

NYIPLA/USPTO Quality Check One Year Later

Valencia Martin Wallace
Deputy Commissioner for Patent Quality
June 14, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE



EPQI Programs

Focused on three implementation areas:



Data Analysis

Pillar 1

- **Topic Submission for Case Studies**

Pillar 2

- **Clarity and Correctness Data Capture (Master Review Form or MRF)**
- **Quality Metrics**

Examiners' Resources, Tools & Training

Pillar 1

- **Automated Pre-Examination Search Pilot**
- **STIC Awareness Campaign**
- **Clarity of the Record Training**
- **Post Grant Outcomes**

Pillar 3

- **Interview Specialist**

Changes to Process/Product

Pillar 1

- **Clarity of the Record Pilot**

Pillar 3

- **Post-Prosecution Pilot**
- **Reevaluate QPIDS**
- **Design Patent Publication Quality**



Clarity of the Record Pilot

Wendy Garber

Director, Technology Center 3700

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Clarity of the Record Pilot

Changes to Process/Product

Pillar 1

- **Clarity of the Record Pilot**

Pillar 3

- **Post Prosecution Pilot**
- **Reevaluate QPIDS**
- **Design Patent
Publication Quality**

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



Clarity of the Record Pilot:

This program is designed to:

- Develop **best examiner practices** for enhancing the clarity of various aspects of the prosecution record and
- **Study the impact** on the examination process of implementing these best practices

Clarity of the Record Pilot: Short-Range Goals

- To provide applicant with a better understanding of the Office's positions leading to more efficient prosecution of patent applications
- To afford greater certainty in the scope of protection granted by the patent

Clarity of the Record Pilot: Long-Range Goals

- To identify best practices for enhancing the clarity of the prosecution record
- To find the correct balance for appropriate recordation
- To use data/feedback to assist other quality-enhancing programs, such as:
 - Master Review Form (MRF)
 - Post Grant Outcomes Program

Clarity of the Record Pilot: Areas of Focus

- Enhanced documentation of claim interpretation
- More precise reasons for allowance
- More detailed interview summaries
- Pre-search interview at the examiner's option

Clarity of the Record Pilot: Current Participants

- Examiners - randomly selected individuals, who met the requirements for participation, were invited to volunteer for the pilot
 - Approximately 130 participants
 - GS 11-15, with at least two years of experience
- Supervisors (SPEs)
 - Approximately 45 participants

Clarity of the Record Pilot: Examiner Participant Duties

- Attend Pilot-specific training and quality enhancement meetings (QEMs)
- Enhance clarity of Office actions for applications in the pilot
- Record amount of time spent enhancing clarity

Clarity of the Record Pilot: Supervisor Participant Duties

- Manage Pilot-specific QEMs and group training
- Review Office actions using a pilot-modified Master Review Form (MRF)
- Provide individual feedback and assistance

Clarity of the Record Pilot: Evaluation

- Pilot runs from March 6, 2016 to August 20, 2016
- Statistical data will be gathered from:
 - Reviews of Pilot and control Office actions using the pilot-modified Master Review Form
 - Amount of time recorded by examiners for enhancing clarity
 - Surveys of Pilot examiners and supervisors

Clarity of the Record Pilot: Impact

- While examiner analysis of a patent application has not changed, recordation is being enhanced
- The training for the Pilot has increased examiner awareness among the participants on providing a clear record
- USPTO will evaluate the impact that the Pilot's areas of focus have on achieving greater clarity of the record

Clarity of the Record Pilot: Additional Information

<http://www.uspto.gov/patent/initiatives/clarity-record-pilot>



The screenshot shows a web browser displaying the USPTO website page for the Clarity of the Record Pilot. The page has a dark grey header with navigation links: Home / Patents / Initiatives / Clarity of the Record Pilot. On the right side of the header, there are icons for 'Share' and 'Print'. A left-hand navigation menu is visible, listing various patent-related topics such as 'More Patents', 'Forms', 'Fees & payment information', 'Initiatives' (which is expanded to show 'Accelerated Examination', 'Executive Actions', 'Glossary Initiative', 'Patent Application Initiatives', 'Patent Examiner Technical Training Program', 'Patents for Humanity', 'Third-Party Preissuance Submissions', and 'Site Experience Education (SEE) Program'). The main content area is titled 'Clarity of the Record Pilot' and features a circular logo with the text 'EXCELLENCE IN PATENT WORK PRODUCTS' around a central icon of a classical column. Below the logo, there is a paragraph of text describing the pilot program. Underneath this text is a section titled 'Goals of the Pilot' with a bulleted list of three objectives. At the bottom of the main content area, the text 'Pilot Participants and their Duties' is visible.

