

**From:** Frank Stromotich [mailto:frank\_stromotich@telus.net]  
**Sent:** Friday, January 15, 2010 3:37 PM  
**To:** patent\_quality\_comments  
**Subject:** Request for Comments on Enhancement in the Quality of Patents

Hello Madam(s)/Sir(s):

These are my comments:

In the context of petitions to make special and accelerated examination in matters of green technologies, and the electronic filing to Acrobat 9.3 reading standards, my suggestions follow the old adage, *'To bake something good, start with good ingredients.'*

My suggestions are as follows:

1. A recognition that efficiency benefits start with consistency in the application by the inventor.
2. The application be guided by an objective of ease and speed of comprehension.
3. Initial application must include fully automatic Line numbering, line spacing, page numbering, paragraph numbering starting with **[0001]**, followed by 4 character hard space, Arial font, 8.5x11 portrait or landscape for description and drawings; or A4 size.
4. The rigorous adherence to margin requirements at top and left borders, and similar scale for drawings that are largely identical, which permits the examiner to toggle between drawings to instantly view what is different about the drawings.
5. The use of bookmarks and destinations in the application for ease and speed of comprehension by the examiner. With destinations buttons to efficiently jump over several drawings, to compare FIG 1 with say FIG 10.
6. The entire application be in press quality at least 4000dpi for both black and white and color.
7. A good application is pivotal to moving speedily between other PCT countries.
8. Communication is all important and an applicant should have as a minimum two-22inch, high resolution, 1600dpi monitors. So the inventor can converse with the examiner with the description on one monitor and the figures on a second monitor.

It became apparent from the following the links from the request for comments notice that USPTO works to high resolution standards but does not impose then on applications when it is consistent with the public interest and high resolution benefits of press quality are not onerous:

1. The flowchart\_complete\_process was download and marked with the prefix "1-" attached hereto. This document (39KB) is at least 4000dpi press quality or higher --- as apparent from enlarging it to 6400% with the dynamic zoom tool and nothing breaks up.
2. The said flowchart was marked with a Callout note *'Where am I now?'* and marked with prefix "2-". This document (252KB) appears to be at the same high quality -- only the file size has increased.
3. Document prefixed "2-" was then printed to Acrobat Converter and marked with prefix "3-". This document (40KB) is only 1 KB larger than the original marked "1-" which can be attributed to the addition of the Callout now permanently fixed in the document.
4. The workstation as described in paragraph 8 above costs less than 2 hours of attorney billing time at \$420/hour.

Sincerely,

Frank Stromotich PhD  
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## Request for Comments on Enhancement in the Quality of Patents

DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
[Docket No.: PTO-P-2009-0054]

### Request for Comments on Enhancement in the Quality of Patents

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Request for comments.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) has in place procedures for measuring the quality of patent examination, including the decision to grant a patent based on an application and of other Office actions issued during the examination of the application. The USPTO in conjunction with the Patent Public Advisory Committee (PPAC) has undertaken a project related to overall patent quality. This notice is one element in that endeavor. As part of this effort to improve the quality of the overall patent examination and prosecution process, to reduce patent application pendency, and to ensure that granted patents are valid and provide clear notice, the USPTO would like to focus, inter alia, on improving the process for obtaining the best prior art, preparation of the initial application, and examination and prosecution of the application. The USPTO is seeking public comment directed to this focus with respect to 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 indicia. This notice is not directed to patent law statutory change or substantive new rules. It is directed to the shared responsibility of the USPTO and the public for improving quality and reducing pendency within the existing statutory and regulatory framework.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before February 8, 2010. No public hearing will be held.

**ADDRESSES:** Written comments should be sent by electronic mail message over the Internet addressed to [patent\\_quality\\_comments@uspto.gov](mailto:patent_quality_comments@uspto.gov). Comments may also be submitted by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Kenneth M. Schor and Pinchus M. Laufer. Although comments may be submitted by mail, the USPTO prefers to receive comments via the Internet.

The written comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the USPTO Internet Web site (address: <http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** By telephone: Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710; by mail addressed to U.S. Patent and Trademark Office, Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Pinchus M. Laufer and Kenneth M. Schor; or by electronic mail (e-mail) message over the Internet addressed to [pinchus.laufer@uspto.gov](mailto:pinchus.laufer@uspto.gov) or [kenneth.schor@uspto.gov](mailto:kenneth.schor@uspto.gov).

**SUPPLEMENTARY INFORMATION:** This notice is directed to the quality of the examination and prosecution of patent applications in the USPTO and the quality of patents resulting from that examination and prosecution.

#### I. Purpose of Notice

U.S.C. 2(a)(1). The USPTO examines patent applications to determine whether an applicant is entitled to a patent under the law, and issues a notice of allowance if, upon such examination, it appears that the applicant is entitled to a patent. See 35 U.S.C. 131 and 151. The USPTO examines applications for compliance with the applicable statutes and regulations, and for patentability of the invention as defined in the claims. See 37 CFR 1.104(a).

The USPTO is seeking to improve the quality of the examination of patent applications and patents resulting from that examination.

A quality patent is defined, for purposes of this notice, as a patent:

(a) For which the record is clear that the application has 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; (b) for which the protection granted is of proper scope; and (c) which provides sufficiently clear notice to the public as to what is protected by the claims. The present quality improvement effort has, as one goal, reduction of overall application pendency and is thus also directed towards identifying quality issues that give rise to process inefficiencies. The term "quality patent" as used herein does not include the economic value of the resulting patent, which is a result of market conditions and not the patent process itself. Rather, providing the strongest quality patent possible in the shortest time permits making the best use of a patent, given any set of marketing conditions.

