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A blurred, close-up image of a lens or optical component, showing a red and white reflective surface, positioned at the top of the slide.

Patent Quality Roundtable

USPTO Rocky Mountain Regional Office
Wednesday, October 21, 2015

Leading in Quality Excellence – Every Interaction Counts

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2

Agenda

- Introduction
- Update on the Enhanced Patent Quality Initiative (EPQI)
- Improving Patent Quality through Remote Examiner Interviews
- Clarity of the Record: A Shared Responsibility



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3

Creating a World-Class Patent System

This is the Right Time for a Greater Focus on Quality

- America Invents Act (AIA) provides USPTO with a stable budget
- USPTO continues to reduce patent application inventory and pendency
- On-going investments in IT and training provide an opportunity to improve quality in our patent system
- USPTO has always made patent quality a priority



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4

Creating a World-Class Patent System NOW

This is the Right Time for a Greater Focus on Quality

- With the addition of Post Grant Review by the Patent Trial and Appeal Board (PTAB) under the AIA, issued patents can be under greater scrutiny
- Non-practicing entities continue to be a concern to the public; frivolous lawsuits hurt the IP system as well as the economy
- With clarity of patent rights comes certainty in patent rights making IP-intensive industry stronger
- USPTO has always made patent quality a priority



5

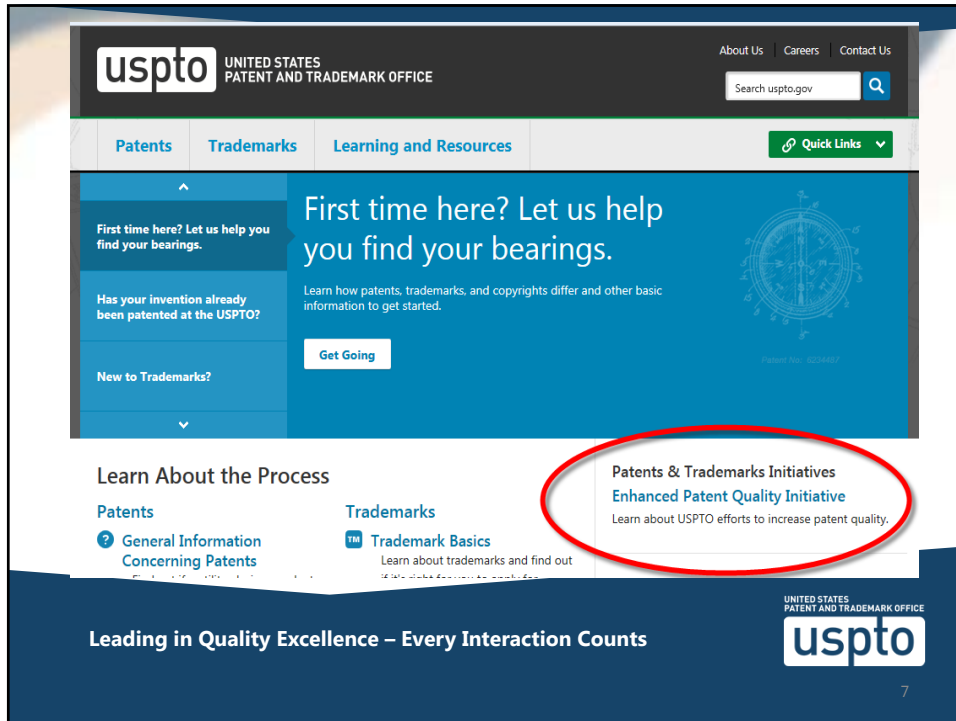
Update on the Enhanced Patent Quality Initiative

Kathleen Bragdon & Tom Hughes
Senior Advisors to the Deputy
Commissioner for Patent Quality, USPTO

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6



Enhanced Patent Quality Initiative - Background

- In February, the USPTO presented six proposals to stimulate the public’s thinking on patent quality (see 80 Fed. Reg. 6475 (Feb. 5, 2015))
- Enhanced patent quality is built around three patent quality pillars:
 - I. Excellence in Work Product
 - II. Excellence in Measuring Patent Quality
 - III. Excellence in Customer Service



Initial Proposals of the Enhanced Patent Quality Initiative

- I. Excellence in work products
 1. Applicant requests prosecution review of selected applications
 2. Automated pre-examination search
 3. Clarity of the record

- II. Excellence in measuring patent quality
 4. Review/improvements to quality metrics

