

The background of this slide is a blurred photograph showing a hand holding a red, glowing object, possibly a piece of technology or a tool, against a light background. The image is out of focus, creating a sense of depth and highlighting the subject matter.

*USPTO partnering with NYIPLA and Fordham IP Institute to present*


## **USPTO Patent Quality Overview**

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

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# OPENING REMARKS

Valencia Martin Wallace  
Deputy Commissioner for Patent Quality


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# Today's Agenda

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



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## 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

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## 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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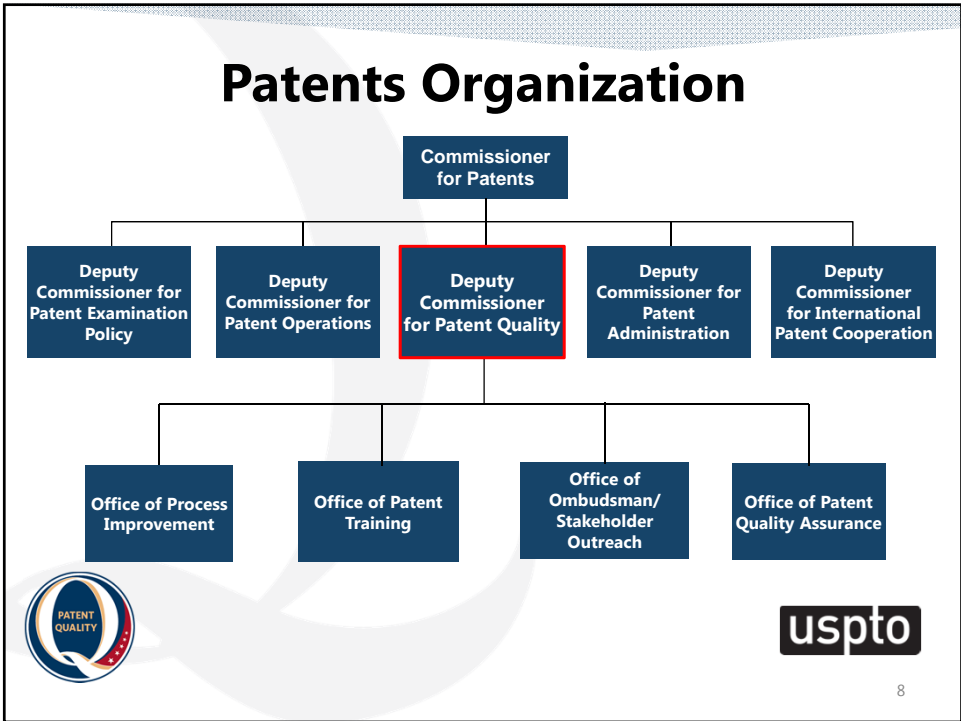


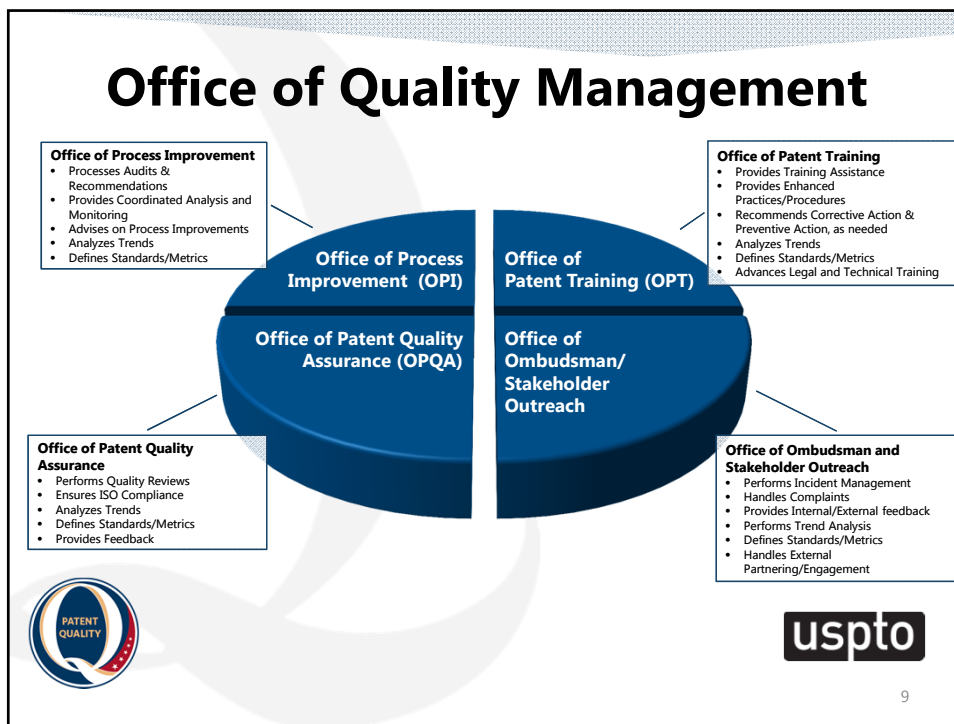
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## USPTO's Enhanced Patent Quality Initiative

