

# YOU are the Manager

As a SPE:

- You have the choice to review any and all work produced in your unit.
- You have the prerogative to contact any examiner and ask them about their work. For example, ask the examiner:

What is the invention as described?	Where did you search and why?
What problem is the applicant trying to solve?	What is the best art you found?
What is the prosecution history?	What was your decision process to reject/allow claim?
Why are you proposing this course of action?	Are the differences between the claims and best prior art slight enough to be able to propose an amendment?

# How to be Efficient in Reviewing Work

To be efficient and effective at case review:

- You must be aware of the current skills and abilities of your examiners
  - Assess skills and abilities on an ongoing basis to determine if the examiner is progressing
- You must establish and maintain an understanding of the level of quality of work of each of the examiners you are reviewing
- You must treat every examiner appropriately based on individual circumstances. This does not mean treating them all exactly the same.
  - You can treat examiners differently, but you should have a reason for doing so (e.g. if an examiner's work products contain more errors than others and require more review time to evaluate them)
- Assess the amount of knowledge you have of the current case and work product being reviewed
- Be aware of any TC hot spots: 101, 112 issues, etc.

# Benefits of Focusing Efforts on FAOMs

Think of the life of an application as having a “front-end” (FAOM) and a “back-end”(everything else). Focusing your review on the “front-end” has many benefits:

1. More compact prosecution
  - a. Fewer actions per disposal means fewer actions for you to review
  - b. Fewer reopens (2<sup>nd</sup> action NFs, reopen after final, reopen after appeal conference, etc.) means fewer actions for you to review
  - c. Fewer pre-appeal/appeal conferences
2. “Back-end” reviews become easier
  - a. You are already familiar with the case
  - b. Better FAOMs lead to higher-quality amendments/responses from applicant

# **Examiner's Performance Appraisal Plan Standards in Quality and Documentation**

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# Performance Appraisal Plan (PAP) Standard

- What an Examiner is responsible for varies based on GS level
  - PAP sets forth standard for examiners performance
  - Degree of responsibility based on GS level (Major Activities Chart)
  - Clear Error Definition

# PAP Quality Element

Quality Major Activities	Error Category	GS 5	GS 7	GS 9	GS 11	GS 12	GS 13	GS 13/14 PSA	GS 14 FSA	GS 15
1. Checking applications for compliance for (a) compliance with formal requirements of patent statutes and rules and (b) technological accuracy	1	✓	✓	✓	✓	✓	✓	✓	✓	✓
2. Treating disclosure and claims of priority	1	✓	✓	✓	✓	✓	✓	✓	✓	✓
3. Analyzing disclosure and claims for compliance with 35 USC 112	2	⊥	✓	✓	✓	✓	✓	✓	✓	✓
4. Planning field of search	1	⊥	✓	✓	✓	✓	✓	✓	✓	✓
5. Conducting search	1	✓	✓	✓	✓	✓	✓	✓	✓	✓
6. Making proper rejections under 35 USC 102 and 103 with supporting rationale, or determining how claim(s) distinguish over the prior art	2		✓	✓	✓	✓	✓	✓	✓	✓
7. Determining whether amendment introduces new matter	2				✓	✓	✓	✓	✓	✓
8. Appropriately formulating restriction requirements, where applications could be restricted	1				✓	✓	✓	✓	✓	✓
9. Determining whether claimed invention is in compliance with 35 USC 101	2				✓	✓	✓	✓	✓	✓

# PAP Quality Element (cont.)

Quality Major Activities	Error Category	GS 5	GS 7	GS 9	GS 11	GS 12	GS 13	GS 13/14 PSA	GS 14 FSA	GS 15
10. Evaluating/applying case law as necessary	*					✓	✓	✓	✓	✓
11. Determining where appropriate line of patentable distinction is maintained between applications and/or patents	1				✓	✓	✓	✓	✓	✓
12. Evaluating sufficiency of affidavits/declarations	*					✓	✓	✓	✓	✓
13. Evaluating sufficiency of reissue oath/declaration	1					✓	✓	✓	✓	✓
14. Promotes compact prosecution by including all reasonable grounds of rejections, objections, and formal requirements (MPEP 707.07 (g), etc.)	1							✓	✓	✓
15. Makes the record, taken as a whole, reasonably clear and complete	1							✓	✓	✓
16. Properly treats all matters of substance in applicant's response	1							✓	✓	✓
17. Formulates and independently signs final determinations of patentability (final rejections, allowances, examiner answers and advisory actions)	*								✓	✓
18. Properly closes prosecution: makes no premature final rejection	2								✓	✓
19. Properly rejects all rejectable claims in a final rejection; properly allows all claims in an allowance	3								✓	✓

# Tracking Quality Performance

- Integrated Quality System (IQS)
  - Master Review Form (MRF) to document work product reviews
  - Quality Tracker (QT) to document quality performance
- Work which may be reviewed using IQS:
  - Any action which the examiner posts for credit