Home / Patents / Initiatives / Clarity of the Record Pilot

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Clarity of the Record Pilot



The **Clarity of the Record Pilot**, which is one of the **evolving programs** of the **Enhanced Patent Quality Initiative (EPQI)**, identifies best examiner practices for enhancing the clarity of various aspects of the prosecution record. In particular, the Pilot focuses on best practices regarding enhanced documentation of claim interpretation, more detailed interview summaries, and more precise reasons for allowance. The Pilot studies the impact of implementing such best practices during examination. The Pilot is underway, and is expected to end on August 20, 2016.

Goals of the Pilot

- To identify and help develop best examiner practices for enhancing the clarity of the prosecution record so as to provide applicants with a deeper understanding of the Office's positions during prosecution.
- To obtain feedback on the correct balance for appropriate recordation of an examiner's determinations during examination.
- To assist with the development of the [Master Review Form](#).

Pilot Participants and their Duties

uspto

A blurred background image showing a person's face and hand, possibly in a professional or interview setting. The image is out of focus, with a dark blue overlay at the top and bottom.

First Action Interview Pilot Program

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Pilot Program Objectives

- Promote personal interviews prior to issuance of a first Office action on the merits
- Advance examination of applications once taken up in turn
- Facilitate resolution of issues for timely disposition of an application
- Give applicants more options in regards to the amount of notice and procedure needed

Pilot History

- Original pilot
 - 4/28/08 – 11/1/08
 - Two small computer technology areas
- Enhanced pilot
 - 10/1/09 – 3/31/11
 - One technology area in each Technology Center
- Full pilot
 - 5/16/11 – present
 - All technology areas are eligible

Application Requirements

- Must be a non-reissue, non-provisional utility application under 35 USC 111(a) or national stage application under 35 USC 371
- Must contain three or fewer independent claims and twenty or fewer total claims
- Must not contain any multiple dependent claims
- Must claim only a single invention
- Must not have a first Office action on the merits as of the date Applicant requests participation in program

Pre-Interview Procedures

Examiner will:

- Follow current restriction policy and practice
- Conduct a prior art search
- Follow current policy and practice if a determination of allowability is made
- Issue a Pre-interview Communication (PTOL-413FP) setting a one month (30 day) time period to request or decline an interview
- The time period to respond to the Pre-interview Communication maybe extended for one additional month (30 days).

Pre-Interview Communication

First Action Interview Pilot Program Pre-Interview Communication				Application No.	Applicant(s)
				XXXXXXX	XXXXXX
				Examiner	Art Unit
				XXXXXXX	XXXX
				Page 2 of 2	
Notification of Rejection(s) and/or Objection(s)					
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection	
1	1-8		101	Claim 1 recites a binary translator with various components. The binary translator as claimed is software per se and software is not considered patentable subject matter. Claims 2-8 depend on 1 and do not include hardware so as to overcome the rejection.	
2	1-8		112, 1st	Claim 1 recites the limitation of "replace disabled legacy binary instructions with native instructions". However, according to the specification, on page 6, lines 1-3, "...used to disable...insert new instruction without (see continuation below)	
3	1-5, 7-8	U	102 (b)	Claim 1 (Figure 1, 1 st para, 3 rd para, Section 3.1 Components', 4 th & 5 th Paragraph-note the claimed "processor means" is interpreted as the CPU in fig. 1); 2 (Fig. 1); 3 (Section 3.1, 4 th para); 4 (section 4.2, para 9 – note fig.) (see continuation below)	
4	6	U,V	103 (a)	U does not disclose said native instruction processor as claimed. V discloses this at section 2.1, 2 nd paragraph. As one would want to have better code for hot spots in order to improve performance (see V, Section 2.1), it would have (see continuation below)	
Expanded Discussion/Commentary					
2				altering the original legacy instructions." Thus, the specification does not disclose replacing disabled legacy binary instructions. On the contrary, the specification specifically discloses not altering the original legacy binary instructions. The claim limitation of claim 1 contradicts with what the disclosure describes. Thus, this subject matter was not described in the specification in such a way to enable one skilled in the art to make and use the invention without undue experimentation.	
3				section states that "any kind of memory can be used"; 5 (Section 3.1, 5 th para); Claim 7 (Section 3, Resourceable and Retargetable Binary Translation); 8 (Section 3.1, 4 th para).	
4				been obvious to include the native instruction processor in the system described in V.	
DATE:		Examiner Signature:		Primary Examiner Signature:	

Pre-Interview Procedures

Applicant's response:

- Properly respond to the Pre-Interview Communication by filing one of the following:
 - Request not to have the interview;
 - “Applicant Initiated Interview Request” form (PTOL-413A) along with a proposed amendment and/or arguments via EFS-Web, and conduct the interview within 60 days from the filing of the Applicant Initiated Interview Request; or
 - Request not to have the interview AND submit a reply in accordance with 37 CFR 1.111

