

**Strategic Plan**

**For the**

**Office of General Counsel**

**Of the**

**United States Patent and Trademark Office**

**2005**

## **Strategic Plan for the USPTO Office of General Counsel**

### **VISION**

*The USPTO will lead the way in creating a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system for the 21st Century.*

The Office of General Counsel (OGC) embraces this vision by fostering the highest degree of expertise, professionalism, and promptness in handling legal issues facing the USPTO. The OGC is committed not only to enhancing its operations' quality, productivity and responsiveness to the needs of the public, but also to expanding the effectiveness of its operations in supporting the efforts of other organizations of the USPTO. The ethic of quality-driven performance will permeate the actions of employees of the OGC and their efforts will be supported by specific initiatives in such areas as timeliness, e-Government, and expanded support of the USPTO's quality initiatives. Through these activities, the OGC supports the USPTO's overall strategy to become a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system for the 21st Century.

### **MISSION**

*The USPTO mission is to ensure that the intellectual property system contributes to a strong global economy, encourages investment in innovation, fosters entrepreneurial spirit, and enhances the quality of life for everyone.*

Standing mainly outside the trademark and patent examination processes, the organizations composing the OGC – the Board of Patent Appeals and Interferences (BPAI), the Trademark Trial and Appeal Board (TTAB), the Office of Enrollment and Discipline (OED), the Office of the Solicitor (SO), and the Office of General Law (OGL) -- play a vital role in the USPTO's mission to assure that the intellectual property system serves its purposes in the public interest. Through OED's role in qualifying attorneys and agents to represent patent applicants, and OED's, SO's, and OGL's roles in discipline proceedings, OGC helps assure the integrity of the patent and trademark prosecution in the interest of the public. The two Boards, in hearing appeals by patent and trademark applicants unsuccessful in obtaining a patent or trademark before the examiner, help assure that the benefits of intellectual property rights are not denied to those with legal rights to obtain them. The TTAB, by hearing cancellation and opposition proceedings, also serves the purposes of trademark protection by assuring that the public has an effective means of preventing or terminating improper registrations. The 21<sup>st</sup> Century Strategic Plan contemplates legislative action to give the BPAI a similar role in guaranteeing the integrity of the patent system. By statute, it currently has a more limited role in considering interferences during the examination process. In defending actions of the Boards and of the Director, participating with the Department of Justice in representing the government in other intellectual property cases of public importance, and advising USPTO operating units on substantive developments, the SO contributes to the sound development of the law. OGL, through its advice to management and defense of administrative actions taken by the USPTO, contributes to the

USPTO's overall capacity continually to improve its ability to serve the public consistent with law and within the appropriated resources.

## **STRATEGIC THEMES**

OGC's strategic plan is a step in our continual effort to improve the ways we perform our mission and contribute to the USPTO as a whole. Our planned initiatives and goals are in keeping with the strategic themes articulated for the agency as a whole in the 21st Century Strategic Plan (June 3, 2002) – the themes of agility, capability, and productivity.

### **1. Agility: Address the 21st Century Economy by Becoming a More Agile Organization –**

An agile organization facilitates its processes to meet the changing demands of its business environment. To maximize that agility, the OGC must streamline its key processes to meet internal and external customer demands. This includes the strategic theme's goals of using e-government innovations to increase OGC's ability to handle the increasing and growing complexity of its workload, be more responsive to the demands of its internal and external customers, and reduce costs by radically reducing labor-intensive paper processing. The OGC seeks to expand its services and ensure responsive, timely delivery of services notwithstanding budgetary constraints.

### **2. Capability: Enhance Quality through Workforce and Process Improvements –**

A capable organization meets the quality demands of its customers. To be a capable organization, the OGC must have in place effective quality management processes that ensure high quality work and promote continuous performance improvement. In their functions of reviewing and defending actions of the examining corps and in enrolling and disciplining practitioners before the USPTO, the OGC organizations stand to play a strategic role in the USPTO's evaluation of its own processes and work product. Only by modeling attention to quality in all aspects of its own work can OGC also optimize its capability to help the USPTO as a whole constantly improve its quality.

### **3. Productivity: Accelerate Processing Times Through Focused Examination –**

A productive organization meets the timeliness demands of its customers and its business environment. To be a productive organization, the OGC must maximize its output of work performed with limited resources. This is particularly true in those OGC organizations -- BPAI, TTAB and OED – that have a responsibility to promptly decide large numbers of matters brought to them by applicants and the public. It also means, in the OGC's legal advice and litigation functions, meeting the time constraints imposed on the OGC by judicial and other legal regimes and being responsive to the public and USPTO management.

