

From: Jeff Nelson

Sent: Wednesday, April 27, 2016 11:32 AM **To:** QualityMetrics2017

Subject: Comments to Patent Quality Metrics for Fiscal Year 2017

From: Jeffry H. Nelson, Nixon & Vanderhye P.C., 901 N. Glebe Road, Arlington, VA 22203. These comments are my personal comments and do not represent the position of Nixon & Vanderhye or anyone else.

(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?

I welcome the USPTO's move to focusing on metrics but doubt the proposed metrics would be any more helpful than the Composite Quality Metric. I find the proposed metrics confusing, complicated, subjective and have limited relevance to my work as a patent prosecutor. Many of the metrics proposed by the USPTO are subjective and are of little value to non-USPTO patent professionals. Whether rejections/objections are clear and correct is subjective and depends on the judgment of a USPTO reviewer of an application. That the USPTO generates subjective metrics judging its own examination does not show high quality examination to those of us on the outside of the PTO. For those of us on the outside, objective metrics would be welcomed that are easily understood and directly relatable to events that occur during examination.

Metrics that would be most useful me as a patent attorney practicing before the PTO are metrics that measure objectively and directly routine interactions with the PTO. My answer to question 3 proposes such metrics.

(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?

Section 22 (Reply to Applicant) of the Master Review Form (MRF) is the key driver to determine quality of examination. The USPTO should consider limiting the MRF to Section 22, Section 2 (Search) and the sections asking whether there were omitted rejections. These sections are sufficient to evaluate patent examination quality. Section 22 allows a review to evaluate rejections in the light of replies made by the Applicant. Applicant's replies will in most instances identify shortcomings in rejections and objections made by an examiner. In view of Section 22, it is unnecessary and burdensome to the PTO to have a reviewer to independently determine the quality of rejections and objections.

The MRF should ask if withdrawn rejections were proper when made, and not just ask if a withdrawn rejection should have been maintained. Asking only if a withdrawn rejection should have been maintain will drive examiner's to maintain rejections that should have been withdrawn. Examiner's should be driven to withdraw poor rejections as well as maintain good rejections.

On 103 rejections, the MRF should ask if the applied prior art is analogous prior art and whether the number of prior art references is beyond a certain number, such as three. In most instances, combining four or more references indicates a poor rejection for obviousness. A metric evaluating the number of references in a 103 rejection would be helpful to evaluate examination quality.

The MRF should ask if the rationale was applied to combine references reasonable and supported by what was known in the prior art. Section 13 only asks if a rationale to combine was explained. Often the rationale is explained but is not reasonable.

(3) How can patent metrics best provide objective, rather than subjective, measurements of quality related features in clarity and correctness reviews? In addition to the three questions posed above, the USPTO welcomes comments on any and all areas of quality measurement.

Examples of objective metrics are: (i) the number of prior art references supporting an obviousness rejection (more than three references suggests a poorly supported rejection), (ii) are non-analogous prior art references applied in an obviousness rejection (the metric could be whether references are in classifications outside the technical field of the invention), and (iii) are new prior art references applied in Office Actions after the first Action (Examiner's waiting until late in prosecution to cite references suggests a poor search at the initial stage of examination). These types of metrics are objective and correspond to the day to day practice of prosecution.

The USPTO's proposed metrics do not consider quality of supervision of examiners or of the quality review staff. It is common that an examiner's supervisor or the quality review staff objects to an action proposed by an applicant or an examiner. These actions by a supervisor or quality review are not always perfect and, when imperfect, degrade patent examination quality. Errors by supervisors and quality review are more harmful to patent examination quality than those by any one examiner because supervisors and quality review staff act on a larger number of applications than do any one examiner and are not supervised in the same manner as examiners. Metrics are needed to evaluate whether there is reasonable consistency of supervision and quality review.