The Interview

- Conducted in accordance with current policy and practice (See MPEP 713):
 - Assisting the examiner in obtaining a better understanding of the claimed invention
 - Establishing the relevant state of the art
 - Discussing all relevant prior art teachings
 - Focusing on what claimed features establish patentability over the prior art
 - Discussing proposed amendments or remarks
 - Applicant may request waiver of the First Action Interview-Office Action and enter a proposed amendment that complies with 37 CFR 1.111

Interview Produces Agreement on Allowability

Examiner will:

- Document the substance of the interview and reasons for allowance on interview summary (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Generate a notice of allowability (PTOL-37), if applicant requests an unofficial courtesy copy.
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Perform an updated search and interference review before issuing an official notice of allowability

Interview Does Not Produce Agreement on Allowability

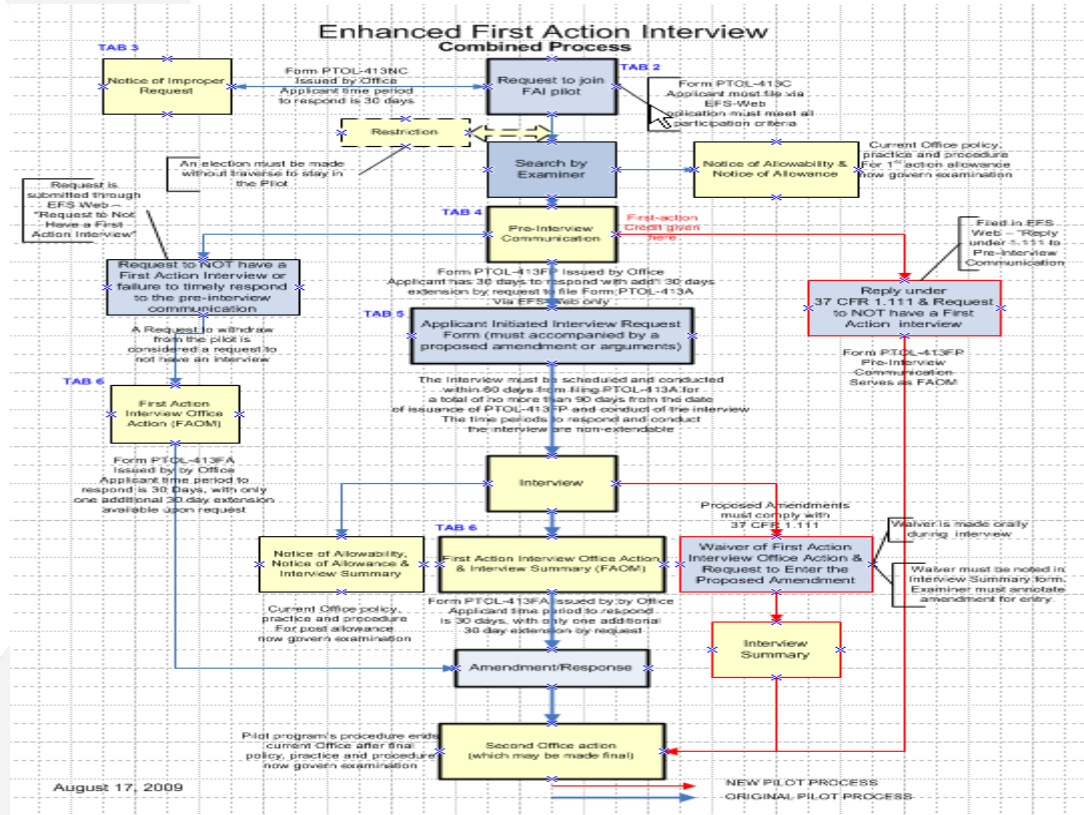
Examiner will:

- Document all requirements, objections and rejections in a First Action Interview Office Action (PTOL-413FA)
- Complete an interview summary (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Upon request provide unofficial courtesy copies
- Upon request for waiver of the First Action Interview Office Action enter a proposed amendment that complies with 37 CFR 1.111

Post Interview Procedures

- Applicants must timely respond to all outstanding issues in accordance with current policies and practice
- Applicants must make the substance of the interview of record when filing a timely response
- Examiners must proceed in accordance with current examination procedures and also insure the substance of the interview made of record by applicants is accurate

Flowchart of EFAI Procedure



Results FAI Pilot

Total Overall	Original	Enhanced	Since 5/16/11	
7278	502	6776	6082	Applicants have joined the pilot program
400	392	8	3	Pre-interview Communications (PFA OA) have been mailed
4201	12	4189	3708	Pre-interview Communication (MPICO) have been mailed
4417	390	4027	3563	Interviews have been conducted
2257	294	1963	1723	First Action Interview Office Actions have been mailed
618	23	595	507	Final Rejection mailed with No FAI Office action
4177	345	3832	3325	Allowances
1247	62	1185	1046	Allowed after pre-interview communication but before FAI office action
2422	257	2165	1835	Allowed after the FAI office action
508	26	482	444	Allowed without/before pre-interview communication
1275	76	1199	1040	First Action On the Merits without a Pre-Interview Comm
25	3	22	17	Quayle Actions
29.6%	18.2%	30.6%	31.2%	First Action Allowance rate



