

## USPTO Summary of Comments to Federal Register Request for Comments

Request for Comments on Enhancement in the Quality of Patents, 74 Fed. Reg. 65093  
(December 9, 2009), 1350 Off. Gaz. Pat. Office 46 (January 5, 2010)

On December 9, 2009, the USPTO published a Federal Register Notice entitled “Request for Comments on Enhancement in the Quality of Patents.” 74 Fed. Reg. 65093. In this Request, the USPTO sought public comment on improving the process for obtaining the best prior art, preparation of the initial application, and examination and prosecution of the application. In particular, the USPTO sought ideas for methods that may be employed by applicants and the USPTO to enhance the quality of issued patents, to identify appropriate indicia of quality, and to establish metrics for the measurement of the quality indicia. The USPTO received a large number of comments in response to the Request, many of which were targeted towards specific suggestions for measuring and improving the quality of the examination process. In this posting, the USPTO provides summaries of the majority of the comments. The comments have been grouped into different categories; where beneficial, categories are further divided into individual issues or concerns.

### Examiner Count System

The patent examiner count system was addressed by a number of persons submitting comments. Comments focused primarily on modifying the count system by the addition or elimination of various incentives or disincentives to create the desired result of changing examiner behavior. For example, it is suggested that the examiner count system should be modified to create disincentives for examiners who issue multiple non-final Office actions citing new art when the applicant has overcome the previously cited prior art. Another commenter suggests modifying the count system to permit examiners more time for complex applications, complex applications being those that are lengthy, which contain a large number of working examples or claims, or which cite a large number of prior art references.

### Peer Review Prior Art Pilot

Feedback on the Peer Review Prior Art Pilot (“Peer Review”) was directed primarily at ways in which to revise or enhance the format of the Peer Review program previously piloted by the USPTO. As suggested by one commenter, patent applicants (undergoing a form of candidate review) should be required to create a submission discussing the candidate-provided prior art and whether it is of relevance to their patent application. Additionally, it was suggested that if the USPTO were to re-open the pilot program that it be expanded in scope, and that the USPTO should more aggressively promote knowledge and awareness of the program and be a key player in the IT infrastructure of the program.

### First Action Interview Pilot

Commenters appear pleased with the First Action Interview Pilot, offering positive feedback, for the most part, on their experiences in interacting with examiners earlier during prosecution. One commenter recommends that the pilot in fact be extended to all art units and applications. Looking to establish a measurement for pendency and/or quality purposes, other commenters suggest measuring the timing of applications and the time for final disposal of the applications in which a first action interview is conducted. This could reveal whether efficiency gains are obtained through the pilot.

### Ombudsman Pilot Program

Few commenters addressed the USPTO's Ombudsman Pilot Program presumably because the Ombudsman Pilot did not begin until after the close of the comment period, (the Ombudsman Pilot Program effective date was April 6, 2010, and the close of the comment period for the Request for Comments on Enhancement in the Quality of Patents was March 8, 2010). Nevertheless, at least two commenters suggested thoughtful metrics to facilitate the success of the Ombudsman pilot program and to provide valuable output for both the USPTO and the public. It was thought that the Ombudsman Pilot program should include a database for tracking issues handled by the program and that the data collected in the database then used for identifying individuals or groups (such as an art unit) which may need additional training in a particular area. Other important features suggested for the pilot program were tracking the time lapsed for resolution of the issue presented to the ombudsman and the opportunity for anonymous feedback on the part of applicants to avoid any potential retaliation. Another suggestion was to reestablish the position of prosecution specialist in TC 1600, which played the role of an ombudsman.

### Work-sharing

Several commenters brought attention to quality and efficiency benefits which might be achieved through a greater use of work-sharing amongst international intellectual property offices. For example, it is suggested by multiple commenters that if offices were to collaborate to develop a common database of prior art and a system for automatic access to citations of prior art documents from other IP offices particularly for corresponding applications, the quality of patents might dramatically improve. Similarly, if other IP offices were to agree on a common application format (CAF) such as that accepted by the Trilateral Offices, there would be a greater ease for sharing application specifications and claims internationally.