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

### Internal

- QAS Details
- GS-14 Trainer Program Expansion
- Search Analysis Program
- Peer Interaction Meetings
- QAS Assistance in TCs
- Interview Specialists
- Training
  - 35 USC § 112(f)
  - 35 USC § 101

### External

- Patent Quality Chat Webinar Series
- Ombudsman Hours by Time Zone
- Patent Quality Roadshows (Fall 2015)
- Federal Register Public Comments Analysis
- Patent Quality Summit Comments Analysis



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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



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## 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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## 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:
  - Two-Day Patent Quality Summit (held on March 25-26, 2015)
  - 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](mailto:worldclasspatentquality@uspto.gov))



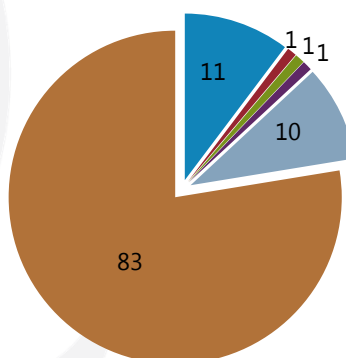
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## Official Federal Register Responses

### 107 Responses/Emails

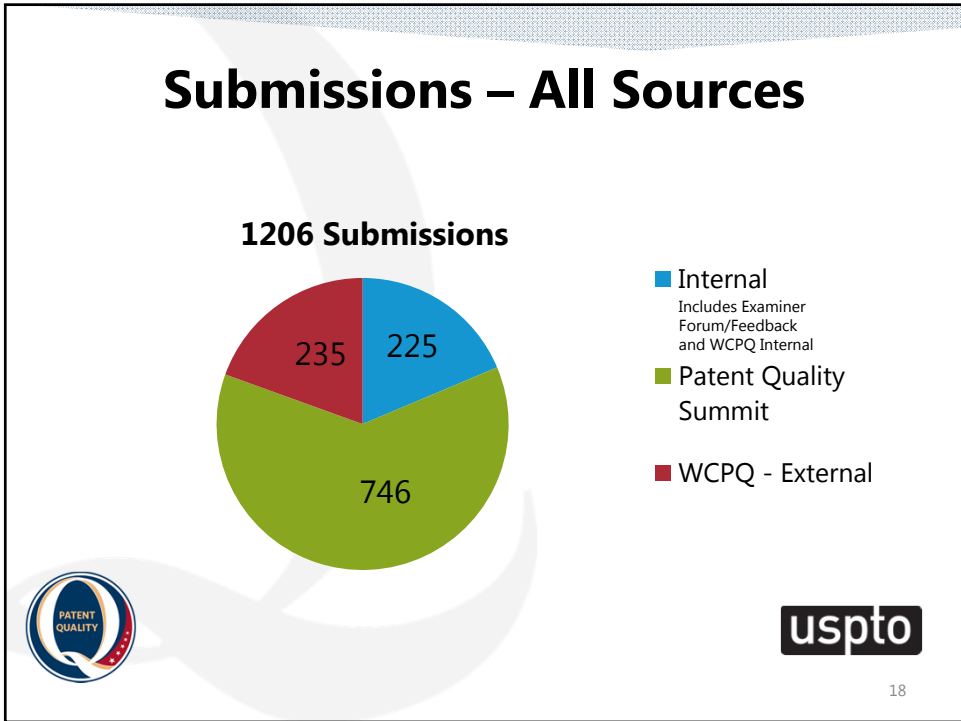
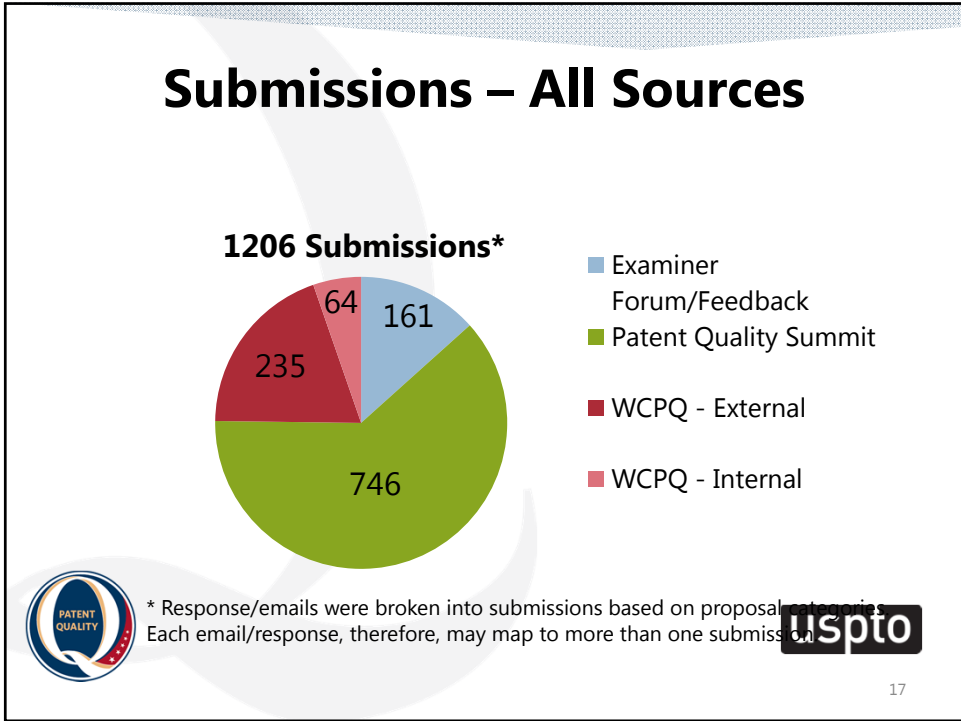
- IP Organizations and Associations
- Government Agencies
- Academic and Research Institutions
- Law Firms
- Companies
- Individuals



