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Via Electronic Mail

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Attention: Raul Tamayo, Senior Legal Advisor
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in Response to "Request for Comments on Examination Time Goals," 81 Fed. Reg. 206 (October 25, 2016)

IBM thanks the United States Patent and Trademark Office (the "Office") for the opportunity to comment on examination time goals. We appreciate the Office's ongoing commitment to enhance patent quality, and as part of that effort, reevaluating and refining examination time goals.

IBM asserts that the quality of the examination of a patent application is integral to the ultimate quality of the resulting patent. An effective search increases the likelihood that the claims of the disclosed invention distinguish over the prior art. A thorough review of the specification and claims is required to ensure claim definiteness. A clear and well-reasoned rejection provides an opportunity for clarity of the record. Adequate examination time is necessary to perform these, and other necessary examination tasks completely and effectively. Our comments center on the Office maintaining focus on improving the quality of examination and providing the adequate examination time to achieve this most essential goal.

The Overall Complexity of Technology Has Increased

Technological innovations are occurring at a tremendous pace and inventions are now commonly interdisciplinary, requiring comprehension of multiple technology areas to examine. As such, applications are becoming increasingly more complex and difficult to examine.

Certainly applications in rapidly developing technology areas require more time for the examiner to understand and fully grasp the invention. The search areas for these applications are not as well defined or span multiple classifications, necessitating a more expansive search. In truly pioneering technologies the standard terms in the art have not yet been established such that different applications may use different terms to describe the same thing. These inconsistent terms may make it increasingly difficult to find relevant prior art.

Accordingly, IBM has experienced decreased examination quality in applications directed to these more complex and developing technology areas, which we attribute to the difficulties noted above.

Additional Examination Time Would Increase Patent Quality

The current count system creates pronounced time constraints on examiners that impact patent quality. According to a recent U.S. Government Accountability Office (GAO) report¹, 70 percent of examiners have less time than needed to complete a thorough examination.

Under such time pressure, undoubtedly some corners will be cut during examination thereby detrimentally impacting patent quality. If an examiner skips reading the specification, then it would be impossible to identify enablement or written description problems. Further, without reading the specification, the examiner would be unable to ascertain the scope of the claims in applications where the claims recite functional language invoking § 35 U.S.C. 112(f). If the examiner cuts a search short upon finding a reference that is close enough to apply, but not the closest prior art available, then prosecution may later be extended when the examiner is forced to identify and apply additional prior art. Worse yet, an undeserving application may be allowed without a full search ever being conducted.

To ensure patent quality adequate time must be provided for the examiner to perform a thorough examination as required by the Manual of Patent Examining Procedure². Accordingly, IBM believes that an increase in examination time per application is necessary to improve the examination quality overall. Allowing the examiner more time during any aspect of the examination process should permit the examiner to read the specification, better understand the claimed invention, formulate and conduct effective searches, and develop well-articulated and better informed office actions.

Moreover, IBM does not believe that the additional time allotted should be designated to particular activities, but rather suggests that the Office leave it to the examiners' discretion on how to allocate the additional time. An examiner may need to spend more or less time on any given phase of the examination process for a particular application, and rigid allocation of the additional time may unduly constrain examiners.

¹ U.S. Government Accountability Office. (2016, June). *Patent Office Should Define Quality, Reassess Incentives, and Improve Clarity*. (Publication No. GAO-16-490). Retrieved from GAO Reports and Testimonies main page: <http://www.gao.gov/browse/date/week>

² See Manual of Patent Examining Procedure §2103. Ninth Edition, Revision 07.2015.

Pendency Should Take a Backseat to Patent Quality

IBM recognizes that increasing the time allotted per application appears to be at odds with pendency and cost. However, we assert that the Office should continue to emphasize quality of examination over and above either pendency or cost so as to realize the most fundamental goal of patent quality. As a stakeholder, IBM would be willing to absorb a reasonable increase in examination cost and a slight increase in pendency to provide adequate examination time. However, as discussed below, IBM believes that increasing the examination time in the early stages of prosecution may actually reduce the pendency of an application.