### Metrics

Many insightful comments were submitted on methods of identifying and measuring quality. The most commonly mentioned suggestions for identifying quality concerns

during an examination were the presence of multiple non-final actions and instances of reopening prosecution after a final rejection, particularly following a pre-appeal brief conference. The comments expressed enthusiasm for measurement of quality throughout the examination process, rather than solely at the endpoint of prosecution of the application. Commenters also expressed an interest in applying data analysis techniques to gathered quality data to identify trends and outliers across the USPTO as well as in specific subgroups such as art units. The USPTO responds below with comments on the ease of applicability, perceived advantages, and potential issues raised by each comment. Many of the comments have been incorporated into suggestions for quality metrics for discussion at the May, 2010 Quality Roundtable meetings. As the USPTO received numerous specific suggestions for specific quality metrics, these comments are addressed in greater detail below.

The most commonly suggested metric for determining examination quality was measurement of multiple non-final actions. This measurement was offered to measure the number of actions which improperly apply one or more claim rejections that are, by the examiner's admission in the next action, fundamentally inadequate.

Some commenters suggested measuring the frequency of occurrence of new references not cited in the first Office action. The commenter raised the concern that repeated presentation of new references can greatly increase pendency and frustrate the process of expeditiously focusing the claims on allowable subject matter. The commenter noted that such a measurement should not include those references cited in view of amendments presented after the first Office action. Such a measure was also stated to reflect upon the quality of the initial search.

Commenters suggested increased attention to the quality of restriction requirement; in particular, measuring withdrawn, late or sequential restriction requirements. This measurement was offered to capture errors in the initial restriction.

Certain commenters suggested reviewing final Office actions and allowances to ensure that the finality or allowance was properly made.

Multiple commenters suggested measuring instances of reopening prosecution after the issuance of a final Office action.

One commenter suggested measuring instances of petitions under 37 C.F.R. 1.181 for review of an action or requirement of an examiner.

Many commenters suggested measurement of quality throughout the prosecution process, with the advantage of providing real time feedback, using methods such as a selective internal review. Additionally, many commenters suggested measurement of certain types of actions (*e.g.*, the first action on the merits), certain types of rejections (*e.g.*, obviousness or written description), or other matters related to Office actions (*e.g.*, search, PTO giving full faith and credit to the ISA/US opinion, giving full credit to attorney arguments).

One commenter suggested measurement of quality throughout the prosecution process by randomly selecting cases for duplicate searching at the pre-examination stage by a non-assigned examiner, with the relative quality of each search being stored, aggregated over numerous such head-to-head comparisons, and used to identify consistently strong performers.

Suggestions for search metrics were also received, including identification of indicia of quality searches, such as number and age of references found, and the crowdedness of the technology field. The use of automated search quality metrics was also suggested.

Many commenters suggested measuring instances of reopening prosecution after pre-appeal brief conference as a formal quality checkpoint. One proposed advantage to measurement at this stage of prosecution was stated to be that the per-case analysis is being performed through the conference, and all that needs to be done is to collect it in a form that permits broader analysis. However, one commenter questioned whether decisions to proceed with appeal were representative of the quality of examination.

Some commenters suggested measuring instances of reopening prosecution after the filing of an appeal brief.

Multiple commenters suggested measuring instances of examiner reversals in decisions by the Board of Patent Appeals and Interferences. However, one commenter noted that patents issued after Board decisions have a likelihood of validity 60% lower than patents that were issued without a Board decision, as measured by litigation outcomes.

One commenter suggested measuring instances of reissue and/or reexamination filings on a patent.

One commenter suggests that the new Final Action/Allowance Compliance Rate metric should take special care to evaluate examiners' statements of reasons for allowance.

Certain commenters suggested that the metrics focus on claims examined rather than case disposals; e.g., publication of the Final Disposition Error Rate in the form of the percentage of claims improperly allowed and the percentage of claims improperly rejected.

Some commenters suggest standard deviation analysis of data taken from a large cross-section of the total number of applications to identify outliers and/or trends in the quality of examination.

Certain commenters suggest using a balanced metric to address errors of allowance and rejection.

One commenter suggested sending customer surveys not just to frequent filers, as this introduces a bias into the surveys. Another commenter suggested that future surveys focus on the substance of applications, prosecution, and the quality of the final product (the issued patent), and should solicit meaningful answers that identify the kinds of issues that create costs in time and money for the Office and applicants. Possible survey topics were identified, including examiner compliance with MPEP guidelines on specific topics.

Some commenters suggested that the USPTO should make the entirety of its official data available to outsiders in raw form, so that the public would be able to suggest appropriate metrics. However, one commenter stated that it is essential that any quality data should be submitted off the record for use by the USPTO for quality improvements only.

