USPTO Request for Comments on Enhancing Patent Quality

Introduction

The Chartered Institute of Patent Attorneys (CIPA) is the professional body which represents around 2000 patent attorneys in the United Kingdom.

Our members act on behalf of large corporations, small and medium entities, universities, public bodies and individual inventors. They are regularly involved in the filing and prosecution of US patent applications. Often this is part of a wider multinational filing programme in which the UK patent attorney acts directly before the UK Intellectual Property Office and European Patent Office (EPO), while instructing local practitioners to file and prosecute corresponding applications in other worldwide jurisdictions including the USA. The examinations leading to qualification as a UK patent attorney require knowledge of the law and practice in overseas jurisdictions, including USA.

Quality is an important concern of our members and we therefore welcome the present USPTO consultation. As a result of our members' wide-ranging international experience, we believe we are well-placed to offer helpful suggestions and comparisons with other jurisdictions.

Patent Quality Pillar (1)

Excellence in work products, in the form of issued patents and Office actions

Proposal 1: Applicant Requests for Prosecution Review of Selected Applications

We broadly welcome this initiative, but caution that its take-up by applicants may be limited, and will depend on how it is implemented.

A similar quality review initiative has been in place at the European Patent Office (EPO) for a while, but has no appreciable effect on the particular case about which the complaint has been raised. Instead complaints are reviewed for more broad lessons that can be learned about the examination of applications generally. This leads to a low level of complaints being raised, since they are seen as ineffective.

On the other hand, if the quality review feeds directly back to the examiner of the particular case, some regular applicants may also be reluctant to complain. If they have multiple applications in the same technical field, handled by the same examiner or within the same small group of examiners, they may be concerned that the feedback will result in a loss of goodwill and make prosecution of other applications more difficult. Such concern may persist (with or without justification) even if the senior management of the Office reassures applicants that it is unfounded.

Unless the outcomes of requests for review can be presented in a positive light and have visible beneficial effects on the case concerned, there is a danger that the incidence of requests will be low. This would give a misleading impression of high quality.

Proposal 2: Automated Pre-Examination Search

This facility is already available to EPO examiners. They are presented with a group of documents found automatically, but are not limited to this when conducting their search. Anecdotal evidence suggests that some examiners at least find it useful as a starting point. It may depend on the field of technology being examined.

We believe that any tool which assists the search is to be welcomed, but it should not be seen as a substitute for a proper manual search through well-classified documentation, based upon a thorough review and understanding of the invention claimed.

US examiners have been criticised in the past when cited documents appeared to result from a mere keyword search, and therefore to have low relevance. There is a risk that the proposed automated pre-search would have a similar result. Examiners must therefore be given the time and incentive to assess the usefulness of the results of the pre-search, and to conduct their normal manual search in addition.

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There is another way in which searches could be improved. Many applicants are highly knowledgeable in their technical field, and mindful of their obligation to give the US examiner any material prior art that is available to them. Patent specifications originally drafted for the European Patent Office may even discuss the most relevant prior art in the introduction. It is very likely that the applicant's own information disclosure would be the most useful starting point for the official search.

Yet it is all too common that US examiners pay little regard to the applicant's information disclosure. Applicants find that the US examiner's first official action is a rejection based on less relevant documents. The more relevant documents in the IDS have been initialled but not cited.

We suggest that the Office should conduct an internal review to discover the reasons. Is it because examiners assume the applicant would not have cited it if it was relevant? Is it because they lack computer-based tools to aid their review of documents provided by applicants? Is it because they fear an allegation that they did not perform their own independent search? Is it because they are not in the habit of reading European-style discussions of the prior art in the specification? Is it because court decisions on inequitable conduct cause applicants to provide much irrelevant as well as relevant material (and the same court decisions deter applicants from identifying the documents they believe to be most relevant)?

Proposal 3: Clarity of the Record

We acknowledge the Office's proposals to improve the clarity of the record. We would support, for example, a better record of which arguments presented at an interview overcame a rejection. For a third party, it is most unhelpful to see a file wrapper containing a damning rejection, an interview record stating merely "document X was discussed", followed by a notice of allowance.
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It should be noted that there may be a tension between these legitimate needs of third parties and the applicant's own interest. For an applicant having an eye to possible future litigation, the less said in the file wrapper the better. Where an interview record is filed by the applicant, it may be desirable for the examiner to review it and consider whether to supplement it in a statement of reasons for allowance.

