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Via Electronic Mail
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Attention: Michael Cygan, Senior Legal Advisor
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in response to "Patent Quality Metrics for Fiscal Year 2017 and Request for Comments on Improving Patent Quality Measurement," 81 Fed. Reg. 58 (March 25, 2016)

IBM thanks the United States Patent and Trademark Office (the "Office") for the opportunity to comment on its proposed patent quality metrics for use in fiscal year 2017. We appreciate the Office's continuing commitment to enhance patent quality, and as part of that effort, improving the Office's quality metrics to better identify quality-related issues and more clearly communicate those quality issues to the public.

General Comments on Improving Metrics of Patent Examination Quality

IBM supports the Office's proposed shift in focus to not only reviewing the correctness of office actions, but also the clarity of those office actions. We agree with the Office's statements that the clarity of the examiner's determinations and the rationale underlying the decisions made in office actions are important elements of overall patent examination quality and should be emphasized in reviews of USPTO work product. We believe that the proposed "Master Review Form" ("MRF") goes a long way towards providing the needed focus on both the correctness and clarity of the office action.

IBM welcomes the move away from the single comprehensive metric previously used to represent the overall state of patent examination quality. The uncoupling of the Quality Index Report (QIR), the internal quality survey, and the external quality summary from the quality review of the examiner's work product throughout prosecution will provide a clearer picture of patent examination quality to both the public and the Office.

The measurement of statutory compliance and clarity in work products should include more than just a sampling of office actions. We recognize that review of a single office action using the proposed MRF will require significant time and resources and thus, would be unreasonable to require for every office action. We propose the Office collect a minimum amount of data on every office action. For example, IBM believes that data regarding the type of each rejection applied (e.g.

§101, §102, §103, and/or §112) and whether the rejection is final should be collected for every office action. The data collected on every office action could then be mined for specific events or trends that could be used to identify potential quality issues (e.g. newly applied §101 rejections after the first office action on the merits, reopening of prosecution, consecutive non-final rejections, etc.) without the required in-depth analysis of the proposed MRF. We suggest that the Office consider systematic collection of this minimum amount of data for every office action.

Suggested Improvements to the Proposed Master Review Form

As the Office recognizes, clarity of the record is an essential element of patent quality. It is vital that the public is provided clear notice as to the metes and bounds of an invention. As Judge Giles Rich said, **"the name of the game is the claim...** [and] the function of claims is to enable everyone to know, without going through a lawsuit, what infringes the patent and what does not."¹ IBM encourages the Office to make the examiner's claim construction explicit on the record. A clear description of the examiner's claim construction allows the examiner and applicant to work together to clarify the metes and bounds of the applicant's invention. The members of the public and patentees should all have an interest in improving clarity of the record to avoid the burden of unnecessary litigation or work-arounds caused by ambiguity of the record.

IBM believes that the clarity of the record is not fully captured in the current proposed MRF. For example, the questions on pages 11 and 13 of the proposed MRF address the clarity of 102 and 103 rejections by asking "Were annotation(s) provided that reasonably pin-point where each claim limitation is met by the references?" and "Were explanations provided to further clarify the basis of the rejection(s)?" In our experience, even in situations where such annotations were made, it still may remain unclear how the examiner interpreted the claim limitation(s) in view of the reference or how the reference is interpreted and applied to the claim limitation(s). While the questions in the proposed MRF broadly cover the issue of clarity of the record, IBM believes that it would be valuable to also include questions directed at the examiner's interpretation of the claims and the examiner's interpretation of the reference, specifically with respect to 102 and 103 rejections.

In addition, we believe that the proposed MRF does not go far enough to extract meaningful data around the clarity of the record in the areas of the Interview Summary and the Notice of Allowance. IBM strongly believes that any time an examiner's position regarding patentability changes, the change in position and the basis for that change in position, should be made clear on the record. For example, if during an Examiner Interview an applicant demonstrates that a term in the claim is defined or limited in the specification, and the examiner's new understanding of the claim term renders the claim allowable, the examiner should reflect the understood meaning of that claim term and source for the meaning in the interview summary. IBM submits that the most common times for a change in position regarding patentability are at the time of an Examiner Interview or Notice of Allowance and, accordingly, suggests additional clarity review questions in these

areas.

While the proposed MRF does include a few questions that address the Interview Summary under the category "Other Quality-Related Items," the questions included appear to be fairly cursory in nature. We believe additional factors should be reviewed when evaluating the clarity of the record concerning Examiner Interviews. In our experience, Examiner Interviews are an effective tool for advancing prosecution; however, the Examiner's Interview Summary often does not include substantive details of the interview.

IBM has found that after a successful interview in which some agreement is reached as to the allowability of the claims, the discussion of the agreement and the reasons for the change in the examiner's position on patentability is very often not included in the Interview Summary nor in the next office action. The omission of these details deprives the public of clarity of the precise metes and bounds of the claim language and permits unwarranted interpretation that is easily avoidable when the examiner provides these necessary details on the record. Thus, we believe the proposed MRF should address whether or not the examiner indicated an agreement was reached, and if so, whether the examiner described the substance of that agreement.

