



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 USPTO 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

Examination of Quality of Examiners’ Statements of Reasons for Allowance

Proposal For Study

Whether examiners’ statements of reasons for allowance are in compliance with the USPTO’s policies.

Explanation

The allowance of a patent application is an incredibly significant event, as it causes the endowment of legal rights in the soon-to-be patent holder and defines new obligations upon the entire public. Consequently, USPTO policy is to ensure that there is a complete explanation of why an application is being allowed, to better guarantee that the public understands the reasoning behind the allowance.

Section 1.104(e) of the USPTO's regulations (Title 37) reads in part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning.

MPEP § 1302.14 explains:

One of the reasons of 37 CFR 1.104(e) is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

As the MPEP thus recognizes, the statement of reasons for allowance serves the purpose of helping the public understand the patent and the scope of its grant, and it helps future litigants by simplifying the issues in litigation.

Unfortunately, in the authors' experience as a patent prosecutor and litigators, statements of reasons for allowance are frequently disappointingly lacking and uninformative. Many of the statements are nothing more than a recitation of one of the limitations of a claim along with a bare statement that certain prior art references do not teach or suggest those limitations. Indeed, among the worst that the authors have seen—and this practice is unfortunately frequent—the notice of allowance will quote the *entire claim* without even identifying which of the limitations distinguishes the claim from the prior art.

Even the USPTO itself in its new Patent Quality Initiative recognized the need for improved quality of statements of reasons for allowance. In its February 5, 2015 Federal Register Notice, under Proposal 3 of Pillar 1, the USPTO contemplated “providing a

more detailed summary of the reasons for allowing a claim” in order “to clearly communicate to the public the examiner's reasons why the claimed invention is patentable.”

Not only are barebones statements a bane to the public notice function of patents, they also do not comply with the USPTO’s policies. MPEP § 1302.14(I) says:

Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record.

Indeed, it goes on: “Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used.”

OPQA should thus easily and effectively conduct a study of whether statements of reasons for allowance meet the quality requirements of § 1302.14 and the policy goals of the USPTO and the public. Among other things, OPQA could analyze:

- The number of applications that include a statement of reasons for allowance where one would be required according to the MPEP.
- Among those statements of reasons for allowance, the number that only quote claim limitations and assert that prior art references do not teach or suggest those limitations.
- Among those statements of reasons for allowance, the number that quote an entire claim.
- Among those statements of reasons for allowance, the number that provide explanation beyond quotation of claims and citation to claims, and the type of explanation provided.

This information would be greatly beneficial to improving the quality of statements of reasons for allowance, which would improve the quality of patents, simplify litigation, and advance the public interest.

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Respectfully submitted,

Public Knowledge

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February 12, 2016