Improvement of the quality can reliably be achieved by a four step process:

(1) Identification of the key aspects of the examination process that affect quality. These key aspects are the quality items-i.e., activities and actions carried out by the USPTO, by the applicant, or by both;

(2) Identification of indicia of the presence (existence) of the desired quality items;

(3) Establishment of a process that can meaningfully measure such indicia (establishing the metrics that can measure the indicia); and

(4) Establishment/modification of policy and USPTO operations to optimize successful performance of the quality items (activities and actions carried out) to bring about desired improvements in patent quality and reductions in patent application pendency.

The public is being requested to comment on items that affect patent quality, as well as addressing patent process inefficiencies with the aim of simultaneously improving patent quality while reducing overall application pendency. It is preferred that comments be provided in the manner set forth in the "Public Comments Requested" section of this notice (which immediately follows this section) and address the criteria for evaluating such comments set out below in Section III of this notice. In this regard, the USPTO is seeking comments from the public on improved methods of identifying indicia of existing quality items, and additional metrics for the measurement of indicia of existing quality items. Improvement to the monitoring of existing quality items should include methods of more reliable and efficient monitoring, as well as methods for making procedural changes based on the results of the monitoring. The USPTO desires to assess whether existing measures are reflective of the quality items they are designed to measure, how these measures can be improved upon, whether other measures could better assess the same quality items, and whether there are other aspects more indicative of quality that can be readily measured and used to improve quality and reduce application pendency.

The public is also being requested to comment on suggested quality items of particular interest identified below in Section V of this notice by which the examination process can be meaningfully enhanced, or to suggest other key quality items; to identify appropriate indicia of the enhancement of quality provided by the quality items; and to establish metrics for the measurement of the indicia of enhancement. These quality items of particular interest, which will be discussed below, include (but are not limited to) identifying and analyzing the best prior art and evidence bearing on patentability, facilitating the presentation of the positions of

the USPTO and the applicant to each other, coming to a definitive resolution of the issues that are presented which resolution is clearly stated, and presenting a clearly identified scope of the patent coverage,

to provide the strongest quality patent possible in the shortest time.

## II. Categories of Public Comments Requested

For ease of organization and analysis, the areas for which the USPTO is requesting comment by way of this notice are divided into specific categories. The categories for which public comments are solicited are as follows:

Category 1-Quality measures used: The USPTO is specifically requesting feedback on the quality measures that it is currently using (described below in Section IV.A), and new measures that it may adopt in the future. As to quality measures currently in place, the USPTO desires to assess whether these measures are reflective of the quality items they are designed to measure, whether these measures can be improved upon, whether other measures could better assess the same quality items, and whether there are other aspects more indicative of quality that can be readily measured.

Additionally, areas in which the USPTO is particularly interested are those of: (1) Finding the best prior art; (2) obtaining a comprehensive initial application; (3) providing a comprehensive first Office action on the merits including a clear explanation of all issues raised; (4) obtaining a comprehensive and clear response to Office actions on the merits; and (5) proper use of interviews. These are discussed in Section V of this notice. The public is invited to comment on those areas, including suggesting modifications of the USPTO's suggestions. In addition, the public is invited to suggest other areas of the process which are believed to have a significant bearing on quality. Any such suggestions should be accompanied by an explanation of the basis for the belief that the suggested area(s)/modification(s) has/have a significant bearing on quality.

The USPTO is requesting that such feedback be provided in terms of the following information:

A. Identification of the key items, i.e., the activities and actions that are carried out by the USPTO, by the applicant, or by both, that bear on quality. What is the nature of activity, action, or conduct that increases quality, and why is it believed to do so?

B. Identification of indicia of the presence of the desired quality items. How do the proposed indicia show that the desired activities and actions were indeed carried out, and show the quality or effectiveness of that activity performed by the USPTO and/or the applicant?

C. What metric(s) should the USPTO use to measure each indicium, and what is the nexus between the measured indicium and the metric(s) used (why is the existence of the indicium proved by the metric)? Based on that nexus, why is the proposed metric believed to provide a practical combination of reliability and efficiency?

Category 2-Stages of Monitoring: With a view toward reducing patent pendency, the USPTO is considering the monitoring of quality at each step, or at as many steps, in the patent application, prosecution, and examination processes as is feasible, and monitoring of quality as close in time to when the step whose quality is being measured is performed as is feasible. The USPTO is specifically considering monitoring quality at each of the following stages of the patent application and examination process: (1) When the application is filed in the USPTO; (2) when the initial search for the application has been completed; (3) when the first Office action for the application has been completed; (4) when an interview for the application has been conducted; (5) when a reply to the first or any subsequent non-final Office action has been filed; (6) when an Office action (non-final or final) or notice of allowance in response to a reply to a non-final Office action has been completed; (7) when an after-final submission has been filed; and (8) when an appeal brief or other appeal-related paper has been filed.

The USPTO is requesting comments on the choice of these stages, and the practicality of measuring quality at each one of these stages. It

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is requested that the public point out at what step or steps in the patent application and examination process the USPTO should measure the quality obtained by the identified activity, action, or conduct that increases quality. While measuring quality at each stage may yield much information, it seems credible that increasing quality of the application in the early stages would be most effective in reducing pendency, and the USPTO is seeking comment on this hypothesis.

