

From:
Sent: Friday, June 18, 2010 1:00 PM
To: patent_quality_comments
Subject: Comments on Quality Enhancement

In response to the request for comments in 75 FR 22120 (April 27, 2010), I am submitting the following.

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I am submitting the following comments on Enhancement in the Quality of Patents in response to the Federal Register notices at 74 FR 65093 (Dec. 9, 2009) and 75 FR 22120 (Apr. 27, 2010), that request public comment with respect to

Methods that may be employed by applicants and the PTO to:
enhance the quality of issued patents
identify appropriate indicia of quality, and
establish metrics for the measurement of the indicia.

I. Definition of quality:

In the 1st FR notice at P 65094, col 2, in 2nd para, a quality patent is defined as:

1. having a clear record that the application received a thorough and complete examination, addressing all issues on the record, all examination having been done in a manner lending confidence to the public and patent owner that the resulting patent is most likely valid,
2. being of the proper scope for the protection granted, and
3. providing sufficiently clear notice to the public as to what is protected by the claims.

I basically agree with the above definition of a quality patent. With this definition in mind, I do think it is very important to evaluate the quality (of the various steps) of the examination/prosecution process, preferably in an objective manner, but only to the extent that the items reviewed have a bearing on the elements identified in the definition. Stated another way, the Office should not evaluate items that do not affect the necessary elements of the definition of quality.

I do not think, however, that the Office's current review program reliably or accurately assesses examination quality, as defined above, nor for the factors or elements that are critical to the above noted definition of quality. Further, I do not think that the Office's current program is effective to meaningfully enhance the quality of the Office's actions being sent out, and the resulting patents, being issued, and

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merely revising the items, or metrics, being measured will not solve the deficiencies.

II. Quality Review Process should be CONSTRUCTIVE, and add value to the examination process, as it is being performed:

I strongly believe the quality evaluation/review process should be used as a constructive tool during the examination/prosecution process so as to enhance the quality of the examination process on each application, as it is being performed, as the notice indicates. This is radically different from the current process being performed by OPQA - which reviews examination work after it has been completed, and therefore does not effectively enhance, or improve, the quality of the examination process - as it is being performed.

III. Why OPQA, a party who is not involved in the examination process, should NOT assess examination/prosecution quality.

Additionally, I strongly feel that it is extremely difficult, inefficient and, more importantly, essentially unreliable, for any separate organization, or non-involved party, either within the PTO or even external to the PTO, to effectively review any one (or more) patent (application) file(s) to determine the quality level of the examination/prosecution. A non-involved party is unfamiliar with the specific disclosure and claims in each application being reviewed. As such, a reviewer, must familiarize him/her self with the application before starting the evaluation assessment process, and it all must be done within an allocated average amount of time for the review process. This is inherently very inefficient - as it is not associated in any way with the actual examination process of the subject application, nor does it contribute or play any part in the actual examination, or treatment of issues, of the subject application. Further, the allocation of an average amount of time per case (which is always a predetermined given) for the (non-involved) reviewer to perform the review inherently limits the effectiveness and comprehensiveness of the review, and yields results that are significantly dependent upon the predetermined-limited amount of time allocated beforehand for performing the review. Clearly the less time allocated for the review, the fewer errors or deficiencies would be found/noted, and the amount of time allocated by the PTO to the OPQA reviewers has been reduced in recent years to the point

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where the effectiveness and reliability of their review (as to the many issues that could/should be reviewed) is highly questionable.

Also, the external or separate review OPQA arrangement does not really add value to (or enhance) the examination process while the examination process is being performed. Feedback from the reviewer during the examination process itself (and before an action is mailed), in a constructive manner, would result in a higher quality product during the examination process. Thus, it is my opinion that the current OPQA review system should be revised so as to provide such constructive feedback before actions get mailed.

IV. Why reviewer should be a person involved in the examination/prosecution process:

If the reviewer is also a person involved in the examination/prosecution process, either from within the PTO or external to the PTO, the reviewer could essentially perform 2 functions at the same time, namely,

1) his/her examination work input function in whatever amount of time has been allocated for him/her to perform his/her examining/prosecution related function, and

2) his/her review evaluation function of the quality of the inputs and actions of the examiner in the process. This 2nd QR function could be performed with only a little additional time - but it would meaningfully improve the quality of Office actions being issued by examiners.