IBM contends that the focus on quality of examination, even while allowing additional examining time, may instead reduce pendency, and thus also avoid the cost of protracted prosecution. IBM believes that a portion of the increased examiner time may be best devoted to the first action on the merits. The additional time spent during the initial examination will allow the examiner to read the specification and fully understand the invention, and perform an adequate search. Further, any objections or rejections may be clearly communicated to the applicant and the resulting office action will likely be more complete, understandable, and appropriately based on the closest prior art available. Accordingly, the applicant will be aware of all perceived patentability issues at the beginning of prosecution and may respond or amend as necessary in the first response. Addressing all patentability concerns in the first response will result in more compact prosecution and may actually reduce pendency.

IBM recognizes and appreciates that the Office provides alternative prosecution options that applicants may use to control pendency of a patent application. Specifically, IBM believes that accelerated examination programs may be of particular value for applicants to offset any increased pendency resulting from increasing examiner time.

The Office Should Encourage Examiner Interviews

While we do not advocate designating the additional examination time for particular examination activities, IBM does believe that the Office should encourage Examiner Interviews at all stages of prosecution (including after final rejection) by offering increased time incentives. IBM believes that Examiner Interviews are an important part of quality examination that can reduce pendency. IBM has found that Examiner Interviews efficiently advance prosecution by providing Applicants a deeper understanding of the Examiner's point of view as well as providing Applicants an opportunity to ensure that the Examiner has an appropriate understanding of the invention.

We request that that the Office publish statistics illustrating any correlation between interviews conducted during prosecution of an application and pendency. For example, Applicants would benefit from statistics that provide insights as to when an interview should be conducted, e.g., before a first office action, after a first office action, or after a final office action. IBM would be interested in

understanding if the Office's statistics demonstrate that an interview conducted prior to a first office action provides for a shorter pendency when compared with applications where the interview is conducted after a first action. Interview statistics such as these would provide significant feedback to Applicants as to whether interviews are effective and, if so, whether the timing of the interviews can influence pendency of patent applications.

The Office Should Provide Additional Examiner Training

At the most fundamental level, quality examination requires the examiner to understand the invention and find the closest prior art. For that reason, we encourage the Office to increase opportunities for examiners to receive technical and search training.

IBM acknowledges and has participated in the Office's Patent Examiner Technical Training Program (PETTP) which shares the technical knowledge of volunteers within industry and academia with examiners. IBM suggests that the program be expanded to increase the opportunities for examiners to keep pace with state of the art developments within their technology area. The expansion of this program is particularly important in technology areas of increasing complexity. Further, we suggest that the Office strive to improve the administration of these programs such that the program becomes more structured to identify topics needed, interested volunteers, and better follow through with ensuring participation in these valuable technical presentations.

We also recommend the Office provide examiners with technology-specific search training so that examiners are better equipped with where to search and how to search efficiently and effectively within their technology. In particular, Examiners have expressed that searching for non-patent literature (NPL) is difficult and inefficient because the literature appears in different journals or databases that cannot be searched with a single search function³. Consequently, IBM recommends that the Office provide examiners more access to non-patent literature (NPL) and integrate NPL search capabilities with the typical patent literature search currently performed. Further, the Office should provide examiners guidance on identifying relevant sources of NPL in their particular technology area.

³ U.S. Government Accountability Office. (2016, June). *Patent Office Should Strengthen Search Capabilities and Better Monitor Examiners' Work*. (Publication No. GAO-16-479). Retrieved from GAO Reports and Testimonies main page: <http://www.gao.gov/browse/date/week>

Conclusion

IBM applauds the Office for its continued focus on patent quality and its reevaluation of examination time goals to align with that focus. We believe that patent quality cannot be achieved without adequate examination time. IBM encourages the Office to increase patent examination time goals to provide sufficient examination time even with the prospect of increased pendency and cost. We urge the Office to consider other quality initiatives that may aid in decreasing pendency and cost to applicant. We thank the Office for considering our comments on examination time goals.

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