The public is also invited to provide information on how quality is affected by action taken in the above-identified eight stages, or in other stages in the patent application process and to identify the nature of activity, action, or conduct that increases quality in that stage-such information would be included as "other areas of the

process which are believed to have a significant bearing on quality" in the comments responding to Category (1) of this section. Also included would be how the USPTO should measure the quality obtained at each such step, and the nexus between the targeted quality aspect and the measured indicia of the activity, action, or conduct that increases quality in that stage.

Feedback from the USPTO: In connection with this category, the USPTO is also requesting input on the timing of the USPTO's assessment and reporting of various measures of quality in relation to the stages of monitoring. For example, should the USPTO await final disposition of the application before reporting on the quality measure obtained for that application? Or, would there be a practical, cost-effective way for the USPTO to report quality measures, during certain identified stages in the proceeding to be identified in the comments (with an explanation of why it would be practical and cost-effective)?

Category 3-Pendency: The USPTO is also requesting comments on whether the quality of the prosecution and examination of the application and quality of the resultant patent can be improved at the same time as reducing the overall pendency of an application. This category also includes input on how the use of continuing applications (continuations, voluntary divisional applications) has affected overall pendency and quality. For example, where specific claims are allowed in a given application, does the filing of a continuation application to address the broader rejected claims add to or detract from the quality of prosecution and examination of the applications and the quality of the resultant patents?

Category 4-Pilot Programs: The USPTO is interested in receiving feedback regarding the effect on patent quality and examination quality resulting from various pilot programs (e.g., Peer-to-Patent, Pre-Appeal Brief Conference Pilot, First Action Interview Pilot, Continuing Education for Practitioners (CEP) Pilot) either expired or currently in effect. This quality effort does not include at this time providing selection options for different examination procedures such as deferred examination. Input as to what metrics could be used to measure enhancements of quality due to any of these pilot programs is also solicited.

Category 5-Customer Surveys Regarding Quality: The USPTO is requesting feedback on past USPTO surveys of the patent community and proposed modifications for future surveys. In 2006 the USPTO launched the Customer Panel Quality Survey (CPQS). The survey is designed to capture input from the USPTO's frequent customers regarding key examination quality issues and to provide customers with a mechanism to suggest critical training needs and areas on which the USPTO should focus in terms of quality improvement. The survey is also designed to assist the USPTO in monitoring changes in patent examination quality between survey periods.

The USPTO partners with an independent research firm to administer the CPQS. The survey has been administered in regular survey periods or "waves" on a roughly quarterly basis from fiscal year 2006 through fiscal year 2009. The target population for the survey is a panel of patent customers who have had the most interaction with the USPTO over the past year. Top filers are defined as law firms, organizations, or individual inventors who have submitted six or more patent applications in the previous year. The survey uses a rotating panel survey design;

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customers are asked to participate in two consecutive survey periods in order to provide valid trend comparisons between survey periods. On average, there have been about 1,100 respondents per survey period. Survey results are analyzed on a quarterly basis to assist USPTO in developing data-driven improvement strategies on topics related to examination quality.

The USPTO is interested in comments regarding survey composition and methodology, such as questions, format, and population. Comments as to how survey results can be more effectively used to enhance quality are also solicited.

Category 6-Tools for Achieving Objectives: The USPTO is requesting identification of existing tools which are, or can be made, available to users and the USPTO to enhance the quality of the USPTO's processes. Such would include, for example, software tools that will provide meaningful monitoring, search tools, claim analysis tools, and case law identification tools. In addition, the USPTO is interested in data mining tools to help monitor its quality items and other useful statistics.

Category 7-Incentives: The USPTO is requesting comments on means to incentivize applicants and USPTO personnel to adopt procedures and practices that support the achievement of patent quality. It is

recognized that any additional effort to increase the quality of the product has an associated cost.

The criteria used to evaluate comments and proposals are set out below in section III which immediately follows. Comments should consider these criteria and address them as best possible to enhance the value and impact of any proposals and comments.

### III. Criteria for Evaluating Comments and Proposals

Public input which is received will be evaluated in terms of:

- (a) The feasibility of implementation of each proposed enhancement;
- (b) The relative value of the proposed enhancement-
  - 1. Will it affect a statistically significant number of cases, as compared to other suggestions?
  - 2. Will there be any negative consequences of proposed enhancement to the USPTO and practitioners that could outweigh the benefits of its implementation?
  - 3. Will cost/expenditure in USPTO resources outweigh the benefits of its implementation?
- (c) The ability to provide clear indicia of successful quality enhancement, and metrics that will meaningfully measure the results of such enhancement-
  - 1. Are there associated metrics that accurately reflect the indicia?
  - 2. Are there indicators associated with the metric that are capable of accurately reflecting meaningful progress?
  - 3. Do the indicia and metrics reflect a behavior that can, in response to its being tracked, affect a statistically significant number of cases or apply only to certain technologies?
- (d) Practicality of implementing a process to obtain data reflecting the indicia, including-
  - 1. Will cost/expenditure in USPTO resources be too much or how should it otherwise be paid for?
  - 2. Will the tracking of the metric require major overhaul of USPTO internal process in order to gather the appropriate data?
  - 3. Will there be any negative consequences of using the indicia or its metrics to the USPTO and practitioners (e.g., chilling effect on other actions taken) that could outweigh the benefits of its use?

### IV. Background for the Requested Information

A. Quality Monitoring: The Office of Patent Quality Assurance (OPQA) conducts in-depth reviews of examiner work products, evaluates findings, and assists the Patent Examining Corps in the development and implementation of quality improvement initiatives. The OPQA reviews are

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currently used to generate the official USPTO examination quality metrics.