Thus, there would be little wasted time by the reviewer - as the reviewer's evaluation and opinion(s) about the quality of work would be gained while performing his/her examining/prosecution related input function to the examination/prosecution process.

Also, a person involved in the examination/prosecution process who also performs a review function would be able to make a corrective, constructive input to the process as the process is being performed. Deficiencies could be corrected, or errors avoided if recognized, and corrected, during the process, which is the most desirable of all outcomes. To make this work, however, this QR role on individual cases must NOT be linked to, or used for, rating purposes of the examiner!

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The current quality review and evaluation performed by OPQA, an organization not directly involved in the examination process, is not the right system for evaluating the quality of the examination/prosecution process of a patent application in the USPTO for the following reasons:

As stated above, a (technically competent) examiner type person who is actively (directly) involved in all, or a significant part, of the examination/prosecution process is best qualified to:

- a. make an evaluation of the quality of the work done by the examiner(s), and also to
- b. initiate an action or contribute to an the examiner taking an action which would result in an improved quality process/product if deficiencies, errors or alternative actions would be appropriate to take.

Thus, the most appropriate and qualified reviewer should either be someone from the PTO, or persons external to the PTO, so long as the reviewer person(s) is/are actually significantly involved in the examination/prosecution process.

If not OPQA, who would be a qualified reviewer from the PTO?

Any of the following persons who are each, in a significant way, actively (directly) involved with the examination/prosecution process to the extent that the person can make an informed decision about the quality of the action(s)/work reviewed:

- 1) the SPE to whom the junior examiner reports;
- 2) the primary examiner to whom the junior examiner reports;
- 3) another SPE , or primary examiner, who is consulted on the case, and is familiar enough to understand the issue(s);
- 4) a primary examiner or other SPE who is handling a petition in the case to the extent that it requires developing an understanding of the critical issues involved in the examination process;
- 5) a SPE or other TC examiner who has reviewed the case for partial, full signatory purposes, or for other promotion purposes ;
- 6) a conferee for a pre-appeal brief conference, or an appeal brief conference; and
- 7) a BPAI judge who is deciding an appeal on the case.

While each such above noted person may be able to give meaningful feedback to improve the quality of work going out the door, many times before the work goes out from the Office, each such person would also be well qualified and knowledgeable enough about issues to

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be able to give feedback about the quality of the work product, as previously defined.

Who might be a qualified reviewer - from outside the Office?

Any of the following persons to the extent that their involvement enables an objective informed evaluation to be made of the quality of the action(s)/work reviewed:

- 1) the attorney who prepared and filed the application, and/or who is prosecuting the application;
- 2) the inventor(s); and
- 3) an expert who has been brought in to assist in the prosecution.

Each of such above noted persons would be able to give feedback, not on a specific case, or about a specific action taken by an examiner, but in a general way, in a manner similar to the way feedback is requested in the survey of practitioners now being done by a contractor for the Office. Again, the important issue is whether or not the examiner clearly explained the positions he/she has taken, are the proper issues treated, is the action reasonable and thorough (including being responsive to relevant applicant arguments), and is it reflective of proper consideration of the relevant examination related issues.

V. Why quality review (OPQA) findings should not be linked to performance ratings.

First, the current review performed by OPQA primary examiners is not giving any true indication of patent examination quality, and the resolution of reported errors wastes a lot of examining time and, moreover, frequently adds to application pendency.

Secondly, and more importantly, OPQA findings are not reliable at all. An explanation follows:

1. The review findings are used, at least in part, for rating purposes of the examiners who perform the examination process, as well the art units and TCs to which the examiners are assigned. This is really bad! For example, in the PTO the quality performance results or findings produced by OPQA are used to evaluate the performance of, at least, the different TCs, and sometimes various sub TC organizations, such as art units. As the review findings do/will impact an annual rating, the rated examiner, supervisor or manager, and the organization itself, is (very) defensive and antagonistic whenever there is feedback of an

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error or other notification about a deficient performance. Instead of an OPQA finding being used in a constructive manner to improve the quality of the Office action (examination) of a specific patent application, the finding is usually contested and otherwise opposed. The result is that defending the status quo is the norm instead of embracing the finding, and taking an appropriate corrective action to correct a (possible) error while there is time to do so. Fighting the OPQA error finding leads to a large waste for everyone who is involved - instead of fixing the problem in a constructive manner, and improving the quality of the Office action before it gets mailed.