# Tracking Quality Performance (cont.)

- Quality Tracker (QT) reviews may be forwarded to examiners as:
  - Clear error charged
  - Coaching/Mentoring
  - Indicia of Commendable or Outstanding Performance

# Reviews after Mailing

- Quality Initiatives
- Quarterly PAP Rating Reviews
- Appeal/Pre-appeal Conferences
- Signatory Program
- GS12 to GS 13 Promotions

# OPQA Reviews of Examiner Work Product

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# Random Compliance Reviews

- Sample is based on the volume of work completed by TC to achieve a statistically significant sample
- Allowances, Finals and Non-Finals
- Assigned to Review Quality Assurance Specialist (RQAS) based on TC designation
- Approximately 4 hours/review

# Review Process

- Focused on the assigned action, but will review prosecution history as appropriate
- A Compliant Rejection will include:
  - Correct Claim(s)
  - Correct Statute
  - Sufficient Evidence
- All reviews include feedback
  - Positive reinforcement
  - Best practices/Areas for improvement
  - Issues for consideration

# Review Process

- Master Review Form (MRF)
  - Rejections Made
  - Omitted Rejections
  - Other issues
    - Search
    - Restrictions
    - Objections

# Returns to TC

- All reviews are provided to the TC for appropriate action categorized as:
  - Noncompliant
  - For Consideration
  - Pass Through
  - Accolade

# Summary

- How SPEs approach case review
- Understanding the PAP Standard
- The role of OPQA in assessing TC Quality

# Open Discussion

# Workshop Breakout

## **Part I- 103 Clarity Workshop**

- 1:00-1:05 Distribution of materials and instructions
- 1:05-1:30 Review and assessment of sample 103 rejections
- 1:30-1:40 Report-out

## **Part II- Office Action Review**

- 1:40-1:45 Distribution of materials and instructions
- 1:45-2:00 Review and assessment of sample Office Actions
- 2:05-2:15 Report-out