Contact Information

- Pilot Program Points of Contact:
 - For EFS-Web questions contact the EBC at 866-217-9197
 - For Notice/Legal questions contact Joseph Weiss
OPLA 571-272-7759 or
first.action.interview@uspto.gov
 - <http://ptoweb.uspto.gov/patents/pai/> for program
and eligibility information

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Pro Bono Program

Mindy Bickel

Associate Commissioner for Innovation Development,
USPTO

UNITED STATES
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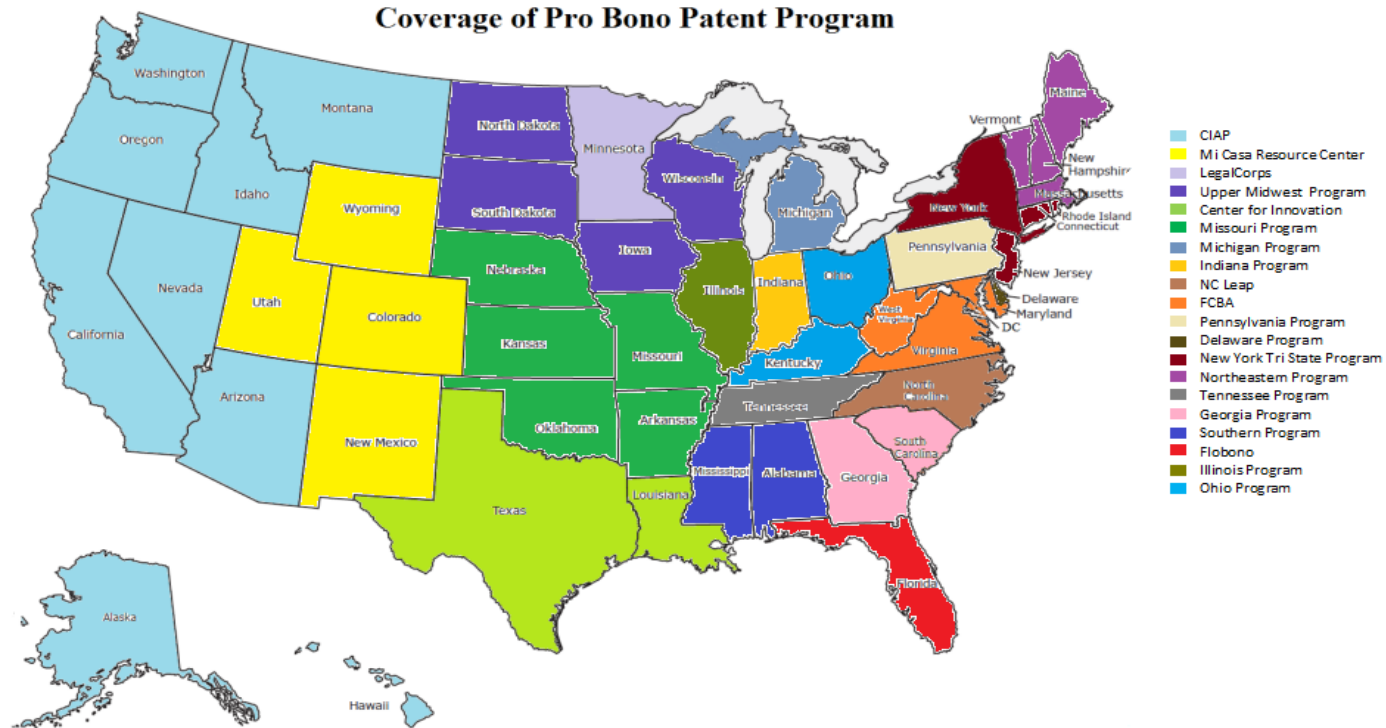
Pro Bono Clients

- Believe in their invention
 - Can be emotionally involved
 - May have invested significant personal resources
- Often not familiar with patent prosecution
 - Statutes, rules, and procedures appear complex
 - May not know what to expect from an attorney/client relationship

USPTO Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses
 - Coverage in all 50 states achieved and maintained since August 2015
- Promotes small business growth and development
- Helps ensure that no deserving invention lacks patent protection because of a lack of money for IP counsel
- Opportunity for patent attorneys to serve in their area of expertise

Pro Bono Program – May 2016



National Pro Bono Metrics

(Second – Fourth Quarter, Calendar Year 2015)

Applicants requesting services	1857
Applicants approved for placement	471
Applicants placed with attorney/agent	328
Number of attorneys agreeing to accept cases	754
Provisional applications filed	54
Non-provisional applications filed	82
Design applications filed	12



Volunteer Patent Attorneys Are the Linchpins for Program Success

- The program can't work without you!
- Improved patent quality - a *pro se* inventor is now a represented inventor
- Professional advice:
 - Inventor is educated about the patent system
 - "No" may be what the inventor needs to hear
- Gives a person a chance to be a job creator and paying client
- Consumer protection

Get Involved with your Regional Program!

