

of application-level data on patent prosecution that was previously only available through PAIR¹⁶ has already started to stimulate research and study.¹⁷ In short, the USPTO's ability to access and analyze this kind of information has never been greater.

By cross referencing data on patent validity determination with data on patents' characteristics and prosecution histories, the USPTO can determine whether any patent characteristics correlate strongly with validity and, if so, which ones.¹⁸ For example, this analysis might reveal that the citation of NPL or FPA during prosecution, as described above, is strongly and positively correlated with validity. If so, the USPTO might decide in the future to stress to its examiners the importance of looking for prior art outside databases of U.S. patents or to implement additional training for examiners in this regard.

While in an ideal world the USPTO might conduct this kind of study using with a complete sample of all patents adjudicated by any tribunal, the USPTO could focus first on "institution decisions" and "final written decisions" issued by the Patent Trial and Appeal Board in inter partes reviews (IPRs).¹⁹ In the last three years, thousands of invalid claims in hundreds of issued patents have been eliminated in IPRs and many more have been deemed likely invalid in reviews that were settled after an institution decision.²⁰ As the USPTO has already recognized, these decisions offer useful feedback for (at least) the examiner of record of invalidated patents.²¹ Moreover, the USPTO has already collected a good deal of data on PTAB outcomes and, thus, likely need not rely on databases created by third parties (or otherwise reinvent the wheel) to identify confirmed and invalidated patents.²² Finally, compared to litigation outcomes (as well as reexaminations), IPR decisions are made (and become final) relatively quickly²³ and likely involve newer patents – facts that help mitigate the confounding influence of the fact that legal rules and USPTO policies have shifted over time.

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We are delighted that the USPTO is carrying out quality case studies and in support of this effort, encourage the USPTO to take a broad view of what "case studies" it might be possible to carry

¹⁶ Patent Examination Research Dataset, <http://www.uspto.gov/learning-and-resources/electronic-data-products/patent-examination-research-dataset-public-pair> (last accessed Feb. 12, 2016).

¹⁷ See Alan C. Marco, et al., Patent Claims Data and Implications for Patent Quality (June 16, 2015), available at <http://hooverip2.org/wp-content/uploads/Marco-Sarnoff-deGrazia-061615.pdf>.

¹⁸ Lists of patent characteristics that could be studied are available in the literature. See, e.g., Mann & Underweiser, *supra*.

¹⁹ One of us has already begun to conduct just such a study. If the USPTO is interested, we are available to share more details on this ongoing project.

²⁰ See, e.g., Brian J. Love & Shawn Ambwani, *Inter Partes Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93 (2014), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2512519.

²¹ Evolving Programs of the Enhanced Patent Quality Initiative, available at <http://www.uspto.gov/sites/default/files/documents/Evolving%20Programs%20One-Sheet%20Public%20Final.pdf> (suggesting that the USPTO plans to "develop a process for providing post-grant outcomes from sources, such as the Patent Trial and Appeal Board (PTAB), to the examiner of record and the examiners of related applications").

²² PTAB/BPAI Statistics Archive Page, <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/statistics/ptabpai-statistics-archive-page#toc-fy2015> (last accessed Feb. 12, 2016).

²³ Love & Ambwani, *supra*, at 99.