# Interview Practice

Marivelisse Santiago-Cordero – SPE AU 2676  
Claire Pappas – SPE AU 2626

UNITED STATES  
PATENT AND TRADEMARK OFFICE



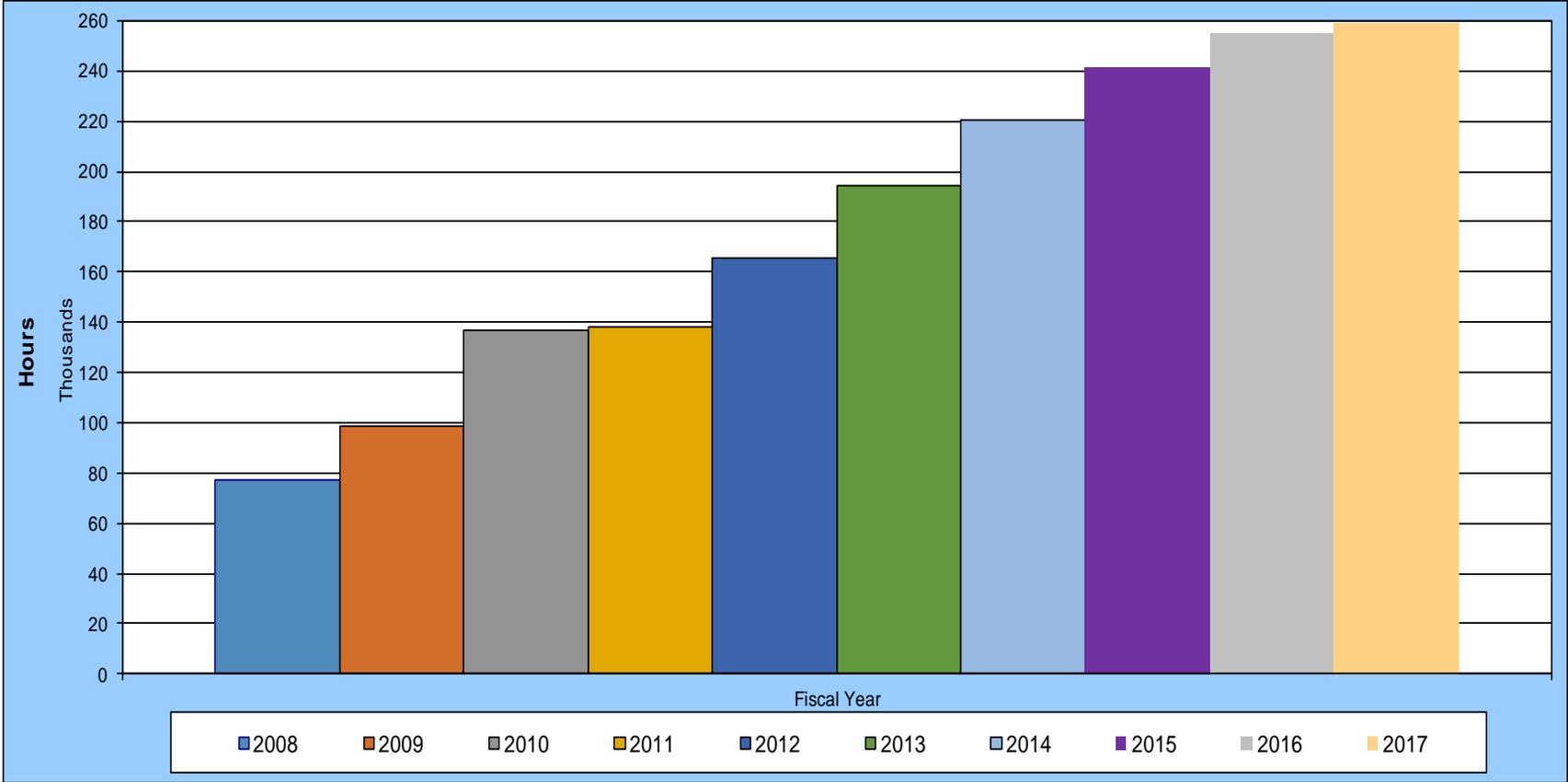
# Interview Practice @ USPTO

- Interview Trends
- Examiner Interview Practice Training
- Internet Authorization
- Video Conferencing Interviews (WebEx)
- Proper Recordation
- Resources
- Looking Ahead

