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USPTO's Request for Comments on Patent Quality and Appeals Rules

MIPLA Roundtable

January 8, 2010

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Two Notices Published by the USPTO

- FR Request for Comments on Enhancement in the Quality of Patents, 37 CFR 65093
- FR Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Request for Comments on Potential Modifications to Final Rule and Notice of Roundtable During Comment Period, 37 CFR 67987



Request for Comments on Patent Quality

- ❖ PTO notice defines quality as
 - Proper claim scope with clear notice to public of same
 - Clear record that the examination was thorough
- ❖ PTO goals are to improve patent quality and reduce pendency
- ❖ PTO is soliciting input regarding
 - The key processes/items that affect patent quality
 - How should these processes items be measured? Are the existing QA processes sufficient?
 - How should the PTO procedures are the quality processes/items be changed
- ❖ Overarching them: If you can't measure it . . .



Request for Comments on Patent Quality

Topical categories provided in the notice

- 1) Quality Measures
- 2) Stages of Monitoring
- 3) Pendency
- 4) Pilot Programs
- 5) Customer surveys
- 6) Tools for achieving objectives
- 7) Incentives



Request for Comments on Patent Quality

Overview of Existing QA Measures

- Allowance Compliance Review
 - Random Sampling
 - Review cases and determine if the case was allowed in error
- In-Process Review
 - Random sampling
 - Cases are reviewed to determine if examiner made error that would cause unnecessary rework or expense
- Quality Index Ranking (new for 2010)
 - Identify and analyze cases that have characteristics that may be indicative of low (or high) quality
 - Multiple non-final actions, lots of restrictions, reopening of prosecution after appeal or final rejection, first action allowances, multiple RCEs, and allowances after RCE filing without any substantive amendment.



Request for Comments on Patent Quality

- FR Quality items of specific interest to PTO
 - How to identify the best prior art, especially NPLs
 - Comprehensive initial application, including claims tailored around best prior art and disclosure of that art
 - Comprehensive first office action, including claim interpretation on how art is being mapped to the claims
 - Comprehensive response, including secondary and tertiary positions
 - Effective interviews, including detailed agendas and summaries by both examiner and applicant



Request for Comments on Patent Quality

- ❖ Proposed Organization of MIPLA response
 - Top ten (?) quality items
 - Organize, if possible, according to five areas of interest identified by PTO
 - How these items could be measured or measured better
 - Comment on existing QA processes to extent applicable
 - Things PTO could do to improve those quality items
 - Rules, internal processes, incentives



Request for Comments on Appeals Rules

- FR The Office is considering modifications to the final rule (37 CFR 32938) in order to:
 - Better frame the issues so cases can be considered more effectively by conferees, board
 - Reduce the number of returns based on defective briefs
 - Reduce burden on appellants



Request for Comments on Appeals Rules

The changes being considered:

- (1) Remove requirement for petition seeking extensions of time to file certain papers after an appeal brief or seeking to exceed a page limit;
- (2) Remove requirement for a jurisdictional statement, table of contents, table of authorities, and statement of facts in appeal briefs, a table of contents, table of authorities, and statement of additional facts in reply briefs, and a table of contents and table of authorities in requests for rehearing filed in ex parte appeals;
- (3) Remove requirement for an appellant to specifically identify which arguments were previously presented to the Examiner and which arguments are new;



Request for Comments on Appeals Rules

The changes being considered (cont):

- (4) Remove specific formatting requirements and page limits for appeal briefs, reply briefs, and requests for rehearing; and
- (5) Remove requirement for list of technical terms and other unusual words for an oral hearing.
- (6) Remove prohibition on examiner entering a new ground of rejection in an examiner's answer
- (7) Remove provision allowing an examiner to file a supplemental examiner's answer in response to a reply brief.
- (8) Insert rule permitting the Chief Administrative Patent Judge, rather than the Board, may remand an application to the examiner.



Request for Comments on Appeals Rules

- ❖ Roundtable on January 20th
 - Pedersen/Gardella have rec'd approval to attend & present MIPLA comments
- ❖ Written comments on proposed mods to final rule due by February 12th
- ❖ Written comments any matters discussed at the roundtable due by February 25th



Request for Comments on Appeals Rules

- ❖ Note reversion to old appeals rules
- ❖ After January 21, may no longer file briefs in format specified in final rule published last summer at 73 FR 32938
- ❖ Appeal briefs filed on or after January 21, 2010 must comply with the “current rules” published at 37 CFR 41.1 et seq. (2007)