- III. Excellence in customer service
 5. Review of current compact prosecution model and effect on quality
 6. In-person interview capability with all examiners



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9

Comments on the Enhanced Patent Quality Initiative

- Comments and suggestions on the Enhanced Patent Quality Initiative (EPQI) have been collected from a variety of sources:
 - Two-Day Patent Quality Summit (held on March 25-26, 2015)
 - Federal Register Notice Comment Period (closed May 20, 2015)
 - Internal examiner forums and feedback forms
 - Roadshows and roundtables across the country
- We continue to EPQI collect feedback via our mailbox WorldClassPatentQuality@uspto.gov



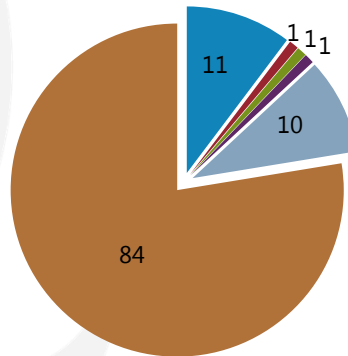
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10

Official Federal Register Responses

108 Responses/Emails

- IP Organizations and Associations
- Government Agencies
- Academic and Research Institutions
- Law Firms
- Companies
- Individuals



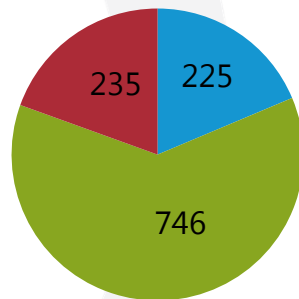
All responses in their entirety have been published at:

<http://www.uspto.gov/patent/laws-and-regulations/comments-public/comments-request-comments-enhancing-patent-quality>

11

Submissions – All Sources

1206 Submissions*



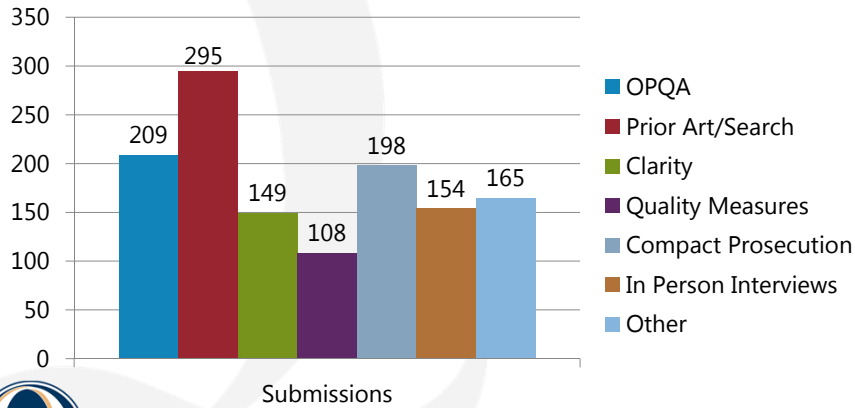
- Internal
Includes Examiner Forum/Feedback and WCPQ Internal
- Patent Quality Summit
- WCPQ - External



* Response/emails were broken into submissions based on proposal categories. Each email/response, therefore, may map to more than one submission.

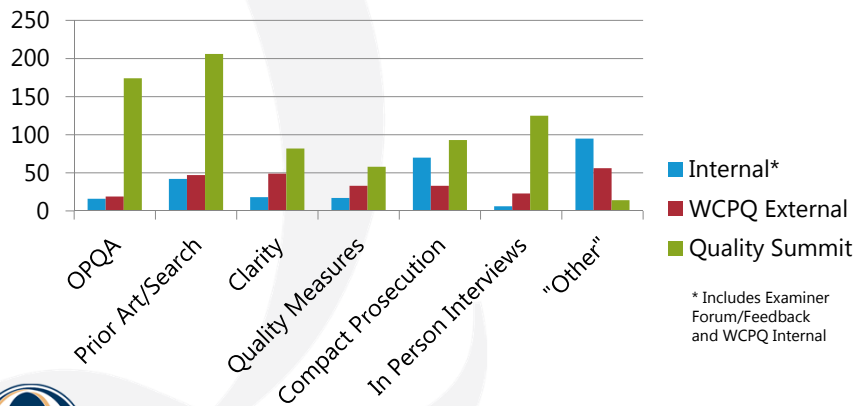
12

Topic Distribution – All Sources



13

Topic Distribution – By Source



* Includes Examiner Forum/Feedback and WCPQ Internal



14

“Other” Topic Distribution

- Additional Examiner/SPE Resources
- More Time for Examiners
- Improved/Additional Examiner Training
- Examiner Performance Appraisal Plans/Awards
- Miscellaneous