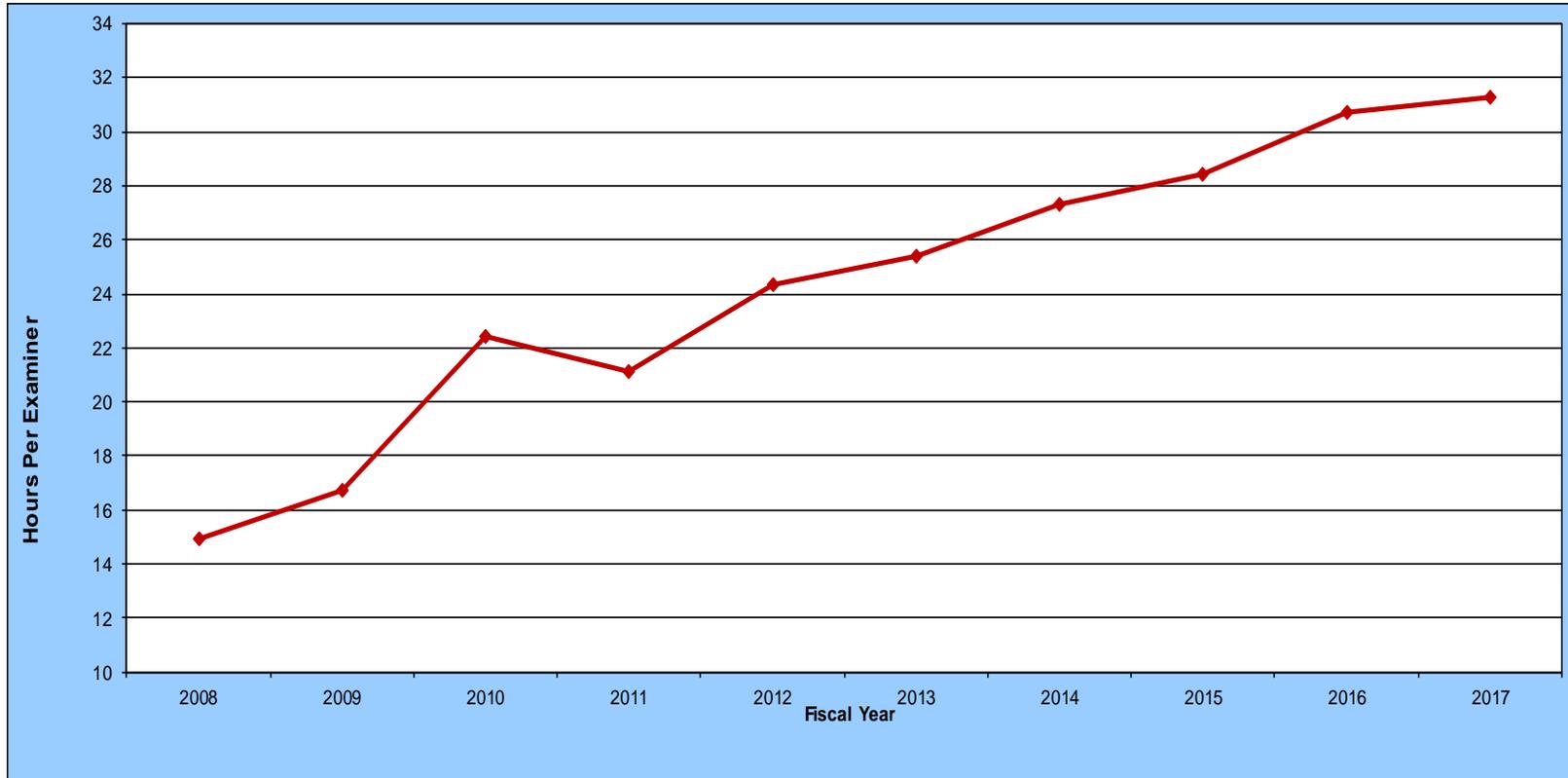
# Trends

Interview Practice

# Interview Time – Patent Corps FY 2008 – FY 2017

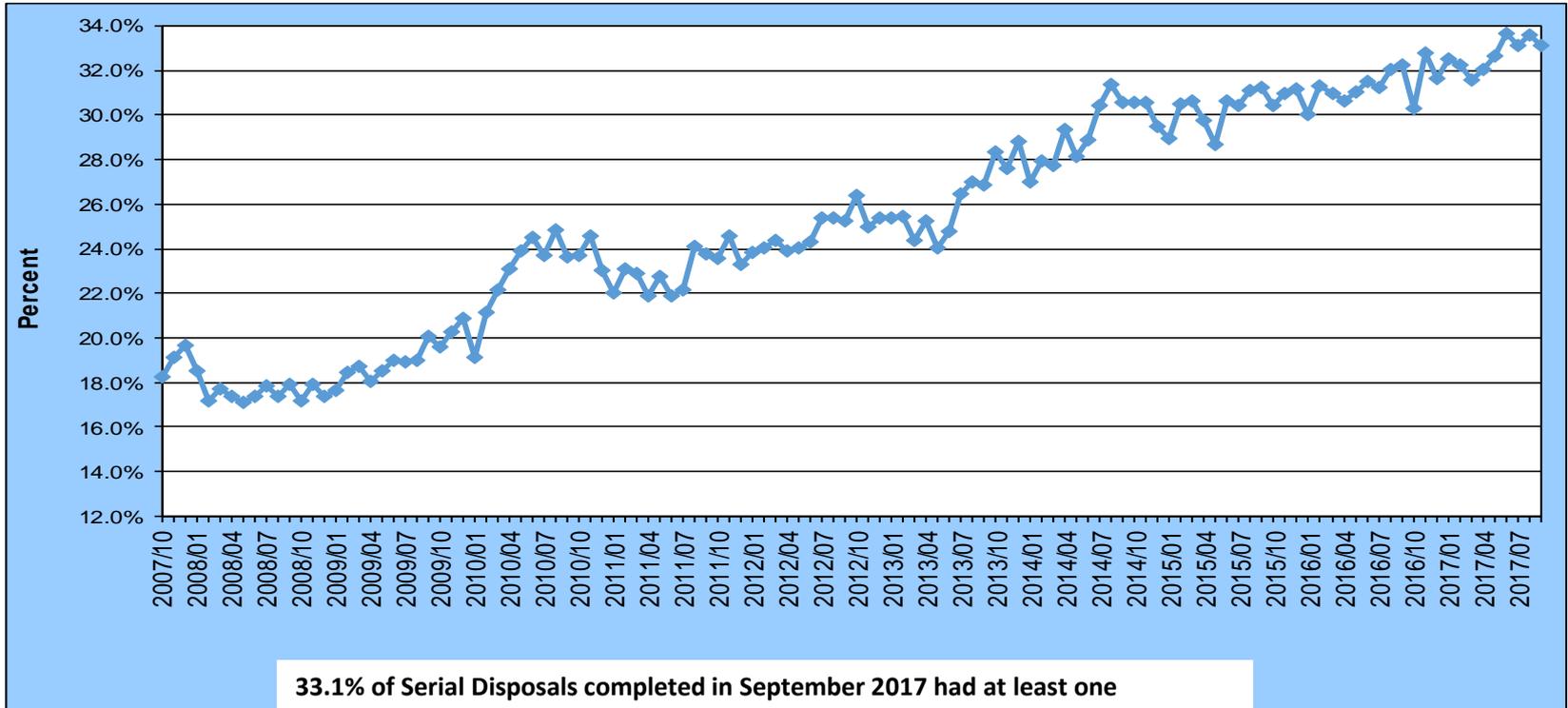


# Interview Time Per Examiner – Patent Corps FY 2008 – FY 2017



# Percent of Serial Disposals Having at Least One Interview by Month

## FY 2008 – FY 2017



**33.1% of Serial Disposals completed in September 2017 had at least one interview.**

# **Examiner Interview Practice Trainings**

Interview Practice

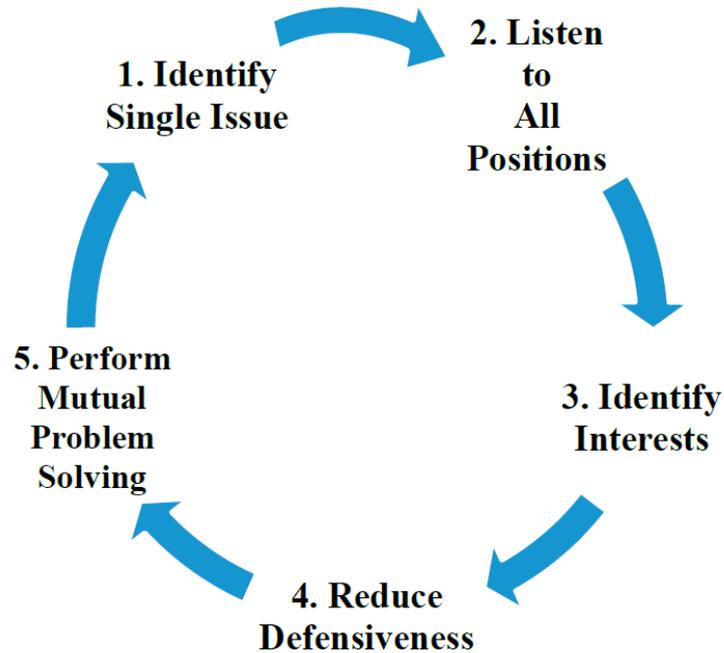
# Interview Practice Training Re-cap

## FY12-FY16

Fiscal Year	Topic
FY16	Covered FAQs including when to place an email in the file record; how to check for written authorization; entering papers marked "do not enter"; as well as interview best practices
FY15	Covered interview policy guidelines and principles, survey results, oral/written authorization, AIR form, interview preparation and recordation, WebEx refresher, and Public Interview Room recap
FY14	Three-part training series on effective interview practice consisting of internal employee interview survey, training material discussion, and WebEx certification with Home SPE. Training material discussion covered WebEx refresher, Public Interview Room overview, and recap on Interview Practice Guidelines and Collaboration Tools
FY13	Covered Interview policy guidelines and introduced Examiner Interview Resource Website
FY12	Effective Interview Practice discusses the use of an agenda, preparing for the interview, properly recording the interview to clarify the record, and steps that can be taken to properly follow through after the interview

# FY-17 Interview Practice Training

## 5-Step Resolution Process



# FY17 Interview Practice Training Video



*Note: This is an example of how **NOT** to conduct an interview*

# Tips for Achieving Resolution

- Be Well Prepared
- Be Empathetic
- Be Flexible
- Employ Good Communication Skills

