USPTO partnering with NYIPLA and Fordham IP Institute to present

USPTO Patent Quality Overview

Wednesday, July 29, 2015
Fordham IP Institute, New York, NY
OPENING REMARKS

Valencia Martin Wallace
Deputy Commissioner for Patent Quality

Today’s Agenda

– Introduction to the USPTO’s Enhanced Patent Quality Initiative
– Clarity of Record
– Collaboration Tools for Interviews
Introduction to the Enhanced Patent Quality Initiative

Valencia Martin Wallace
Deputy Commissioner for Patent Quality

Moderator: Janet Gongola
Senior Advisor, Office of the Under Secretary for Intellectual Property
and Director of the USPTO

Leading in Quality Excellence – Every Interaction Counts

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
Office of Quality Management

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Patents Organization

Commissioner for Patents

Deputy Commissioner for Patent Examination Policy
Deputy Commissioner for Patent Operations
Deputy Commissioner for Patent Quality
Deputy Commissioner for Patent Administration
Deputy Commissioner for International Patent Cooperation

Office of Process Improvement
Office of Patent Training
Office of Ombudsman/Stakeholder Outreach
Office of Patent Quality Assurance
Office of Quality Management

Office of Process Improvement
- Processes Audits & Recommendations
- Provides Coordinated Analysis and Monitoring
- Advises on Process Improvements
- Analyzes Trends
- Defines Standards/Metrics

Office of Process Improvement (OPI)

Office of Patent Training
- Provides Training Assistance
- Provides Enhanced Practices/Procedures
- Recommends Corrective Action & Preventive Action, as needed
- Analyzes Trends
- Defines Standards/Metrics
- Advances Legal and Technical Training

Office of Patent Training (OPT)

Office of Patent Quality Assurance (OPQA)
- Performs Quality Reviews
- Ensures ISO Compliance
- Analyzes Trends
- Defines Standards/Metrics
- Provides Feedback

Office of Patent Quality Assurance

Office of Ombudsman and Stakeholder Outreach
- Performs Incident Management
- Handles Complaints
- Provides Internal/External feedback
- Performs Trend Analysis
- Defines Standards/Metrics
- Handles External Partnering/Engagement

Office of Ombudsman and Stakeholder Outreach

USPTO’s Enhanced Patent Quality Initiative

Visit USPTO’s Enhanced Patent Quality Initiative website at
http://www.uspto.gov/patent/initiatives/enhanced-patent-quality-initiative

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## Current Patent Quality Initiatives

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<th>Internal</th>
<th>External</th>
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<td>– QAS Details</td>
<td>– Patent Quality Chat Webinar Series</td>
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<td>– GS-14 Trainer Program</td>
<td>– Ombudsman Hours by Time Zone</td>
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<tr>
<td>Expansion</td>
<td>– Patent Quality Roadshows (Fall 2015)</td>
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<td>– Search Analysis Program</td>
<td>– Federal Register Public Comments Analysis</td>
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<td>– Peer Interaction Meetings</td>
<td>– Patent Quality Summit Comments Analysis</td>
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<td>– QAS Assistance in TCs</td>
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<td>– Interview Specialists</td>
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<tr>
<td>– Training</td>
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<td>• 35 USC § 112(f)</td>
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<td>• 35 USC § 101</td>
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## Proposed Enhanced Patent Quality Initiative

– In February, the USPTO proposed six initiatives to enhance patent quality (80 Fed. Reg. 6475 (Feb. 5, 2015))

– These six initiatives are built around three pillars:

I. Excellence in Work Product

II. Excellence in Measuring Patent Quality

III. Excellence in Customer Service
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

Comments on USPTO’s Enhanced Patent Quality Initiative

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Comments on the Enhanced Patent Quality Initiative

- Comments and suggestions on the enhanced patent quality initiative have been collected from a variety of sources:
  - Federal Register Notice Comment Period (closed May 20, 2015)
  - Internal examiner forums
- We are still collecting comments and suggestions through our World Class Patent Quality (WCPQ) mailbox (worldclasspatentquality@uspto.gov)

