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Subject: Response to USPTO's RFC on Examination Time Goals - from Medtronic

Medtronic, plc is pleased to provide the following comments in response to the USPTO's Examination Time Analysis (ETA) initiative. Medtronic is a worldwide leader in medical device technology, delivering innovative products and improvements to health care markets across many practices and fields. Medtronic also protects its innovation and investments by actively participating as an intellectual property owner, including filing patent applications at the USPTO. Medtronic was founded in 1949, and has been a heavy user of USPTO services in the decades since.

We have collected our combined experience to provide the following feedback regarding examination time at the USPTO.

(3) Are the applications you prosecute more or less complex than in the past, e.g., 10 years ago? What factors contribute to the increase or decrease in complexity? Do you believe the increase or decrease in complexity has affected the amount of time it takes to prosecute the applications? If so, by how much? Do you believe the increase or decrease in complexity has affected the quality of examination? If so, how?

In our experience, yes, applications have increased in complexity somewhat in the last 10 years. However the amount of time it takes to prosecute an application has increased even more dramatically due to the complexity of caselaw in certain areas (such as section 101), the continually increasing volume of searchable prior art, and the increasing number of tools available to locate that prior art. The advances in this area make searching prior art a more difficult and complex task than it has been in the past.

(4) In order to increase the quality of examination, do you believe that an increase in the time allotted for examination should be designated for specific activities, such as interviews, or left to the discretion of the examiner? What activities would you prioritize and allocate more time to?

Yes. Sustained improvement to the quality of examination will be difficult without an increase in the time allotted for examination. Current examining time is simply too short, especially at the Primary level.

Specific activities that would benefit from additional allotted time include:

(a) Increase the time allotted for the first non-final Office action. In art units on the lower end of the allotted time, primary examiners are expected to read a new application for the first time, consider the claims, conduct a search, and write a first Office action within 6-8 hours. The patent bar is accustomed to spending the first interview in each case walking the examiner through the specification, with the understanding that the examiner has most likely not read it. Without reading the specification, the examiner is unable to use the initial search to find art that is truly relevant to the disclosed invention.

In our opinion, increasing the time allotted for this activity would have the greatest effect on patent quality.

(b) Align counts with active work, rather than giving zero or deferred counts. The count system should align points with active work, rather than deferring points to a time when the examiner is not actively

working. For example, full credit should be given for a Final Office action when it is mailed, rather than withholding 0.5 counts until abandonment or RCE. The count system expects an examiner to spend 0.75 counts worth of time on that Final OA; however, only one third of that time is actually credited when the examiner does the work. Six months later, the examiner gets 0.5 counts worth of credit for zero active work (in the case of an abandonment or RCE). This system presents two problems. One, examiners are incentivized to rush the Final Office action in the biweek during which they get reduced credit. Two, examiners are incentivized to work less efficiently in the biweek during which they get the extra credit.

When examiners are expected to perform active work without receiving counts, lower quality results.

Specific suggested changes: Give full credit (0.75 counts) for a Final Office action when it is mailed. Give an additional credit (such as 0.25 counts) for an Examiner's Answer or Notice of Allowance. Give zero credit for an abandonment or RCE.

Increasing the time allocated for a Final Office action provides another benefit – it decreases the large discrepancy in time allocated for amendments filed after non-final (0.25 counts) and amendments filed with an RCE (1 or 1.25 counts). When examiners are pressed to review substantive amendments in 0.25-counts worth of time, they learn to handle all amendments with similar speed – including amendments that arrive with an RCE. Systematic rushed review of amendments is a detriment to high quality examination.

(c) Award counts for a limited number (for example, two per year) of second non-final action. Examiners should not be expected to be perfect. This also aligns counts with active work.

(d) Give guidance to its examiners on how to spend this additional time. Suggestions include:

- Encourage examiners to:
 - Review NPL. This is hugely valuable.
 - Craft a narrower “broadest reasonable interpretation” based on the specification, and search to that narrower BRI. Limited examination time is likely to lead to broader BRI, producing references that are less relevant to applicants. Encourage examiners to continue searching for the best reference, and not end their search with the first reference that reads on the broadest BRI interpretation of claim 1.
 - Pick the narrowest dependent claim to search first.
- Train SPE's on these measures – for example, they need to be on board with citing NPL.
- Consider hiring more quality assurance specialists for spot-checking.
- Provide a feedback mechanism for directing quality assurance specialists to spot check particular Examiners that routinely provide poor quality Office actions.

(e) Evaluate examiners on their success in moving cases to final resolution, not just on producing counts. Importantly, to the patent bar, “final resolution” does not include appeal or RCE. Final resolution is only allowance or abandonment.

(f) Consider granting signatory authority at a lower workload, to examiners that meet quality standards. Currently, signatory autonomy is granted only at high production quotas. This combination means examiners are freed from oversight at exactly the same time they get most rushed. The “program” for Primary status has flaws (for example, examiners know which types of actions will be reviewed in each part of the program, and examiners can issue serial rejections in their Office actions to ensure that a claim is properly rejected, even if also improperly rejected) and is not an accurate reflection of the quality level an examiner can maintain at steady-state.

(g) Pilot Programs. Encourage the PTO continue pilot programs to expedite prosecution time and quality. Incentivize examiners to be more engaged in pilot programs.

- Post-Prosecution Pilot (P3) Program
 - This program allowed for submission of arguments and optionally a proposed non-broadening amendment to be considered by a panel of examiners (which includes the examiner on the case). Applicant made an oral presentation to the panel. This program was semi-effective in that the case received review by a panel of three examiners before proceeding with a lengthy appeal.
 - Given the limited number of requests allowed by the pilot program (200 for each technology center), participation was not extensive. Also, the oral conference was limited to Applicant's presentation with very limited questions from the panel. The process could be improved by requiring or, at a minimum, allowing the examiner to discuss his/her position on the issues during the conference.
- After Final Consideration Pilot (AFCP) 2.0
 - Our general experience with this program is that examiners routinely determine that they cannot complete a search within the allotted time, even for relatively minor amendments, and thus an additional search via RCE is required. As such, many AFCP 2.0 requests are denied without an interview. The program could be improved by requiring an interview, so that the proposed amendment and relevant art can be discussed, and by narrowing and clarifying the circumstances under which an examiner can decline to conduct a search.

(5) Are there any portions of Office actions which you feel do not add value or quality to the examination? If yes, what are they?

Yes. Here is a list:

- Reasons for Allowance.
- Obviousness-type double patenting rejections written before the case is otherwise in condition for allowance.

(7) While the focus of this request for comments and the roundtables is to find the appropriate amount of time for examination, cost and pendency are also contributing factors. Do these factors raise a concern that should be considered?

Quality should come first, and within reason, quality trumps both pendency and cost. In our view, higher quality examination can easily reduce cost and pendency by leading to earlier resolution of cases. We hope the above suggestions are a step in that direction.

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