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We see a significant problem with the USPTO proposal *"Making claim construction explicit in the record, including the scope of claim terms, claim preambles, and functionally defined clauses (e.g., wherein clauses)"* This clearly comes from the debate about so-called alleged patent "trolls", some of whom might be thought to stretch vague wording beyond its original intent.

But this proposal presents a major problem of file wrapper estoppel for the majority of legitimate patentees. Claim construction is ultimately the job of a court, after hearing evidence of what the claim terms mean to a person skilled in the art. Functional claim terms often need to be construed in the light of the description under 35 USC 112(f). We see a big risk that claim terms will be misconstrued during examination, based upon examiner misunderstandings which are then written into the file wrapper. The court will then never reach claim construction issues which are properly its job.

In addition, such a proposal would result in added complexity of prosecution. Since it would affect the scope of the patent, applicants and examiners would need to argue the wording of these claim constructions as closely as the wording of the claims themselves. If the examiner proposes a claim construction that plainly indicates a lack of understanding of the invention, the applicant would be faced with the problem of deciding whether to proceed to grant on a false construction that will be binding in court, or whether to drag out the prosecution by arguing for something better.

We believe that instead of writing "Claim term X is understood to mean abc", or requiring the applicant to provide a construction, an examiner should instead raise a clarity objection. If the claim term X is actually vague or could have multiple meanings, then it shouldn't be in the claim. Otherwise, the debate in court will simply shift to what was meant by "abc", which might be even less clear.

If patents with unclear claims are currently being asserted against alleged infringers, that represents a failure when they were examined. Had the examiner spotted the lack of clarity, he/she would presumably have objected. That no objection was raised means that the problem was not spotted at the time. It follows that under the present proposal, neither would the examiner spot any need to make the claim construction clear in the record.

Thus, the proposal to make the claim construction clear in the record might sound good, but in reality it will not solve the problem it attempts to address.

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There are other areas in which the information provided to the public by the Office could be improved. The patent offices in many other major countries provide an

official Register (nowadays usually online) which gives live up-to-date information about all aspects of a patent in a single place. This includes its current status and current ownership. In the US, while the public PAIR system is useful, it falls significantly short of what other countries provide as a matter of course. It does not seem to have been designed with a view to what the public would find useful, but instead simply to provide public access to the Office's existing systems.

For example, in other countries there is usually a simple indication of the current status of a granted patent, live or dead. In the US, the status field in public PAIR will record that the case is patented, but does not say if it has subsequently lapsed due to failure to pay maintenance fees, or if maintenance fees are overdue. Nor is the expected expiry date of the patent presented, assuming all maintenance fees will be paid (taking account of terminal disclaimers, term adjustments etc).

Instead, members of the public have to access a separate system which records maintenance fees, but which seems to be more geared to enabling patentees to pay them than providing information to the public. And it is necessary to pull together information about terminal disclaimers and term adjustments from separate parts of the official record, making calculations based on multiple dates of filing and issuance.

From the standpoint of a member of the public, the separate maintenance fee system has a number of confusing options. The best option to find whether the patent is live or dead is far from instantly obvious. Even if this separate system is entered via the "Fees" tab provided in public PAIR, it is necessary to further identify the application number as well as the patent number, following detailed instructions about the necessary format. Why?

Likewise in other countries, when an assignment is recorded, the official Register typically includes a field with the current owner of the patent. On recording the assignment, the patent office updates this field and advises the owner accordingly. The USPTO instead provides a separate database of assignment records. While there is now a tab enabling this to be searched from public PAIR, the public still has to work out the current owner by reviewing all the records found. We note the current White House and Congressional dissatisfaction with the publicly-available information about ownership of patents. While we recognise that patentees do not always file details of assignments, the Office could present the available information more usefully.

<u>Patent Quality Pillar (2)</u>
Excellence in measuring patent quality, including appropriate quality metrics

Proposal 4: Review of and Improvements to Quality Metrics

The word "metrics" implies a numerical result, but patent quality is not susceptible to a numerical analysis. Nor do we think that simply looking for formalistic errors that are obvious from scanning the file of a patent really measures its quality.

At present the quality metrics consider more whether appropriate boxes have been ticked than whether the underlying work was done in a "quality" manner. The quality metrics are more "efficiency" metrics than "quality" metrics and either should be re-

named to improve transparency, or should be supplemented by an improved audit process or other means to assess quality of the product rather than quality of the process.