Prior to fiscal year 2005, the USPTO official quality metric was directed to only the final output of the examination process-an allowed application. Since fiscal 2005, OPQA's quality review focus was expanded to encompass all substantive actions within the USPTO's control in the patent process, namely, the quality of the decision to allow an application and the quality of the Office actions issued during the course of examination of an application.

From fiscal years 2005 through 2009, the USPTO employed two official metrics of examination quality: (1) The Allowance Compliance Rate; and (2) the In-Process Review (IPR) Compliance Rate. In fiscal year 2010 the USPTO has modified the official metrics to report (1) Final Action/Allowance Compliance Rate; and (2) IPR Compliance Rate for non-final Office actions.

(1) Allowance Compliance Review: Allowance Compliance is determined by performing a review of a randomly selected sample of allowed applications drawn from all Technology Centers. The reviews are conducted on applications after a notice of allowance has been mailed in an application but prior to patent grant. The focus of this review is on the examiner's decision to allow the application. If any allowed claim is found to be unpatentable for any reason provided in the patent laws, the allowance of the application is considered to be in error. In addition to the assessment of the patentability determination for the claims, the record is reviewed for completeness and clarity and to ensure compliance with procedural and formal matters. The review also evaluates the quality of the examiner's search.

(2) In-Process Review: IPR Compliance is determined by performing a review of a randomly selected sample of applications containing Office actions issued prior to allowance or appeal of an application, drawn

from all Technology Centers. The focus of this review is on indicators of quality that were determined on the basis of feedback from patent practitioners obtained prior to the development of the IPR program and includes, but is not limited to, determining: (1) Whether the rejections made in the Office action are proper; (2) whether the Office action fails to include rejections that would have been appropriate; (3) whether the examiner has responded to all matters of substance in the applicant's reply; (4) whether the examiner has clearly set forth his or her reasoning; (5) the propriety of the finality of a final Office action (where applicable); (6) the propriety of any restriction requirement; (7) the quality of the search; and (8) the propriety of the examiner's handling of formal matters. If there is a clearly erroneous action on the part of the examiner that would cause the applicant or USPTO unnecessary rework or expense in the examination process (such as a clearly erroneous rejection of a claim, failing to include an appropriate rejection where institution of the rejection would necessitate an additional Office action, failure to substantively treat applicant's reply, or improperly making an action final), the action is considered to be an error.

B. Quality Reporting: Fiscal years 2005-2009: As pointed out above, from fiscal years 2005 through 2009, the two official metrics of examination quality used by the USPTO were the Allowance Compliance Rate and the In-Process Review (IPR) Compliance Rate.

The IPR Compliance Rate encompassed both non-final and final Office actions. The IPR Compliance Rate was determined on the basis of a review of a randomly selected sample of both non-final and final Office actions; in FY 2009, the sample size was 3,199, with approximately two non-final actions reviewed for every final action reviewed. The IPR Compliance Rate was defined as the percentage of reviewed applications in which no clearly erroneous action was found.

The Allowance Compliance Rate was a stand-alone review, limited to allowed applications. The Allowance Compliance Rate was determined on the basis of a review of a randomly selected sample of allowed applications. In FY 2009, the sample size was 4,588; thus, approximately three allowances were reviewed for every IPR Compliance Rate action reviewed. The Allowance Compliance Rate was defined as the

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percentage of applications undergoing Allowance Compliance Review whose allowance was not considered to be in error.

Fiscal year 2010: For fiscal year 2010, the In-Process Review compliance rate has been redefined to include only non-final Office actions, and the metric is designated as the "Non-Final In-Process Compliance Rate." In FY 2010 approximately three out of five (58.4%) of all reviews (finals, allowances, and non-finals) will be of non-final actions. Also, final Office actions are now grouped with allowances, to provide a new metric-the "Final Action/Allowance Compliance Rate." In FY 2010, an approximately equal number of allowances (19.4%) and final rejections (22.3%) will be reviewed.

Note that, the new sampling ratios and groupings shift the emphasis of the USPTO quality review process towards the earlier stages of prosecution by emphasizing non-final Office actions. It is believed that an emphasis on the quality of initial actions can do much toward reducing overall application pendency, by identifying weaknesses in the examination process that may have escaped scrutiny by the prior emphasis on allowance compliance.

The Final Rejection/Allowance Compliance Rate is determined on the basis of a review of a randomly selected sample (2,793 for FY 2010) of allowed applications and finally rejected applications. An allowed application is considered to be compliant if it is free from error as defined by the criteria set forth above in Section IV.A(1) titled "Allowance Compliance Review." A final Office action is considered to be compliant if it is free from error as defined by the criteria set forth above in Section IV.A(2) titled "In-Process Review." The Final Action/Allowance Compliance Rate is defined as the percentage of applications undergoing Final Action/Allowance Compliance Review for which no deficiency is found with respect to the examiners' final determination concerning the patentability of the claims.

The Non-Final In-Process Compliance Rate is determined on the basis of a review of a randomly selected sample of non-final Office actions (3,914 for FY 2010). An Office action is considered to be compliant if it is free from error as defined by the criteria set forth above in Section IV.A(2) titled "In-Process Review." The Non-Final In-Process Compliance Rate is the percentage of non-final actions reviewed in which no examination deficiency is found.

Information obtained through the various reviews will be analyzed to identify trends in examination quality, areas where improvement is

needed, and strategies for gaining improvements.