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15

Emerging Themes from Comments

- Having examiners clearly articulate their position on the record is a critical component of quality
- The USPTO needs to differentiate between measures of patent process and patent product
- The quality of the interview is much more important than the type of the interview (e.g., telephonic, video conferencing, in-person)



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16

Next Steps

- Develop programs to address these emerging themes and continue to collect feedback through:
 - WorldClassPatentQuality@uspto.gov email box
 - Patent Quality Chat Webinar Series
 - Patent Quality Roadshows
- Use all feedback in the evolution of these programs
- Continue to encourage stakeholder involvement by means of providing feedback, attending outreach events, and participating in pilot programs



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17

Open Forum Enhanced Patent Quality Initiative

Kathleen Bragdon & Tom Hughes
Senior Advisors to the Deputy Commissioner for Patent Quality, USPTO

Adam Gianola, Associate, Kilpatrick Townsend & Stockton LLP

Aaron Brodsky, Chief IP Counsel, Trimble Navigation Limited

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18



Improving Patent Quality Through Remote Examiner Interviews



Tom Hughes
Senior Advisor to the Deputy Commissioner
for Patent Quality, USPTO

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19

Overview

- Interview Survey Results
- WebEx Interviews
- Authorization Policy
- Interview Resources
 - Interview Specialist
 - Public Interview Rooms
 - Website & Email box



20

Interview Surveys

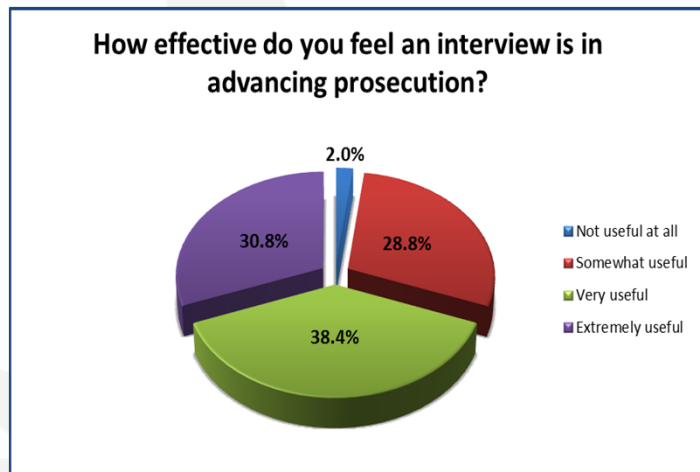
- Surveys on interviews for both Examiners and Applicants were conducted in 2014
- Learn more about interview practice during prosecution
- Identify training opportunities



21

Interview Survey Results

- For advancing prosecution, Applicants were very positive.



22

Interview Survey Summary

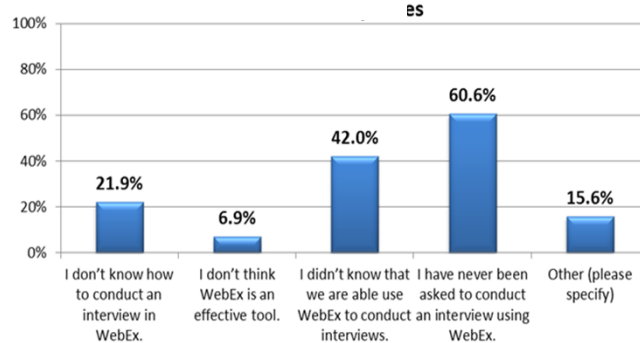
- Most interviews are initiated by Applicants according to both surveys
- 99% of Applicants indicated that request for interviews are usually granted.



23

Training Opportunities

If you have never held a WebEx interview what is the primary reason? Check all that apply.



24

Verbal Authorization for Video Conferencing

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

- Policy has been updated to make it easier for Applicants to authorize the use of video conferencing tools to conduct examiner interviews.
- MPEP § 502.03 now allows a verbal request to authorize a WebEx interview, instead of submitting a written request.
- The verbal authorization is limited to the video conference interview and does not extend to other communications regarding the application.



