Clarity of the Record Pilot
To send in questions and comments during the webinar, please email:

PatentQuality@uspto.gov
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.

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
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")

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
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:

<table>
<thead>
<tr>
<th>Question</th>
</tr>
</thead>
<tbody>
<tr>
<td>Was the substance of applicants position described in the interview summary form?</td>
</tr>
<tr>
<td>Was the substance of an agreement or next steps described in the interview summary?</td>
</tr>
<tr>
<td>Were the details of agreement reached recorded?</td>
</tr>
</tbody>
</table>

Email questions to PatentQuality@uspto.gov
Substance of applicant's position described in the interview summary

Substance of an agreement or next steps described in the interview summary

Details of agreement reached

% of Applicable Office Actions Exhibiting Key Drivers

- Pre-Pilot Office Actions
- Pilot Office Actions

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:

<table>
<thead>
<tr>
<th>Question</th>
</tr>
</thead>
<tbody>
<tr>
<td>The examiner clearly stated 35 USC 112(f) presumptions on the record?</td>
</tr>
<tr>
<td>Has the examiner clearly explained on the record how 35 USC 112(f) presumptions are overcome, when applicable?</td>
</tr>
<tr>
<td>Has the examiner clearly identified the corresponding structure for any limitation that involves 35 USC 112(f)?</td>
</tr>
</tbody>
</table>

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

% Applicable Office Actions Exhibiting Key Driver

- Examiner clearly stated 35 USC 112(f) presumptions on the record: 20%
- Examiner clearly explained on the record how 35 USC 112(f) presumptions are overcome: 17%
- Examiner clearly identified the corresponding structure for any limitation that involves 35 USC 112(f): 21%

Email questions to PatentQuality@uspto.gov
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?

Email questions to **PatentQuality@uspto.gov**
When claims were grouped for purpose of rejection, all claim limitations from all grouped claims were clearly addressed.

If an intended use, purpose, or result limitation is broader than applicant’s presumed interpretation as described in the spec, the explanation addressed why the broader interpretation is appropriate.

Email questions to PatentQuality@uspto.gov
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? |

Email questions to PatentQuality@uspto.gov
If a claim limitation contains an intended use limitation, the explanation addressed how the intended use limitation has been treated.

If a claim limitation contains non-functional descriptive material, the explanation addressed how the limitation has been treated.

% Applicable Office Actions Exhibiting Key Driver:

- Pre-Pilot Office Actions:
  - 53%

- Pilot Office Actions:
  - 70%
  - 50%

Email questions to PatentQuality@uspto.gov
Data – Reasons for Allowance

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

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Does the Office action contain Reasons for Allowance?</td>
<td></td>
</tr>
<tr>
<td>Did the reasons for allowance add to the clarity of the record?</td>
<td></td>
</tr>
</tbody>
</table>

Email questions to PatentQuality@uspto.gov
Data – Reasons for Allowance, cont.

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

- 59% Pre-Pilot Office Actions
- 77% Pilot Office Actions

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
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

Email questions to PatentQuality@uspto.gov
We Want to Hear from You!

Please send all your questions and comments to
PatentQuality@uspto.gov
for discussion now