C. Quality Index Ranking (QIR): In fiscal year 2010, the USPTO will be using internal statistical measures to identify outliers and other anomalies in processing and examination.

QIR involves obtaining data from the PALM internal USPTO tracking system on items such as multiple non-final actions, restrictions (after first action, or multiple, sequential or late in prosecution), reopening of prosecution after the filing of an appeal brief, reopening of prosecution after a final rejection, first action allowances, multiple requests for continued examination (RCE) made in a single application, and allowances after RCE filing without any substantive amendment. The data are analyzed to identify outlier populations-i.e., individuals or populations for which there is a frequency of any of these data points that is significantly different from the norm for a particular cohort. Such outliers may signal the presence of quality or procedural issues that need to be addressed (or conversely, in some instances they may indicate superior examination practices, from which best practices could be identified and shared).

A quality initiative for fiscal year 2010 is for the USPTO to perform reviews of Office actions for the purpose of providing individual examiner feedback and training. These reviews will be in addition to the statistical reviews performed by OPQA and those normally performed within the Technology Centers; these additional reviews will be conducted by a combination of OPQA Review Quality Assurance Specialists and Technology Center managers. Applications will be selected for review on the basis of statistical analysis of prosecution parameters identified as being probable indicators of

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procedural or examination practices that are in need of improvement, such as those that are enumerated in the paragraph above. Such review findings will be used for the purpose of providing one-on-one examiner feedback, and for developing broader training initiatives where such needs are identified. Follow-up reviews and/or analysis will be conducted subsequent to feedback and training, in order to assess effectiveness of the feedback loop. At the time of drafting of this Request, the sample size for these reviews has not been finalized.

D. Looking to the Future in Quality Monitoring: The USPTO has, in the past, reviewed quality studies obtained from the public and those generated internally, and it has included the input from such studies in its effort to continually improve the quality examination process. Recently, however, the USPTO has received feedback that its current quality measures do not accurately measure the quality of patents issued by the USPTO or the quality of the USPTO's examination process. In addition, the USPTO has received feedback that some measures it has taken to improve the quality of the patents it issues have resulted in prolonging the prosecution of applications. The USPTO is continually seeking ways to improve the quality of its examination of patents, to improve the means used to measure that quality, and to reduce application pendency. Thus, the USPTO is seeking public input (as above requested in Section II of this notice) on the best ways to improve quality, measure that improvement, without extending the examination/prosecution process, and in fact to shorten the process. It is preferred that the improvements proposed should be directed to (a) ways of identifying and analyzing the best prior art and evidence bearing on patentability and presenting that information "up front," (b) a clear presentation of the positions of the USPTO and the applicant to each other at each stage of the process, and (c) coming to and clearly stating a definitive resolution of the issues that are presented, and clearly identifying the scope of the patent coverage. Comments that focus on specific issues which apply to certain technologies are also solicited.

#### V. Some Specific Areas of Particular USPTO Interest

Enhancement of the process and its quality, as well as monitoring of same, are best accomplished when process changes are a product of input from the USPTO and from the public. In that context, and in the interest of making this request for comments more focused for subsequent action, five specific areas in which the USPTO is particularly interested in receiving comments will now be discussed. The completeness and quality of action taken in these areas prepares the application for an efficient and reliable conclusion in its evaluation, and furthers the goal of providing valid patents.

This notice makes no representation that these five specific areas are the only areas where quality can be improved. The USPTO welcomes any further suggestions to address the details of improving quality in

the five areas specifically identified below, as well as suggestions to address any other specific areas of concern which may be included in this or follow-up quality improvement efforts.

1. Prior Art: Recognizing the essential need for having the best prior art before a patent examiner during the initial examination of a patent application to the quality of the examiner's decision on the patentability of the invention as defined in the claims and the ultimate validity of a granted patent, the USPTO provides specific instructions to examiners for identifying the most pertinent prior art for an application. These instructions are designed to furnish patent examiners with sufficient information to make appropriate novelty and nonobviousness determinations.

Examiners are instructed to conduct "a thorough investigation of the available prior art relating to the subject of the claimed invention." See 37 CFR 1.104(a). More specifically, the Manual of Patent Examining Procedure (MPEP) instructs examiners that prior art searches are to include not only the field in which the invention is classified, but also analogous arts. See MPEP Sec. 904.01(c) (8th ed. 2001) (Rev. 7, July 2008).

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To assist examiners in obtaining the best prior art, the USPTO has invested a substantial amount of resources in the search and retrieval of a wide variety of prior art documents. Patent examiners can readily search classified files, microfilm, and CD-ROMs, comprising United States patents, foreign patent documents, Patent Cooperation Treaty (PCT) publications, as well as a large selection of non-patent literature, including technical journals, books, magazines, encyclopedias, product catalogues, and industry newsletters. In addition, patent examiners have access to in-house and commercial on-line databases providing convenient access, from their desktop, to millions of United States and foreign patent and non-patent literature documents. Furthermore, all patent examiners have access to the Internet to search relevant Web sites for prior art.

The most rapidly changing technologies, for example, in the telecommunications and the computer-related arts, present challenges in searching and identifying the most relevant prior art. This is because often the best prior art with respect to these emerging technologies is available as non-patent literature months to years before it is available in the form of United States or foreign patents. Accordingly, searching the non-patent literature in rapidly changing technologies is vital to the quality of the patentability determination. To ensure complete coverage, the USPTO is working on assembling a larger, more complete non-patent literature prior art collection in emerging technologies and is working on providing patent examiners with better access to non-patent literature in new areas of technology, as new areas continue to emerge.

