

**From:****Sent:** Friday, February 26, 2010 1:28 PM**To:** patent\_quality\_comments**Cc:** Brad Pedersen**Subject:** Response to Request for Comments on Enhancement in the Quality of Patents**Response to Request for Comments on Enhancement in the Quality of Patents  
PTO-P-2009-0054**

Submitted by Brad Pedersen, Reg. No. 32,432. These comments are submitted on behalf of Patterson, Thuente, Skaar & Christensen, PA as a firm. They do not represent the comments or opinions of any of the clients of the firm.

**II. Categories of Public Comments Requested****Category 1 – Quality Measures Used**

*Comment II-1: Computerized Data Collection of the Types of Rejection in Every Case*  
The Office should create some form of standardized check boxes in PAIR for each Office Action or Examiner's Answer to an Appeal Brief that examiners would be required to complete for identifying the type of rejections (e.g., Section 101 rejection, Section 102 rejection, etc.). Data collected and made available by this computerized reporting would permit an overall statistical evaluation of the type of rejections without the need for manual review and coding of the basis for actions in a sampling of cases. The data collected using such a scheme could be reported, for example, by art group unit, in order to document potential trends over time or differences among art group units. This data can provide high-quality feedback, as well as increase public awareness of the reasons for rejections in a given art area, for applications claiming priority to a given period of time, or even for a given examiner over a period of time. Similarly, applicants could be requested in their responses to check boxes indicating the basis for the response. By collecting and analyzing standardized characterizations of the basis of actions, and even responses, the Office will be better able to use best-in-class process-feedback control mechanisms to improve quality.

**Category 2 – Stages of Monitoring**

*Comment II-2: Special Focus on Cases Where Examiner Makes No Indications or Suggestions for Allowability*  
Quality assurance processes should focus on instances where examiners take a position that there is nothing that could be done to put the case in condition for allowance and offer no suggestions in terms of allowable subject matter, claim amendments or additional evidence in support of patentability. It is believed that focus placed on these cases is likely to capture the bulk of cases in which the applicant and the examiner are like "ships passing in the night." Analysis of this smaller set of cases could provide insight into potential reasons for this problem.

### **Category 3 – Pendency**

*Comment II-3: Measure Pendency of Cases with First Action Interviews*

Quality assurance processes should evaluate the time-to-disposal of matters in which FAI occurs. It is believed that tracking this data can be used to document, over time, both the success of First Action Interviews, as well as any changes or trends.

### **Category 4 – Pilot Programs**

*Comment II-4a: Expand First Action Interview Program to all art units and applications*

Examiner-proposed claim amendments and declaration evidence should be discussed during the interview. First Action Interviews are helpful in focusing both the examiner and applicants on the issues at hand and getting this focus earlier in the case can improve both quality and pendency.

*Comment II-4b: Permit Applicant Interviews with the Pre-Appeal Brief Conferees*

The Office should establish a pilot program in which the applicant would have an option to request an interview with the Pre-Appeal Brief Conferees to fully explain the applicant's positions and answer questions prior to a decision by the conferees. A pre-appeal brief interview would provide the opportunity to focus arguments of both the applicant and examiner for appeal and more likely avoid the "ships passing in the night" problem. The pilot program could be conducted in a blind manner with a statistically significant sample size to determine whether the program results in a statistically significant change toward better quality outcomes.

### **Category 6 – Tools for Achieving Objectives**

*Comment II-6: Consider commercially available tools to enhance USPTO processes*

The Office should periodically consider and evaluate the potential use of commercially available patent preparation and/or search tools like Patent Optimizer (available from Lexis-Nexus) to assist examiners with things like checking antecedent basis and consistent use of terminology and reference numerals. The results of such periodic evaluations should be made available for public comment and review to solicit the experience of the public with these tools as part of the evaluation process. One possibility is to establish a pilot program measured against a control group in order to determine whether the use of such tools results in a statistically significant change toward better quality outcomes.

### **Category 7 – Incentives**

*Comment II-7a: Encourage disclosure of non-patent prior art and competitive products by offering incentives for advancement out of turn*

The most difficult prior art for the Office to find is often associated with commercial products and services. The Office should consider offering applicants faster examination by advancing applications out of turn a given number of months in the queue (e.g., 6 months) in exchange for an identification of companies most likely to have developed similar technologies. The purpose of this incentive would not be to identify prior art *per se*, but rather to help the Office conduct a better search. It is believed that this incentive would permit a more effectively search of patents and NPL. Applicants exploiting this option might also be asked to identify which prior art commercially available products are likely to have included similar functionality. Applicants submitting this information should not be subjected to Rule 105 requests for additional information based on these disclosures.