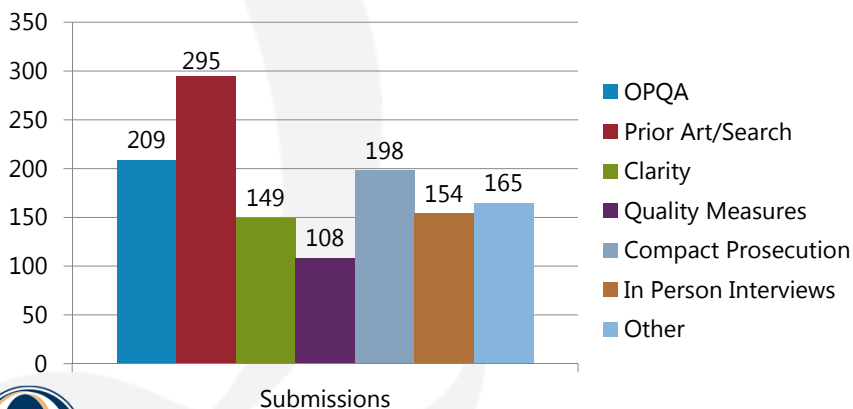
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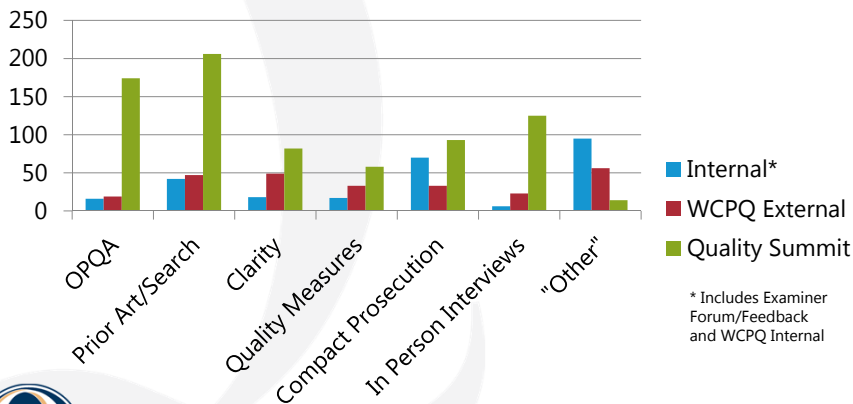


## Topic Distribution – All Sources



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## Topic Distribution – By Source



\* Includes Examiner Forum/Feedback and WCPQ Internal



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## “Other” Topic Distribution

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



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## 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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## Next Steps

- We will continue to collect comments through:
  - [WorldClassPatentQuality@uspto.gov](mailto:WorldClassPatentQuality@uspto.gov) email box
  - Patent Quality Chat Webinar Series
  - Patent Quality Roadshows
- We will analyze the comments and develop recommendations for moving forward



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## QUESTIONS?

### Enhanced Patent Quality Initiative

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Deputy Commissioner for Patent Quality

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## Clarity of the Record

Brian Hanlon  
Director, Office of Patent Legal Administration


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## 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



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## 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



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## Clarity of the Record Topics