Official Federal Register Responses

107 Responses/Emails

- IP Organizations and Associations: 11
- Government Agencies: 10
- Academic and Research Institutions: 1
- Law Firms: 1
- Companies: 83
- Individuals: 11
Submissions – All Sources

1206 Submissions*

- Examiner Forum/Feedback (161)
- Patent Quality Summit (746)
- WCPQ - External (235)
- WCPQ - Internal (64)

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

Submissions – All Sources

1206 Submissions

- Internal (225)
- Includes Examiner Forum/Feedback and WCPQ Internal
- Patent Quality Summit (746)
- WCPQ - External (235)
### Topic Distribution – All Sources

![Bar chart showing topic distribution for all sources.](chart1.png)

- **OPQA**: 209 submissions
- **Prior Art/Search**: 295 submissions
- **Clarity**: 149 submissions
- **Quality Measures**: 108 submissions
- **Compact Prosecution**: 198 submissions
- **In Person Interviews**: 154 submissions
- **Other**: 165 submissions

### Topic Distribution – By Source

![Bar chart showing topic distribution by source.](chart2.png)

- **Internal**: 0 submissions
- **OPQA**: 0 submissions
- **Prior Art/Search**: 0 submissions
- **Clarity**: 50 submissions
- **Quality Measures**: 100 submissions
- **Compact Prosecution**: 150 submissions
- **In Person Interviews**: 200 submissions
- **Other**: 250 submissions

*Includes Examiner Forum/Feedback and WCPQ Internal*
“Other” Topic Distribution

– Additional Examiner/SPE Resources
– More Time for Examiners
– Improved/Additional Examiner Training
– Examiner PAP/Awards
– Miscellaneous

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)
Next Steps

– We will continue to collect comments through:
  • WorldClassPatentQuality@uspto.gov email box
  • Patent Quality Chat Webinar Series
  • Patent Quality Roadshows
– We will analyze the comments and develop recommendations for moving forward

QUESTIONS?

Enhanced Patent Quality Initiative

Valencia Martin Wallace
Deputy Commissioner for Patent Quality
Clarity of the Record

Brian Hanlon
Director, Office of Patent Legal Administration

Clarity of the Record Initiative

- 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
Clarity of the Record Initiative: 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

Clarity of the Record Topics

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

All Sources

<table>
<thead>
<tr>
<th>Comments</th>
<th>Explicit Claim Construction</th>
<th>Memorizing Oral Record</th>
<th>Reasons for Allowance</th>
<th>General</th>
<th>Prior Art Rejections/Responding to Arguments</th>
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<td>37</td>
<td>20</td>
<td>23</td>
<td>21</td>
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</table>

* Includes Examiner Forum/Feedback and WCPQ/Internal

Clarity Of Record Comment Distribution

By Source

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</tr>
</thead>
<tbody>
<tr>
<td>Internal*</td>
<td>9</td>
<td>1</td>
<td>1</td>
<td>7</td>
<td>1</td>
</tr>
<tr>
<td>WCPQ External</td>
<td>20</td>
<td>14</td>
<td>11</td>
<td>5</td>
<td>1</td>
</tr>
<tr>
<td>Quality Summit</td>
<td>29</td>
<td>11</td>
<td>8</td>
<td>4</td>
<td>1</td>
</tr>
</tbody>
</table>

* Includes Examiner Forum/Feedback and WCPQ/Internal
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

Explicit Claim Construction - Comments

- 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
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

Memorializing the Oral Record - Comments

- Many supported a more detailed pre-appeal brief conference decision
- Many supported providing details regarding appeal conference decisions
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
     o Clarify claim construction used in prosecution
     o Understand Examiner's position
     o 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)

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
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

QUESTIONS?
Clarity of the Record

Brian Hanlon
Director, Office of Patent Legal Administration
PANEL DISCUSSION
Clarity of the Record

Brian Hanlon
Director, Office of Patent Legal Administration
Valencia Martin Wallace
Deputy Commissioner for Patent Quality

Mark Bloomberg, Esq.
Zuber Lawler & Del Duca
Robert Rando, Esq.
The Rando Law Firm P.C.

Face-to-Face Examiner Interviews
A Demonstration of USPTO Tools

Timothy Callahan
Director, Technology Center 2400
Overview

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

Interview Surveys

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

- For advancing prosecution, Applicants were very positive.