- Regional programs match underserved inventors and small businesses with volunteer attorneys to file and prosecute patent applications
- Regional programs offer a better experience
 - Inventions are screened
 - You choose your client
 - Malpractice coverage offered by some of the programs
- Get your feet wet by volunteering to help screen applications

The New York Program

- Operated by the Volunteer Lawyers for the Arts (vlany.org)
 - To volunteer contact:
 - Laura Levin-Dando, probono@vlany.org
- The New York program also covers inventors in Connecticut and New Jersey
- All types of technological areas available for volunteering (vlany.org/patent-caselist/):
 - Fashion
 - Music
 - Mixed

USPTO Patent Pro Bono Program

USPTO pro bono coordination team

John Kirkpatrick

john.kirkpatrick@uspto.gov, 571-270-3343

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gautam.prakash@uspto.gov, 571-270-3030





Patents Ombudsman Program

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What is the status of my Application?

When will I get the First Office Action?

Facilitate complaint handling when applications become stalled in the examination process

**Track complaints to ensure each is handled within 10 business days
Currently averaging 3.8 business days**

Provide feedback regarding training needs based on complaint trends

Ombudsman Program: Tracking Database

- Complaints are tracked to ensure each is addressed
- Database will contain only high level information; the application itself will show details of resolution
- Database will be used to identify trends that indicate training needs.

Ombudsman Program Total: Inquiries

Fiscal Year	Inquiries
2010	268
2011	372
2012	951
2013	4292
2014	5469
2015	4859
2016 (through May)	2692

Ombudsman Program Results

Top 5 types of inquiries

- ❖ Status Inquiries
- ❖ Filings (ADS, Corrected Filing Receipts etc.)
- ❖ Case Prosecution Concerns
- ❖ Petitions
- ❖ General Questions

OmbudsmanProgram@USPTO.gov

571-272-5555

1-855-559-8589





Post-Prosecution Pilot

Jack Harvey

Assistant Deputy Commissioner for Patent Operations

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Post-Prosecution Pilot (P3)

Changes to Process/Product

Pillar 1

- **Clarity of the Record Pilot**

Pillar 3

- **Post-Prosecution Pilot**
- **Reevaluate QPIDS**
- **Design Patent Publication Quality**



This program is to determine the feasibility of modifying the After Final Consideration Pilot (AFCP) 2.0 and the Pre-Appeal Conference programs to make them more efficient.

Post-Prosecution Pilot

- Tests how some of the best attributes of the AFCP 2.0 and the Pre-Appeal pilots can be combined to give both applicants and examiners additional information
- Increased understanding of the issues will lead to more accurate decisions on subsequent courses of action

Post-Prosecution Pilot

➤ Additional Features Considered:

- Available within 2 months of final rejection
- Panel, including a neutral party
- Applicant participation to present arguments as in Pre-Appeal (5-page document) or claim amendments
- More information on panel decision (i.e. grounds of rejection withdrawn or maintained, claims rejected, allowed, additional brief comments)

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Post Grant Outcomes

Jack Harvey

Assistant Deputy Commissioner for Patent Operations

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Post Grant Outcomes

Examiners' Resources, Tools & Training

Pillar 1

- **Automated Pre-Examination Search Pilot**
- **STIC Awareness Campaign**
- **Clarity of the Record Training**
- **Post Grant Outcomes**

Pillar 3

- **Interview Specialist**



This program is to develop a process for providing post-grant outcomes from sources, such as the Federal Circuit, District Courts, Patent Trial and Appeal Board (PTAB), and Central Reexamination Unit (CRU), to the examiner of record and the examiners of related applications.

Objectives of Post Grant Outcomes

The purpose of this program is to learn from all post grant proceedings and inform examiners of their outcomes.

