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PATENT AND TRADEMARK OFFICE

A blurred background image showing a close-up of a person's face, likely a woman, with a red eye visible. The image is out of focus and serves as a decorative element for the slide.

Patent Quality Chat: Clarity of the Record

Patent Quality Chat
Webinar Series 2015 (1 of 6)
June 9, 2015



To send in questions or comments during the webinar, please email:

PatentQualityEventParticipationBox@uspto.gov



A screenshot of the USPTO website homepage. The header includes the USPTO logo, navigation links for "About Us", "Careers", and "Contact Us", and a search bar. The main navigation menu has "Patents", "Trademarks", and "Learning and Resources". A large blue banner features the text "First time here? Let us help you find your bearings." and a "Get Going" button. Below the banner, there are sections for "Learn About the Process" with sub-sections for "Patents" and "Trademarks". A red circle highlights the "Patents & Trademarks Initiatives" section, specifically the "Enhanced Patent Quality Initiative" link. The USPTO logo is also visible in the bottom right corner of the page.

**To send in questions or comments related to the
USPTO's Enhanced Patent Quality Initiative,
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Patent Quality Chat: Clarity of the Record

Drew Hirshfeld
Deputy Commissioner for Patent Examination Policy

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Today's Chat Agenda

- Goals and Objectives of Clarity/Quality Initiatives
- Enhanced Patent Quality Initiative:
 - Clarity of the Record Initiative
- Targeted Examiner Legal Training:
 - Previous and Current Legal Training Modules
 - Upcoming Legal Training Modules



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Goals & Objectives of Clarity/Quality Initiatives

- Improve Accuracy of Patentability Determinations
- Promote Communication Between Applicants & Examiners
- Ensure a Complete and Comprehensive Record is Created



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Leading in Quality Excellence: Every Interaction Counts

Three Aspects of Quality to Focus on:

1. Excellence in Work Products, in the Form of Issued Patents and Office Actions
2. Excellence in Measuring Patent Quality, Including Appropriate Quality Metrics
3. Excellence in Customer Service



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Proposed Quality Initiatives

1. Excellence in Work Products
 - Applicant Requests Prosecution Review of Selected Applications
 - Automated Pre-Examination Search
 - **Clarity of the Record**
2. Excellence in Measuring Patent Quality
 - Review/Improvements to Quality Metrics
3. Excellence in Customer Service
 - Review of Current Compact Prosecution Model and Effect on Quality
 - In-Person Interview Capability With all Examiners



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External Stakeholder Input on Improving Patent Quality

- Patent Quality Summit (March 25-26, 2015)
 - Over 300 In-Person Attendees; Over 1,200 Online Participants
 - Stakeholder Discussion on the Importance of Quality
 - Speakers from Various Areas of Intellectual Property
 - Discussion of Initiatives to Enhance Quality
- Public Comments Requested Through Federal Register Notice
 - Notice Published February 5, 2015; Comment Period Ended May 20, 2015
 - 82 Responses Received



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Clarity of the Record Initiative: Background

- Better Communication Between Examiner and Applicant Throughout Prosecution
- Give Inventors and Investors the Confidence to Take the Necessary Risks to Launch Products and Start Businesses
- Provide the Public with the Benefit of Knowing the Precise Boundaries of an Exclusionary Right
- Avoid Costly and Needless Litigation Down The Road



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Clarity of the Record Initiative: Summit Discussion

- Current Best Practices in Office Actions
- Potential Impact on Downstream Events
- Should Prosecution Record Include an Examiner's Claim Construction?
- Memorialization of the Oral Record
 - More Detailed Recordation of Interviews and pre-appeal/appeal conference decisions?
- Reasons for Allowability



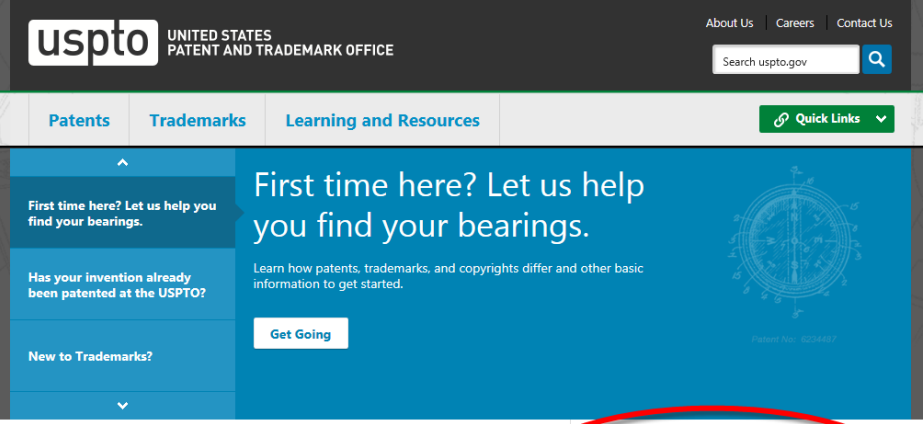
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Feedback: Common Clarity of the Record Themes (Initial Impressions)

- Explicit Claim Construction, Recordation of Interviews and Reasons for Allowability
- Recordation of Pre-Appeal and Appeal Conference Decisions
- Determinations Regarding Compliance with 35 USC § 112



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Trademarks

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Learn about trademarks and find out

Patents & Trademarks Initiatives

Enhanced Patent Quality Initiative


Learn about USPTO efforts to increase patent quality.

