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Clarity of the Record Pilot

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Clarity of Record Pilot - Purpose

This program is to develop **best Examiner practices** for enhancing the clarity of various aspects of the prosecution record and then to **study the impact** on the examination process of implementing these best practices.

Clarity of Record Pilot - Goals

Identify Examiner Best Practices

Find Correct Balance for Appropriate Recordation

Use Data/ Feedback to Assist Other Programs

Enhance Clarity of Prosecution Record

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Clarity of Record Pilot - Areas of Focus

- More detailed interview summaries
- More precise reasons for allowance
- Pre-search interview - Examiner's option
- Enhanced documentation of 7 areas of claim interpretation:

  – **Special definitions of claim terms**

  – **Functional language**

  – **Intended use or result (preamble and body of claim)**

  – **"Means-plus-function" (35 U.S.C. §112(f))**

  – **Optional language**

  – **Non-functional descriptive material**

  – **Computer-implemented functions that invoke 35 U.S.C. §112(f) ("specialized" or "non-specialized")**

Clarity of Record Pilot - Evaluation

- 2,600 Office actions (reviewed and recorded)
  - Included a statistical mix of:
    - Pre-Pilot Office actions
    - Pilot Office actions
    - Control group
- Key Drivers were determined
- Best practices were gathered

Interview Summaries – Key Drivers

- 22 pre-identified practices were used to evaluate the examiner's Office actions

- 11 were deemed **Key Drivers** of overall clarity of the interview summary form
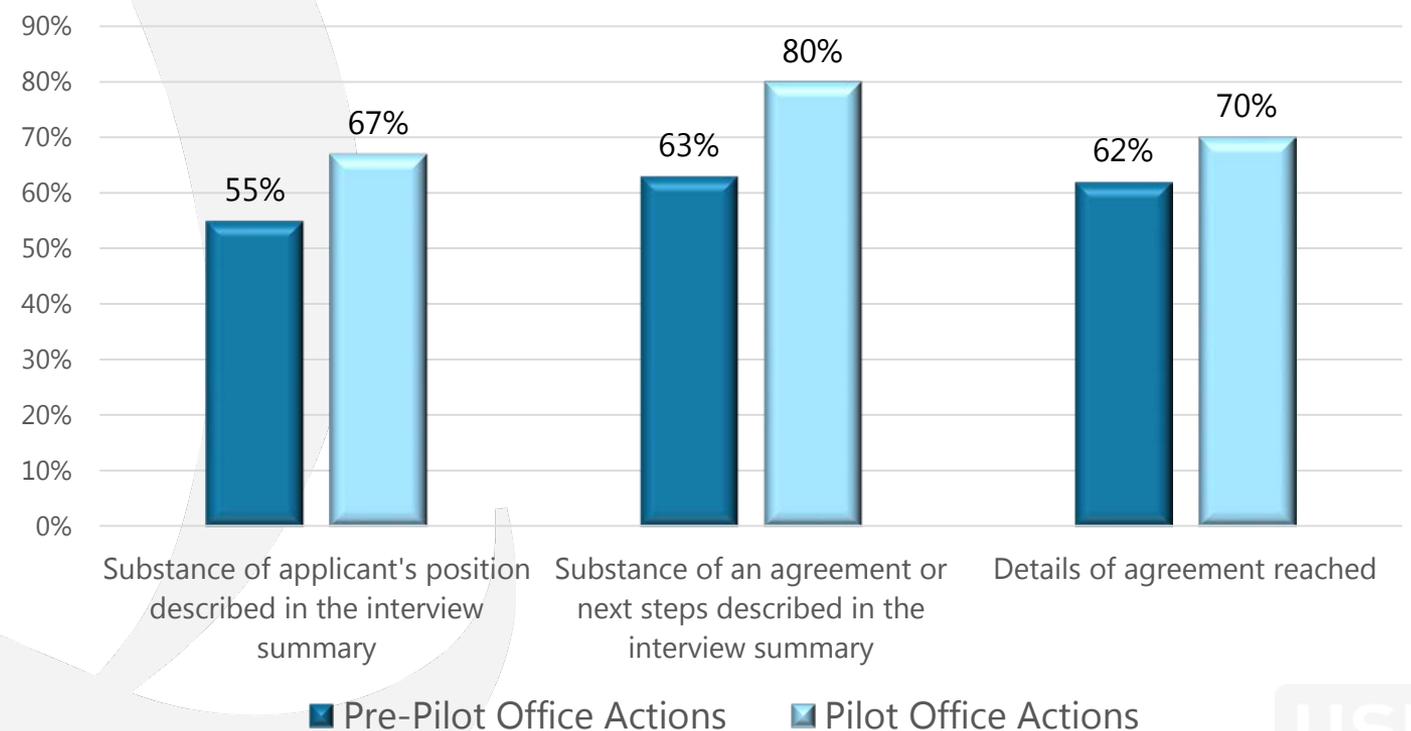
- Top 3 identified **Key Drivers** include:

Was the substance of applicants position described in the interview summary form?
Was the substance of an agreement or next steps described in the interview summary?
Were the details of agreement reached recorded?

Interview Summaries – Key Drivers, cont.

% of Applicable Office Actions Exhibiting Key Drivers

Email questions to **PatentQuality@uspto.gov**
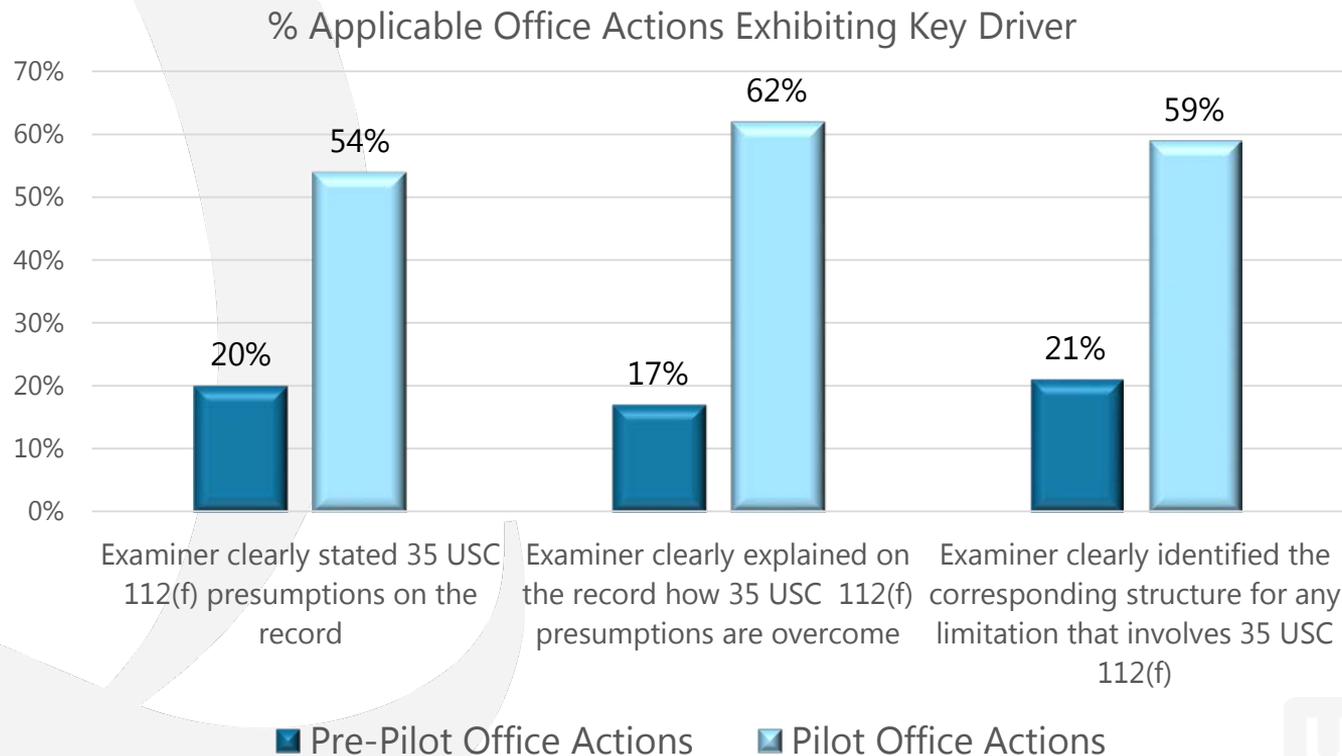
112(f) Presumptions – Key Drivers

- 8 pre-identified practices were used to evaluate the examiner's Office actions

- 5 were deemed to be **Key Drivers** of overall clarity of the 112(f) evaluations

- Top 3 identified **Key Drivers** include:

The examiner clearly stated 35 USC 112(f) presumptions on the record?
Has the examiner clearly explained on the record how 35 USC 112(f) presumptions are overcome, when applicable?
Has the examiner clearly identified the corresponding structure for any limitation that involves 35 USC 112(f)?