*Comment II-7b: Encourage applicants to utilize advanced electronic filing options*

The Foundation initiative is working on defining ways of enhancing quality and efficiency by advanced electronic filing of applications. The Office should consider offering applicants faster examination by advancing applications out of turn a given number of months in the queue (e.g., 6 months) in exchange for using such advanced filing options. As is well recognized by the Foundation initiative, there are numerous quality and pendency advantages to having applicants provide more information about applications in an electronic manner.

**V. Other Areas of Particular Interest**

**1. Prior Art**

*Comment V-1a: Make Better Use of Applicant Cited Art*

There is a general sense that examiners tend to ignore prior art identified by the applicant or discussed in the background in favor of art found by an examiner or Office Search. The Office should encourage examiners to more thoroughly review cited documents by requiring them to identify what the examiner considers to be the more relevant prior art cited in an IDS having less than a given number of references. Creating a mechanism in prosecution to document that the examiner considered the references cited in an IDS may provide an incentive for applicants to make more focused IDS filings.

*Comment V-1b: Create a pilot program for electronic capture of publicly available information as of the filing date of an application*

The Office should consider creating a pilot program to evaluate whether it is possible to make use of Internet search results as a body of assumed prior art, i.e., a snapshot of the Internet prior art. The Internet search results ideally would be automatically captured in response to computer-generated search targets from an electronically filed application on the filing date. If started as a pilot program, statistical measure could be used to determine how often such “snapshot” captured art was used and applied during prosecution as a measure of the quality and value of this effort.

## 2. **Comprehensive Initial Application**

### *Comment V-2a: No measures of application quality*

The Office should not permit measures of the quality of an initial application to be made as any such measures could be used to undermine the presumption of validity accorded to an issued patent.

### *Comment V-2b: Provide Examples of High Quality Patent Applications and Sample Claim Formats for each Art Group Unit*

The Office should make available examples of what the Office considers to be high-quality patent application in each art group unit to provide examples for the practitioners and public to review. The Office should consider creating example claim templates for each art group unit that also could be published, particularly for claims that use different kinds of claiming techniques.

## 3. **Comprehensive First Office Action**

### *Comment V-3a: Explanation of Claim Construction Used by Examiner*

The Office should make the suggestion for providing an examiner's claim construction a mandatory requirement any time the examiner is relying upon a broadest reasonable construction in view of the specification to support a rejection. It is believed that failure by the examiner to point out when and where the examiner is relying on a broader construction than may be intended by the applicant is one of the principal reasons for the "ships passing in the middle of the night" problem.

### *Comment V-3b: Examiners should be required to propose claim amendments and potential declaration evidence*

The Office should consider requiring that, for each rejection, examiners should, where applicable, propose clarifying amendments (e.g., for arguably vague claim terms), identify new limitations that could be added to the claim(s) to distinguish the art, suggest potential declaration evidence, or indicate that none of the foregoing appear likely to overcome the rejections. This suggestion should be taken together with Comment II-2 as a way for the Office to both provide "hints" for the applicant and also better focus on cases where there is more likely to have been a "ships passing in the night" problem.

### *Comment V-3c: Make Citation to Relevant Portions of Cited Art More Consistent*

The Office should consider establishing standards for requiring examiners to specifically identify which portions of the cited references are most relevant. It is believed that the lack of consistency in terms of how the application of cited references is set forth reduces quality and may inhibit quality measures from being used to improve the reasoning for rejections. Perhaps, providing sample and best case examples on an art-group-by-art-group basis could be a starting point for improving this aspect of prosecution.

#### 4. Comprehensive Response to Office Action

##### *Comment V-4: Submission and Consideration of Rebuttal Evidence*

The Office should be willing to accept rebuttal evidence in the form of declarations submitted after a final rejection or as part of the appeal process. While this approach may not be consistent with the Office's view of compact prosecution, depending upon the extent to which the appeal process is considered to be more of a formal agency process than the informal agency process represented by ex parte examination before an examiner, the Office may be required to consider such rebuttal evidence under the relevant provisions of the Administrative Procedures Act. "A party is entitled to present his case or defense by oral or documentary evidence, *to submit rebuttal evidence*, and to conduct such cross-examination as may be required for a full and true disclosure of the facts." 5 USC 556(d). "When an agency decision rests on official notice of a material fact not appearing in the evidence in the record, a party is entitled, on timely request, to an opportunity to show the contrary." 5 USC 556(e). The issue of when and how the Office procedures comply with APA requirements must be one of the fundamentals of establishing quality prosecution and appeal procedures within the Office.

On behalf of Brad D. Pedersen

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