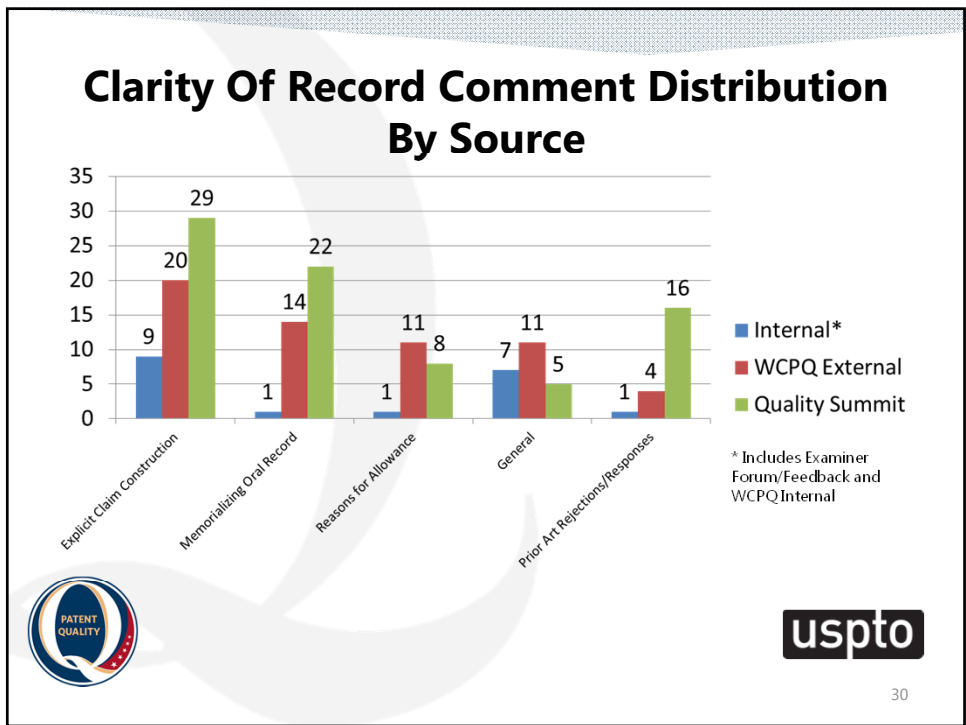
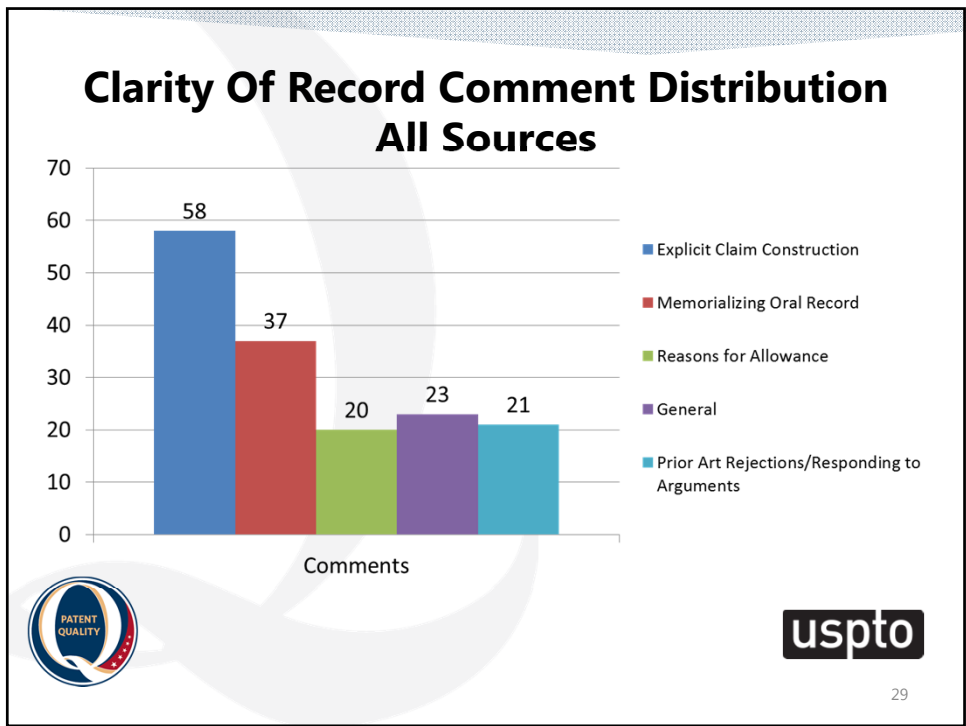
### Distribution of Public Comments:

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



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## 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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## 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



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## 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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## Memorializing the Oral Record - Comments

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



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## 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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## 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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## 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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## QUESTIONS?

### Clarity of the Record

Brian Hanlon  
Director, Office of Patent Legal Administration

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## PANEL DISCUSSION

### Clarity of the Record

**Brian Hanlon**  
Director, Office of Patent Legal Administration

**Valencia Martin Wallace**  
Deputy Commissioner for Patent Quality

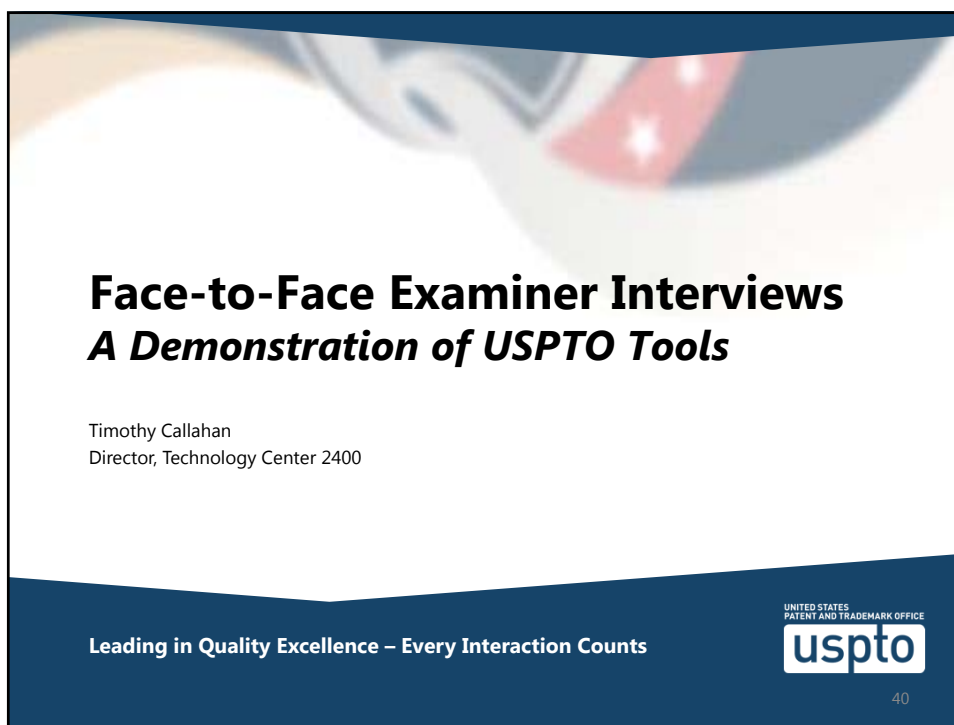
**Mark Bloomberg, Esq.**  
*Zuber Lawler & Del Duca*