The specific initiatives that OGC plans to undertake are discussed in more detail under each of the major themes.

## SPECIFIC ACTIONS

### ***AGILITY: ADDRESS THE 21<sup>ST</sup> CENTURY ECONOMY BY BECOMING A MORE AGILE ORGANIZATION***

USPTO as a whole is committed to leveraging e-government strategies to make it a more agile organization. The organizations of the OGC will also use these tools to help it serve its customers more effectively through such initiatives as e-filing, e-processing, and videoconferencing of hearings, and to prepare to expand its functions as may be required by the Madrid Protocol and such 21<sup>st</sup> Century Plan initiatives as post-grant review of patent claims and examiner and practitioner recertification.

### **Use Information Technology to Improve the Internal Efficiency and Public Responsiveness of OGC Processes**

#### OGC-wide

- Recognizing the national scope of OGC's litigation and adjudicative functions, reduce costs for USPTO and the public by creating an electronic hearing room at the Carlyle location to permit videoconferencing of hearings by the Boards and depositions by OGL and SO.

#### OGL

- Utilize electronic database to track all aspects of timeliness for all OGL deliverables to continuously evaluate overall program.
- Utilize electronic database to store and retrieve legal opinions and briefs.

#### SO

- Assist the U.S. Courts in piloting and implementing electronic reporting of patent and trademark litigation in the federal courts.
- Enhance public access to the role of the Solicitor's Office in advancing intellectual property law by posting briefs of major policy concern on the USPTO web site.
- Utilize electronic database to store and retrieve legal opinions and briefs.
- Use new IFW capability to review appeal cases.

#### BPAI

- Improve workflow tracking at BPAI to ensure that appeals and other proceedings are timely processed throughout the time they are at the BPAI.
- Improve workflow at BPAI in the handling of inter partes communications by scanning all outside communications for interferences declared on and after June 1, 2002.
- Prepare for expansion of BPAI jurisdiction by developing e-filing and e-processing systems for inter partes proceedings at BPAI.
- Use new IFW capability to identify appeal cases that are in a posture for the Board to take jurisdiction.

## TTAB

- Implement additional enhancements to the TTAB workflow system (TTABIS), including migration to a web-based system, to improve workflow and to improve responsiveness of systems for telecommuting employees.
- Enhance TTABIS to include all necessary interfaces with FAST, ensuring prompt and seamless processing of all TM applications involved in Board proceedings.
- Automate the institution of opposition and cancellation proceedings to eliminate the need for TTAB staff to process and examine these filings.
- Develop a procedure to permit parties to TTAB proceedings to serve papers on one another by e-mail.

## OED

- Improve service to those seeking to become patent practitioners and improve OED efficiency by continuing nationwide daily delivery of the patent registration examination through test centers, instituting this year real-time reporting of results.
- Provide for electronic filing of the form portions of all practitioner enrollment applications.
- Improve value to the public of patent practitioner bar membership by developing continuing education program encompassing Web-site delivery of training content to practitioners and verification of their participation.
- Continue to automate the process for tracking currency of enrollment of practitioners and develop automatic integration of that information with the database supporting the patent application process to assure that the registration roles are continually current.
- Continue improvement of reciprocal discipline process by reviewing an American Bar Association service.
- Enhance workflow docketing procedures in OED for enrollment and discipline through the use of work tracking software to report on the monthly status of employee activities.
- Monitor identification system enabling practitioners with limited recognition to have the access to USPTO systems similar to that of other practitioners.
- Implement an item bank management program to identify and revise registration examination questions to be current with the latest revision of the MPEP.
- Implement scanning of data sheet files and registration application files to maximize the availability of records on electronic databases.

## **Enhance Knowledge Management**

### OGC-wide

- Make a searchable catalogue of all law library collections in OGC and make available to all OGC personnel in a way that allows for cross-unit borrowing of unique volumes.
- Maintain and develop searchable databases of OGC work products, enhancing availability of decisions.
- Schedule monthly training meetings for SO and OGL to discuss current developments.
- Provide access to Department of Commerce article database to all OGC employees for review of pertinent articles related to legal and technical issues affecting USPTO.