# **Internet Authorization**

Interview Practice

# Internet Authorization

- Without a written authorization by applicant in place, the USPTO will not respond via Internet email to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in [35 U.S.C. 122](#).
- Sample Authorization:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned and practitioners in accordance with 37 CFR 1.33 and 37 CFR 1.34 concerning any subject matter of this application by video conferencing, instant messaging, or electronic mail. I understand that a copy of these communications will be made of record in the application file."

# Which of the following ways is NOT a proper way to submit Internet Authorization?

EFS-Web

U.S. Postal Service

USPTO Customer service window

One-Time Oral Authorization

Central Fax

E-mail

# Ways to Properly Submit Internet Authorization

- EFS web\*
- US Postal Service
- USPTO Customer Service Window
- Central Fax
- One-Time Oral Authorization

\*Recommended Form

# Oral/Written Authorization for Video Conferencing

## Change to Internet Usage Policy to Permit Oral Authorization for Video Conferencing Tools

- The USPTO is updating its policy to make it easier for patent applicants to authorize the use of video conferencing tools to conduct examiner interviews. The policy change supersedes MPEP § 502.03 in that it now allows the applicant or his/her representative(s) to verbally request and authorize a video conference interview, in the same way they would request a telephone or in-person interview with the examiner, instead of submitting a written request.
- The change is intended to make the interview process more efficient but it is important that the details of the authorization be noted on the record.
- This authorization is limited to the video conference interview being arranged and does not extend to other communications regarding the application.