Propose **three** objectives to accomplish this:

1. Enhanced Patentability Determinations in Related Child Cases

- Providing examiners with full access to trial proceedings submitted during PTAB post AIA Trials

2. Targeted Examiner Training

- Data collected from the prior art submitted and examiner behavior will provide a feedback loop on best practices

3. Examining Corps Education

- Provide examiners a periodic review of post grant outcomes focusing on technology sectors

Objective 1 - Enhanced Patentability Determinations in Related Child Cases

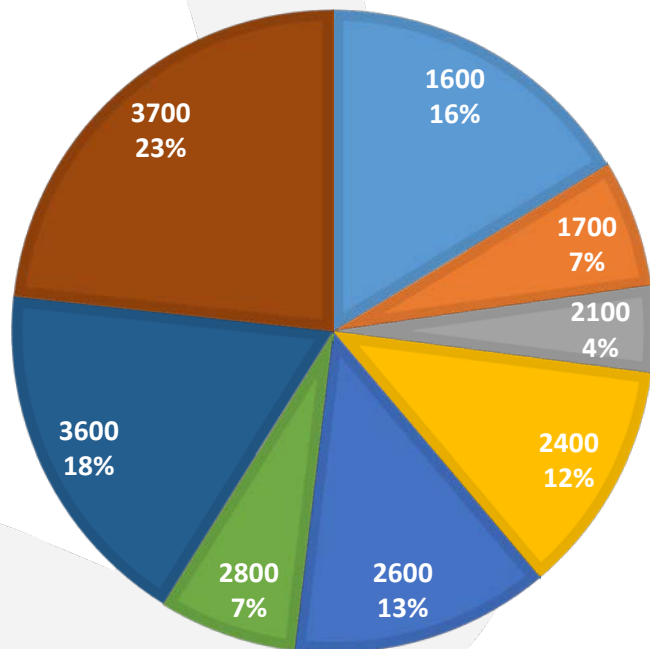
- Identify those patents being challenged at the PTAB under the AIA Trials that have pending related applications in the Patent Corps
- Provide the examiners of those pending related applications full access to the AIA trial proceedings of the parent case

Objective 1 – Post Grant Outcomes Pilot

- Post Grant Outcomes Pilot launched April 2016, continues through August 2016
- Pilot notifies examiners when they have a pending application related to an AIA trial, and provides full access to the trial proceedings
- Pilot participants are surveyed to identify best practices to be shared corps-wide

Objective 1 – Pilot Statistics

DISTRIBUTION OF PILOT APPLICATIONS
BY TECHNOLOGY CENTER



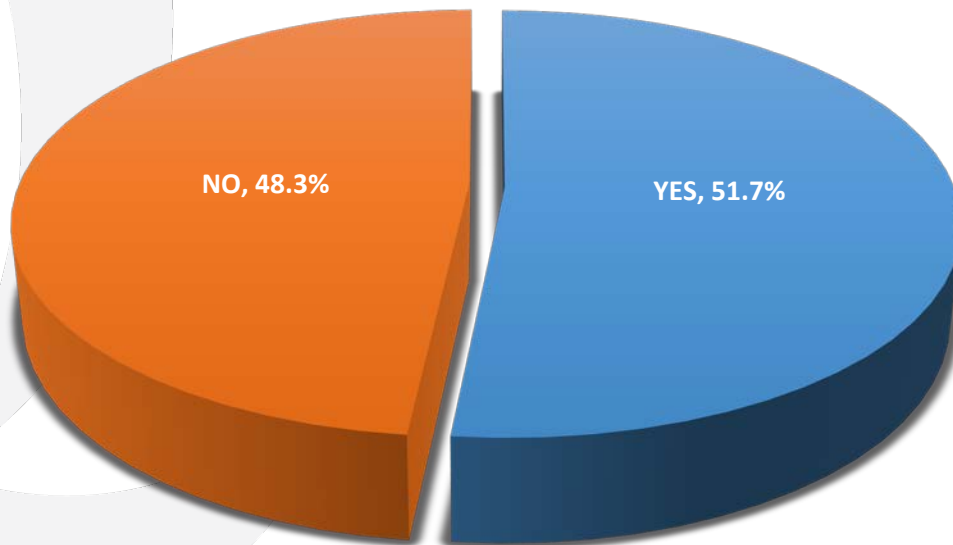
- 1600
- 1700
- 2100
- 2400
- 2600
- 2800
- 3600
- 3700

Technology Center	Number of Pilot Applications
1600	94
1700	37
2100	25
2400	68
2600	75
2800	40
3600	103
3700	134
Grand Total	576