In addition to the prior art uncovered during the search conducted by the examiner, applicants have a duty to submit all information known to them to be material to patentability of the claims. See 37 CFR 1.56. Applicants are also encouraged to review certain types of information, e.g., prior art cited in search reports of a foreign patent office in a counterpart application, to ensure that material information is disclosed to the USPTO. See 37 CFR 1.56(a)(1) and (a)(2). It is also helpful for applicants to perform a search on the disclosed invention prior to drafting claims for presentation for examination. This applicant contribution is important to high quality patent examination because inventors often are in the best position to be aware of the state of the art and are in possession of, or have access to, the most pertinent prior art. The quality of patent examination increases when applicants assist the examiners in identifying prior art information, particularly non-patent literature, which is material to patentability. This is especially so when the information is identified to the USPTO as early as possible in the examination process, so that issues can be clarified, defined and resolved at an early stage in the examination process.

Given the above, comments are being solicited to improve upon the performance of the USPTO in identifying relevant prior art. In this regard, the USPTO would like to address the difficulties involved in locating the best prior art, and any perception that the best art is not being found with particularity regarding gaps in certain technology areas. Comments are also being solicited regarding search techniques and procedures which can improve the success of identifying relevant prior art, as well as how the parties' efforts in bringing this about can be better achieved and measured. Comments are further being solicited on how the success of identifying relevant prior art can be measured, as well as how the parties' efforts in bringing this about can be measured.

2. Comprehensive Initial Application: The patent acquisition process is best streamlined when the applicant presents a comprehensive initial application. It is suggested that such an application could include the following elements:

Applicant's representative practitioner would present a reasonable number of claims upon filing that cover the broadest and narrowest claim coverage the application clearly supports under 35 U.S.C. 112 and the applicant is willing to accept. The claims would be drafted taking into consideration the relevant prior art and evidence available, and

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the closest prior art (e.g., 5-10 most relevant references) and evidence would be presented to the USPTO as early as possible.

Applicant's representative practitioner would present a clear and complete specification that provides clear written description and support that provides antecedent basis for all claim language. The specification would be readily understandable, with terms or phrases that are not clearly defined in the state of the art having special definitions so that the applicant, examiner, and the public share a common understanding of the scope of the specification and claims.

Comments are being solicited as to the various aspects of the initial application. In addition, input is sought as to what guidelines the USPTO can disseminate, to best assist applicants in preparing applications in a manner that the USPTO can most efficiently and completely examine the applications; and how the completeness of filed applications can be measured. In particular, the USPTO is interested in suggestions as to what features of an initial filing can be used as indicia of the quality and completeness of the submitted application and how to measure the effect these indicia have on pendency of the application and quality of the final result.

3. Comprehensive First Office Action on Merits, With Clear Explanation of All Issues: After reviewing the entire specification in detail, the examiner construes the claims and searches the disclosed invention defined by the claims as construed. The examiner then reviews the entire application for compliance with all the relevant statutory and regulatory requirements, and communicates his/her findings to the applicant in an Office action on the merits. The examiner provides a clear explanation of all issues in the Office action. See 37 CFR 1.104(a).

A comprehensive initial Office action (which is geared toward eliciting a comprehensive response from applicant) is important to streamline the effective resolution of issues between applicant and examiner. It is suggested that initial Office action could include the following. When warranted, the examiner may explain in the Office action the examiner's claim construction as compared with the scope of the disclosed invention, and how the prior art is being applied to the claims. In those instances, the examiner would explain how the prior art is applied against the claims given their broadest reasonable claim construction, as that construction was explained by the examiner. The examiner would also apply the prior art to the claims, as they may be interpreted in light of the specification. The examiner would point out any issues of claim clarity and support for the claims (as well as any other statutory or formality deficiency in the claims and disclosure as a whole), and how to address the issues, as appropriate.

It is contemplated that examiners be explicitly instructed not to always rely solely on form paragraphs, and to modify any form paragraph used, when such is appropriate to a given situation. In general, when using a form paragraph, the examiner should be familiar with any statutory, regulatory, and case law cited in the form paragraph and discuss it in detail as it applies to the specific facts of the case.

It is also contemplated that the Office action would be structured to not only clearly define the issues that are raised, but also to explain any subtleties that an applicant might not recognize. Likewise, the action would not only respond to all points made by applicant, but also would address applicant's assumed logic on which those points were based. Finally, the action would provide suggestions to resolve any issues, whether clearly raised or not, that the examiner believes can and should be resolved, to facilitate the process and resolve issues at the earliest point possible.

Comments are being solicited as to the aspects of the initial Office action that will enhance quality, how one can measure the particular suggestions, whether any aspect of the suggestions should be mandatory or be otherwise procedurally handled, and further addresses the cost impact and how and whether any resultant additional costs to the system of implementing the suggestions can be dealt with or whether the costs exceed the perceived benefits. Comments are also solicited as to how examiners can best communicate the information discussed above, to best assist applicants in responding to Office actions; and how the

success of that communication can be measured.