How effective do you feel an interview is in advancing prosecution?

- Not useful at all: 2.0%
- Somewhat useful: 30.8%
- Very useful: 28.8%
- Extremely useful: 38.4%

Interview Survey Results

How often do you get an explanation of the rejection during an interview?

- Applicant: 88.3%
- Examiner: 87.9%
Interview Survey Results

How often do clarification or better understanding of positions occur during an interview?

- Applicant: 97.6%
- Examiner: 95.0%

Interview Survey Results

How often does a better understanding of the claimed invention occur during an interview?

- Applicant: 93.5%
- Examiner: 83.7%
Interview Survey Results

How often reaching an agreement or advancing prosecution occur during an interview?

- 81.1% of Applicants
- 92.6% of Examiners

Interview Survey Summary

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

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

- I don't know how to conduct an interview in WebEx: 21.9%
- I don't think WebEx is an effective tool: 6.9%
- I didn't know that we are able to use WebEx to conduct an interview using interviews: 42.0%
- I have never been asked to conduct an interview using WebEx: 60.6%
- Other (please specify): 15.6%

WebEx Demo

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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.

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”.
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.

Resources & Assistance

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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

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
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).
Leading in Quality Excellence – Every Interaction Counts
Step 1: Click Emailed Link

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".

Step 2: Sign In

Enter 'Your name' and 'Email address' in the Meeting Center window and click 'Join'.
Step 3: Allow Plug-In

If an Add-On or Plug-In appears and you have administrative privileges to install the application, select ‘Allow’ or ‘Download’ to install and launch the WebEx Application. (Depending on which browser you are using, the dialog box may appear different.)

Step 4: Java Admin Options

If Administrative privileges are not available, users can ‘Use Java’ on Internet Explorer or ‘Run a temporary application’ on Google Chrome and Mozilla Firefox.
Step 5: Call In

To join the audio component of the online meeting, enter your **10 digit phone number** in the Audio Conference Window and click on ‘Call Me’. WebEx will call the entered phone number.

Step 6: Answer Phone

Your phone will ring. Answer it and when prompted, press '1' on the phone dial pad to enter the audio portion of the conference.
Step 7: Start Video

To join the visual component of the online meeting, when the WebEx Meeting starts, click the ‘Start my video’ button next to your name in the participants list.

Conducting WebEx Interviews

- Conducting the Video Conference - Presenter

Designating a presenter

The first person to arrive is made the presenter, but the Host can assign a Participant the Presenter’s role.

1. On the Participants panel, select a name to designate as the Presenter.
2. Click the Make Presenter button.
3. To reclaim the Presenter’s role, select your own name and click the Make Presenter button.
Conducting WebEx Interviews

• Conducting the Video Conference - Sharing

Sharing Files and Applications

• Share a File to present information that will not be edited.
• Share an Application to demonstrate software, edit a document, or train attendees on using an application.

Note: Desktop sharing is not available for external meetings (interviews)
Note: File must be open for you to share it.
Note: Participant must be Presenter to share

Conducting WebEx Interviews

• Sharing Examples

During an interview, an Examiner can share their eDAN application to e.g., view claims, or EAST application to e.g., discuss a cited reference.
Conducting WebEx Interviews

• Conducting the Video Conference - Sharing

When viewing a document in full-screen mode, or when sharing an application or desktop, use the WebEx Sharing toolbar to access annotation tools. Hover the cursor over the sharing note at top center of the monitor to bring up the Control Panel; see Figure 18.

The Annotate button will display annotation tools that can be used in conjunction with shared materials to call out specific elements; see Figure 19.

Conducting WebEx Interviews

• Annotate Example

During an interview, an Examiner can annotate a shared document, e.g., markup a copy of the claims.

An Examiner can also use the pointer tool to e.g., show applicant where a claimed feature is not positively recited or point to where a claimed feature is taught in a reference.
QUESTIONS?
Face-to-Face Examiner Interviews
A Demonstration of USPTO Tools
Timothy Callahan
Director, Technology Center 2400

CLOSING REMARKS
Valencia Martin Wallace
Deputy Commissioner for Patent Quality
THANK YOU!

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7/30/2015