## **Increase flexibility through greater reliance on the private sector or other intellectual property offices**

### **OGL**

- Assist Office of Procurement in fully utilizing flexibilities provided for in the Patent and Trademark Office Acquisition Guidelines to streamline the procurement process.
- Assist Patents in developing PCT search as pilot for competitive sourcing of patent searches.
- Assist the Office of Corporate Planning in defending objections to the USPTO's FAIR inventory.

### **OED**

- Improve outsourced delivery of the patent registration examination to permit frequent administration of the exam and more efficient processing of fees, thus making OED more effective in its other functions by leveling the workload across the year due to administration of the practitioner examination.
- Continue to improve timely responses to customers and continue stabilization of workflow by processing new applications, registration of successful candidates, and fees every business day.
- Improve service to the public by completing development of and completing planning implementation of program for electronic filing of applications and fees.
- Improve service to registered practitioners by developing means for electronic filing of annual dues and changes of address.
- Acquire program for delivery of continuing education program encompassing Web-site delivery of training content to practitioners and verification of their participation.
- Develop a process for tracking currency of enrollment of practitioners and integrating that information with the database supporting the patent application process to assure that the registration rolls are continually current.

## **Organizing workforce to be more responsive to customers and clients**

### **OGL**

- Further define team concept to be more responsive to external and internal customers by increasing OGL's participation with Agency management outside of specific requests for advice or litigation which will contribute to managements' understanding of applicable laws and increase OGL's attorneys' understanding of the agency's goals and strategies.
- Cross train among staff in specialties of practice to expand employee's subject matter expertise allowing OGL to increase flexibility in responding to the Agency's multi-faceted legal needs.
- Training of OGL Staff on legal principles affecting granting of patents and registration of trademarks.
- Increase support staff to better accommodate increasing clerical support requirements.

## BPAI

- Streamline processes for declaring Board decisions precedential, thus increasing the Board's ability to be responsive to the need of the examining corps for guidance in areas where judicial decisions do not provide definitive resolutions of substantive or procedural issues.
- Establish a Trial Division that consists of two sections, the Trial Procedures Section and the Trial Merits Section. Judges in the Trial Procedures Section will handle all interlocutory matters in interference cases including, but not limited to, declaration of interferences, assignment of times for taking action, discovery issues and other interlocutory matters. Judges in the Trial Merits Section will prepare opinions on merits motions and priority.

## TTAB

- Refine TTAB information systems to get work to the paralegals and interlocutory attorneys more quickly and thereby improve response time on pending motions.
- Reorganize work teams so that TTAB paralegals work more closely with TTAB attorneys and by assigning the paralegals more responsibility for handling routine motions, to improve response time on pending motions.

## SO

- Expand interaction with Court of Appeals for the Federal Circuit, including participation in court rules development.
- Expand interaction with other parts of the Agency to provide legal input at an earlier stage in the policymaking process.

## **Expand work-at-home opportunities**

### BPAI/TTAB

- Both Boards will continue current support of their Flexiplace programs, expanding those programs as budget constraints allow.

### BPAI

- Develop a remote Flexiplace pilot for out-of-area work-at-home.

### SO

- Implement work-at-home program for non-Board employees (OGL, OED, and SOL) in accordance with established OGC guideline.

## ***CAPABILITY: ENHANCE QUALITY THROUGH WORKFORCE AND PROCESS IMPROVEMENTS***

OGC employs a distinctive collaborative process for assuring quality products in its operations. Led by the BPAI and TTAB, which make substantive rulings in panels of administrative judges, OGC organizations have adopted peer review as a key strategy to enhance their performance. Attorneys of the Solicitor's Office work in teams on cases. OGL reorganized at the end of FY 2002 to create a team leader system to assure the application of the highest level of expertise and

institutional knowledge to each administrative issue. SO and OED have increased and will continue to expand their cooperation in the development of disciplinary cases. This section concentrates on new initiatives that OGC organizations will undertake to improve their own quality of performance and contribution to the quality of the USPTO overall.

