

**From:**

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**Cc:** Stephen G. Kunin; Richard D. Kelly; Steven Weihrouch; Rick Treanor; Bradley D. Lytle

**Subject:** Comments on Quality Initiatives 75 Federal Register 22120 (April 27, 2010)

The Oblon Spivak McClelland, Maier & Neustadt, L.L.P. law firm (Oblon Spivak) offers it comments in response to the **Notice of Roundtables and Request for Comments on Enhancement in the Quality of Patents and on United States Patent and Trademark Office (USPTO) Patent Quality Metrics**. In addition, Oblon Spivak sent representatives from the firm to the May 18, 2010 Roundtable meeting held at the USPTO. Our comments take into account the observations of the Roundtable participants.

Founded in 1968, Oblon Spivak has grown to become one of the largest firms in the United States specializing exclusively in intellectual property law. We attribute our steady growth to our founders' passion for quality service and uncompromising scientific expertise. For more than 20 years, we have obtained more U.S. patents than any other law firm. We pride ourselves in developing a good working relationship with the USPTO. We are one of the leaders in electronic filing of patent and trademark applications and associated communications with the USPTO.

We offer a team of internationally known experts in every field of intellectual property law, all enthusiastically committed to the goal of client service. Our accomplished professionals are experienced in every technical discipline and hold doctorates and other advanced degrees in biotechnology, computer and software engineering, physics, chemistry, and many other fields.

Our practice groups are organized to assure efficient quality service and to focus individual or team attention on every matter. Seasoned professionals and bright fresh talent bring unique insight, balanced judgment and a keen understanding of new technologies to each area of practice.

We commend the USPTO for its initiative in seeking public comments on how to efficiently and effectively improve patent quality and holding roundtable discussions to further facilitate public input. The quality of U.S. patents is of primary importance to our firm and our clients. Most importantly is for the USPTO to establish and implement continuous quality management systems to enable patent examiners to do their jobs right, the first time, every time.

Attention should be given to improving quality at every stage in the process, from initial examination, through search and substantive examination, appeals and post-examination. Ideally, the quality of the various stages of the patent process should be checked in-process before communications are sent to applicants. In particular, we believe that the clarity and completeness of office actions need to be improved. All too often, practitioners have to guess at how the examiners are interpreting the meaning of claim

terms and how they are interpreting the prior art as applied against the claims in making rejections. While we don't support requiring glossaries of claim terms in patent specifications, we do support examiner's use of claim charts in making rejections, that include how examiners are interpreting the ordinary and plain meaning of claim terms where the examiner must make such an interpretation in order to read the claim limitation on the prior art that does not expressly use the same technical terms. We strongly support collaborate efforts between the USPTO and the patent user community to seek improvements in the patent process. The more personal interactions with USPTO the better to identify issues and have a meeting of the minds on how to effectively and efficiently resolve them. We believe interviews in person with examiners, especially if the SPE is present, are of paramount importance in reaching a meeting of the minds and increasing the efficiency and effectiveness of the examination process. We appreciate the USPTO's existing efforts in implementing the pre-first action interview, accelerated examination, peer-to-patent, patent prosecution highway, ombudsmen and pre-appeal brief programs to enhance examination quality as well as renewed emphasis on principles of compact prosecution that encourages interviews, early indications of allowable subject matter, and comprehensive searches. But the USPTO can and should do more to improve patent quality with the collaboration of patent practitioners. For example, the first action interview program is still flawed in that the Examiner essentially has done the first OA before the interview. It would be better to have a pre-search interview opportunity as well to discuss the meaning and form of the claims, before the examiner invests the time in a search. To shorten patent pendency and to reduce the need for RCE, after final rejection practice should be liberalized. All too often amendments after final rejection that merely rewrite objected to dependent claims in independent form are denied entry simply because the limitations of the dependent claim are added to an existing independent claim rather than rewriting the dependent claim in independent form while cancelling the independent claim from which it depends. This treatment by examiners exalts form or substance and results in unnecessary RCE requests and first action allowances after such requests. Additionally, practitioner participation in appeals conferences and patentability review conferences can serve to achieve more timely and negotiated resolutions of patentability disputes. To improve the quality of decisions on patentability, the USPTO should look to the model used in reexamination wherein a patentability review process is employed before any final action is mailed. This will reduce the number of improper final rejections and unnecessary appeals or RCE.