4. Comprehensive and Clear Response to Office Action on the Merits: Following the Office action, the process is most efficiently advanced when the applicant's response presents all the information at applicant's disposal bearing on the patentability of the claims and desired issuance of a patent. It is desirable that the response place the application in a position where applicant has addressed all the examiner's points as well as all of applicant's needs, while at the same time preparing the application for final resolution of the issues. It is suggested that the response include the following elements:

In responding to the Office action, applicant would address the examiner's explanation of claim construction to the extent it is given, including explaining any disagreement between the USPTO and applicant as to the claim construction. After reading the USPTO's position in the Office action, applicant would provide all needed independent and dependent claims to cover all aspects of coverage desired-prior to the need for a final Office action; this set of claims should include claims that would result in the coverage desired should the examiner's claim construction be adopted (i.e., define patentability over the examiner's claim construction and the examiner's overall position). Applicant would not assume that arguments directed to independent claims will be persuasive, but rather would also argue all meaningful dependent claims individually and explicitly point out which limitations define patentability, and which do not. Also, all evidence to address the examiner's position would be presented as early as possible and before final Office action; it should not to be assumed that if applicant's arguments are not accepted, the evidence can later be presented.

Comments are being solicited as to the various aspects of the above suggested response. In addition, comments are being sought as to what guidelines the USPTO can disseminate to best assist applicants in preparing responses in a manner that the USPTO can most efficiently and completely resolve issues, and bring the examination of the application to a rapid, yet comprehensive, conclusion; and how the success of this can be measured.

5. Proper Use of Interviews: It is highly desirable that the examiner encourages, and is prepared to conduct, an interview whenever it will facilitate resolving ambiguities and issues, or will otherwise allow for a more effective examination.

As to applicant's role, it is suggested that (to obtain maximum benefit from the interview) whenever the practitioner requires clarification of a USPTO position, the practitioner have an interview on the application prior to submitting the response and after comments on Office actions have been received from the client. Before an interview, the practitioner would provide the examiner with an agenda for the interview, including copies of any proposed amendments, exhibits, or other information that would be beneficial to review in advance.

After the interview, both the examiner and applicant would independently set forth in detail what took place at the interview (as required by current procedure). Prior art, and other information/evidence discussed would be specifically identified and the points regarding the claim limitations and/or the disclosure and teachings of the references would be made part of the record. The response to the outstanding Office action would make reference to the points noted in the practitioner's interview summary. Likewise, the response would also address the examiner's interview summary, if it is already of record; if there is conflict with attorney's summary, that conflict can be explicitly noted and clarified as needed.

Comments are being solicited on how to improve upon interview practice, to resolve issues at the interview, and to make the full substance of the interview of record; and how the effectiveness of the interview, as well as the completeness of its recorded summary, can be measured.

#### VI. Guidelines for Written Comments

Written comments should include the following information: (1) The name and affiliation of the individual responding; and (2) an indication of whether comments offered represent views of the respondent's organization or are the respondent's personal views.

As discussed previously, the USPTO prefers to receive comments via

the Internet. Information provided in response to this request for comments will be made part of a public record and may be available via the Internet. In view of this, parties should not submit information that they do not wish to be publicly disclosed or made electronically accessible. Parties who would like to rely on confidential information to illustrate a point are requested to summarize or otherwise submit the information in a way that will permit its public disclosure.

