

February 12, 2016

U.S. Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Office of Deputy Commissioner for Patent Examination Policy
Office of Patent Legal Administration
Attn: Michael Cygan
Senior Legal Advisor

Via email TopicSubmissionForCaseStudies@uspto.gov

Re: AIPLA Comments on Submission of Topics for USPTO Quality Case Studies 80 Fed. Reg. 79277 (December 21, 2015)

Dear Mr. Cygan:

The American Intellectual Property Law Association (“AIPLA”) is pleased to present the following comments to the USPTO Request for Submission of Topics for USPTO Quality Case Studies, in response to an invitation for written comments. 80 Fed. Reg. 79277 (December 21, 2015).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Title: Interview Before Search

Proposal for study: AIPLA proposes that the USPTO initiate a pilot program to allow an applicant to request an interview before the Examiner performs a prior art search.

Explanation: Our members observe that one reason so many RCEs are filed is that the key issues or bases for rejections are not identified until a Final Rejection is mailed. Often, these issues are not identified because 1) the Examiner and applicant may be viewing the scope of the claimed invention differently (applicant viewing the claims more narrowly than the Examiner construes them) and/or 2) the Examiner does not appreciate important, disclosed but unclaimed

aspects that are part of the invention described in the specification. As a result, Examiners sometimes issue final rejections with new prior art 1) once the Examiner focuses on perhaps overlooked features of the invention or 2) following the addition of the unclaimed elements by amendment. In some instances, it appears that the new prior art could and should have been cited against the original claims to better advance prosecution.

We propose establishing a pilot program in which an applicant can request an interview before the Examiner performs a prior art search. Applications accepted into the pilot program would receive an automated search that would be shared with the applicant. Ideally, the applicant and Examiner would then be able to discuss the application and search in a telephonic or WebEx interview before the Examiner begins the search.

Alternatively, the USPTO could merely encourage the use of a pre-search interview for a discussion and explanation of the invention and the claims. This discussion would require minimal preparation by the Examiner other than a brief reading of the claims.

This would allow the Examiner to better understand the key features of the invention before searching and make it less likely that additional searching will be needed after the response to the first Office Action. A brief review of the claims by the examiner prior to the first office action could result in the Examiner identifying problematic language in the claims, allowing the applicant to amend prior to a first office action with a reduction in written rejections, and thereby reducing the work for both the USPTO and the applicant. This could lead to potentially fewer office actions, projected higher allowance rates, and fewer RCEs.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

Respectfully Submitted,



Denise W. DeFranco
President
American Intellectual Property Law Association