Some commenters suggest the use of litigation data.

One commenter suggests that patent quality should be judged primarily by how well a given action will foster innovation and competitiveness. This commenter suggests measuring patent licensing and patent marking, perhaps by requiring patent owners to inform the USPTO of related licenses, products, and litigation settlements.

One commenter suggests interacting with other offices to determine “best practices,” such as through benchmarking against the operations of the European Patent Office, to comport with current trends towards harmonizing patentability standards worldwide and to promote worksharing among the world’s patent offices.

Respondents differed on whether quality was best measured as a function of the examination process or as a function of the validity of the issued patent.

### Examiner and Supervisor Performance

Suggestions for improvement of the performances of examiners and supervisors were offered by a number of commenters. Some comments focused on areas in which the Office could encourage cooperation between examiners to identify and share search techniques, examination efficiencies, and other institutional knowledge. Other comments focused on highlighting areas for improvement in the treatment and remediation of quality errors.

One commenter suggested that examiners who fail to promote to SPE within a certain time should be retired similarly to the U.S. military's up-or-out employment scheme.

Some commenters suggested harsher sanction against employees who have quality errors, including one comment suggesting termination of employment of any examiner found to have committed two quality errors in a single year.

One commenter expressed a concern over the capabilities of "non-English speaking" examiners, and that some examiners are too adversarial.

Some commenters suggested a mentoring program to facilitate enhanced interactions between more experienced and junior examiners, including the identification of examiners with proven technical experience.

One commenter suggested that examiners could periodically report to his or her peers the activities taken in various prosecutions to reduce issues, resolve conflict, and expedite prosecutions. The comment suggested that such efforts could be part of the annual review process.

Some commenters suggested a formal mechanism for applicants to identify quality issues in an ongoing case without fear of retribution, or request a second set of examining eyes on a case.

Some commenters suggested additional legal training within the USPTO, particularly on a Technology Center or USPTO-wide level, including analysis of recent court cases, and directed towards specific topics of interest. However, one commenter stated that

practitioners and the courts often struggle with certain areas of the law, and that the ability of the examiners to perform a competent factual examination was of greater importance.

Some commenters suggested creating branch offices to improve recruitment and retention.

Some commenters made statements to the effect that much of the activities in search of improved quality would be unnecessary if supervisors were held more accountable for the quality of examination of their examiners. Other commenters suggested that better supervision would result in greater attention to quality, and additionally permit quality review efforts to be targeted to examiners likely to have quality issues.

### Examiner Prosecution

Many comments were also offered for improvements in examination procedures. These comments discussed the potential for increased examiner participation in identifying allowable subject matter in Office actions and in interviews. Examiner-applicant interviews was a topic frequently addressed by those responding to the request for comments. Nearly all agree that productive interviews can facilitate a more efficient resolution of issues in a pending application. Commenters differed on suggestions relating to compact prosecution, with some suggestions reflecting a desire for extended prosecution, and other comments reflecting an interest in rapid prosecution of applications.

Multiple commenters suggested that examiners should help applicants identify and claim allowable subject matter, either in the Office action or in an interview. Some commenters stressed that more encouragement should be given to all examiners to simply make greater use of interviews throughout prosecution. One commenter added that focus should be put on cases where no allowable subject matter is indicated by examiner. Another commenter suggested that examiner's suggested amendments be accompanied by a detailed explanation regarding the statutory necessity of the suggested amendments, even where such suggestions are made informally (*e.g.*, in an interview). Additionally, it was suggested that interviews should be performed with the goal of the examiner to find and suggest allowable claims. Another commenter suggested a section of the Office action for examiner suggestions to improve prosecution.

Many commenters had substantive suggestions as to procedural mechanisms which would enhance interviews. Other suggestions ranged from giving applicants one comprehensive interview per application as a matter of right to offering incentives for interviews to requiring that examiners search proposed amendments in preparation for the interview. It was also suggested that examiners should be encouraged to grant interviews

prior to a first action on the merits. Other comments suggested that supervisors should be required to participate in the interview if requested by the applicant such that the interview would be binding, or that the reviewer for the next Office action after an interview be a person who was present at the interview.

One commenter suggests that the USPTO constitute the pre-appeal brief panel with at least two experienced examiners that have not taken part in the examination of the case.

