

USPTO Summary of Comments to Federal Register Request for Comments
Part 2

Metrics

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, USPTO giving full faith and credit to the ISA/US opinion, giving full credit to attorney arguments, or clarity and completeness of the record).

One commenter suggests that when an application is abandoned prior to final action, the non-final rejections should be reviewed carefully to determine any useful indicators.

One commenter suggested that applicants or attorneys should be permitted to request targeted review of specified applications for quality review rather than the use of random sampling in the in-process and final disposition review metrics, but that blind protocol is essential for a complete application process review metric.

One commenter suggested that surveys may not be useful to the extent that customers or examiners respond based on individual recent events rather than general trends.

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.

Treatment of Applications From Independent Inventors

One commenter suggested that applications from independent inventors should be treated separately, having smaller fees. The commenter further suggested that applications should not be accepted if one or more joint inventors refuses to file. The commenter also suggested that the first to invent system should be maintained, and the document disclosure program reinstated, in order to protect independent inventors.

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 USPTO 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. Another commenter suggested that keeping the number of claims presented for examination to a specified, limited amount should be reasonable to maintain quality.

Examiner 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. A similar comment suggested that the Office issue advisory opinions on certain aspects of the claims (improper multiple dependency, restriction, statutory subject matter, means-plus-function limitations) prior to substantive examination using a simple checkbox form that indicates the potential for problems in this area, to be determined by non-examining personnel. 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.

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 suggested 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. Another commenter suggested that such a panel be convened prior to the issuance of any final Office action.

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.

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. Also suggested was that quality review be performed not by the Office of Patent Quality Assurance (OPQA), but rather by interested parties having some familiarity with the case, *e.g.*, a reviewing supervisor, a primary examiner previously consulted on the case, a pre-appeal brief conferee, the attorney who prepared the invention, or the inventor. It was further suggested that OPQA review should not be used for ratings purposes, as such use potentially distorts the data and distracts from the use of the review to improve quality.

Definitions of Quality

Some commenters suggested that quality be defined as (i) actions that increase the likelihood that claims that are granted by the USPTO are legally valid, and (ii) actions that reduce the likelihood that valid claims are not properly rejected by the USPTO; with both factors divided by a timeliness factor. One commenter suggested that infrastructure as well as actions should be considered. Two commenters presented views on whether quality should be focused solely on the Office's performance or additionally consider whether the patent that issues from the examination is "high" or "low" quality because of the actions of applicants or their representatives, such as pre-filing and post-issuance activity.

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 was 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 suggested 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. Another commenter suggested that more examiner time will lead to greater quality, which will cause practitioners to improve the quality of their responses to match the quality of Office actions.

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 was suggested by multiple commenters that the quality of patents might dramatically improve 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. Similarly, if other IP offices were to develop and deploy the IP5 foundation projects, including 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.

Other

One commenter suggested that examiners should receive specialized training in the technical areas of their art, including visits to research facilities doing work in the examiners' art area.

One commenter suggested that the USPTO, users, and organizations work together to develop best practices relative to the preparation and prosecution of applications, including the provision of appropriate tools, education, and incentives.

One commenter raised the concern that rules are applied differently in different art units, especially regarding election of species and restriction requirements.

Commenters suggested greater attention to detail in, and timeliness of, petition decisions.

One commenter suggested multiple avenues of improvement for the quality of examination of patent applications that originate in Japan, South Korea, and China, including adherence to an online, text-searchable USPTO classification system in order to employ art-accepted terminology, the use of meaningful titles, and a requirement that the "Field of the Invention" portion of the specification match or paraphrase the applicable class definitions.

One commenter suggested that new matter be allowed with a new matter filing date.

One commenter suggested appropriate legislation and policies permitting reference characters in the claims.