2. The review findings have been/are used for rating purposes for senior level patents management, such as the Commissioner for Patents, and the Director of the USPTO. This is also very bad! The Commissioner controls OPQA, including the staffing, the allocated average amount of time each OPQA reviewer gets to review applications, the types of errors that the reviewers look for, the number of cases reviewed, etc. As such, the performance and findings of OPQA can be manipulated so as to make it appear that the patent corps is performing at a higher level of quality than might otherwise be the case. In fact, this is a common feeling of many members of the patent bar.

3. Because any found errors are used for rating purposes, the findings of the reviewers are limited to "clear" errors. Where there is any doubt about the error or deficiency, the issue is not noted. This is not good at all as many times performance can be improved if a controversial issue or possible deficiency is noted with feedback in a constructive, non-punitive manner. The examination process is difficult and challenging and the feedback should not be only on a right or wrong basis. Rather the feedback should be via a discussion about the pros and cons associated with various alternative but possible actions basis so the examiner will thoroughly learn how to perform the examination of an application in a consistent, reliable, and high quality manner.

4. In addition to being unreliable, and not constructive, the current OPQA process wastes way too much time for the people that get involved when an error is contested - time which could be much better spent doing (almost any) other useful or important examination related function(s). Fighting errors wastes a tremendous amount of time of at least 3 different parties, namely:

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i. those fighting the errors - by justifying or defending the action that was actually taken in the Office action. This would include the examiner, as well as one or more of the SPE(s), primary examiner(s), TC SPRE(s), TC Director(s), or any other person who gets involved on behalf of the examiner;

ii. those in OPQA defending/justifying the error finding. This would include the OPQA reviewer, and anyone or more other OPQA personal or OPQA managers who get involved in explaining the position on the issue; and

iii. those to whom the error issue is brought for resolution. This would include staff in OPLA, or any other person, or organization under the Associate Commissioner for Patent Examination Policy. The issue(s) are usually difficult to quickly resolve, and allocating sufficient time to appreciate all of the nuances involved, which could be technical, procedural, and/or legal - as well as accommodating the personalities of the involved parties - is absolutely essential if it is to be done in a consistent and fair manner.

5. Lastly, after a contested error is finally resolved in favor of the OPQA position, corrective action in the examination process, likely in the form of another Office action, may be required. In this situation, it is highly likely that the pendency of the application would be adversely affected. This is a very undesirable side effect of this process.

Needless to say - this QR process, because it involves ratings, is not only not constructive to improve the quality of work going out the door, but it is also extremely inefficient because of the time wasted by so many examining related personnel, and the negative affects on patent application pendency.. It needs to be changed - to remove the ratings factor!

Bottom Line: Any Quality Review, including any surviving version of the OPQA review and feedback process, should NOT be used for performance rating purposes.

VI. How persons external to the patent office could rate the quality of the Office's work products?

A questionnaire could be sent out with some, or possibly all, Office actions requesting feedback about the quality of the action. The questionnaire should make clear what factors and features (metrics)

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should be reviewed. For example, an attorney could be asked for his/her viewpoint on about the above noted indicia of quality, including:

“having a clear record that the application received a thorough and complete examination,
addressing all issues on the record,
all examination having been done in a manner lending confidence to the public and patent owner that the resulting patent is most likely valid,“

The questionnaire would make it clear that agreement with some or all of the positions in the Office action was not an important factor. Rather, the positions of the examiner should be clearly and thoroughly explained, reasonably based, and focused on the important examination issues, including the search of the prior art, and the search results. The ratings on quality from the patent bar, or others external to the Office who are involved with the patent examination/prosecution process would be much more relevant and realistic than the current self-serving, unreliable quality ratings coming from the patent office.

The customers of the USPTO should be the ones who rate the quality of the work being performed by the USPTO. Self-serving ratings by the USPTO are not reliable at all, and for that and other reasons, are effectively of little value.

VII. Number of Claims Presented for Examination: A Major Factor that affects Quality of the examination process!

The number of claims in an application has a major impact on the quality of the examination process by the examiner.