To improve the uniformity and consistency in patent examination quality renewed emphasis should be placed on rapid development and deployment of the IP 5 Foundation Projects:

1. Common Documentation Database (lead: EPO) - Aim: To bring together a common set of relevant patent and nonpatent literature from around the world to assist patent examiners in their prior art searches

2. Common Approach for a Hybrid Classification (lead: EPO) - Aim: To enable joint and efficient updating of patent classification and facilitate the reuse of work among the patent offices
3. Common Application Format (lead: JPO) - Aim: To facilitate the filing procedure of each office by using a Common Application Format; and by using electronic or digitized patent application filing (in XML format) and subsequent processing and publication in XML format
4. Common Access to Search and Examination Results (lead: JPO) - Aim: To enable examiners to find one-stop references in the dossier information of other offices, such as search and examination results and to conduct the priority document exchange (PDX) to reduce the cost of ordering copies of priority documents for applicants and the administrative costs of electronic processing for offices
5. Common Training Policy (lead: KIPO) - Aim: To standardize the training of patent examiners at each office, helping examiners to produce equivalent results of search and examination at the five offices
6. Mutual Machine Translation (lead: KIPO) - Aim: To help the offices overcome the language barrier of patent information and allow greater access to each other's patent information
7. Common Rules for Examination Practice and Quality Control (lead: SIPO) - Aim: To execute patent examinations at a similar standard and quality through common rules of examination practice and quality control
8. Common Statistical Parameter System for Examination (lead: SIPO) - Aim: To establish a system of common statistical parameters for all examinations at the five offices; and to conduct statistical tasks and exchange information on examination practices under common rules and parameters, building on the work of the Trilateral statistical working group
9. Common Approach to Sharing and Documenting Search Strategies (lead: USPTO) - Aim: To promote reutilization by enabling the patent examiners of each office to understand each other's search strategy
10. Common Search and Examination Support Tools (lead: USPTO) - Aim: To establish a system of common search and examination tools to facilitate work-sharing

Improved search capabilities through comprehensive prior art databases, better search tools and techniques, translations of non-English language prior art and training on searching and the technology of the claimed inventions can pave the way to finding the closest prior art that is at the heart of quality patent examination. Proper continual training on patent law, practice and procedure coupled with good supervision will enable examiners to make better patentability decisions in claim interpretation and application of the proper law to the facts of each case. In-process reviews should be continued and conducted before Office actions are mailed to ensure that claims that should be rejected have been properly rejected and claims that should be allowed are allowed. Moreover, the USPTO should continually monitor abuses in restriction practice by examiners and provide the necessary training on proper uses of restriction practice where appropriate. Where U.S. nonprovisional applications are copending with their U.S. origin PCT applications, the PCT applications should be searched with the counterpart U.S.

nonprovisional application to reduce duplication of effort. To reduce the duty of disclosure burden on applicants, we support the establishment of a common citation database for patent family members in the USPTO to enable the examiners to readily access cited references in counterpart foreign application prosecution as well as related domestic family members. Such information, including references, identification of related applications and office actions, should be made available to examiners by the USPTO rather than requiring applicants to provide same.

The European Patent Office has implemented a very effective quality management system with quality metrics that the USPTO should bench mark and adopt its best practices for ensuring high quality search and substantive examination. When adopted these measures should lead to fewer than 2.3 actions per disposal resulting improved productivity and reduction of examiner rework.

The USPTO's BPAI publishes statistics on the average pendency of all interferences-- including interferences that are settled within days of their declaration. We suggest that the goal should be to minimize the average pendency of interferences that are not settled to within two years. Furthermore, it would be very useful if the BPAI would publish statistics on (1) the average pendency of all those interferences that are terminated by judgment at the conclusion of the first phase of the interference and (2) the average pendency of all those interferences that are terminated by judgment at the conclusion of the second phase of the interference. Those statistics would reflect the pendency times only of the interferences that are not settled.

The USPTO should also strive to achieve the goal of deciding petitions within two months of the filing of a grantable petition. This may require reprioritizing patent resources, but it will lead to greater satisfaction from the patent user community. Additionally, in promoting greater transparency, the petition decisions should be made publicly available on the USPTO website in the same way that BPAI decisions are.

Thank you for the opportunity to share our comments with you.

(On behalf of Richard D. Kelly)

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