**Robert Rando, Esq.**  
*The Rando Law Firm P.C.*

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## Face-to-Face Examiner Interviews

### *A Demonstration of USPTO Tools*

Timothy Callahan  
Director, Technology Center 2400

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## Overview

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



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## Interview Surveys

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



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## Interview Survey Results

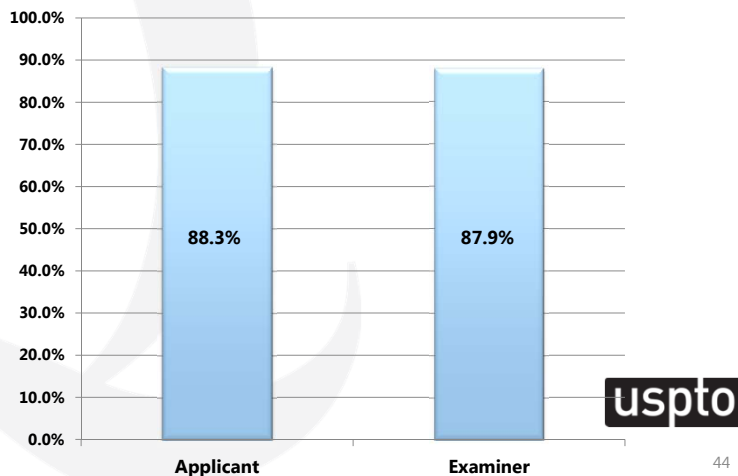
- For advancing prosecution, Applicants were very positive.



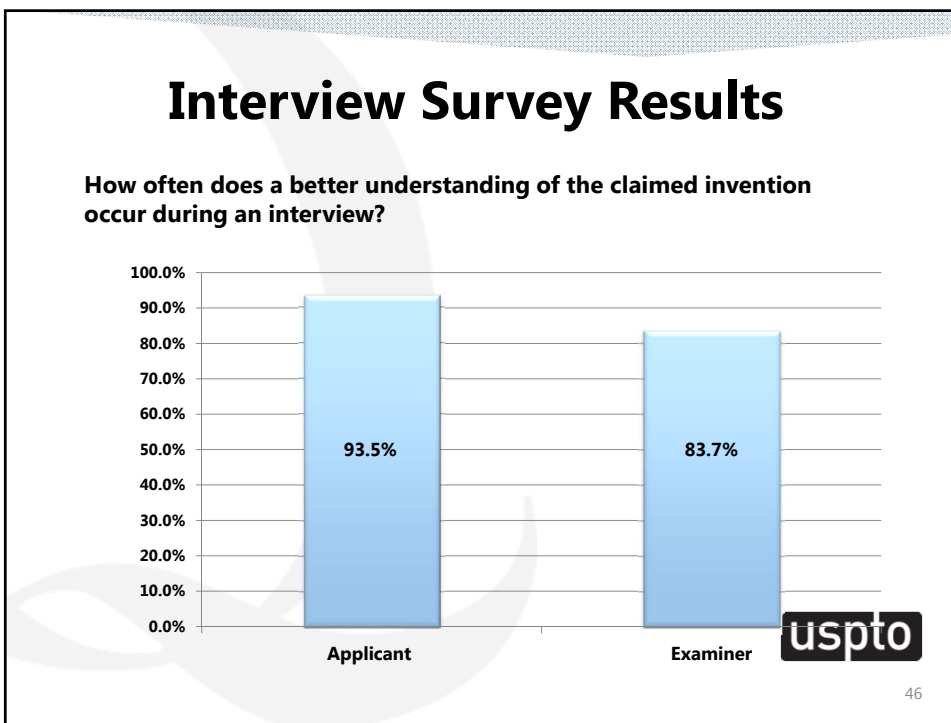
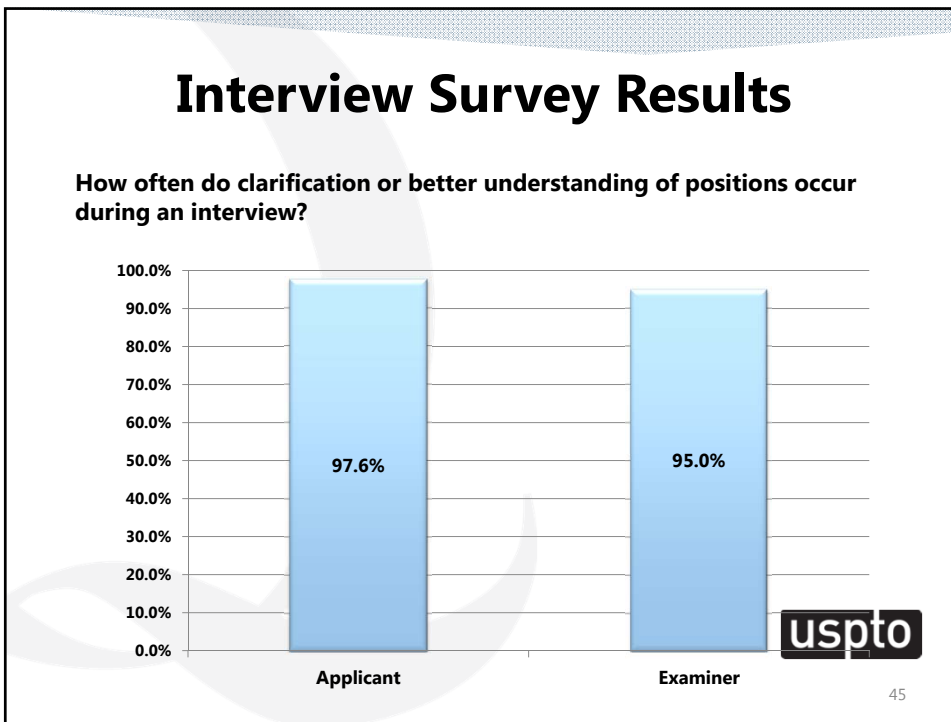
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## Interview Survey Results

