



COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION AND PUBLIC KNOWLEDGE REGARDING REQUEST FOR SUBMISSION OF TOPICS FOR USPTO QUALITY CASE STUDIES

Docket No. PTO-P-2015-0074

The Electronic Frontier Foundation (“EFF”) and Public Knowledge are grateful for this opportunity to respond to the request by the United States Patent and Trademark Office (“USPTO”) for comments regarding potential topics for PTO quality case studies.

EFF is a non-profit civil liberties organization that has worked for more than 20 years to protect consumer interests, innovation, and free expression in the digital world. Founded in 1990, EFF represents more than 26,000 contributing members. EFF and its members have a strong interest in promoting balanced intellectual property policy that serves both public and private interests. Public Knowledge is a non-profit organization that is dedicated to preserving the openness of the Internet and the public’s access to knowledge; promoting creativity through balanced intellectual property rights; and upholding and protecting the rights of consumers to use innovative technology lawfully.

As established advocates for consumers and innovators, EFF and Public Knowledge have a perspective to share that might not be represented by other persons and entities who submit comments in this matter, where such other commentators do not speak directly for the interests of consumers or the public interest generally.

Title

Quality of Interview Summaries as Resources for the Public

Proposal For Study

Whether interview summaries contain sufficient substantive information to help the public later understand the events during prosecution of the patent and the eventual scope of the patent as understood by the patent examiner and applicant.

Explanation

Patent applicants often, after receiving a rejection (or beforehand, in the case of the First Action Interview pilot), will seek to speak with the examiner in interviews. These interviews are intended to offer a meeting of the minds between examiners and applicants to clarify the scope of the alleged invention, to better understand rejections, and to discuss ways applicants can put applications into a position for allowance.

Interviews are largely done “off-the-record” however, in that the only “record” of an interview is the interview summary.

The authors of this comment have observed that many interview summaries consist only of statements such as “the prior art of record was discussed” or “the rejections were discussed and the applicant and examiner were able to reach a resolution.” Subsequent filings often show the patent applicant amending claims as a result of the interview or the patent office withdrawing a rejection, suggesting that the examiner and applicant arrived at some agreement during the interview. But where the interview summary is sparse as described above, the file wrapper fails to show how the amendments overcome the art of record or what the understanding was that was reached between the examiner and the applicant that led to the withdrawal of a rejection.

An interview summary that does not record the specific nature of the agreement reached is not only contrary to public policy, it is contrary to the USPTO’s own policy. MPEP § 713.04 requires that a “complete written statement as to the substance of any in-person, video conference, electronic mail, telephone interview, or electronic message system discussion with regard to the merits of an application must be made of record in the application.” While the applicant is generally tasked with writing the summary of the interview, it is ultimately the examiner’s responsibility to ensure that the “complete written statement as to the substance” makes it into the record: “It is the examiner’s responsibility to see that such a record is made and to correct material inaccuracies.” Thus, OPQA should review whether interview summaries are meeting this standard.

Furthermore, MPEP § 713.01(IV) requires “A paper copy of the Internet email contents or instant message system transcripts or video conferencing transcripts, if any,

MUST be made and placed in the patent application file as required by the Federal Records Act.” However, the contents of materials emailed to examiners, such as slide presentations, demonstratives, or other explanatory materials, appear to be rarely placed into the file wrapper, in the experience of the commenters. OPQA should review whether examiners are complying with this requirement.

To conduct this study, OPQA should identify a set of applications for study and review interview summaries provided by the applicant and/or the examiner. Ideally, OPQA representatives would attend the interviews, if it could be done without undue intrusiveness, so as to provide an accurate comparison between the actual substance of the interview and the contents recorded. But even without attending the interview itself, OPQA could still simply review interview summaries and identify:

- Whether the summary identifies prior art discussed.
- Whether the summary explains the differences between the prior art and the claims.
- Whether, if the claims are subsequently amended, the summary describes the differences between the pre-amendment and post-amendment claims.
- Whether the interview summary provides constructions of key claim terms discussed, particularly if those terms are amended subsequently.
- Whether the interview summary includes any demonstratives, presentations, or exhibits presented to the examiner.

By studying whether interviews accurately reflect the substance of conversations held between the examiner and the applicant, the USPTO can better understand whether current practices are sufficient to place the public on notice as to the scope of the applicant’s claim of a patent right.

Respectfully submitted,

Public Knowledge

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