From: Kristy Downing
Sent: Tuesday, November 22, 2016 12:49 PM
To: External Examination Time Study <ExternalExaminationTimeStudy@USPTO.GOV>
Subject: Request for Comments on Examination Time Goals

Please see the attached.

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Sincerely,

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"Scientia potentia est"

Memo

To: ExternalExaminationTimeStudy@uspto.gov

From: Kristy J. Downing

Date: 11/22/2016

Re: Request for Comments on Examination Time Goals

The following is submitted in response to the US Patent Office's Request for Comments on Examination Time Goals published October 25, 2016. 81 Fed. Reg. 73,383-84.

As an initial matter, I would take with a grain of salt all commentary received from stakeholders *outside* of the Patent Office; certainly, there is no need to trash every existing time metric. I have been practicing over ten years in private practice and I still have no first-hand knowledge of some of the daily functions of the examining staff and how long it would take to properly execute them – e.g., denoting a list of references considered, seeking SPE approval for a final decision, satisfactorily searching by the Office's standards, or your considerations after receiving a first response to substantive office action. Unless a patent professional has prior experience working in the US PTO, they probably have little appreciation for all of the substantive and administrative steps that the Examining Corps undergoes to produce a competent decision on the merits. An interesting statistic that I recently read is very telling of how those on ground zero view the Office's existing time allotments – the GAO Survey of US Patent and Trademark Office Patent Examiners, GAO-16-479. Table 11 of Appendix III – Estimated Sufficiency of Patent Examiners' Time for Completing a Thorough Prior Art Search – indicates that across technology areas most patent examiners believe that they either have "somewhat less time than needed" or "much less time than needed" to complete a thorough prior art search. *See* the reproduction hereinbelow.

Table 11: Estimated Sufficiency of Patent Examiners' Time for Completing a Thorough Prior Art Search

Estimated percentage of examiners

U.S. Patent and Trademark Office technology center		Much more time than needed	Somewhat more time than needed	About as much time as needed	Somewhat less time than needed	Much less time than needed
Biotechnology and Organic Chemistry		2	5	23	49	20
Chemical and Materials Engineering		1	4	23	46	24
Computer Architecture, Software, and Information Security		3	7	23	44	21
Computer Networks, Multiplex Communication, Video Distribution, and Security		5	10	23	36	24
Communications		6	11	21	39	23
Semiconductors, Electrical and Optical Systems and Components		5	8	22	42	22
Transportation, Construction, Electronic Commerce, Agriculture, National Security and License and Review[a]	Business methods	4	3	29	42	21
	Not business methods	2	4	22	46	26
Mechanical Engineering, Manufacturing, and Products		1	5	16	40	37

Source: GAO survey of U.S. Patent and Trademark Office patent examiners. | GAO-16-479

Notes: Rows may not total 100 percent because the table does not include all response categories, such as "don't know." All estimates have 95 percent confidence intervals of within +/- 6 or fewer percentage points. We asked examiners if given a typical workload they have sufficient time to complete a thorough prior art search. See the related e-supplement, GAO-16-478SP, for the original survey language and more detailed results.

[a] The Transportation, Construction, Electronic Commerce, Agriculture, National Security and License and Review technology center includes a diverse set of technologies, including transportation, construction, agriculture, and business methods. In our review, we separated the art units focused on electronic commerce and business methods (collectively referred to as business methods) in light of recent legislation and court decisions related to business methods.

I believe the existing Examining Corps should be the prime source of information on timing goals.

Answers to Some of the Proposed Questions

As to proposed question #2, a critical factor considered when estimating time for various steps in prosecution is historical data. Though there is an average range of time taken for certain matters, every patent professional is different. The most instructive information as to estimating how long a matter will take me is to consider how long a similar matter has taken in the past. Perhaps, if it is not already done, examiners can report the time it takes them to complete each prosecution milestone or every application.

As to proposed question #4, you asked, "do you believe that an increase in the time allotted for examination should be designated for specific activities…?" Yes, I believe this would be value-added. The example you provided was an increase in time for interviews; I think an increase in time for these activities would increase quality, whether through a pilot program or as a matter of permanent policy. I would prioritize time for activities related to

interviewing and an explanation of reasons for allowance, which is not always consistently provided.

As to proposed question #5, when I receive a second/final office action that does not directly address the response to office action and arguments therein but merely regurgitates language from the first office action it does not seem to add much to the value or quality of examination. Indeed, one may wonder if the response has been substantively understood or considered at all. A response to argument should always be included in a subsequent office action as a matter of course and any time goals should take this into account.

As to proposed question #6, there are activities I believe the Examining Corps can engage in that will indirectly improve examining quality and perhaps time allocations and/or bonuses should reflect this. First, especially for junior examiners, information regarding the state of the art and how certain technology works in their art unit would likely be beneficial. While the art may appear lifeless when searching one patent publication after another, the technology can be very alluring and engaging when seen implemented. To this extent, I would encourage attendance at trade shows, industry demonstrations, independent library research, periodical subscription, membership to technical organizations and the like. If there were a time allotment, budget or bonus opportunity for this sort of learning, I think examiners would find value (and enjoyment) in it.[1] Additionally, for more senior examiners, it would seem that they have know-how that is not necessarily trickling down into junior examining staff efficiently enough. Perhaps they need more time for supervisory activities like, checking the prior art searches, mentoring examiners, reviewing office actions, talking through matters with junior staff and the like.

As to proposed question #7, while cost and pendency are not to be completely ignored, they do not appear to be a significant impediment to time goal alteration since the Office is operating at a substantial surplus or net income of $61M (million) last year per the US PTO FY2015 Performance and Accountability Report and other avenues exist for expedited prosecution when time is of the essence – e.g., fast(er) track programs, petitions to make special, etc.

Additional Suggestions

It may be the case that the Office of Patent Quality Assurance, Correctness and Clarity Data Collection Review Form provides an opportunity for temporal feedback on examining activities. I would like to know time estimates for each case evaluated using that form in addition to activity-specific time data, e.g., for interview preparation and providing reasons for allowance. It may be the case that the applications hitting the quality mark take more or less time than the others. I would also collect salary grade information for the examiner doing the lion's share of the examination and the approving SPE. There may be different kinds of quality issues in the Examining Corps depending on experience level.

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[1] I would certainly consult the existing Patent Examiner Technical Training Program in this regard, especially with respect to the recent technology fairs they have hosted.

The aforementioned GAO Survey provided very detailed information on examining time allotments. It may be beneficial to obtain bid information from private consulting firms on timing estimates and human resource management. They likely have value-added, modern approaches if nothing else.

Attrition seems to be a significant problem for the Office even though the Office is consistently ranked as one of the best federal employers by its employees and I am not really sure why, looking from the outside in. It is possible, however, that time goals and/or overall compensation have something to do with it. I am not sure if you have considered an increase in compensation with this initiative to reset time goals but the two appear to be directly correlated. Even if uniform salary increases would be too costly for the Office, there may be opportunity for bonus/budget increases to incentivize examiners to yield the desired performance, e.g., increased efficiency, hitting quality targets, supervising for quality and/or continuing education in the law and technology.

I hope this is helpful. I am commenting on my own behalf and for the Just Intellectuals *e*Newsletter – an intellectual property law commentary.

Sincerely,

s/ Kristy J. Downing /