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

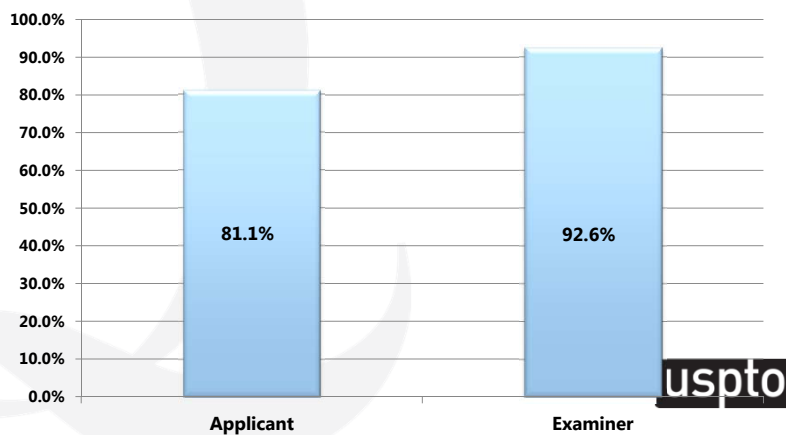


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## Interview Survey Results

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



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## Interview Survey Summary

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

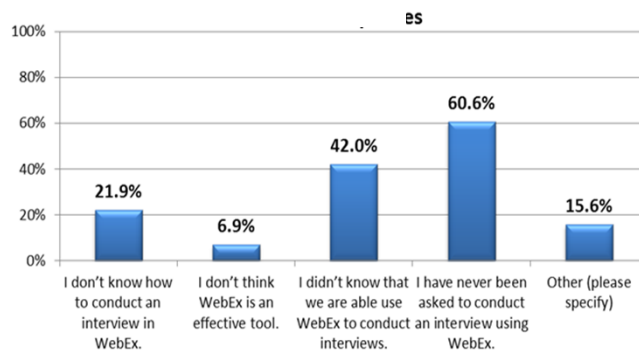


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## Training Opportunities

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



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## 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.



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## 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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## 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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## 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>



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## 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](mailto: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

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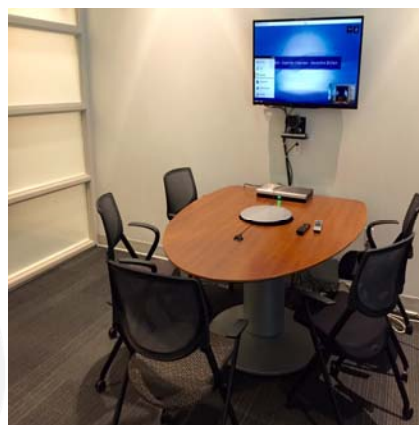
## Public Interview Rooms

- 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).