Similarly, while the proposed MRF also addresses allowable subject matter under the heading "Other Quality-Related Items," it does not address allowable subject matter in a substantive way. For patent clarity, and thus patent quality, the examiner must provide an unambiguous reason for allowance. The examiner should not merely parrot the claim back to the applicant, as it does not provide any further clarity to the record. If the allowance is as a result of a change of the examiner's position, then that change in position should be made explicit on the record. While we understand that the reasons for allowance need not be necessarily provided with the Notice of Allowance, the reasons should be made explicit, somewhere in the record--the public should not be left to wonder. The proposed MRF at page 24 asks "Did the Reasons for Allowance add substance to the record?" Instead, we believe the question regarding allowance should be "Is it clear on the record why the application has been allowed?" and, more particularly, "Is it clear why the examiner deemed prior rejections to be overcome?"

Additionally, IBM believes that the proposed MRF does not fully capture an important aspect of patent quality—completeness of the first office action. While the proposed MRF evaluates the correctness of rejections made and identifies the rejections omitted in the *present* office action, it does not evaluate the completeness of the first office action on the merits. A complete first office action which includes all necessary objections and/or rejections and also clearly explains the examiner's position on each of the essential issues is critical for compact prosecution and allows applicants to make informed prosecution decisions. IBM believes that the proposed MRF form should have an option to indicate if a particular objection or rejection should have been made earlier. This would allow the Office to flag applications that have a new ground for rejection not provided in a first office action and not necessitated by an amendment.

IBM recognizes that §101 patent-eligibility is an area of the law that is in great flux. We appreciate the Office's recent guidance² on patent-eligibility and urge the Office to provide additional information technology examples in future guidance. In response to the Office's most recent guidance, we suggest the question on page 19 of the proposed MRF, "Is there an explanation as to why any additional elements, if present, are not significantly more?" be replaced with, "Is there an explanation as to why any additional elements taken individually and in combination do not amount to a claim as a whole that is significantly more than the exception identified?" We encourage the Office to update the proposed MRF in response to changes to this area of the law and in response to further updates to the Office's guidance.

While the proposed MRF should be as comprehensive as possible, IBM believes that some of the questions included in the proposed MRF go beyond the review of the office action itself and may require further research and/or burden on the reviewer that may not have been contemplated by the Office. For example, on page 11, under "Correctness" the proposed MRF addresses whether the "claimed feature(s) are found in the prior art relied upon." IBM submits that this determination goes beyond the scope of reviewing the office action, and actually requires the reviewer to review the whole of the prior art applied, and in some instances, consider the complicated question of inherency. IBM suggests that this question be omitted from the proposed MRF, and submits that the subsequent question, "Claim limitation(s) are properly matched to prior art relied upon?" is sufficient.

Finally, IBM suggests some minor edits to improve the readability and clarity of the proposed MRF itself. On page 11, under the heading "Correctness" for a 102 rejection made, we recommend replacing "Did not use incorrect form paragraph(s)" with "Correct form paragraph(s) used?" This would make the language for 102 rejections consistent with the language that is used for 103 and 112 rejections. Further, on page 22, regarding the examiner's reply to applicant, we believe that "Were all of applicant's arguments addressed in the Office action...?" should be replaced with "Were each of applicant's arguments individually addressed in the office action ...?" The examiner should clearly address each and every argument provided by the applicant. This recommended clarification is provided to avoid the interpretation that a blanket response to applicant's multiple arguments would be acceptable.

Conclusion

IBM appreciates the comprehensive quality metrics developed by the Office. We believe that the dual focus of correctness and clarity captured by proposed MRF is an improvement to the current quality review metrics. However, to increase data collection and reduce the burden of the review, IBM urges the Office to consider systematic collection of a minimum amount of data for every office action to identify potential quality issues.

Further, IBM encourages the Office to provide accompanying guidance with the final version of the MRF to aide examiners and stakeholders in understanding how these questions will be applied to office actions and the relative weight of the correctness and clarity factors. Providing this accompanying guidance will provide insight as to the key elements of a quality office action to examiners and transparency of the quality review process to the public.

High quality patents, examined with correctness and clarity, provide more certainty to the metes and bounds of issued patents. This certainty drives innovation, reduces unnecessary litigation, and benefits patentees and the public alike. IBM applauds the Office for its focus on patent quality and its efforts to improve their patent quality metrics. We thank the Office for considering our comments on improving patent quality metrics.

Respectfully submitted,

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¹ See Rich, Giles S. "The Extent of the Protection and Interpretation of Claims—American Perspectives." 21 INT'L REV. INDUS.PROP.& COPYRIGHT L. 497, 499, 501 (1990) as quoted in *Hilton Davis Chem. Co. v. Warner-Jenkenson Co.*, 62 F. 3d 1512, 1539 (Fed. Cir. 1995) (emphasis in original).

² Bahr, Robert W. "May 2016 Update: Memorandum- Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant's Response to a Subject Matter Eligibility Rejection." May 4, 2016, (<http://www.uspto.gov/sites/default/files/documents/ieg-may-2016-memo.pdf>), last visited May 16, 2016.