The higher the number of claims, the more difficult it is for the examiner to perform a reliable, consistent, fairly thorough examination - in each and every one of the various phases of the examination process. In fact, as the numbers of claims increase above some reasonable level, somewhere around 30 claims, perhaps a bit higher, the quality of the examination process declines. Further, for a number of reasons, the quality goes down significantly, and at an increasing rate, as the numbers of claims increases above that 30 to 40 threshold, and most certainly above 75 to 100 claims.

A quality examination requires the examiner to understand and appreciate the inventions (claims), so as to formulate and then perform the necessary search of the prior art. If it is not already apparent, it

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should be pretty clear that all examiners, as a practical matter, can only keep a limited number of issues, features and factors in mind as they do their work. Claim limitations, and variances in claim limitations/language are very significant especially when there are multiple claims directed to the same basic invention. How many independent inventions/claims do you think an examiner can keep in mind, and look for when searching? Further, there are many different types of claims that can be used to seek protection for an invention, including method claims and product claims, each of which may be directed toward combinations, subcombinations, generic inventions, species, etc. The differences in claim types, and in claim language, and the nuances between different types and claim language, can be very, very significant; and as the number of claims increase, the difficulties for the examiner increase, and probably in some sort of an exponential manner.

More time: Is giving more time to the examiner to perform the examination the answer? NO!

Merely giving examiners more time to perform the examination is not practical for a number of reasons. First and most importantly, more time will not necessarily enable the examiner to perform at the desired quality level. Even with more time, examiners will not be able to do a consistent, high quality examination of all the claims! There are just too many issues and nuances to consider, and keep in mind - with the result that items will be overlooked, or not fully treated as they should be. Examiners clearly recognize this problem, and for this reason, some (even a few is too many, and I would think that it is more than just a few) examiners use the restriction process to essentially carve the large number of claims into smaller, more manageable groupings of claims, without following the proper criteria for making a restriction requirement. This is tolerated by the Office as well as by most patent attorneys even though the restriction requirements do not meet the criteria set forth in the MPEP.

For so many reasons that it is just not practical to go into, or recite, them all, for quality of examination purposes, the number of claims presented for examination in an application should be kept to a reasonable number!

Further, if applicants file parallel patent applications with overlapping claims - that would/could be subjected to double patenting

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rejections - applicants should be responsible for resolving the double patenting issues. This could be done by requiring applicants to file terminal disclaimers, or to state why the separate applications are patentably distinct.

VIII. Most Important Quality factor: Completeness and Clarity of the Patent Application File Record:

The completeness and clarity of the record is the most important indicator of quality! The proposed definition of quality in the FR notice is right on target on this point. It is not so important that every rejection or allowance or interpretation that an examiner makes be correct - but what is important is that the examiner should be required to explain his/her position so the record is clear, and it reflects why certain actions were taken, or not taken. The record for the search should reflect the places searched, and the various search criteria followed. Attorney arguments should not be summarily dismissed. They should be properly and clearly treated in the next Office action. Interpretations of claim terms, and claim language are very critical to the examination/prosecution process, and Office actions should address these issues as they are very critical to patentability determinations, as well as to scope of protection if a patent is granted.

It has been my experience that one can always second-guess, or even find some fault, with an examination or prosecution action, especially if one spends enough time looking for a problem, or wants to find an "error". Finding "errors," however, should not be the way quality is evaluated. Instead, quality should be measured by evaluating the process by which the examination was performed, as reflected in the record of the examination process. We need a consistent examination process to be followed that will seek to do the best quality treatment of issues within the time limits that have been allocated by the Office.

Mark Adler, at the public hearing at the USPTO on May 18, 2010 stated that he considered quality to 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.

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He further stated that it would be desirable to have actions that increase process efficiency and reduce application pendency.

I agree with these statements and feel strongly that the quality review of the examination/prosecution process, if revised so that is "constructive", and not punitive, will help to achieve better quality of the examination process. The quality review process, when it is performed, and by whom-ever does it, should (be revised to) ensure that the feedback adds value to the Office actions before they are mailed! The only way to do this is to remove the "ratings" factor associated with the current OPQA system.

I appreciate the opportunity to submit the above comments, and I heartily support your efforts to look at this issue of quality of the examination/prosecution process.

s/Robert J. Spar/

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