One commenter suggests that the examiner cite all of the possible rejections and art in the first Office action. The commenter suggests this to eliminate anticipation rejections on different art after claims have been amended.

Some commenters suggested that compact prosecution, in which the issues are thoroughly developed and addressed in each Office action such that the second Office action concludes prosecution, is an impediment to high patent quality, and multiple non-final Office actions should be permitted to permit a meaningful conversation between the examiner and applicant. Similar comments were made suggesting complete Office actions prior to the first non-final Office action.

One commenter suggests the use of more detailed rationale in decisions from pre-appeal brief review conferences to better explain the application of the law by the examiner.

One commenter suggested marking the patent document to represent issues of the examiner's claim interpretation, including preamble and field of use, as well as prosecution history and any "inventive step," in order to better serve the public notice function of patents.

Some commenters suggested an expansion of the public's role in submitting and/or commenting on art as third parties, such as through crowdsourcing, an "originality bounty," or a dedicated web interface. One commenter suggests the use of college students for determining obviousness for potential patents cheaply; e.g., for \$60 worth of pizza.

Some commenters expressed a desire for greater clarity in the prosecution record, including improvements to interview recording, reasons for allowance in all cases, detailed claim construction, and citations to prior art.

### Patent Use

A few commenters suggested additional requirements for maintenance of patent rights; however, these additional requirements would be at odds with patent statutes and international treaties.

One commenter suggested that patent applications should require a working model such that the claims should be instantly verifiable by personal demonstration.

Some commenters suggested that patents be required to be used actively; one commenter suggested that the USPTO require proof of active use annually.

### Information Technology

Many comments were received suggesting the implementation of specific software functions. Some recommended that the Office develop appropriate software to implement the desired application and others identified (commercially) available software tools that the Office could employ. For many of the proposals, the link to quality is evident – the tool would make the examiner’s job more efficient by enhancing search, claim analysis, or some other examination function. Other proposals were directed to making the system more convenient for applicant. To the extent that such proposals might lead to better application submissions, these contribute to quality.

### Data Dissemination

A number of commenters urged that the entirety of the official data be made available to the public in raw form. It was suggested that such openness would provide transparency, allow the public to suggest (and calculate) metrics, lend credibility to any measure of quality reported on by the Office, and ensure that the Office could not manage to any stated metric at the expense of other factors.

### Data Collection (for quality)

Two comments suggested that the Office modify forms to allow for collection of data on the type of rejections included in each office action. This would allow trends to be spotted without the need for manual review and coding.

### Quality of Applications as filed

Commenters have made suggestions for and against measurement of the quality of initial applications and applicant actions. Two comments proposed the use of software to obtain a measure of the application as filed. It was suggested that the information could be used to monitor use of PTO resources and to communicate valuable information to the applicant as to the quality of the submitted application, amount and quality of prior art uncovered and probability and expected timing of key prosecution events (allowance, rejection, issuance, etc.). Other comments vigorously opposed any measure of the quality of applicant submission(s) and insisted that the Office should solely monitor its own work product.

One commenter suggested that the public should be required to adhere to higher standards in the quality of the documents submitted to the Office such as minimum 4000 dpi resolution and embedded bookmarks and destinations for ease of navigation by the examiner. This commenter also suggested that an applicant have computers that meet certain stated minimum requirements to aid communication when interviewing.

Several comments suggested that the Office use commercially available patent preparation/quality assurance software to check for typographical errors, antecedent basis of the claims within the specification, consistent use of terminology and reference numerals, and proper support for the claimed invention.

### Search and search enhancements:

Various proposals relating to search tools were proposed including (a) giving examiners access to databases and catalogs of open source computer code; (b) conducting periodic evaluations of commercially available search tools; (c) using software to automatically search and capture publicly available information as of the date of filing; (d) making the examiners' search tools and databases (*e.g.* EAST) available for use by the public; (e) using an internet RSS feed that works similar to the Craigslist.org RSS feeds, in which a user can perform a search, and have the search results contain a link to an RSS feed URL that enables a computer to automatically perform that search on a periodic basis; and (f) using an automated tool that locates relevant documents based on an input document.

One comment suggested that a hierarchical category structure for patents be established and that patent applicant be required to designate the categories to which the invention belongs. Another comment suggested improving the current classification system.

