Selections Have Been Made for the Topic Submissions for Case Studies Pilot!

Back in December 2015, the Topic Submission for Case Studies Pilot team published a Federal Register Notice inviting you, our stakeholders, to submit patent-quality related topics to be the subject of a USPTO case study. We've defined a USPTO case study as an in-depth examination of cases with respect to a single issue to provide a better understanding of the quality of our work products. Specifically, we use case studies to assist us in formulating best practices to enhance patent quality by improving our patent work products and examination processes, as well as recognizing areas where further examiner training may be needed.

You enthusiastically responded to our invitation for suggested topics, and by the time the comment period closed in February 2016, we received over 135 qualified case study submissions from 110 requestors, which includes IP organizations, law firms, companies, and individuals. All of these submissions are still viewable on the team's Submissions webpage.

In view of the overwhelming response, we devised a review-and-ranking process to systematically identify the most popular topics to be addressed through a case study. To begin, we assessed whether the topic was appropriate or capable of assessment for a case study that could be performed within a reasonable amount of time and with measurable analytics. After identifying the topics deemed appropriate for study under this pilot, we next determined whether other programs or mechanisms in the Office were more appropriate for addressing the issue to avoid duplication of efforts. For example, the suggested topic of evaluating the consistency of the application of lack of unity practice in 37 C.F.R. §371 applications is currently being investigated by our Office of International Patent Cooperation and the submissions requesting review on the frequency and effects of claim interpretation are being evaluated as part of another EPQI program, Clarity of the Record Pilot. These and other submissions within this grouping have been forwarded to the appropriate offices for further evaluation.

Finally, we grouped the remaining submissions by subject matter and ranked them according to public interest in each topic. We are hereby pleased to announce the following six topics have been selected for the pilot:

1) Evaluation of the deviation of 35 U.S.C. §101 rejections from official guidance, correctness of rejections and completeness of the analysis. This study will evaluate whether examiners are properly making rejections under 35 U.S.C. §101 and clearly communicating their reasoning.

2) Review of consistency of the application of 35 U.S.C. §101 across Art Units/Technology Centers. This study will take a look at applications with related technologies located in different Art Units or Technology Centers and determine whether similar claims are being treated dissimilarly under 35 U.S.C. §101.

3) The practice of compact prosecution when 35 U.S.C. §101 rejections are made. This study will determine whether all appropriate rejections are being made when a subject matter eligibility issue is also identified.

4) Correctness and clarity of motivation statements in 35 U.S.C. §103 rejections. This study will evaluate whether rejections under 35 U.S.C. §103 are being set forth clearly and with correct motivation to combine statements.

5) Enforcement of 35 U.S.C. §112(a) written description in continuing applications. This study will evaluate claims in continuing applications to determine if they contain subject matter unsupported by an original parent application as additional continuations are filed and whether examiners are appropriately enforcing the requirements of 35 U.S.C. §112(a) written description.

6) Consistent treatment of claims after the May 2014 35 U.S.C. §112(f) training. This study will determine whether claims invoking 35 U.S.C. §112(f) are being properly interpreted and identified.

We will be utilizing our new Master Review Form, patent reviews along with a variety of additional data to undercover patterns, correlations and trends (commonly known as Big Data) to conduct the studies and assist with the analytics. The Master Review Form and our Big Data initiative are on the cusp of being capable to do detailed inquiries on specific topics without having to resort to conducting all topic-specific reviews. The Master Review Form, as explained in the recent Federal Register Notice on Quality Metrics, is a single, standardized review form currently being used by our quality reviewers in OPQA to assess the clarity and correctness of mailed Office actions. By including detailed and expanded review items, this form will help us systematically capture a good portion of the data we will need for these studies. Combining the data from the Master Review Form with our Big Data analytics will allow us to identify examination trends in a more focused and minable manner as compared to our traditional case study methodology. While these tools are still very new and the relevant databases are currently being populated with data, we are confident that we can move forward with all six case studies and provide a greater understanding in each of these areas.

Please stay tuned as we share more details, updates and results on the selected studies as we move forward with our data gathering and analysis. We will periodically post results on the Topic Submission for Case Studies Pilot webpage.