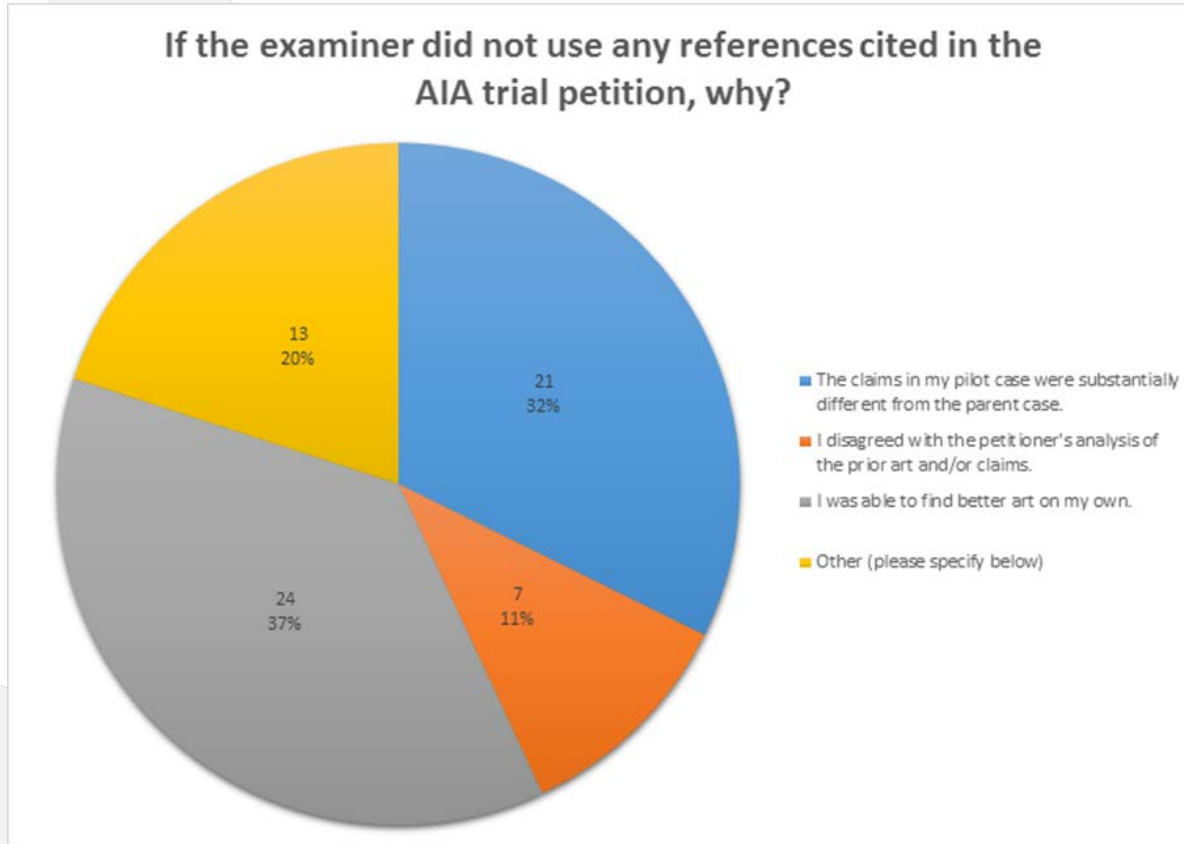
Objective 1 – Pilot Statistics cont.

In the Office Action of the child case, did the examiner refer to any of the references cited in the AIA trial petition of the parent case?