There is a problem in determining what to measure, and how. We are not able to offer an easy answer. A user's or third party's view of a "quality" patent is likely to differ from the Patent Office's view. A judge's view might be different again.

For example, a post-allowance review of a sample application could assess whether the examiner had correctly understood the claimed invention and made the appropriate objections, or – just as importantly – made objections which were inappropriate or unnecessary or based upon a failure of understanding. But to do this the reviewer would need to spend as much time (or more) than the original examiner. Otherwise, it is as likely that the reviewer's assessment would be wrong as the examiner's.

A reviewer given enough time might study the documents found in the search and find prior art attacks that the original examiner missed. However, that still does not assess the quality of the search itself. The only way to do that would be to repeat the search independently and compare the results. There could be value in comparing the US examination with the examination of corresponding applications in other countries. The Common Citation Document may provide a tool for assessing quality of the search by comparison of what documents are cited where.

Patent Quality Pillar (3)
Excellence in customer service

Proposal 5: Review of the Current Compact Prosecution Model and the Effect on Quality

We would welcome a relaxation of the usual model that a second office action is normally made final. A more flexible model could usefully be combined with giving examiners more time and incentives in the count system to enable proper consideration of the applicant's response to the first action.

Too frequently it happens that the first action misses the point of the invention. This might perhaps be because the independent claims prove to be too broad and the relevant sub-claims are not given individual detailed consideration, or it might be a simple lack of understanding of a complex invention. The applicant responds with amendments and arguments that stress the inventive step which has been made.

However, since this is directing the examiner to issues lying beyond his/her initial view of the invention, it requires time to properly consider and assimilate the arguments. Having insufficient time and incentives under the count system, the second action is largely copied-and-pasted from the first, with a short additional paragraph saying that the applicant's arguments were unpersuasive, but failing to properly address the issues they raised. And this second action is made final.

The applicant then has a problem. Further correspondence and/or an interview will be needed to ensure that the examiner has a proper understanding of why the invention is

patentable, and to reach an agreement on the form of the claims. A Request for Continued Examination (RCE) is often the only way forward if an appeal is to be avoided.

In these circumstances, we are not convinced that requiring a fee for a further response is any more justified than requiring a fee for an RCE, though it would be an advantage if it was lower.

A fee for further action would be more justifiable if it was combined with changes to the count system which guaranteed proper consideration of the applicant's responses to previous actions.

Proposal 6: In-Person Interview Capability With All Examiners

Additional facilities for interviews would be welcomed.

We would also welcome enhancements to existing initiatives, such as longer timescales for the option of an initial interview prior to the full examination. We suspect that few foreign applicants make use of this, because of the difficulties in communicating with their US attorneys via their foreign patent attorneys in a short timescale. Bear in mind that the application would typically have been prepared abroad. The local US attorney's involvement when filing it may only have involved checking the specification, with minimal interaction on technical issues. So time is needed to instruct and prepare the local US attorney.

Additional inputs requested by USPTO outside the above three pillars:

- **Are there any new or necessary changes to existing procedures that the USPTO should consider to improve the efficiency and effectiveness of the examination process?**

  We urge the USPTO to make full use of international initiatives such as the Common Citation Document (CCD), which seeks to make available the results of searches in other patent offices. Filing updated information disclosure statements whenever a search is received from a foreign patent office is a significant burden to applicants. A better system would cause the US examiner to receive an automatic update whenever further results were input into the CCD, coupled with an amendment to Rule 56 which absolved the applicant of the need to file search results from participating offices.

- **While specific questions have been provided to initiate the discussion on patent quality, the USPTO solicits any other input outside of these questions that the public believes can lead to the issuance of higher quality patents.**

  The current limitations on third party pre-issuance submissions guarantee lower quality than is achievable.

  At present an observer is limited in the nature of the observations that can be made and can only provide a concise statement of relevance rather than an argument on

patentability. In addition an observer cannot file observations once a notice of allowance issues and cannot normally file observations once a first rejection issues.

This means that art that might be relevant to an amended claim might never be presented to the examiner.

The European Patent Office permits observations through the lifetime of the prosecution and this appears to enhance quality. This freedom for third parties has not proven to be a problem to the efficient prosecution of meritorious applications, despite fears to the contrary, and results in a higher quality of granted patents. In fact, if there is a serious issue of patentability, a European practitioner would often prefer to deal with it ex-parte prior to grant rather than in less flexible and more expensive inter-partes proceedings after grant.