One commenter suggested that the public should be provided with the ability to submit information to the USPTO on-line and users should be able to assign keyword tags to

these documents. These documents should then be available to both the public and the examiner for search purposes, enhancing both examiner performance and the quality of applications as filed. Other similar comments suggested improved USPTO database resources, including non-patent literature and archiving of web pages.

#### Ease and Uniformity of Citation and Submission

Several comments were provided for easing the citation of documents to the Office. One comment suggested that the USPTO develop a URL naming scheme for USPTO documents, as the resulting uniformity would make citation easier. Another suggested that the USPTO develop links within its document management system and the systems of other patent offices to streamline citations of Office actions. The comment recommends a "tool" that allows the applicant to identify/link to related cases (US or foreign) that have prosecution histories of possible interest to the examiner and allow for electronic retrieval by the Office. Another comment in this vein suggested that the USPTO create a database with each reference submitted to the Office, so that future applicants may cross refer electronically to the desired document rather than re-submit an identical reference to the USPTO.

#### Other:

One comment suggested that the Office integrate filing docketing, searching and office action correspondence.

One comment suggested that the electronic copy of the patent as shown on the USPTO website should be the "official" copy, and that it must have accurate searchable text and meet other specified criteria.

Some comments suggested the use of search specialists, either in the USPTO or through private entities.

One commenter suggested publication of a detailed search report prior to the first Office action.

#### Information Disclosure Statements

Some comments were offered on altering the duty of disclosure or the procedure for submission or review of prior art references. Comments suggested requiring only non-patent literature submissions from applicant, or at least eliminating the requirement to submit the actual patent documents to the USPTO. Other comments suggested

heightening the explanation requirements to discourage large submissions of prior art having dubious relevance, encouraging disclosure by offering incentives for advancement out of turn, or requiring examiners to briefly address each submitted reference.

#### Deferred or Multitrack Examination

Many commenters suggested some type of deferred or advanced examination, based upon either additional fees, upon request, in relation to PCT filings, a cap-and-trade system, requiring applicants to file Jepson-type claims, establishment of a “purgatory continuation”, or an examination excluding obviousness analysis.

#### Pre-Grant Publications

One commenter suggested pre-grant publications be printed in a column-and-line format to more precisely identify the location of citations in rejections citing the publication.

#### Social Media

One commenter suggested the use of social media technologies to share information within the USPTO, such as search strategies.

#### Reexaminations

One suggestion was made that reexamination be under a strictly observed, accelerated schedule that allows the reexamination to be finished in one year. Another commenter suggested that all reexaminations be *inter partes*.

#### Oversight of Quality

A suggestion was made for an independent oversight board to review USPTO quality. The ability for applicants to initiate quality review of a rejected application was also suggested.

#### Restriction Practice

A suggestion was made for a separate restriction office to reduce breaking up applications into an unwarranted number of parts. Use of PCT “Unity of Invention” practice was also suggested.

### Pre-Appeal Brief Conference

A suggestion was made to permit applicant participation and greater explanation of panel decisions in pre-appeal conferences.

### Controlling Dictionaries

A suggestion was made for the use of controlling dictionaries to establish, document, and maintain a clear literal meaning for the claims at the time of filing to improve claim clarity.

### Board of Patent Appeals and Interferences Practice

One commenter suggested numerous improvements to the appeal process, including eliminating the Notice of Appeal, automatic appeal docketing following reply brief, prohibiting citations of new references in examiner's answers without designation of a new ground of rejection. Another commenter suggested a simplified appeal process for laypeople.

### Pendency and Patent Term Adjustment

One commenter suggested that patent term adjustment could be printed prominently on every Office Action to encourage applicants and examiners to proceed expeditiously. Another commenter suggested publishing pendency data on an Art Unit and Customer number basis. Another commenter suggested publication of data relating to PCT pendency data.

### Submission of Rebuttal Evidence

One commenter suggested that the USPTO should be willing to accept rebuttal evidence in the form of declaration submitted after a final rejection or as part of the appeal process.

### Patent Practitioners

A number of comments addressed policing and enforcing practitioner behavior, and addressing inequitable conduct issues.

### Manual of Patent Examining Procedure

One commenter suggested increasing the number of case citations in the MPEP.

Electronic Filing System

Comments were received requesting improved help for utilizing the EFS-Web system, and requesting that its use be encouraged.

Continuations

Continuations should be taken up as of their filing date, not as of parent filing date.

Clerical Handling

The USPTO should ensure that same day responses are correctly entered.

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