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Patent Quality Chat: Clarity of the Record Pilot: A Discussion of Findings

Patent Quality Chat

Webinar Series 2016 (12 of 12)

November 8, 2016

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Enhanced Patent Quality Initiative



High-quality patents enable certainty and clarity of rights, which fuels innovation and reduces needless litigation. To ensure we continue issuing high-quality patents well into the future, we established the **Enhanced Patent Quality Initiative (EPQI)**. We are strengthening work products, processes, services, and how we measure patent quality at all stages of the patent process.

Updates

- Join us for presentations and panel discussions across the country on the latest achievements of the EPQI programs. This November, our Patent Quality Forums will be visiting Washington, DC; Milwaukee, Wisconsin; Baton Rouge, Louisiana; Kansas City, Missouri; and Portland, Oregon. See our [Patent Quality Forum Series](#) page for more information.
- **Post-Prosecution Pilot (P3)**, which launched on July 11th, explores a new after final program that combines features of the Pre-Appeal Brief Conference and After Final Consideration 2.0 pilot programs and adds in new features requested by our stakeholders. For more information, please visit the [P3 webpage](#).
- Join **Michelle K. Lee**, Under Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office, to discuss results from the Enhanced Patent Quality Initiative, how patent quality impacts the U.S. Courts, and next steps the USPTO is taking to advance patent quality. Learn more about the event details on the [Patent Quality Conference event page](#).

[2016 Patent Quality Chats](#)
NEXT: November 8, 12-1 pm ET

[Patent Quality Forum Series](#)

November, 2016 - Visiting cities across the country to discuss patent quality achievements and options for your participation

[Patent Quality Conference](#)

Advancing Patent Quality Across the IP Community
Keynote Speaker: Michelle K. Lee, Under Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office

Patent Quality Chat: Clarity of the Record Pilot: A Discussion of Findings

Robin Evans

Director of Technology Center 2800

Marty Rater

Acting Director of the Office of Patent Quality Assurance

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Clarity of Record Pilot - Purpose

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



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Clarity of Record Pilot Goals



Identify Examiner Best Practices

Find Correct Balance for Appropriate Recordation

Use Data/Feedback to Assist Other Programs

Enhance Clarity of Prosecution Record



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Clarity of Record Pilot - Areas of Focus

- More detailed interview summaries
- Enhanced documentation of claim interpretation

➤ Special definitions of claim terms	➤ Optional language
➤ Functional language	➤ Non-functional descriptive material
➤ Intended use or result (preamble and body of claim)	➤ Computer-implemented functions that invoke 35 U.S.C. §112(f) ("specialized" or "non-specialized")
➤ "Means-plus-function" (35 U.S.C. §112(f))	

- More precise reasons for allowance
- Pre-search interview - Examiner's option



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Clarity of Record Pilot - Participants

- 125 Examiners participated
 - Advanced Training
 - Met regularly
 - Recorded time spent
- 45 Supervisors (SPEs) participated
 - Managed program
 - Provided reviews
 - Provided direct assistance



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Clarity of Record Pilot - Evaluation

- 2,600 Office actions (reviewed and recorded)
 - Included a statistical mix of:
 - Pre-Pilot Office actions
 - Pilot Office actions
 - Control group
- Key Drivers were determined
- Best practices were gathered



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Results and Recommendations – Interview Summaries

Identified Best Practices/Key Drivers:

- Adding the substance of the Examiner's position
- Providing the details of an agreement, if reached
- Including a description of the next steps that will follow the interview

Recommendations:

- Provide corps-wide training on enhancing the clarity of interview summaries that focuses on the identified best practices/key drivers
- Consider whether to require examiners to complete more comprehensive interview summaries
- Continue to evaluate Pilot cases to see whether improved interview summary clarity has a long-term impact on prosecution



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Results and Recommendations – 112(f) Limitations

Identified Best Practices/Key Drivers:

- Explaining 112(f) presumptions and how the presumptions were overcome (when applicable)
- Using the appropriate form paragraphs
- Identifying in the specification the structure that performs the function

Recommendation:

- Consider whether to require examiners to use the 112(f) form paragraph



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Results – 102 and 103 Rejections (Claim Interpretation)

Identified Best Practices/Key Drivers:

- Clearly addressing all limitations in 35 U.S.C. 102 rejections when claims were group together
- Explaining the treatment of intended use and non-functional descriptive material limitations in 35 U.S.C. 103 rejections

Overall Pilot Determination:

- Examiners currently doing a good job with clarity in claim interpretation



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Results and Recommendations – 102 and 103 Rejections (Claim Interpretation)

Key Drivers that *Added to and Detracted From Clarity*:

- Providing, in 35 U.S.C. 102 rejections, an explanation for limitations that have been identified as inherent
- Providing, in 35 U.S.C. 103 rejections, annotations to pin-point where each claim limitation is met by the references

Recommendation:

- Assess how to use the identified best practice of recording claim interpretation to improve the clarity of Office actions *without* detracting from clarity



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Results and Recommendations – Reasons for Allowance

Identified Best Practices/Key Drivers:

- Identify specific allowable subject matter or where found, if earlier presented, during prosecution
- Confirm applicant's persuasive arguments
- Address all independent claims

Recommendations:

- Provide training on best practices
- Require more comprehensive reasons for allowance



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Results – Additional Practices

Identified Best Practice:

- Pilot Examiners shared best practices with non-Pilot Examiners

Practices that did NOT significantly impact overall clarity:

- Providing an explanation regarding the patentable weight given to a preamble
- Providing an explanation of how relative terminology in a claim is being interpreted
- Providing an explanation for how a claim limitation that was subject to a rejection under 35 U.S.C. 112(b) has been interpreted for purposes of applying a prior art rejection



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Clarity of the Record - Next Steps

Surveys

- Internal surveys sent to Pilot examiners
- Data currently being collected

Quality Chat

- Gather information/thoughts on any differences seen during Pilot time period
- Share data results of Pilot
- Discuss/share best practices

Focus Sessions

- Are best practices still being used?
- Discuss amended cases resulting from Pilot

Clarity of the Record - Next Steps (cont.)

Monitor Pilot Treated Cases

- Are applicant's arguments more focused?
- Average time to disposal compared to pre-pilot cases?

Recommendations

- Discuss implementation of training and best practices in all Technology Centers
- Consider further efforts to enhance claim interpretation including key drivers that did not significantly impact clarity
- Expand Pilot to gather additional data



Let's Chat about Clarity of the Record Pilot: A Discussion of Findings

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Acting Director of the Office of Patent Quality Assurance

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**In Lieu of the Next Patent Quality Chat:
Patent Quality Conference
Tuesday, December 13, 2016**

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Patent Quality Conference

Advancing Patent Quality across the IP Community



Tuesday, Dec 13, 2016 | 8:30 a.m. - 5 p.m. EST
USPTO Headquarters - Madison Auditorium

Presentations, Panel Discussions, and Insights into the Future of Patent Quality

Keynote Speaker

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office



Thank you for joining us today!

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