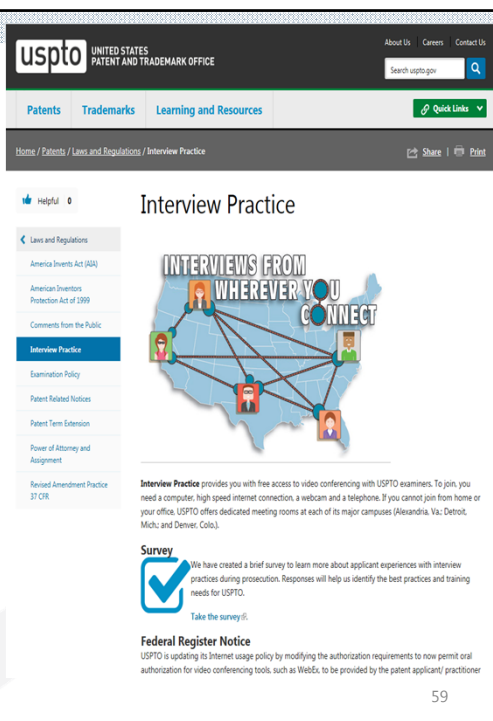


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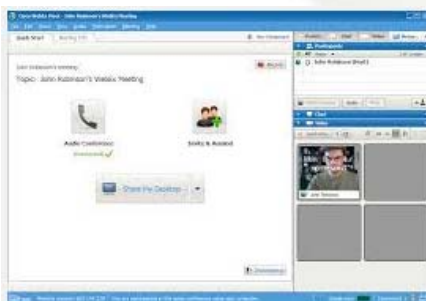
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# Website

- USPTO.GOV
  - Policies
  - Training
  - FAQs
  - Contacts
- Comments & Questions  
[ExaminerInterviewPractice@USPTO.gov](mailto:ExaminerInterviewPractice@USPTO.gov)



# WebEx Demo



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## 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".



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## Step 2: Sign In

Enter '**Your name**' and '**Email address**' in the Meeting Center window and click '**Join**'.

It's time to join!

Your Name:

Email Address:

Meeting password:

Join

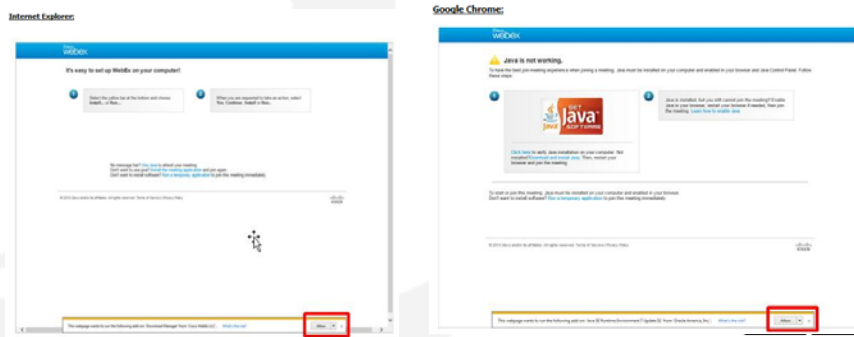


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## Step 3: Allow Plug-In

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.)



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## 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.



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## 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.



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## 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.



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## 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.



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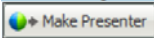
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## Conducting WebEx Interviews

### • 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.



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# 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.

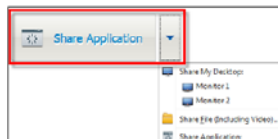


Figure 16. Share Application Menu

Click to expand the **Share** drop-down menu from the main **Quick Start** tab, or the **Share** drop-down menu; see **Figures 16** and **17**.

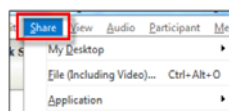


Figure 17. Share Menu



**Note:** Desktop sharing is not available for external meetings (interviews)

**Note:** File must be open for you to share it.

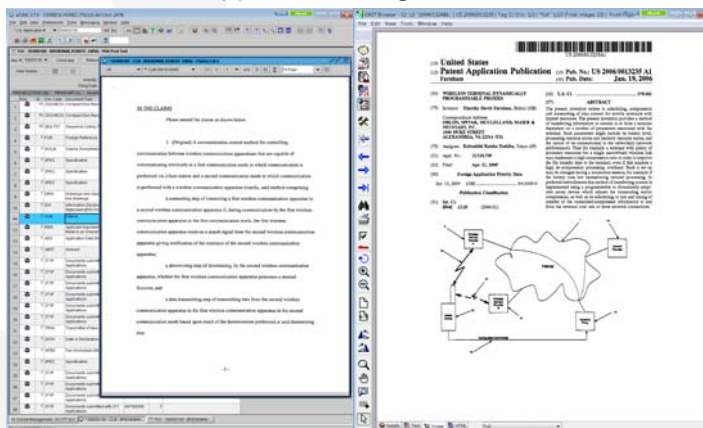
**Note:** Participant must be **Presenter** to share



# 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**.



Figure 18. WebEx Sharing Toolbar



Figure 19. Annotation Tools



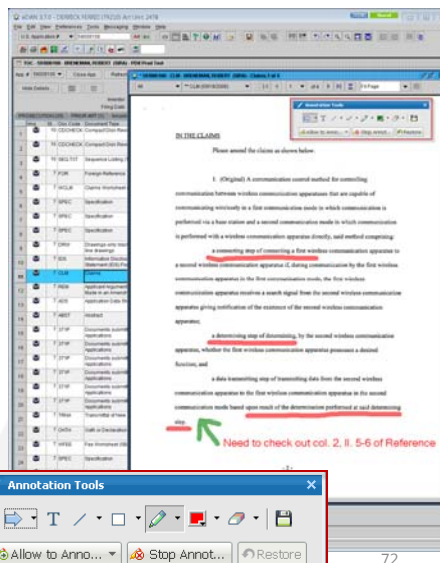
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# Conducting WebEx Interviews

