

May 24, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Attn: Michael Cygan
Senior Legal Advisor, Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Via email: QualityMetrics2017@uspto.gov

**Re: Comments on Patent Quality Metrics for Fiscal Year 2017 and Request for
Comments on Improving Patent Quality Measurement. 81 Fed. Reg. 16142 (March
25, 2016)**

Dear Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the proposed Master Review Form for monitoring patent examiner performance and to provide its comments on the proposed changes to the Patent Quality Metrics.

The American Intellectual Property Law Association is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA provides these comments and suggestions, regarding the specific questions set forth in the Federal Register Notice.

(1) Is the USPTO moving in the right direction by choosing to focus on two core metrics: A work product metric representing correctness of actions, and a clarity metric that more

thoroughly explores the sufficiency of the Examiner's reasoning in an Office Action, thus moving away from the Composite Quality Metric?

We believe it is beneficial to move from the Composite Quality Metric to the two core metrics. As we have stated previously, the Composite Quality Metric focused more on improving examination efficiency than on examination correctness. We are concerned that this focus may not change since the components of the Composite Quality Metric are still being used to determine patent quality.

Although we welcome the USPTO's move to focusing on a standardized set of metrics implemented in "Master Review Form" (MRF) to implement the Clarity Metric, we suggest the following:

- i) Continue collecting and analyzing external quality surveys: The materials explaining the above question imply that the external quality surveys are to be deemphasized. We believe it is important to collect and analyze external quality surveys as they will facilitate open communications between the USPTO and patent prosecution practitioners and will provide input from the practitioners on the progress being made to improve patent quality. Using these surveys as an "independent check on the quality metrics" may not be sufficient. Furthermore we suggest that each external quality survey provide the person taking the survey with the option of suggesting a question for future surveys.
- ii) At the onset, the MRF could appear overwhelmingly long and may cause some uncertainty for reviewers. In order to reduce these potential issues, we suggest that the MRF be shortened or provided with instructions and/or a user manual for at least those questions that have the potential to be misinterpreted.
- iii) To ensure that the MRF is being used consistently, it may be helpful to point to specific MPEP sections or to specific training materials that provide the basis for the rejection or restriction.

(2) Which of the proposed clarity and correctness review items in the proposed standardized "Master Review Form," available at <http://www.uspto.gov/patentquality>, should be used as the key drivers of patent examination quality metrics?

The Master Review Form (MRF) prompts the reviewer to analyze many aspects of the Office Actions issued by the Examiner and the applicant's response. These aspects, when taken together, can provide a good metric: Is there anything currently happening in the prosecution that should have happened earlier? All rejections in an application should be presented at the earliest time – nothing should be held back. If, for example, multiple references disclose a feature of the invention, the Examiner should so indicate in the Office Action.

The portions relating to the substantive 102, 103 and 112 rejections have the potential to be the “key drivers.” In particular, Section 22 (Reply to Applicant) of the Master Review Form (MRF) is an example of a “key driver” to determine the quality of examination. This section allows a reviewer to evaluate rejections in light of replies made by the Applicant. Applicants’ replies will often be an excellent source to assess quality as in most instances such replies identify shortcomings in rejections and objections made by an Examiner.

Our members note that many issues during prosecution occur because of an incomplete initial search. Thus, even before analyzing the propriety of the 102 and 103 rejections, the review form should prompt the reviewer to determine whether the Examiner performed a proper initial search.

Many problems with issued patents could be overcome by a more rigorous application of the enablement and written description requirements under 35 U.S.C. § 112(a). Thus, although we understand that the Examiners have recently received additional training on these sections, the MRF should include a thorough review focusing on whether the Examiner should have rejected one or more claims under section § 112(a) and, if such a rejection was made, whether it was proper.

(3) How can patent metrics best provide objective, rather than subjective, measurements of quality related features in clarity and correctness reviews?

Objectivity may be increased by applying the metrics impartially or may come from the metrics themselves. With respect to applying the metrics objectively, we suggest developing a clear set of instructions as noted above in response to Question #1 in order to reduce subjective application of the metrics.

The metrics themselves can provide an objective measure if they are used to identify outliers, for example, Examiners who make too few or too many of a particular type of rejection or restriction, or have too many errors for a particular type of rejection or restriction. To implement this, the data in the forms should be consolidated to generate an overall measure of performance by the examining corps against which each Examiner could be compared. Furthermore, this consolidated measure could be used to identify system-wide issues that can be addressed with more training.

In addition to the three questions posed above, the USPTO welcomes comments on any and all areas of quality measurement.

With respect to increasing objectivity in metrics themselves, we suggest the following additional questions to be included in the MRF:

- i) If the application is a continuing application, the MRF should ask whether the Examiner conducted a search of the outcome/status of all family-related applications in terms of appeal,

litigation, and/or post-issuance review, reissue or reexamination and whether prior art and the arguments made in the related applications were considered.

ii) For 103 rejections, ask a) if the applied prior art references are all in analogous prior art, b) if the rationale applied to combine references would have been within the skills of the one skilled in the art, c) was at least one of the categories from MPEP section 2143 for the reasoned rationale theory identified in the Office Action and d) whether the number of prior art references is beyond a certain number. Notwithstanding *In re Gorman*, in most instances, combining four or more references may indicate an unreasonable obviousness rejection. While obviousness rejections based on more than four references may be proper, they should also be rare.

iii) Ask whether prior art references are first applied in Office Actions after the initial Office Action: An Examiner's delay in citing references until late in prosecution suggests an inadequate search at the initial stage of examination.

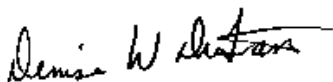
iv) Ask if withdrawn rejections were proper when made, not just if a withdrawn rejection should have been maintained. Asking only if a withdrawn rejection should have been maintained may incentivize Examiners to maintain rejections that should have been withdrawn.

v) Prior art documents in other languages are likely to become more relevant in the examination process. The machine translations of these documents available through the Global Dossier may not provide a complete indication of their relevance. We suggest that Examiners should look not only at the references from the Global Dossier but also at the Office Actions from the other Examiners to understand how the references are applied.

CONCLUSION

AIPLA acknowledges the effort by the USPTO to improve patent quality. These comments have been provided in the spirit of making proposed changes in a way that is compatible with the needs of our members. Thank you for allowing AIPLA the opportunity to provide comments on the proposed quality metrics.

Sincerely,



Denise W. DeFranco
President
American Intellectual Property Law Association