112(f) Presumptions – Key Drivers, cont.

% Applicable Office Actions Exhibiting Key Driver

Pre-Pilot Office Actions: 20%, 17%, 21%
Pilot Office Actions: 54%, 62%, 59%

- Examiner clearly stated 35 USC 112(f) presumptions on the record
- Examiner clearly explained on the record how 35 USC 112(f) presumptions are overcome
- Examiner clearly identified the corresponding structure for any limitation that involves 35 USC 112(f)

■ Pre-Pilot Office Actions ■ Pilot Office Actions
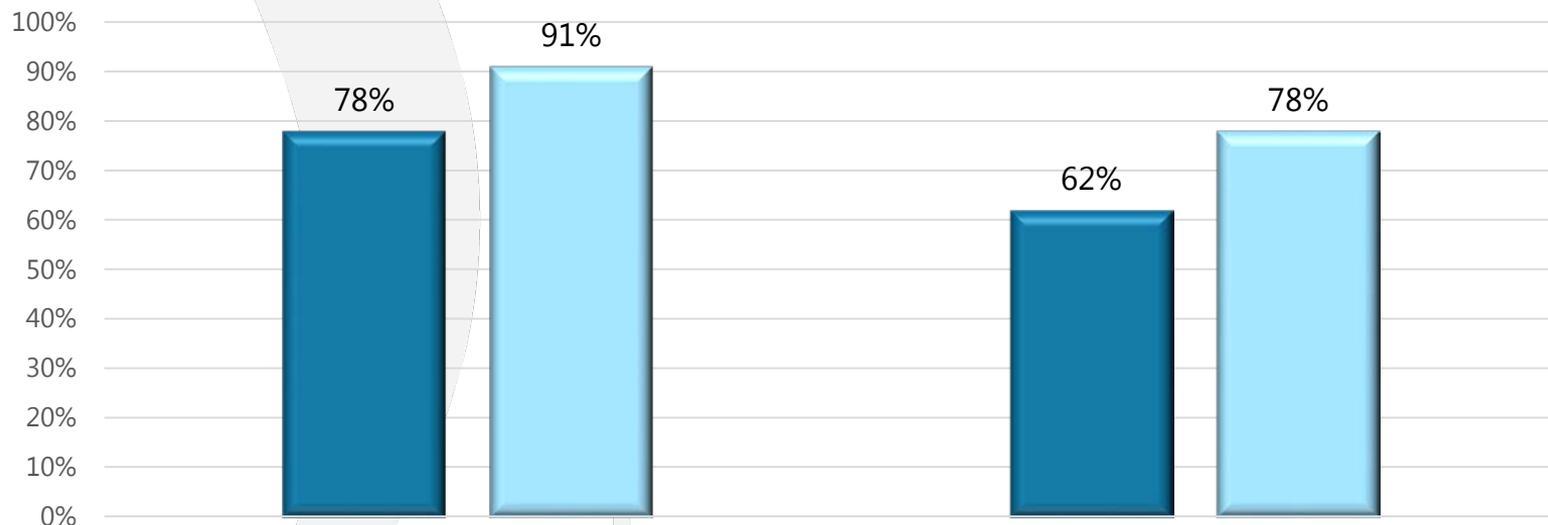
102 Rejections – Key Drivers

- 17 pre-identified practices were used to evaluate the examiner's Office actions

- 5 were deemed **Key Drivers** of overall clarity of the 102 rejections

- Top 2 identified **Key Drivers** include:

When claims were grouped for purpose of rejection, were all grouped claims' limitations clearly addressed?

If an intended use, purpose or result limitation is broader than applicant's presumed interpretation as described in the specification, did the explanation address why the broader interpretation is appropriate?