### **Focus on Quality in all aspects of the USPTO mission**

#### **BPAI**

- Expand knowledge of the BPAI's Interference Trial Procedures Section by training additional APJs in the new trial procedures.
- Position BPAI to conduct post grant reviews of patent claims to assure the integrity of the patent system through trial training and development of electronic filing and processing systems.
- Implement a peer review performance element in APJ PAPs to assess more thoroughly and enhance the quality of BPAI decision-making.
- Institute a mentoring program at BPAI to expose new APJs to the variety of methods that experienced APJs have developed to effectively decide issues.
- Conduct quarterly meetings between APJs and TC Directors to identify ways in which the Board can assist in improving examination quality.
- Expand coordination with Patents in analyzing effects of Board decisions on examiner training and increase Board awareness of legal guidance to examiners.
- Hold regular meetings between SO and Trial Procedures Section judges to improve guidance on areas of development in the law.

#### **SO**

- Increase its feedback to BPAI judges concerning lessons learned in defending BPAI decisions in court, including through regular meetings with BPAI judges.
- SO will deliver annual legal update lectures to patent examining corps and BPAI.
- SO will initiate annual legal update lectures to trademark examining corps and TTAB.
- Coordinate on a regular basis with Patents on legal issues arising in reexamination.
- Continue working with Patent and Trademark management in developing agency policy on intellectual property matters.

#### **SO/OED**

- OED will continue to identify for SO disciplinary cases that are particularly complex before the cases are presented to the Committee on Discipline to allow increased collaboration between prosecutors and investigators before cases are developed for prosecution.
- Schedule monthly meetings for OED and SO to discuss current developments in disciplinary proceedings and investigations, cases status, and investigation techniques.

#### **OGL**

- Continue working with the business units and the CFO/CAO organization, identify opportunities to provide enhanced training to managers on areas of administrative law.
- Enhance review of the Office of Employee Relations' proposed employee and labor relations training for managers.

- Coordinate with Labor Relations the review of proposals for negotiability determinations.
- Utilize model settlement agreements.
- Further develop new individual performance elements to thoroughly capture OGL productivity and assess its impact on production quality.
- Work with CFO/CAO and business units, to develop and revise administrative orders to create improved administrative processes for agency.
- Provide training to non-OGC business units, upon request, regarding Agency-wide initiatives that are managed by OGL.
- Assist the Office of Human Resources in training managers on anti-harassment policies.
- Assist Office of Civil Rights in training managers on reasonable accommodation policies and procedures.
- Assist in training Employee Relations Specialists on proper drafting of conduct based employment actions.

#### TTAB

- Implement a peer review performance element in ATJ PAPs to assess more thoroughly and enhance the quality of TTAB decision-making.
- Assist Trademarks' Examining Organization in identifying recurrent problems in examination that appear on appeal and suggest process changes. As part of this effort, the TTAB will coordinate with the newly expanded Office of Trademark Quality Review.
- Review statistics on appealed cases that are allowed after request for reconsideration or on remand for the examining attorney's brief on appeal to evaluate whether those statistics suggest possible improvements in the examination processes.

### **Enhance workforce capabilities by certifying competencies and make improvements in patent and trademark quality assurance techniques covering all stages of examination**

#### OED

- Work with Patents and other organizations in OGC to develop materials for continuing legal education process to confirm the knowledge, skills and abilities of supervisory patent examiners, primary examiners, and the legal knowledge of those seeking certification for promotion to GS-13.

#### SO/BPAI

- Support the recertification project by developing questions for such examinations that reflect appellate experience with recurrent problems in examination and practice as well as new legal developments.

#### BPAI

- Work with the Patent Corps to establish precedents from BPAI on important issues in which the Patent Corps needs guidance and where processes need reinforcement.
- Enhance review of BPAI decisions to identify precedents for Patents' guidance by establishing a database of decisions to facilitate the review of previous decisions and briefs.

- Working with Patents, develop and help implement a program for qualifying appeal conference specialists and using such specialists to implement a program to increase the quality of conferences and feedback between the Corps and the Board.

#### SO/BPAI

- Expand current OGC training initiatives by having BPAI and SO identify new matters to be brought to Patents' attention to update the examination practice.
- Enhance interaction between BPAI and SO to address issues specific to the handling of procedural matters on key ex parte and inter partes cases.

#### **Make process improvements that contribute to enhance quality through legislative/rule changes**

#### BPAI

- Implement new rules to govern appeals and interferences, thus institutionalizing such recent developments as prompt file review of appeals cases to assure that cases are not referred to Board panels if they are not ready for decision, and Trial Procedures Section techniques that have expedited interferences.