# **Video Conferencing Interviews (WebEx)**

Interview Practice

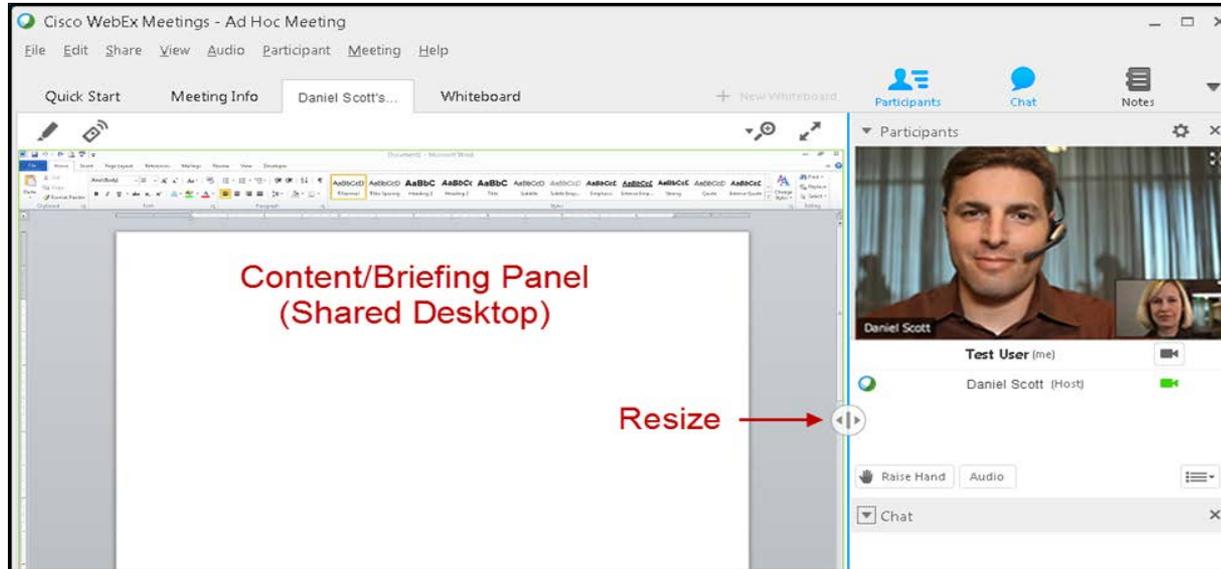
# WebEx Interview Reminders

- Face-to-face interviews should normally be granted.
- Obtain verbal or written authorization from applicant prior to sending Outlook/WebEx meeting invite (see MPEP §§ [502.03](#) and [713.01](#), and 80 Fed. Reg. 23787, April 2015)
- Face-to-face video conference through WebEx is a great alternative to in-person interviews for hoteling examiners
- Face-to-Face video conference interviews should be offered when an in-person interview is not feasible
- Webcam needs to be turned on to allow video conferencing
- Examiner (and not applicant) must host the WebEx session and send the WebEx invitation link

# WebEx Basics

- You need a computer and a high-speed Internet connection is recommended.
- WebEx is a web-based service, so you can use it from any computer (Windows, Mac, Linux, or Solaris).
- No software needs to be downloaded or purchased.
- A telephone will be used to join the audio component of the meeting while a video camera may be used as part of the visual component.

# WebEx Refresher



Participants may resize the content/briefing panel for optimal viewing and may also independently resize the video panel up to full-screen size.

For participants viewing a shared desktop or application, the view is now contained in the content/briefing panel instead of taking up the entire computer screen or window. This allows the video, participants list, and chat section to be retained in the view when a desktop or application is shared

# Can someone outside of the U.S. join in on a WebEx interview?

Yes.

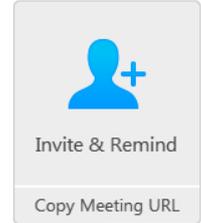
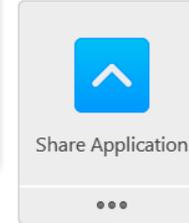
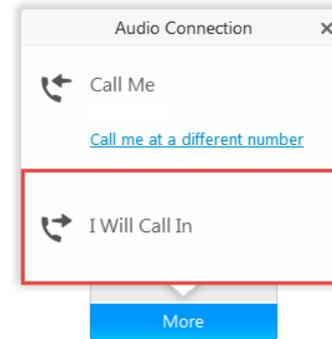
No.

I  
don't  
know.

# International WebEx Interviews



- WebEx can be used to host an international WebEx interview.
- An international applicant should dial-in to join the audio component by using the **"I will Call In"** option.



# **Proper Recordation**

Interview Practice

**As part of an interview, an examiner receives a paper (e.g., proposed amendment) with the words "Do Not Enter Into Record" or "For Discussion Purposes Only". Should the examiner enter the paper into the file wrapper?**

Yes.

No.

I don't know.

## **Substance of Interview Must Be Made of Record**

- The agenda must be placed into the record to help ensure a complete and proper recordation of the substance of the interview (MPEP 502.03, see also MPEP 713.01).
- Office policy for the complete and proper recordation of the substance of any interview.

# Resources

Interview Practice

# Do you know what the Automated Interview Request (AIR) form is?

Yes.

No.

Not another form.

# **Automated interview requests (AIR)**

Interview Practice

# Automated Interview Request (AIR) Form

- New web-based tool
- Permits Applicants to schedule an interview with an examiner



The screenshot shows the USPTO website interface. At the top, there's a navigation bar with 'uspto UNITED STATES PATENT AND TRADEMARK OFFICE' and search options. Below that, there are tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The main content area is titled 'Interview Practice' and includes a sidebar with a menu: '1 USPTO AIR', '2 Video Conference', '3 TC Interview Specialist', '4 Policy and Guidance', '5 Training and FAQs', '6 Summary', '7 Federal Register Notice', and '8 Contact Us'. The 'USPTO AIR' section is highlighted, showing a description: 'A new web-based tool that allows Applicants to schedule an interview with an Examiner for their pending patent application. Complete the form.' Below this is the 'Video Conference' section, which includes a video player with the title 'USPTO Video Conference Interviews'. At the bottom, there's a 'TC Interview Specialist' section with a QR code and text: 'Interview Specialists are subject matter experts in each Technology Center (TC) on interview practice and policy to assist in interviews, including building and assisting with technical issues that may arise (e.g. WebEx problems, public release room setup). If you have questions or comments about interview practice at the USPTO, please contact a TC Interview Specialist, based on the Technology Center that the application is docketed in.'