102 Rejections – Key Drivers, cont.

% Applicable Office Actions Exhibiting Key Driver

When claims were grouped for purpose of rejection, all claim limitations from all grouped claims were clearly addressed: Pre-Pilot 78%, Pilot 91%

If an intended use, purpose, or result limitation is broader that applicant's presumed interpretation as described in the spec, the explanation addressed why the broader interpretation is appropriate: Pre-Pilot 62%, Pilot 78%

Pre-Pilot Office Actions   Pilot Office Actions
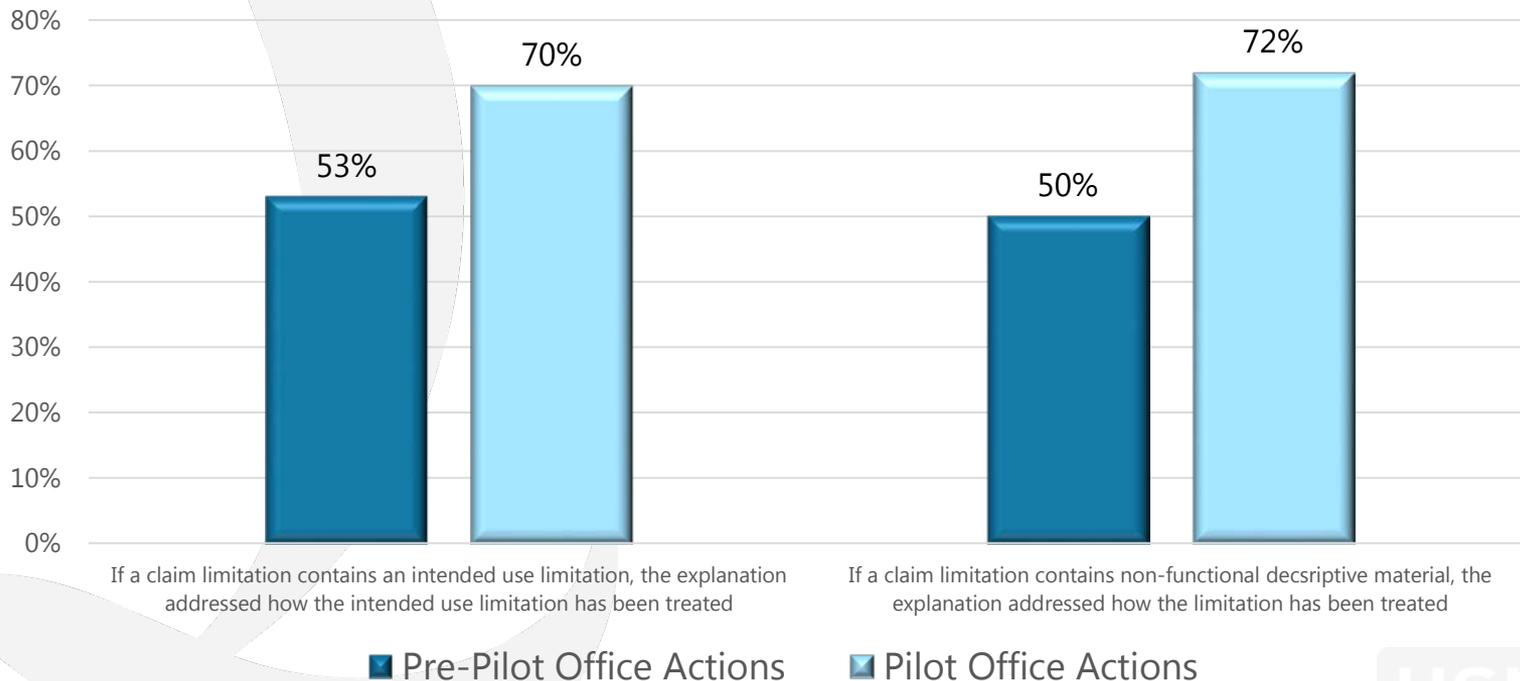
103 Rejections – Key Drivers

- 26 pre-identified practices were used to evaluate the examiner's Office actions

- 7 were deemed to be **Key Drivers** of overall clarity of the 103 rejections

- Top 2 identified **Key Drivers** include:

If a claim contains an intended use limitation, did the explanation address how the intended use limitation has been treated?
If a claim limitation contains non-functional descriptive material, did the explanation address how this limitation has been treated?