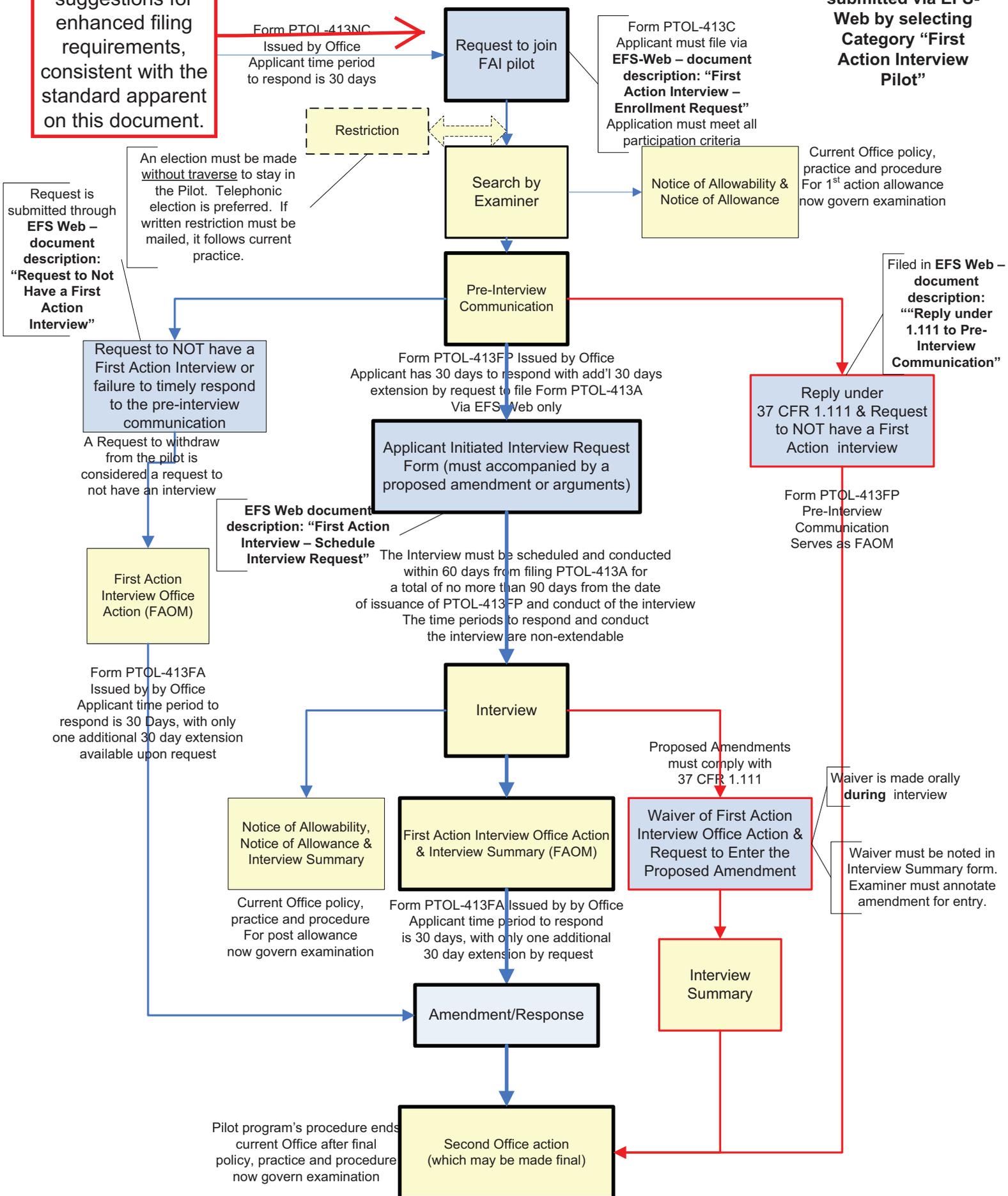
November 30, 2009

DAVID J. KAPPOS  
Under Secretary of Commerce for  
Intellectual Property and Director of the  
United States Patent and Trademark Office

# Enhanced First Action Interview Combined Process

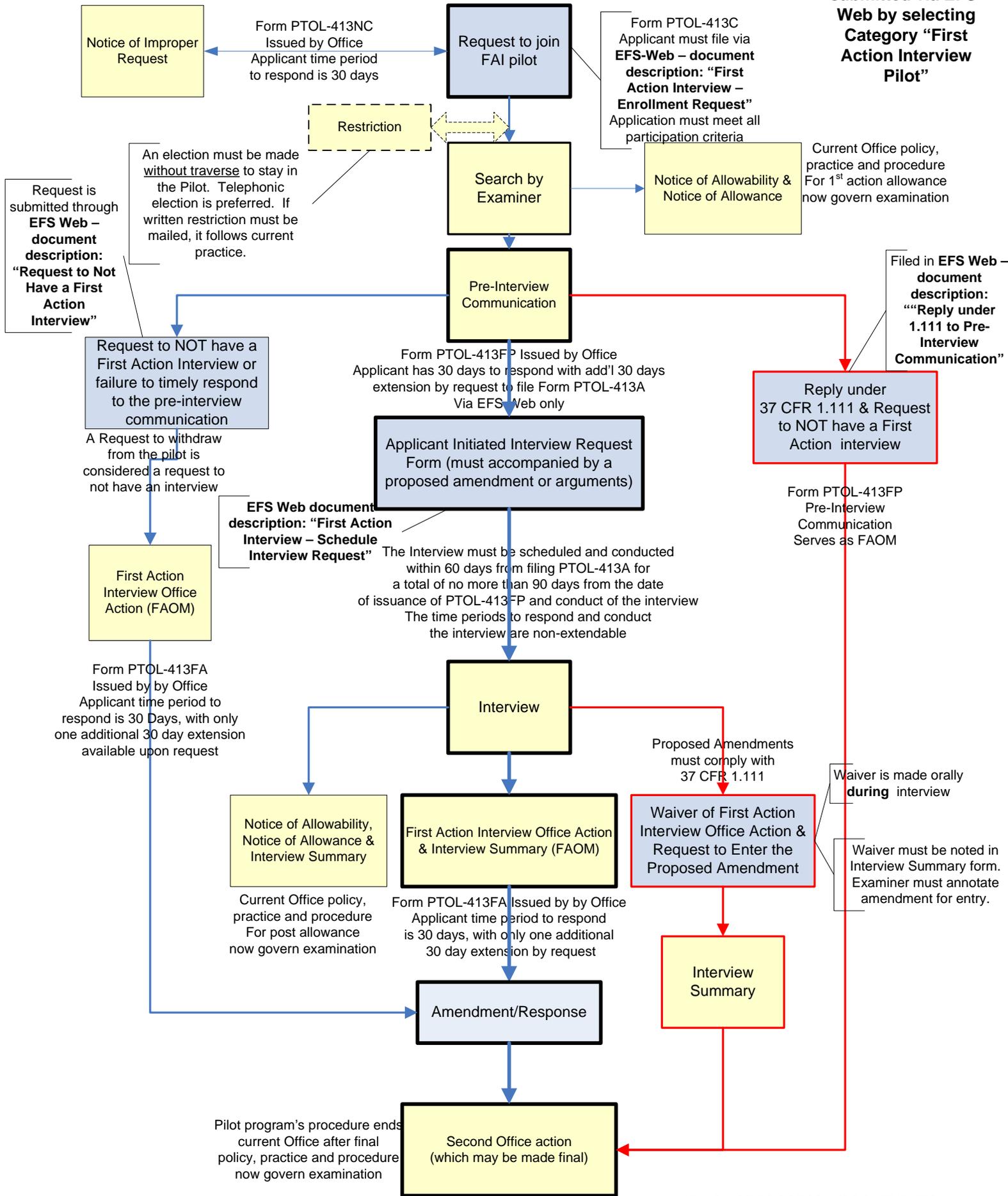
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# Enhanced First Action Interview Combined Process

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September 6, 2009

NEW PILOT PROCESS IMPROVEMENTS  
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