## • Annotate Example

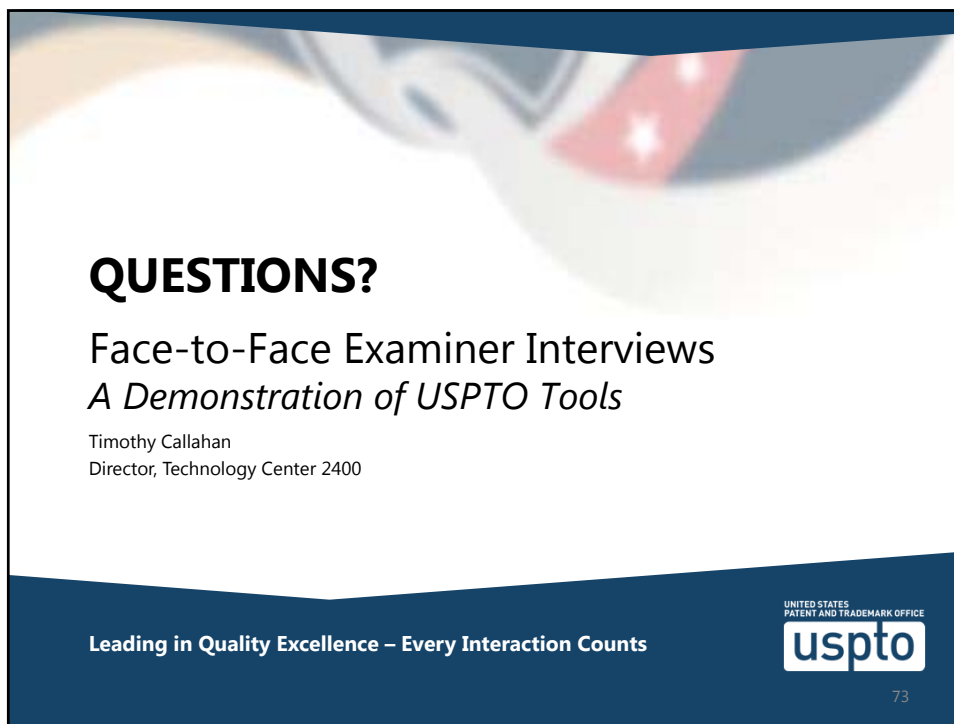
During an interview, an Examiner can annotate a shared document, e.g., **markup** a copy of the claims.

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.



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# QUESTIONS?

## Face-to-Face Examiner Interviews

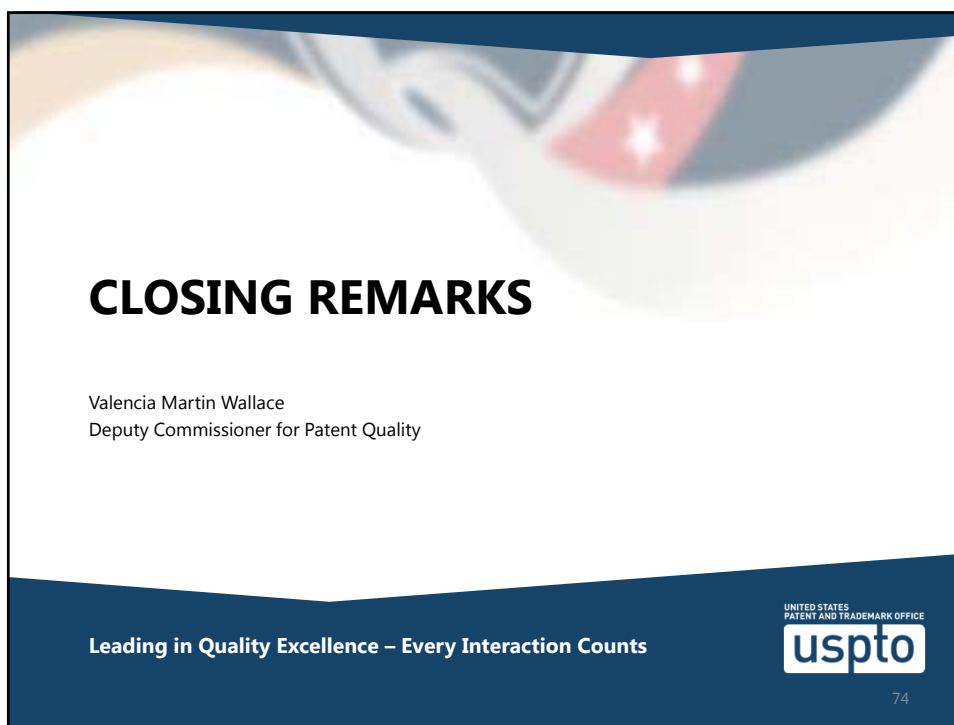
### *A Demonstration of USPTO Tools*

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Director, Technology Center 2400

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# CLOSING REMARKS

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