

February 12, 2016

U.S. Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Office of Deputy Commissioner for Patent Examination Policy
Office of Patent Legal Administration
Attn: Michael Cygan
Senior Legal Advisor

Via email TopicSubmissionForCaseStudies@uspto.gov

Re: AIPLA Comments on Submission of Topics for USPTO Quality Case Studies 80 Fed. Reg. 79277 (December 21, 2015)

Dear Mr. Cygan:

The American Intellectual Property Law Association (“AIPLA”) is pleased to present the following comments to the USPTO Request for Submission of Topics for USPTO Quality Case Studies, in response to an invitation for written comments. 80 Fed. Reg. 79277 (December 21, 2015).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Title: Consistency in rejections under 35 U.S.C. § 101

Proposal for study: AIPLA proposes a study to review rejections under 35 U.S.C. § 101 across art units for consistent application of USPTO Guidance on Subject Matter Eligibility. Our members have noted that different art units handle rejections under 35 U.S.C. § 101 differently. We believe that some examiners apply the Guidance as it was intended by viewing the examples and discussion while others look for a particular characteristic, such as a computer being used in an unconventional manner, in issuing rejections. Some of our members have noted that the difference in the way these rejections are handled has led applicants to draft applications to be less likely to be assigned to art units that they have found to apply the Guidance inconsistently.

Explanation: The USPTO should identify applications receiving § 101 rejections across different art units and compare the rejections to ensure that a consistent methodology complying with the Guidance is applied across all of the art units. The outcome should result in more consistent, uniform application of §101 Guidance, resulting in more applicant satisfaction when § 101 is applied evenly to all applications.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

Respectfully Submitted,



Denise W. DeFranco

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Title: Interview Before Search

Proposal for study: AIPLA proposes that the USPTO initiate a pilot program to allow an applicant to request an interview before the Examiner performs a prior art search.

Explanation: Our members observe that one reason so many RCEs are filed is that the key issues or bases for rejections are not identified until a Final Rejection is mailed. Often, these issues are not identified because 1) the Examiner and applicant may be viewing the scope of the claimed invention differently (applicant viewing the claims more narrowly than the Examiner construes them) and/or 2) the Examiner does not appreciate important, disclosed but unclaimed

aspects that are part of the invention described in the specification. As a result, Examiners sometimes issue final rejections with new prior art 1) once the Examiner focuses on perhaps overlooked features of the invention or 2) following the addition of the unclaimed elements by amendment. In some instances, it appears that the new prior art could and should have been cited against the original claims to better advance prosecution.

We propose establishing a pilot program in which an applicant can request an interview before the Examiner performs a prior art search. Applications accepted into the pilot program would receive an automated search that would be shared with the applicant. Ideally, the applicant and Examiner would then be able to discuss the application and search in a telephonic or WebEx interview before the Examiner begins the search.

Alternatively, the USPTO could merely encourage the use of a pre-search interview for a discussion and explanation of the invention and the claims. This discussion would require minimal preparation by the Examiner other than a brief reading of the claims.

This would allow the Examiner to better understand the key features of the invention before searching and make it less likely that additional searching will be needed after the response to the first Office Action. A brief review of the claims by the examiner prior to the first office action could result in the Examiner identifying problematic language in the claims, allowing the applicant to amend prior to a first office action with a reduction in written rejections, and thereby reducing the work for both the USPTO and the applicant. This could lead to potentially fewer office actions, projected higher allowance rates, and fewer RCEs.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

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Title: Consistency in the Handling of Claims with Limitations Under § 112(f)

Proposal for study: AIPLA proposes a study to identify applications having means-plus-function limitations and determine whether such limitations are being consistently handled as required by the Examiner Training Materials on §112(f) dated May 2014.

Explanation: As set forth in the Examiner Training Materials, the broadest reasonable interpretation (BRI) is restricted for claim elements that are subject to § 112(f). In particular, the “BRI = corresponding structure, material, or acts disclosed in the specification, and equivalents, for performing the recited function.” (See slide 9 of the PowerPoint presentation dated May 5,

2014 entitled, “35 USC 112(f): Broadest Reasonable Interpretation and Definiteness of § 112(f) Limitations”). Our members note that Examiners sometimes do not follow the training materials and interpret claims subject to § 112(f) too broadly. Failure to follow the guidance causes delays in patent prosecution as applicants need to file a response indicating the inapplicability of the prior art due to the improper determination of BRI and the Examiner needs to perform an additional search and issue what is often a second non-final Office Action.

We propose that the USPTO initiate a study to identify applications with claims receiving rejections under 35 U.S.C. §§ 102 or 103 that include the term “means” or other nonce words and do not recite sufficient structure. The Office should review the rejections to ensure that the USPTO guidance is being properly and consistently applied. This would allow for a more consistent, uniform application of §112(f), a clearer record, and fewer RCEs. Identifying these rejections would allow for better compact prosecution stemming from better understanding between Examiner and applicant regarding meaning of the claim language.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

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***Title:* Consistency in the treatment of claims having terms of degree.**

Proposal for study: AIPLA proposes a study to determine whether claims that include terms of degree, such as “substantially,” “approximately” and “generally” are being handled consistently and according to MPEP § 2173.05(b).

Explanation: Our members have observed that some Examiners seem to believe that terms of degree inherently render claims indefinite and these Examiners do not perform the analysis set forth in the cited MPEP section. We propose that the Office identify applications having claims that were rejected under § 112(b) and that include terms of degree, such as “about,”

“substantially” and “essentially” to determine whether the rejections are consistently following the guidance from the MPEP. This pilot may assist the Office in providing a uniform approach for Examiners, reducing the need for applicants to respond to improper indefiniteness rejections, and requesting fewer claim amendments in response to such rejections.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

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Title: Quality of search

Proposal for study: Currently, the USPTO performs a random evaluation of the quality of the search performed in applications. A targeted evaluation of applications that included an improper final rejection may provide insight into ways that searching may be improved. In particular, the current pre-appeal and appeal conference evaluations offer an area which could be utilized to determine the reasons why the rejections in those applications are not maintained when the applications are reopened or allowed after filing a Notice of Appeal or Appeal Brief or when the finality of an office action is withdrawn. Evaluating the quality of the search done in these

applications may reveal valuable information regarding the root causes of inadequate final rejections.

Explanation: AIPLA suggests that the USPTO perform evaluations of the quality of the search in targeted areas, in particular, 1) applications that are either reopened or allowed as a result of a pre-appeal brief conference or appeal conference and 2) final rejections utilizing new prior art in which the finality of the action is withdrawn. Some benefits include: identification of root causes of inadequate final rejections and identification of weaknesses in search techniques and development of training materials to improve search abilities. Eventually, this could reduce the rate at which applications are reopened after Notice of Appeal or in which the finality of a rejection is withdrawn and provide an area of improvement that would demonstrate the USPTO's commitment to quality improvement.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

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