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The International Society for Patent Information Professionals

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January 30, 2017

VIA EMAIL

United States Patent and Trademark Office
600 Dulany Street
Alexandria Va. 22314

Re: Request for Comments on Examiner Time Goals:
Commit to Search

Dear Sirs:

My name is Robert Grantham and am a private sector patent searcher with 27 years' of experience. I represent the Patent Information Users Group (PIUG), an association whose members conduct patentability, freedom-to-operate, and validity searches for numerous end clients. We are employed by both large and small corporations, law firms and patent search firms. The comments herein do not address overall examination time since our function does not involve the back and forth of examination on the merits but we can authoritatively speak to search and search time. It is understood that the Request for Comments is made in the effort to find ways to improve patent quality.

In response to the October 25th 2016 Federal Register Notice we offer the following insights.

BACKGROUND

Patent examining is not a singular vocational activity as it consists of two functions: searching and examining. Searching is the act of identifying prior art. Examining is the act of applying the law in a negotiation with a patent applicant's representative to: 1) define patent claims or 2) reject the application. Both functions, searching or examining, are full time jobs, each requiring full time attention and employing completely different skill sets. The Patent Office has combined both functions since the

inception of the Office. The combination of both functions was codified by rule making, in response to the patent act of 1954.¹

I will discuss briefly, first, a pair of Comparative Search Models, and secondly, PTO Commentary to date directed to search.

Comparative Search Models

- A. Recent studies² have highlighted differences between the USPTO and the EPO in terms of how each organization conceptualizes their approach to prior art. Several things that the Europeans do differently are worth noting.
1. Search and examination are performed by different people; one conducts the search and a second examines/prosecutes the case.
 2. The EPO made a conscious decision to emphasize that searching is the cornerstone of patent quality.³ This includes a focus on the human component.⁴
 3. Sixty per cent of examination time is dedicated to searching.⁵
 4. The EPO devotes 8 – 12 hours per search.⁶
 5. EPO searches the specification where the search results reflect a body of art around the invention.⁷
- B. The US Private Sector provides yet another comparative model for the PTO. Like the EPO, the private sector has a long history of providing patent searches where best practices have developed that are insightful to the PTO.
1. Patent searching is a separate activity independent from prosecution. A patent searcher provides search results to a practitioner who then prosecutes the case.

¹ The Patent Office promulgated rule 37 CFR 10.7(2)(ii) which defines valuable service as patent prosecution only and eliminates any other activity as substantive. <https://www.gpo.gov/fdsys/pkg/CFR-1998-title37-vol1/pdf/CFR-1998-title37-vol1-sec10-7.pdf>

² GAO Reports [16-479; 16-490] to the Chairman, Committee on the Judiciary, House of Representatives, “Patent Office Should Define Quality, Reassess Incentives, and Improve Clarity” and “Patent Office Should Strengthen Search Capabilities and Better Monitor Examiners Work”, June 2016. <http://www.gao.gov/products/GAO-16-479> <http://www.gao.gov/products/GAO-16-490>; Chien; Coleen, “Comparative Patent Quality”, Santa Clara University School of Law, Legal Research Paper Series, Working Paper No. 02-16, September 2016. https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2833980

³ EPO Patent Quality Director Alfred Spigarelli in a presentation entitled “Patent Quality: Get it Right the First Time”, Santa Clara –Duke Law Patent Quality Conference: Patent Quality – It’s Time, September 9, 2016. <https://santaclarauiversity.hosted.panopto.com/Panopto/Pages/Viewer.aspx?id=76f90ab1-cb48-4302-8596-0737d9acc97d>

⁴ *ibid*

⁵ *ibid*

⁶ Chien; Coleen, “Comparative Patent Quality”, Santa Clara University School of Law, Legal Research Paper Series, Working Paper No. 02-16, September 2016, p. 46. Link at footnote 2.

⁷ Comments by Colleen Chien at the Santa Clara –Duke Law Patent Quality Conference: Patent Quality – It’s Time, September 9, 2016. Link at footnote 3.

2. Private sector patent searchers are full time searchers. Finding high quality prior art is the basis of the job and to be good at it the driving objective.
3. A typical “patentability” search will consume 8 – 12 hours.
4. Private sector searchers are technical generalists. The job is searching which means searching in multiple technological areas in order to become an expert searcher.
5. Private sector searchers look for concepts where the search results reflect a body of art around the invention.