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Examiner Training: Goals

- Improve Examiner's Claim Construction
 - 35 USC § 112(f), Broadest Reasonable Interpretation, Functional Language
- Improve Examiner's Evaluation of Claims under 35 USC § 112(a), (b)
- Ensure Clear Prosecution Records
- Deliver Training in Small Modules, Phased Over Time
 - Facilitate Adult Learning
 - Incorporate Examples
 - Create a resource for examiners and the public



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35 USC § 112: Tool to Enhance Clarity

- 35 USC § 112 Efforts:
 - 2011 Supplementary Examination Guidelines for Determining Compliance With 35 USC § 112
 - Software Partnership Meetings
 - June 4, 2013 Executive Action Item #2
 - **USPTO Examiner Training**



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Functional Claim Language – Discussion Example

Claim interpretation is critical for evaluating claim scope during examination

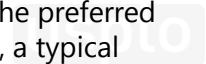
- Consider how the interpretation of the following claim changes based on variations in language:

Claim 1. A recording system, comprising:

a base; and

- a) **a camera for recording images** mounted to the base.*
- b) **means for recording images** mounted to the base.*
- c) **mechanism for recording images** mounted to the base.*

- The specification describes the camera as a digital video camera that records images for broadcasting. The camera is remotely operable, and the preferred embodiment is a pan tilt zoom camera with recording ability (e.g., a typical surveillance camera).



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Example – Broadest Reasonable Interpretation

Claim 1. A recording system, comprising: a base; and

a) a camera for recording images mounted to the base.

BRI : all cameras known to those of ordinary skill in the art that can be mounted to a base and record images

b) means for recording images mounted to the base.

BRI: limited to a digital video camera that records images and is remotely operable and any equivalent devices recognized by those of ordinary skill in the art

c) mechanism for recording image mounted to the base.

BRI: the same as "means" because in this instance "mechanism" is a generic placeholder that serves as a substitute for "means"



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Examiner Training Completed: Initial Focus 35 USC § 112(f)

- Identifying Limitations that Invoke § 112(f)
 - Key Topics: Three prong analysis, legal presumptions, interpreting generic placeholders
- Making the Record Clear
 - Key Topics: Use of Legal Presumptions to facilitate clarification of the record



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Examiner Training Completed: Initial Focus 35 USC § 112(f) (cont.)

- Broadest Reasonable Interpretation & Definiteness of § 112(f) Limitations
 - Key Topics: BRI of § 112(f) limitations and determining equivalents, indefiniteness for § 112(f) limitations
- Evaluating § 112(f) Limitations in Software-Related Claims for Definiteness under 35 USC § 112(b)
 - Key Topics: Evaluation of the need for disclosed algorithms (specialized v. non-specialized functions), definiteness of § 112(f) limitations that link to an algorithm in the specification



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Examiner Training: Claim Construction

- Broadest Reasonable Interpretation, plain and customary meaning of terms and treating the claim as a whole
 - Key Topics: Comparison of non-§112(f) and §112(f) claim limitations, evaluation of plain and customary meaning for non-§112(f) limitations
 - Completed
- Claim Interpretation: Examining Functional Claim Language
 - Key Topics: Distinguishing functional limitations v. intended results, weight of preambles
 - Examiner training started



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Upcoming Examiner Training: 35 USC § 112(a)

- Written Description for Electrical, Software, and Business Methods technologies
 - July/August 2015
- Enablement for Electrical, Software, and Business Methods technologies
 - July/August 2015



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Related Links of Interest

- FACT SHEET: White House Task Force on High-Tech Patent Issues:
<http://www.whitehouse.gov/the-press-office/2013/06/04/fact-sheet-white-house-task-force-high-tech-patent-issues>
- FACT SHEET - Executive Actions: Answering the President's Call to Strengthen Our Patent System and Foster Innovation:
<http://www.whitehouse.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-p>
- USPTO Training Materials:
<http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials>



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Thank You

Questions?



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Next Patent Quality Chat: **Face-to-face Examiner Interviews:** **A Demonstration of USPTO Tools**

Timothy Callahan
Director, Technology Center 2400

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July 14, 2015

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