TC 2600 Customer Partnership

## USPTO Automated Interview Request (AIR) Form

Automated Interview Request Form (IR-21)  
Approved for use through 7/31/2016; OMB A031-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

\* This paper requesting to schedule and/or conduct an interview is appropriate because:  
 I have previously submitted an authorization for internet communications in a patent application. See form SB/0439.  
 I am concurrently submitting an authorization to communicate via the internet. See form SB/0439.  
 This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

I understand that a copy of this communication will be made of record in the application file.

\*Name(s):

\*S-signature:  (See 37 CFR 1.4(d)(2)) (I/Name)

Registration Number:  (5 Digit Numeric Only: 12345)

\*U.S. Application Number:  (8 Digit Numeric Only: 12345678)

\*Confirmation Number:  (4 Digit Numeric Only: 1234)

\*E-mail Address:

\*Phone Number:  (10 Digit Numeric Only: 0123456789)

\*Proposed Date and Time of Requested Interview must be more than one (1) week after today:  
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)  
MM  DD  YYYY  Time  Eastern Time

\*Proposed Type of Interview:  (Examiners working remotely will offer Video Conference or Telephonic interviews)

I am the applicant or applicant's representative for this application.

\* Indicates fields that are required

This collection of information is required by 37 CFR 1.113. The information is required to obtain or retain a benefit by the public which it is to promote (and) by the USPTO to process an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.111 and 1.12. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 3480, Alexandria, VA 22303-3480. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

# Form Paragraph

Started on January 2017 – New paragraph in Office Actions:

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

# Public Interview Rooms

- When an Applicant is visiting a USPTO campus, Video conference rooms are available to facilitate meetings with remote examiners.
- Video conferencing is also available anytime anywhere from your own office.
- There is a Public Interview Room at every USPTO campus.

# Public Interview Rooms

- Must be reserved by Examiner at least two business days prior to interview.



**Alexandria**



**Denver**



**Dallas**

# TC Interview Specialists

- Subject matter expert on interview practice and policy in each Technology Center
- To assist Examiners and Applicants in facilitating effective interviews
- The list of TC Specialists can be found here:  
<http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist>

# TC 2600 Interview Specialists

Michael Horabik ([michael.horabik@uspto.gov](mailto:michael.horabik@uspto.gov)) 571-272-3068

Kamran Afshar ([Kamran.afshar@uspto.gov](mailto:Kamran.afshar@uspto.gov)) – 571-272-7796

Srilakshmi Kumar ([Srilakshmi.kumar@uspto.gov](mailto:Srilakshmi.kumar@uspto.gov)) – 571-272-7769

Claire Pappas ([claire.pappas@uspto.gov](mailto:claire.pappas@uspto.gov)) – 571-270-1051

# Other Electrical TCs Interview Specialists

## TC 2100:

Jeffrey Gaffin (571-272-4146);  
Matt Kim (571-272-4182);  
Charles Rones (571-272-4085)

## TC 2400:

Jeffrey Pwu (571-272-6798)  
Sath Perungavoor (571-272-7455)  
Ashok B. Patel (571-272-3972)  
Derrick Ferris (571-272-3123)  
Michael Thier (571-272-2832)

## TC 2800:

William Kraig (571-272-8660)  
Timothy Dole (571-272-2229)  
Peter Macchiarolo (571-272-2375)  
Anh T. Mai (571-272-1995)  
Robert Kim (571-272-2293)  
Drew Richards (571-272-1736)  
Jacob Choi (571-272-2367)

# Interview Experience Survey

- USPTO has launched an Interview Experience Survey in response to Applicants desire to share feedback on the interview experience
- The survey is given to Applicants who used the AIR form to schedule their interview and to the Examiner of record
- Feedback from both Applicants and Examiners are evaluated to determine future improvements

# Sample Email to Applicant

Your name →

Application Number →

Link to Survey →

Questions? Email us. →

From: USPTO [[mailto: email\\_notifier@foreseeresults.com](mailto:email_notifier@foreseeresults.com)]  
Sent: Monday, July 3, 2017 9:53 AM  
To: Applicant's email address  
Subject: Your feedback about your interview experience is requested



**We appreciate your feedback!**

Dear {Applicant Name},

Thank you for using USPTO Automated Interview Request (AIR) for your recent meeting. Your feedback is very important to us as we strive to improve your customer experience.