PTO Commentary on Searching with Follow-Up Questions

Public comments by the PTO on search are limited to the automated pre-examination search.⁸ The Office has accurately qualified the search process procedurally,⁹ but there is no policy, rule or regulation that specifically addresses either the search function or the actor, whether public or private sector. We agree that the automated pre-examination search tool will improve the search process. However, in view of the empirical evidence, there are many unanswered questions with clear implications to the future of search quality, particularly:

1. How exactly will the automated pre-examination search facilitate a transition from a production based system that rewards speed-quantity over thoroughness-quality, particularly in view of the size of the Examining Corps?
2. How will the automated pre-examination search engender pride in a quality search product by the Corps, as is the case at the EPO?¹⁰
3. How will the automated pre-examination search compel a deep understanding by the Corps of the classification system considering the resources committed to the CPC?
4. How will the automated pre-examination search result in deeper knowledge by the examiner of source material outside the patent literature?
5. What follows in the footsteps of the automated pre-examination search? Is the automated search the endgame for search improvement by the Office? Will the automated pre-examination search result in more time, less time, or the same amount of time, focused on developing a body of art directed to the invention?
6. What are the cognitive qualities native to the search function and how will the pre-examination search strengthen those skills?
7. What additional steps beyond the automated pre-examination search does the Office foresee taking to increase the quality of prior art found by the Examiners.

⁸ The automated pre-examination search was introduced February 5, 2015 when a Request for Comments on Enhancing Patent Quality was published in the Federal Register (vol. 80 no. 24 p. 6475). <https://www.gpo.gov/fdsys/pkg/FR-2015-02-05/pdf/2015-02398.pdf>. On December 13, 2016 at the Patent Quality Conference held at the USPTO the Associate Commissioner for Patent Quality, Greg Vidovich, spoke on the progress of developing this tool. <https://www.uspto.gov/sites/default/files/documents/patent-quality-conference-slides-508.pdf>

⁹ M.P.E.P. Chapter 900, Section 904.12 https://www.uspto.gov/web/offices/pac/mpep/old/E8R3_900.pdf

¹⁰ Chien, p. 16.

COMMENTS

Our first two comments are directed to the immediate subject of evaluating examination time as was requested. The next three comments address a conceptual change and propose reform intended to affect patent quality in general.

Examiner Search Time

1. For the immediate subject of evaluating examination time, we submit that based on our private sector experience a typical patentability search takes 8-12 hours on average to conduct.
2. In order to evaluate time per case, search time must be separated from all post-search activity. In order to get a better picture of possible future needs, we point out that the self-analysis for current PTO examination time should account for searching using a 3-5 hour time metric.¹¹ (However, we contend that a study of search time using IPR's as the source material will reveal a search effort, by both parties of less than 3-5 hours total.)¹² It isn't how the Office's current formula accounts for search time that's important but instead an honest self-evaluation that provides a picture of current practice so that future objectives can be more effectively reached.

Conceptual Change and Search Reform

3. Search quality is attained more consistently when the person doing the search is a full time patent searcher as has been demonstrated by EPO and US private sector practice. Patent searching is a separate activity independently valuable to patent quality.
4. The situation where a single person is both a patent searcher and a substantive – on the merits – examiner diminishes the quality possible when the functions are separate. The model where one person does both functions is no longer up to modern demands. The PTO has articulated reasons why examination time needs to be re-assessed by stating that the framework has not been updated in 40 years. The single person search and examination model has been around far longer than that, at least since 1954. The EPO found a way to make prior art centric to the process that fits them so the USPTO should begin exploring ways to achieve the same kind of prior art commitment that fits US particulars. In the longer

¹¹ Chien, p. 46

¹² I have personally looked at these four cases: 2012-00001 (Cuozzo); 2014-00056(Ballard); 2014-00070 (Logan, et al); and 2014-00237 (Larson et al). The comment about deficient searching by both parties is confirmed in these four cases.

term, we argue that patent quality is better served by separating the functions.¹³

5. The automated pre-examination search questions herein asked only scratch the surface. The lack of policy directed to searching is seen as attributable to the Office not seeing searching as an independent substantive activity in its own right. Prior art is at the very root of the patent quality issue so a thoughtful analysis of the search function, beyond the narrow automated pre-examination search, is absolutely necessary. A conversation that considers the above questions, and more, would identify best practices and allow the formation of a policy that defines a path forward to the enhancement of patent quality.

CONCLUSION

Before the PTO can understand examiner time usage it should evaluate the search component. Lessons from both the EPO and the US private sector where searching is demonstrated to be a time intensive human based activity must be incorporated into the PTO analysis and compared to contemporaneous PTO practice. The PTO should ask how their examiners search and whether or not that comports with EPO and/or US private sector practice. It should be understood that searching will take at least half the available time for any application regardless of the seniority of the examiner.

Dennis Crouch recently observed that there still appears to be a general consensus that “...the PTO continues to issue too many invalid patents...”¹⁴ Searching is where the “rubber meets the road,” so to speak, and if the office doesn’t look for ways to directly address the human component evident in the problem, nothing will change. I do not expect change to happen overnight. I also do not think that the PTO foresees further eroding of the human component in the search process. While it’s true that the capabilities of Watson may one day reach the search function, the automated pre-examination search tool will not meet that demand tomorrow or in the near future.

Sincerely,

/robertgrantham/

Robert Grantham

¹³ The immediate comments do not address downstream options e.g. an internal search cadre or new applicant options made possible by separating the functions. Such a discussion is beyond the scope of the immediate Request for Comments

¹⁴ USPTO Transitions and Traditions, Patently-O, Jan. 18, 2017. <http://patentlyo.com/>