



February 12, 2016

Michael Cygan  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy.

Mail Stop Comments Patents  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313

<http://www.regulations.gov> (docket number PTO-P-2015-0074)

**Re: Request for Submission of Topics for USPTO Quality Case Studies**

Intel Corporation (Intel) submits the below topic for consideration in response to the United States Patent and Trademark Office's (USPTO) request for submissions of topics for USPTO quality case studies. *See* 80 Fed. Reg. 79277 (Dec. 21, 2015). We appreciate the opportunity to provide a submission for this important initiative.

**Title:** "Prior Art References Submitted to the USPTO in Information Disclosure Statements (IDSs) Should Be More Effectively Used and Weighted in Examination."

**Proposal for Study:** Prior art references submitted by an Applicant in an IDS, which tend to be the best and closest prior art, are not effectively considered and used during examination.

**Explanation:** In Intel's experience, prior art disclosed by the Applicant in an IDS can be very germane to the pending claims. These references frequently include material that can form the basis of high quality obviousness rejections. We have seen, however, that prior art submitted in an IDS is often not effectively used in office action rejections, resulting in overly broad and ambiguous claims. It is frequently not until post-grant proceedings and litigation that highly material IDS-cited prior art is used to invalidate issued claims.

Intel proposes two methodologies to investigate the effective use of prior art cited in an IDS during the pendency of an application. First, the USPTO should study the frequency that art submitted in an IDS is used to invalidate issued claims in inter partes review or post-grant review. This study would review claims that issued from applications in which the Examiner did

not rely on IDS-cited art to determine if that art is later used in post-grant proceedings to invalidate the issued claims.

In addition, we recommend that the USPTO study the related issue of whether an Examiner's reliance on IDS-cited art improves the quality of the examination process. Specifically, this review would study whether cases in which an Examiner relied on art cited in an IDS results in an increased number of office actions, request for continued examination, appeals, or abandonments compared to applications in which the Examiner did not rely on such art.

We believe that these studies could lead to USPTO process changes that place greater weight on prior art cited in an IDS and thus improve the overall quality of issued patents. The USPTO also could issue examination guidance or training materials for Examiners that emphasizes the importance of close scrutiny of prior art cited in an IDS and recommends searching techniques that focus on disclosures in IDS-cited art. Likewise, the USPTO could improve search tools to rank references submitted to the USPTO in IDSs very highly. In other words, IDS submitted references merit additional algorithmic weighting in search tools, thus facilitating close attention to the art submitted by Applicants.

Sincerely,



Tina M. Chappell  
Associate General Counsel  
Director of Intellectual Property Policy  
Intel Corporation



Alan Pedersen-Giles  
Senior Patent Attorney  
Intel Corporation