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25

Automated Interview Request (AIR) Form

- New web-based tool that allows Applicants to schedule an interview with an Examiner for their pending patent application.
- Enables an Applicant to submit a request for an interview from our Interview Practice website (<http://www.uspto.gov/patent/laws-and-regulations/interview-practice>) by simply filling out the AIR form. The request will then be sent directly to the Examiner's E-mail box.



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26

Automated Interview Request (AIR) Form (con't)

- The submitted AIR form will provide the authorization (MPEP §502.03) needed for internet communication between the Applicant and the Examiner and will be in effect until the Applicant provides a written withdrawal of authorization to the Examiner of record.
- The proposed interview date/time must be at least one week from the date of the request.
- Applicant should receive a communication from the Examiner within 2 business days via either the telephone or E-mail.



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27

USPTO Automated Interview Request (AIR) Form

Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned and any practitioner of record or acting in a representative capacity in accordance with 37 CFR 1.33 and 37 CFR 1.34 concerning a subject matter of this application via video conference or electronic mail. I understand that a copy of these communications will be made of record in the application file.

I acknowledge that this communication will be recorded as part of the application file.

*Name:

Registration Number: (5 Digit Numeric Only: 12345)

*U.S. Serial 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 at least one (1) week later than current date:
(Note: Confirmation of actual interview date and time will be arranged between examiner and requester)

MM DD YYYY Time (EST)

*Proposed Type of Interview: Please select a 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

28

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.



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29

Click Link for Examiner

Open the email containing the WebEx online meeting invitation and click on the link to join the visual component of the online meeting.

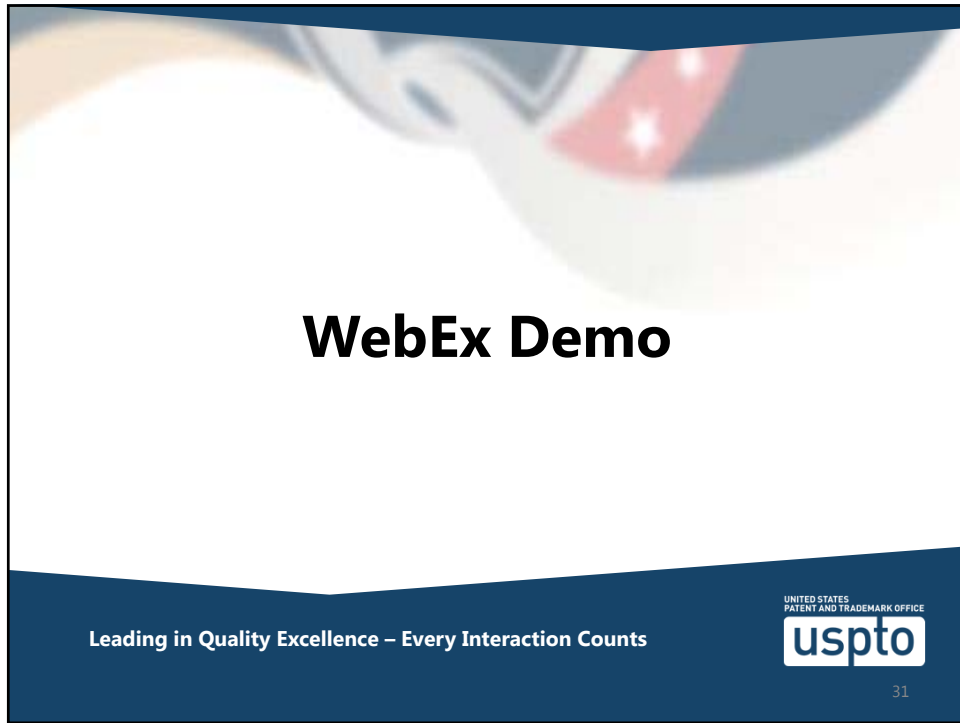
To join the online meeting (Now from mobile devices!)

1. Click the following link: [Join the meeting](#)
2. If requested, enter your name and email address.
3. If a password is required, enter the meeting password:
4. Click "Join".