We invite you to provide your opinions about the recent interview held regarding Application # xxx7231.

The survey will take about 3-5 minutes and your responses will be kept strictly confidential. Thank you for your time, your feedback is key to evaluating our performance.

To take the survey, please click the link below:

[Take Survey](#)

Thank you

If you have questions regarding this survey, please contact [InterviewExperience@uspto.gov](mailto:InterviewExperience@uspto.gov)

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ForeSee works with hundreds of companies around the world to collect customer insights. If you are experiencing problems with this company's website or the customer service or support department we recommend that you contact the company directly.

If you prefer not to receive future survey invitations from ForeSee, [click here](#).

# Applicant's Survey

1: \*Thinking about scheduling with USPTO Automated Interview Request (AIR), please rate the following:  
**The convenience** of scheduling with AIR as compared to other methods  
 1=Not Convenient at all Very Convenient=10  
 1 2 3 4 5 6 7 8 9 10 Don't Know

2: \***How long I had to wait** to confirm the interview with an examiner  
 1=Unexpected Wait Time Expected Wait Time=10  
 1 2 3 4 5 6 7 8 9 10 Don't Know

3: \*Please rate the examiner who conducted the interview in the following areas:  
**Level of knowledge** regarding the inventive concept and prior art  
 1=Poor Excellent=10  
 1 2 3 4 5 6 7 8 9 10 Don't Know

4: \*Please rate the responses provided to your requests or questions in the following areas:  
**Thoroughness** of explanations regarding examiner's position **during the interview**  
 1=Insufficient Very Thorough=10  
 1 2 3 4 5 6 7 8 9 10 Don't Know

5: \*The extent to which my issues or requests were resolved  
 1=Not Resolved at all Complete Resolved=10  
 1 2 3 4 5 6 7 8 9 10 Don't Know

6: \*What was your **overall satisfaction** with this interview experience?  
 1=Very Dissatisfied Very Satisfied=10  
 1 2 3 4 5 6 7 8 9 10

7: \*How well did your interview experience **meet your expectations**?  
 1=Fell Short Exceeded=10  
 1 2 3 4 5 6 7 8 9 10

Reservation / Scheduling

Overall Satisfaction

# Applicant's Survey – Con't

8: \*How well did your experience compare to an ideal interview experience?  
1=Not Very Close Very Close=10  
1 2 3 4 5 6 7 8 9 10

9: \*How likely are you to schedule interviews using USPTO AIR in the future?  
1=Very Unlikely Very Likely=10  
1 2 3 4 5 6 7 8 9 10

10: \*How likely are you to communicate with others about your USPTO AIR Interview experience?  
1=Very Unlikely Very Likely=10  
1 2 3 4 5 6 7 8 9 10

11: \*What were your reasons for requesting this interview? (Please select all that apply.)  
 Clarify reasons for rejection(s)  
 Present proposed claim amendments  
 Discuss claims of prior art  
 Provide a demonstration  
 Other, please specify:  
11.1: Please specify the other reason for your interview:

12: \*Was the examiner of record prepared at the scheduled time and date?  
 Yes  No

13: \*Besides the examiner on record, was a Supervisory Patent Examiner (SPE) or another examiner present at the interview?  
 Yes  No  Don't know

13.1: \*Was the SPE or other examiner present in the interview prepared at the scheduled time and date?  
 Yes  No  Don't know

Overall Satisfaction

Preparedness

# Applicant's Survey – Con't

14: *Did you reach resolution on pending issues during this interview?
<input type="radio"/> Yes <input type="radio"/> No
15: *Did this interview improve your understanding of the examiner's positions regarding this application?
<input type="radio"/> Yes <input type="radio"/> No
16: *Did the examiner discuss possible ways to overcome the rejections of record?
<input type="radio"/> Yes <input type="radio"/> No
17: *Did the interview provide adequate time to address all issues?
<input type="radio"/> Yes <input type="radio"/> No
18: *Were the examiner's positions presented with decorum, courtesy, and professionalism?
<input type="radio"/> Yes <input type="radio"/> No
18.1: Please explain:
<input type="text"/>
19: Please provide any additional comments that might help us improve your experience. <i>Please do <u>not</u> include any information regarding the substance of the interview.</i>
<input type="text"/>

Effectiveness

# Examiner's Survey

- Similar to Applicant's Survey
- Focus remains on:
  - Reservation
  - Overall Satisfaction
  - Preparedness
  - Effectiveness

# Looking Ahead

Interview Practice

# Coming Soon

- Developing new video for the Interview Practice website
- Updating a tool that the examiners use to fill out an interview summary form
- Beginning discussions for FY18 interview training

# Summary

- Interview Trends
- Examiner Interview Practice Training
- Internet Authorization
- Video Conferencing Interviews (WebEx)
- Proper Recordation
- Resources
- Looking Ahead

**Questions?**

# Thank You

UNITED STATES  
PATENT AND TRADEMARK OFFICE