#### SO/BPAI

- Take lead in developing and evaluating legislative, regulatory proposals to implement the USPTO's proposal for post-grant review in the BPAI.
- Assist Patents in developing rule- and guideline-based changes in the application and examination processes to improve quality and efficiency.

#### TTAB

- Develop rules to further streamline discovery and other processes in inter partes cases.

#### OED

- Publish in FY 2005 revised proposed rules governing the disciplinary process and ethical requirements to make the enrollment and discipline functions more effective.

#### OGL

- In collaboration with CFO/CAO, identify internal procedures for which USPTO-specific procedures would be beneficial and develop agency administrative orders.
- Assist other business units, where required, in drafting agency administrative orders.

## ***PRODUCTIVITY: ACCELERATE PROCESSING TIMES THROUGH FOCUSED EXAMINATION***

In the late 1990s, many of the organizations within OGC were regarded as in crisis. Those organizations – OED, BPAI, and TTAB – embarked on long-term strategic plans to improve their performance. The production goals that those organizations have set below represent the culmination of a concerted, multi-year effort to improve productivity. Without those improvements, the expanded service to the public and to the rest of USPTO that OGC plans under the themes of agility and capacity would not be possible. OGL is a new organization, designed to effectuate the increased autonomy of the agency under 1999 legislation. Reflecting the performance-based philosophy of that legislation, it has set specific performance goals. Its true productivity contribution to the agency lies, however, more in its effectiveness in providing legal advice and litigation support, as needed, to the goals of the business units of USPTO. SO, too, has established performance measures for many aspects of its work. Its functions of defending the agency in intellectual property matters and promoting the sound development of intellectual property law in conjunction with other agencies of the federal government are less amenable of quantification.

### OGL

- Review of 90% of proposed personnel actions within five business days.
- Review procurement decisions within 5 business days 95% of the time.
- Final stage review of rules packages within 10 days 98% of the time.
- Take initial action on FOIA requests and decide FOIA administrative appeals within 20 days 100% of the time.
- Review draft Agency Administrative Orders within 10 working days of receipt.
- Cut backlog of pending grievances through settlement or arbitration.
- Complete review of OED appeals no later than 90 days after receipt.
- Review reasonable accommodation requests within five business days.

### SO

- Review of TMEP and MPEP within 20 business days 80% of the time.
- Provide expedited clearance review where matters are urgent and brought to SO attention in advance.
- Review all speeches and presentations by USPTO employees within 7 days 100% of the time.
- Reach a settlement agreement, file a complaint, or otherwise resolve all of the OED cases within 4 months after probable cause determination in 90% of the cases.
- Review Official Gazette Notices within 10 business days 100% of the time.
- Review substantive content of both patent and trademark rule packages within 10 business days of receipt 98% of the time.

### BPAI

- Manage the patent appeal docket so that the average pendency of decided appeals is 8 months from the assignment of an appeal number.
- Manage the electrical patent appeal docket so that the average pendency of decided electrical appeals is reduced by 30% from the average FY 2004 decided electrical patent appeal pendency.
- Manage the patent interference docket so that interferences on average are terminated within 24 months after the declaration of interference.
- Manage the patent interference docket so that 70% of interferences are terminated within 24 months after the declaration of interference.

### TTAB

- Expedite discovery by encouraging the practice of interlocutory resolution of discovery issues via telephone, including documenting the number of telephone conferences held and their outcomes.
- Maintain pendency of decision on the merits in TTAB cases following full submission at 10 weeks.
- Continue to provide on-line filing, and identify enhancements to simplify e-filing and subsequent processing.
- Work to encourage electronic filing to reach anticipated levels for 2005: 70% of extensions of time to oppose, 50% of notices of opposition, and 40% of notices of appeal and petitions to cancel filed electronically.
- Continue to provide on-line access to all TTAB proceeding files, and work with the Trademark Operation to link TICRs to TTABVue.

### OED

- Maintain a reduced enrollment cycle time for applicants for registration by developing means to deliver the patent practitioner examination on a continual and national basis.
- Continue six-month target from initiation for completion of enrollment investigations except in particularly complex cases, and issue report on the monthly status of employee activities.
- Complete discipline investigations within two years from initiation.
- Decrease OED's response time to customer requests.

## **FINAL COMMENTS**

This strategic plan is a living document that the OGC is committed to refine and update periodically to adjust to changing conditions. In pursuing this commitment, the OGC will seek guidance from USPTO management, OGC employees and, where applicable, the intellectual property community in general.