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30

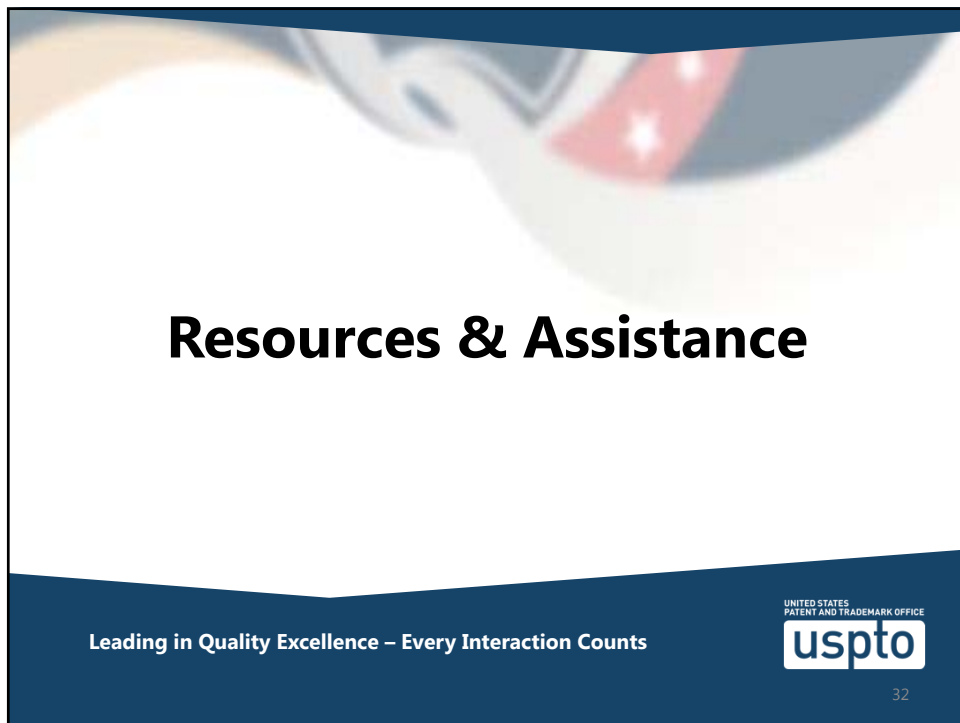


WebEx Demo

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31



Resources & Assistance

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32

Interview Specialist

- 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>



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33

WebEx Training & Assistance

- Applicants who are interested in more detailed WebEx training may request a **one-on-one** WebEx training session with an interview specialist.
- Please email your request to ExaminerInterviewPractice@USPTO.gov
 - Include preferred dates and times
 - Please give at least one week notice



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Email questions to PatentQualityEventParticipationBox@uspto.gov

34

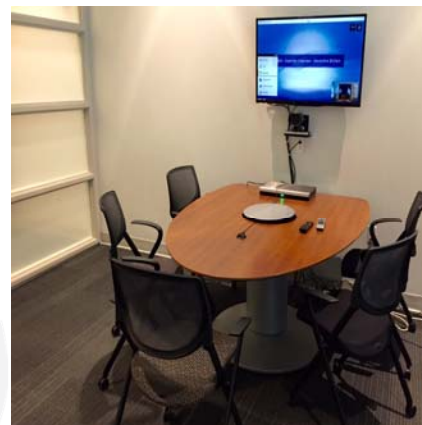
Public Interview Rooms

- A Public Interview Room is a video conference room on each USPTO campus designated for Applicants to use to connect and collaborate with examiners that are working remotely or at a different USPTO campus
- Currently in Alexandria, Detroit & Denver
- Coming soon to San Jose & Dallas



Public Interview Rooms

- Must be reserved by Examiner at least two business days prior to interview.
- Written or verbal authorization to communicate electronically is required prior to reserving a public interview room (see MPEP § § [502.03](#) and [713.01](#), and 80 Fed. Reg. 23787, April 2015).



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36

Website

- USPTO.GOV
 - Policies
 - Training
 - FAQs
 - Contacts
- Comments & Questions
ExaminerInterviewPractice@USPTO.gov

The screenshot shows the USPTO website's 'Interview Practice' page. At the top, the USPTO logo and navigation links are visible. The page title is 'Interview Practice'. A central graphic features a map of the United States with the text 'INTERVIEWS FROM WHEREVER YOU CONNECT' and icons of people connected by lines. Below this, there is a 'Survey' section with a blue checkmark icon and a 'Federal Register Notice' section. The page number '37' is located at the bottom right.