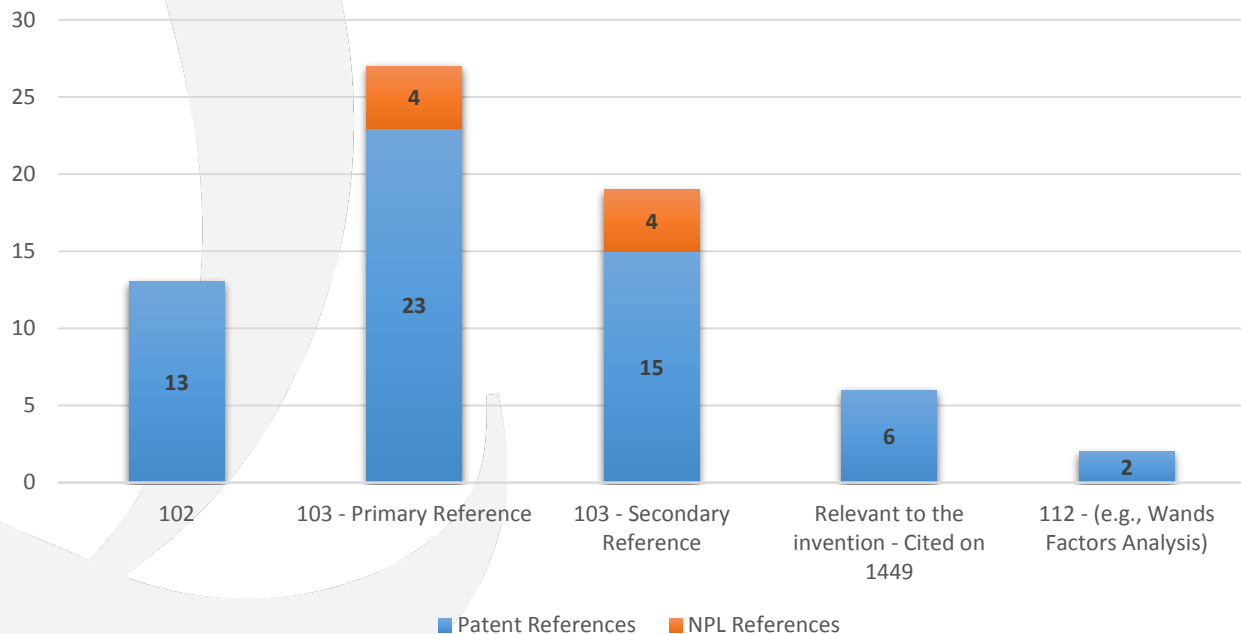
Based on 125 survey responses

Objective 1 – Pilot Statistics cont.



Objective 1 – Pilot Statistics cont.

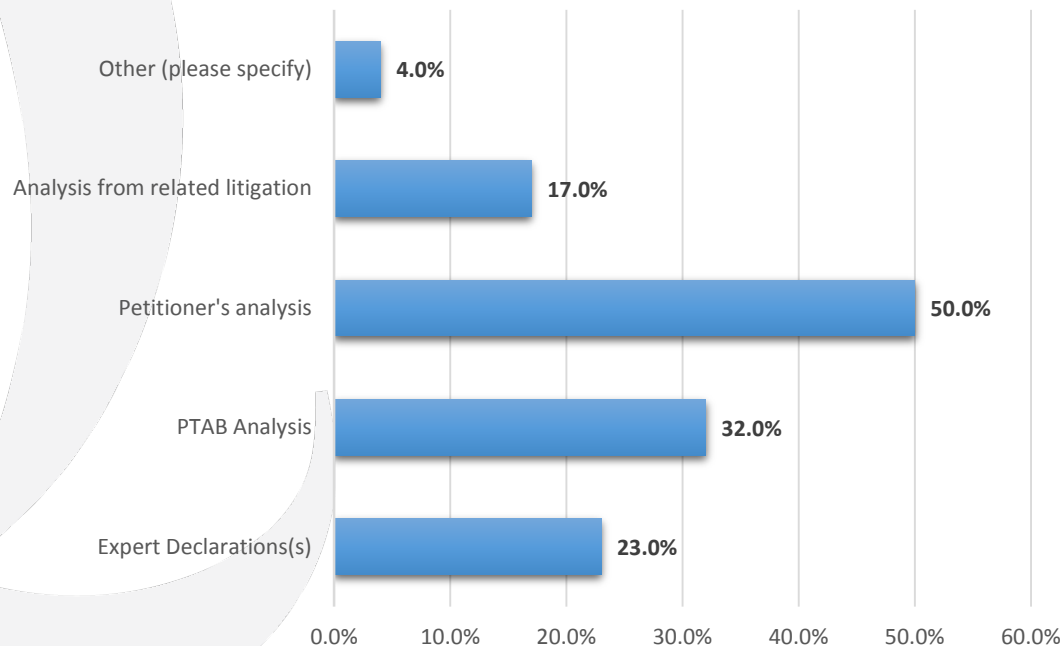
How did the examiner apply the AIA Trial reference(s) in the pilot application?



Based on 51 survey responses

Objective 1 – Pilot Statistics cont.

Did the examiner consider any other documents submitted with the petition, e.g., expert declarations, PTAB analysis?



Based on 100 survey responses. Percentages do not add to 100% since more than one response could have been selected.

Objective 2 – Targeted Examiner Training

- Data collected from the prior art submitted and resulting examiner behavior will provide a feedback loop on best practices
- Educate examiners
 - Prior art search techniques
 - Sources of prior art beyond what is currently available
 - Claim interpretation
 - AIA Trial proceedings

Objective 3 – Examining Corps Education

- Leverage results of all post grant proceedings to educate examiners on the process and results
 - Provide examiners a periodic review of post grant outcomes focusing on technology sectors
 - Utilize the proceedings to give examining corps a fuller appreciation for the process

Post Grant Outcomes Summary

- Learn from the results of post grant proceedings
- Shine a spotlight on highly relevant prior art uncovered in post grant proceedings
- Enhance patentability of determination of related child cases
- Build a bridge between PTAB and the examining corps

Next Steps

- Develop training and best practices gleaned from pilot and implement corps-wide
- Send your feedback to:
WorldClassPatentQuality@uspto.gov
- More information at the PGO Pilot home page:
<http://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot>

Panel Discussion

Panelists:

- **Jack Harvey**, Assistant Deputy Commissioner for Patent Operations
- **Wendy Garber**, Director, Technology Center 3700
- **Mark Bloomberg**, Zuber Lawler & Del Duca LLP
- **Robert Rando**, The Rando Law Firm P.C.

Thank You!

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