

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: Quality of search

Proposal for study: Currently, the USPTO performs a random evaluation of the quality of the search performed in applications. A targeted evaluation of applications that included an improper final rejection may provide insight into ways that searching may be improved. In particular, the current pre-appeal and appeal conference evaluations offer an area which could be utilized to determine the reasons why the rejections in those applications are not maintained when the applications are reopened or allowed after filing a Notice of Appeal or Appeal Brief or when the finality of an office action is withdrawn. Evaluating the quality of the search done in these

applications may reveal valuable information regarding the root causes of inadequate final rejections.

Explanation: AIPLA suggests that the USPTO perform evaluations of the quality of the search in targeted areas, in particular, 1) applications that are either reopened or allowed as a result of a pre-appeal brief conference or appeal conference and 2) final rejections utilizing new prior art in which the finality of the action is withdrawn. Some benefits include: identification of root causes of inadequate final rejections and identification of weaknesses in search techniques and development of training materials to improve search abilities. Eventually, this could reduce the rate at which applications are reopened after Notice of Appeal or in which the finality of a rejection is withdrawn and provide an area of improvement that would demonstrate the USPTO's commitment to quality improvement.

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