Clarity of the Record - A Shared Responsibility

Tom Hughes
 Senior Advisor to the Deputy Commissioner
 for Patent Quality, USPTO



Clarity of the Record

- Ensure that a complete and comprehensive record is created
- Improve the communication between Examiner and Applicant throughout prosecution
- Reduce prosecution costs and prosecution time
- Reduce the patent-related risks in launching products and starting or investing in businesses
- Provide the public with the benefit of better knowing the boundaries of an exclusionary right
- Minimize the risk of costly and avoidable litigation



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39

Clarity of the Record: Summit Discussion

- Current best practices in Office actions
- Potential impact downstream (litigation/enforcement)
- Whether the Office should provide an explicit claim construction in the record
- Making the substance of interviews more extensive on the record
- Explanation on the record concerning the decision made in pre-appeal / appeal conferences
- Desirability of explicit reasons for allowability during prosecution



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40

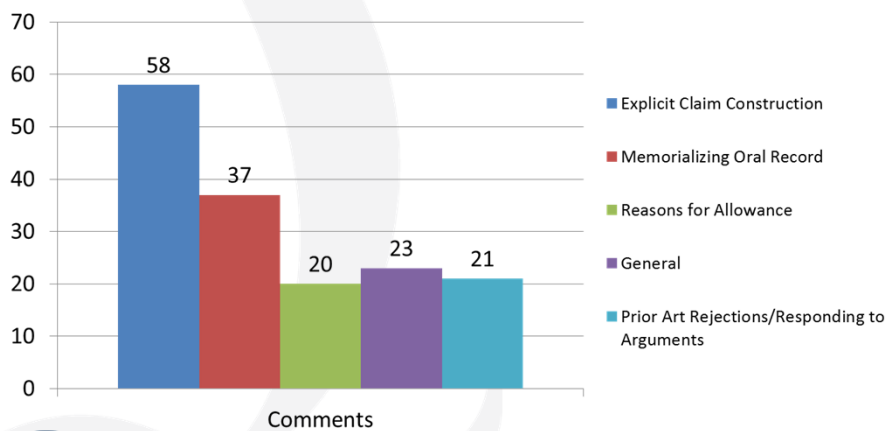
Distribution of Public Comments on Clarity of the Record

- Explicit Claim Construction
- Memorializing the Oral Record
- Reasons for Allowance
- Prior Art Rejections/Responding to Arguments
- General



41

Clarity Of Record Comment Distribution



42

Explicit Claim Construction - Comments

- Many supported providing some level of claim construction because it gives the public adequate notice of the scope of the inventor's exclusionary rights
- Some raised the concern that explicit claim construction in the record presents a major problem of file wrapper estoppel



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43

Explicit Claim Construction – Comments (con't)

- When should explicit claim construction be made in the record?
 - As a requirement for construing certain terms (*i.e.* when claim terms are not clearly defined or supported in the specification)
 - To address the issue of a limiting preamble and/or means/functional language
 - At the Examiner's discretion, when necessary



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44

Memorializing the Oral Record - Comments

- Many supported a more detailed interview summary:
 - Clarification of claim terms
 - Accurate summary of discussion
 - Why agreement was reached
- Some raised the concern that recordation/transcription of interviews could create a chilling effect on both Applicants and Examiners
- Others suggested continuing current interview recordation practice as it provides the correct balance



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45

Memorializing the Oral Record – Comments (con't)

- Many supported a more detailed pre-appeal brief conference decision
- Many supported providing details regarding appeal conference decisions



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46

Reasons for Allowance - Comments

- When should a reasons for allowance be provided?
 - Most agreed that there should be some reason given in the prosecution record:
 - Clarify claim construction used in prosecution
 - Understand Examiner's position
 - Aid parties in future litigation
 - Some believed that explicit statements of reasons for allowance should only be necessary when the prosecution record is unclear (in accordance with current MPEP requirements)



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47

Prior Art Rejection / Response - Comments

- Minimize the occurrence of incomplete or poor quality Office actions
- In § 103 rejections, the examiner should provide reasons for combining references and explain the reasons for all claims
- Provide improved training on, and enforce use of, form paragraphs
- Examiners should explain inherency positions



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48

General Comments

- 35 U.S.C. §112 is under-utilized by Examiners
- Applicant should provide an explicit invocation of 35 U.S.C. § 112(f)
- Require Applicant to show support for claim amendments when words are not verbatim in specification



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49

PANEL DISCUSSION

Clarity of the Record – A Shared Responsibility

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50



PANEL DISCUSSION

Clarity of the Record – A Shared Responsibility

- Explicit Claim Construction
- Memorializing the Oral Record
- Reasons for Allowance
- Prior Art Rejections/Responding to Arguments

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51



THANK YOU!



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52