103 Rejections – Key Drivers, cont.

% Applicable Office Actions Exhibiting Key Driver

- 53% — If a claim limitation contains an intended use limitation, the explanation addressed how the intended use limitation has been treated (Pre-Pilot Office Actions)
- 70% — If a claim limitation contains an intended use limitation, the explanation addressed how the intended use limitation has been treated (Pilot Office Actions)
- 50% — If a claim limitation contains non-functional decsriptive material, the explanation addressed how the limitation has been treated (Pre-Pilot Office Actions)
- 72% — If a claim limitation contains non-functional decsriptive material, the explanation addressed how the limitation has been treated (Pilot Office Actions)

■ Pre-Pilot Office Actions ■ Pilot Office Actions
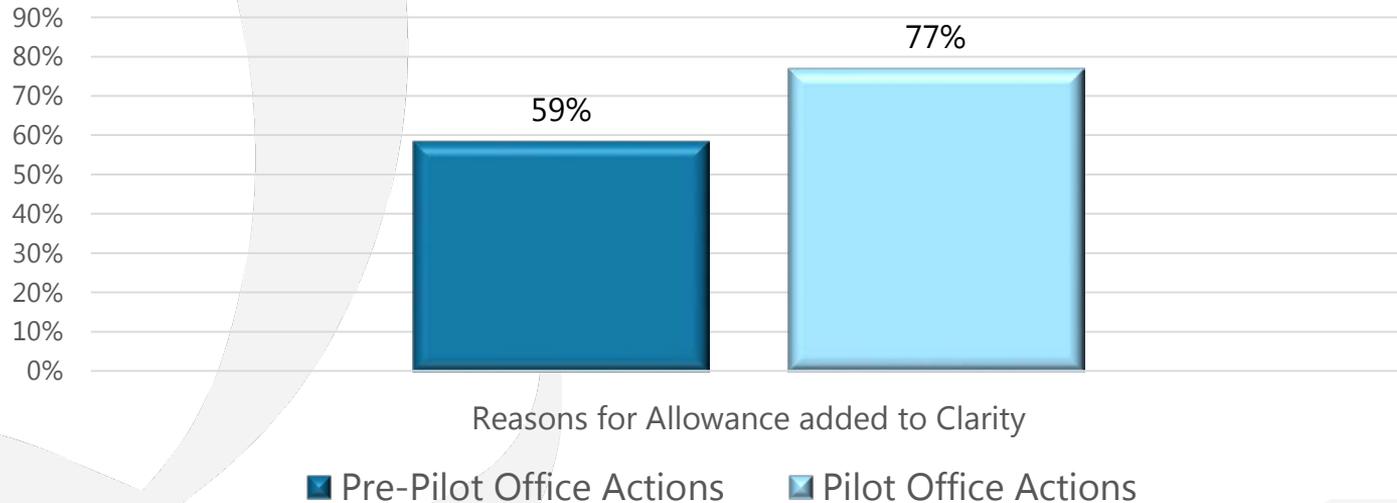
Data – Reasons for Allowance

2 questions on the overall clarity of Reasons for Allowance include:

Does the Office action contain Reasons for Allowance?
Did the reasons for allowance add to the clarity of the record?

Data – Reasons for Allowance, cont.

% Applicable Office Actions where Reasons for Allowance Added to the Clarity of the Record

Results – Additional Practices

Identified Best Practice:

- Pilot Examiners shared best practices with non-Pilot Examiners

Practices that did NOT significantly impact overall clarity:

- Providing an explanation regarding the patentable weight given to a preamble
- Providing an explanation of how relative terminology in a claim is being interpreted
- Providing an explanation for how a claim limitation that was subject to a rejection under 35 U.S.C. 112(b) has been interpreted for purposes of applying a prior art rejection

Lessons Learned

- Require examiners to complete more comprehensive, but balanced, interview summaries

- Provide corps-wide training on enhancing the clarity of interview summaries that focuses on the identified best practices/key drivers

- Utilize the identified best practice of recording claim interpretation to improve the clarity of Office actions *without* detracting from clarity

- Require more comprehensive reasons for allowance

- Provide training on best practices (key drivers)

- Have examiners share their best practices with other examiners by utilizing quality enhancement meetings (QEMs) consistently across Technology Centers

Clarity of the Record – Post Pilot Activity

Surveys

- Surveyed Pilot examiners
- Collected data

Quality Chat

- Shared data results of Pilot

Focus Sessions

- Are best practices still being used?
- Discussed amended cases resulting from Pilot

Clarity of the Record - Next Steps

Monitor Pilot Treated Cases
- Are applicant's arguments more focused?
- Average time to disposal compared to pre-pilot cases?

Applicant Quality Chat
- Focused only on applicants with at least one pilot treated case
- Gather information/thoughts on any differences seen during Pilot time period
- Discuss/share best practices

Full Detailed Report
- 2nd Quarter FY17

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