

# Compact Prosecution

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# Introduction

- TC1600 FY 2009-2010 Training Initiatives:
  1. Preview of the TC1600 Management Quality and Efficiency Teams
  2. Compact Prosecution Team Training Modules:
    - TC1600 Compact Prosecution Interactive Examiner Workshop



# TC 1600 Administered Training

## **FY 2009**

- How To Read and Interpret Case Law
- Incorporation by Reference
- Restriction-Variou Topics
- Written Description: Antibodies

## **FY 2010**

- Written Description: Chemical Compounds



# TC-1600 Examiner Training

- FY 2009-FY 2010
- Tech Center 1600 and Corp-Wide Initiatives
- Management-Run Team Approach to Develop and Implement
- Quality and Efficiency Training Using:
  - ❖ Art Unit Meetings
  - ❖ Work Shops
  - ❖ Voluntary Lunchtime Seminars



# TC-1600 Management Teams

1. Restriction Practice (TC-1600)
2. Examination Efficiency (TC-1600)
3. First Action (TC-1600)
4. Allowable Subject Matter (TC-1600)
5. After-Final Practice (TC-1600)
6. Interview Practice (Corps-Wide)
7. Compact Prosecution (Corps-Wide)



# Restriction Practice (Team 1)

## **FY 2009 (2<sup>nd</sup> half)**

- SPE-coordinated art unit restriction training
- Discussions on PCT Unity of Invention Practice for chemical and biotech examiners
- Reviewed restrictions prepared by junior examiners in 1610s
- Identified applications with three or more written restrictions
  - Examiners with more than five such applications were individually counseled by a SPE, tQAS and rQAS panel.
- Monitored *Markush* and Restriction Other Time

## **FY 2010**

- Continue to monitor restriction quality and provide training as necessary
  - Continue restriction discussions in art unit meetings
- Continue to hold seminars on restriction and unity of invention, as needed.



# Examination Efficiency (Team 2)

## **FY 2009 (2<sup>nd</sup> half)**

- Researched common causes of delayed prosecution:
  - Notices of incomplete or non-responsive amendment
  - Office replies mailed more than 4 months after receipt of an applicant's response
  - Applications in the same status for more than 8 months
  - Un-entered amendments
- Developed training to improve the quality and efficiency of examiner searching.

## **FY 2010**

- Develop strategies to expedite entry of amendments
- Provide seminars on docket management to examiners
- Develop biotech/chemical search efficiency workshops



# First Action Efficiency (Team 3)

## **FY 2009 (2<sup>nd</sup> half)**

- Developed training aimed at more efficient prosecution through more complete first actions, with focus on:
  - A) Claim interpretation
  - B) Pre-empting and Responding to arguments
  - C) Early Indicating of Allowable subject matter
- Provided training for supervisors on facilitated discussion techniques

## **FY 2010**

- Complete training materials
- Deliver training to examiners through a series of facilitated discussions (focus sessions) in small group format





# Allowable Subject Matter (Team 4)

## **FY 2009 (2<sup>nd</sup> half)**

- Allowance checklist developed for early FY10 deployment
- Internal appeals and pre-appeal tracking to determine how allowable subject matter could have been identified earlier
- Art unit-focused study on how allowable subject matter could have been identified earlier
- Lunchtime seminars held
  - Identification of allowable subject matter
  - Board cases

## **FY 2010**

- Provide Lunchtime seminars on early identification of patentable subject matter
- Provide training on proper *Quayle* procedures
- Deliver allowance checklist to examiners
- Case studies identifying allowable subject matter



# After Final Practice (Team 5)

## **FY 2009 (2<sup>nd</sup> half)**

- Reduced delays from 35 days to 26 days in after final processing
- AF refresher training module under development for FY10

## **FY 2010**

- Rollout of AF refresher training module



# Interview Practice (Team 6)

## **FY 2009 (2<sup>nd</sup> half)**

- Interview training for examiners and managers (Corps-wide)
- Compiled interview best practices list

## **FY 2010**

- Disseminate to examiners an interview best practices list (interview tips)
- Expansion of First Action Interview Pilot to 1610 Workgroup



# Compact Prosecution (Team 7)

- Corps-Wide Initiative
- **GOAL:** To give examiners the information and tools they need to reduce the amount of work and time that is required between the first action and final disposal (e.g., allowance, abandonment or appeal)
- **Workshop:** “Best Practices in Compact Prosecution Awareness”



# Compact Prosecution Workshop

## **FY 2009**

- Developed compact prosecution workshop for managers and primary examiners
- Focus on strategies to reduce the number of office actions:
  - Claim interpretation
  - Comprehensive searching
  - Clear and concise Office actions
  - Complete response to an applicant's reply
  - Allowable subject matter identification early in prosecution

## **FY 2010**

- Continue workshops for junior examiners
- Development of follow-up materials (e.g., a best practices brochure) from ideas captured in the workshops



# Overview: TC 1600 Compact Prosecution Workshop

- Participants: 50 to 70 TC Examiners per session
- Two hour, interactive workshop facilitated by:
  - TC 1600 Supervisory Primary Examiners (SPE) and
  - TC 1600 Quality Assurance Specialists (QAS)
- ❖ TC 1600 Group Director: Workshop Introduction



# Workshop Agenda

1. Workshop Introduction: Director's Welcome
2. Manager-Led Compact Prosecution Review
3. Manager Facilitated Focus Session:
  - Examiner Break Out to consider questions
  - Examiner Report Out
4. Wrap Up (by Manager)



# Compact Prosecution: Defined

“Compact Prosecution” is:

- ❖ Conducting a complete initial search
- ❖ Issuing a comprehensive first Office action:
  - Citing pertinent art;
  - Identifying allowable subject matter





# Compact Prosecution Workshop: TC-1600 Director Introduction

- **Important Results of Compact Prosecution:**
  - Promotes USPTO Goals:
    - Aids in promoting new “count system” changes, particularly relating to putting more effort upfront
    - Reduces prosecution “churning” and actions/disposal
    - De-incentivize practices leading to RCE filings
  - Facilitates Examiner/Customer Relations:
    - Identify allowable subject matter as early as possible
    - Incentivize discussions with applicants
    - Encourage discussion with colleagues about best practices



# Compact Prosecution Workshop: Manager Review

- Manager Discussion:

Compact Prosecution benefits:

1. Examiner
2. USPTO
3. Applicant



# Compact Workshop: Manager Review (cont.)

- Examiner Benefits:
  - Higher quality office actions (saves time)
  - Higher production (potential bonus money)
  - Better performance rating
- Increased examiner satisfaction



# Compact Workshop: Manager Review (cont.)

- USPTO Benefits:
  - Improved pendency
  - Increased quality and efficiency
  - Improved employee morale
- Timely examination spurs innovation



# Compact Workshop: Manager Review (cont.)

- Applicant Benefits:
  - Facilitates business decision whether to continue prosecution
  - Faster resolution of issues leading to either allowance, abandonment or appeal
- Improved applicant satisfaction



# Compact Prosecution: Examiner Role

- How can the Examiner Help?
  - Proper Claim Interpretation
  - Thorough Search
  - Clear and Concise First Action on the Merits (FAOM)
  - Complete Response to Applicant's Reply
  - Expedite Prosecution (facilitate prompt disposal)



# Compact Prosecution: Examiner Focus Session Questions

- Focus Questions:
  1. Name at least five ways proper claim interpretation aids compact prosecution
  2. Identify at least five effective searching techniques that aid in compact prosecution
  3. Identify steps that you can take to avoid making a 2<sup>nd</sup> action non-final rejection or reopening prosecution
  4. In your art, how do you identify the allowable subject matter prior to a first action on the merits
  5. What are the advantages in contacting the Attorney/Agent during prosecution



# Compact Prosecution: Focus Session Report Out

- Each table of 5-7 examiners considers and discusses amongst themselves one of the questions
- An Examiner from each table “reports out” the answers to the question when called upon by the Supervisor
- Supervisor(s) lead interactive discussion
- Other tables participate and voice their own opinions regarding another table’s answers
- Supervisor notes each table’s answers





# Compact Prosecution: Focus Session Answers (Question 1)

- Question 1: Five ways proper claim interpretation aids compact prosecution ?
- Ensures a clear understanding of the claim scope
- Facilitates identification of allowable subject matter
- Enables Examiner to cite most pertinent prior art
- Enables Examiner to formulate a clear, concise and complete Office action
- Minimizes time to reach disposal in the application
- Claim interpretation aided by early attorney interviews



# Compact Prosecution: Focus Session Answers (Question 2)

- Question 2: Five effective searching techniques to aid compact prosecution?
  - Outline a proposed field of search
  - Search broad claims and preferred embodiment
  - Search inventive concept based on the disclosure
  - Review all evidence of record
  - Leverage search help when needed
  - Search relevant databases
- Perform an early comprehensive search



# Compact Prosecution: Focus Session Answers (Question 3)

- Question 3: Steps to avoid making a 2<sup>nd</sup> action non-final rejection or reopening prosecution ?
  - Conduct a thorough initial search
  - Carefully diagram claims
  - Restrict early in the prosecution, if necessary
  - Determine whether any benefit or priority claims are proper, especially for CIPs
  - Review all formal matters and account for all claims
  - Initiate telephone interviews to resolve issues
- Set forth all grounds of rejection in FAOM (most popular)



# Compact Prosecution: Focus Session Answers (Question 4)

- Question 4: How to identify allowable subject matter pre-FAOM?
- Review background and summary section of the specification for critical elements of the invention
- Review related applications to identify relevant previous claim limitations drawn to allowable subject matter
- Review working examples for evidence of:
  - scope of enablement (e.g., generic claim not fully enabled)
  - secondary considerations (overcome obviousness rejection)



# Compact Prosecution: Focus Session Answers (Question 4)

- Question 4: How to identify allowable subject matter pre-FAOM?
- Look for dependent claims that distinguish over the prior art
- Review specification for explanation or definition of ambiguous claim terminology
- Review record evidence to decipher broadest “reasonable” claim interpretation and to avoid citing irrelevant prior art
- Discuss allowable subject matter with colleagues/managers
- Provide suggestions to overcome a rejection



# Compact Prosecution: Focus Session Answers (Question 5)

- Question 5: Advantages in contacting the Attorney/Agent during prosecution ?
- Establish a working relationship with the attorney/agent
- Clear up any misunderstandings between the examiner and the attorney/agent
- Obtain a clearer understanding of Applicant's invention and goals to aid search and consideration of art
- Attorney/Agent feedback regarding claim interpretation and the correction of minor claim informalities
- Early discussion of allowable subject matter
- Examiner willingness to “work with” the attorney



# Compact Prosecution: Final Thoughts

- Carefully consider claim limitations
- Ensure a thorough and complete search
- Strive for concise and complete 1<sup>st</sup> Office actions:
  - Apply the best available art
  - Avoid cumulative rejections

See MPEP 706.02 (Rejection on Prior Art).

- To clarify issues or expedite allowance , INITIATE A TELEPHONE INTERVIEW (requires Negotiation Authority)



# Questions ????

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