Case Study: Correctness and Clarity of Rationale Statements in 35 USC 103 Rejections Case Study

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Objective of 103 Case Study

To study whether Examiners are making clear and correct rationale statements under 35 USC 103.

- 4916 Random OPQA Reviews completed using the Master Review Form (MRF) including the evaluation of at least one 103 rejection made

- Reviews Completed between November 2015 and June 2016

Correctness of Articulated Rationale

MRF Section: 103 Rejection Made
Questions Considered to Address Rationale <u>Correctness</u>

Question 1:

Proper rationale to combine prior art references provided (*e.g.*, motivation to combine)   ○ Yes   ○ In-Part   ○ No   ○ N/A

Question 2:

OVERALL   ○ OK   ○ Needs Attention   ○ Significant Deficiency

Question 1: Correctness of Articulated Rationale Statement

TC	Yes		In Part		No		N/A *		Total
1600	308	82.6%	29	7.8%	12	3.2%	24	6.4%	373
1700	571	78.0%	25	3.4%	35	4.8%	101	13.8%	732
2100	527	86.5%	57	9.4%	17	2.8%	8	1.3%	609
2400	490	73.8%	121	18.2%	43	6.5%	10	1.5%	664
2600	535	88.9%	36	6.0%	22	3.7%	9	1.5%	602
2800	554	72.8%	137	18.0%	36	4.7%	34	4.5%	761
2900	11	84.6%	0	0.0%	0	0.0%	2	15.4%	13
3600	431	85.3%	16	3.2%	29	5.7%	29	5.7%	505
3700	564	85.8%	29	4.4%	24	3.7%	40	6.1%	657
	3991	81.2%	450	9.2%	218	4.4%	257	5.2%	4916

* The wording of the question is "Proper Rationale to combine prior art references" which led to some reviewers to answer "N/A" (not applicable) if it was a single reference 103. Suggestion to change the wording on the MRF to: "Proper rationale for the modification(s)" and/or train RQAS how to interpret.

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Percent of 103 Rejection Reviews

	Corps	TC 1600	TC 1700	TC 2100	TC 2400	TC 2600	TC 2800	TC 2900	TC 3600	TC 3700
"No"	4.7	3.4	5.6	2.8	6.6	3.7	5		6.1	3.9
"In Part"	9.6	8.3	4	9.5	18.5	6.1	18.8		3.4	4.7
"Yes"	85.7	88.3	90.4	87.7	74.9	90.2	76.2	100	90.5	91.4

"Yes" "In Part" "No"

*Percentages of reviews without N/A

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Correctness of Articulated Rationale (Question 1)

95.3% with at least one correct rationale

"Yes"

85.7%

"In Part"

9.6%

"No"

4.7%

14.3% with at least one incorrect rationale

*Percentages of reviews without N/A

"Yes" = All Rationale Statements Correct
"In Part = Some Rationale Statements Correct and Some Rationale Statement Incorrect
"No" = All Rationale Statements Incorrect

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Correctness of Articulated Rationale to Overall 103 Correctness

Correctness of articulated rationale (Question 1)	Overall 103 Correctness (Question 2)			
		OK	Needs Attention	Significant Deficiency	Total
Yes	3568	311	112	3991
In Part	222	168	60	450
No	36	94	88	218

"OK" = No error that rises to the level of a significant deficiency as defined by the IPED standard
"Needs Attention" = Issues present that require attention generally formal in nature and are not found to have a significant impact on prosecution
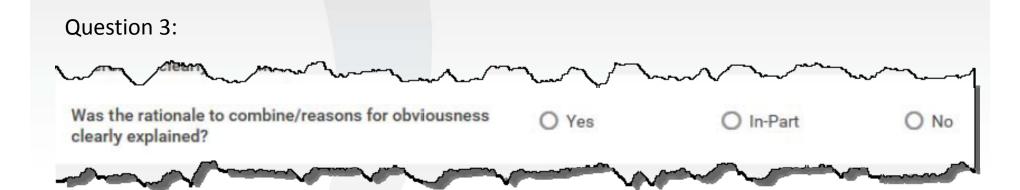**"Significant Deficiency"** = Issues present that have significant impact of prosecution

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Clarity of Rationale

Question 3:

Was the rationale to combine/reasons for obviousness clearly explained?   ○ Yes   ○ In-Part   ○ No

Question 3: Clarity of Articulated Rationale Statement

TC	Yes		In Part		No		Total
1600	342	91.69%	23	6.17%	8	2.14%	373
1700	658	89.89%	34	4.64%	40	5.46%	732
2100	559	91.79%	43	7.06%	7	1.15%	609
2400	548	82.53%	88	13.25%	28	4.22%	664
2600	552	91.69%	33	5.48%	17	2.82%	602
2800	620	81.47%	120	15.77%	21	2.76%	761
2900	12	92.31%	1	7.69%	0	0.00%	13
3600	466	92.28%	13	2.57%	26	5.15%	505
3700	623	94.82%	13	1.98%	21	3.20%	657
	4380	89.10%	368	7.49%	168	3.42%	4916

"Yes" = All Rationale Statements Correct
"In Part = Some Rationale Statements Correct and Some Rationale Statement Incorrect
"No" = All Rationale Statements Incorrect

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Question 3: Clarity of Articulated Rationale Statement – Bar Graph Comparison

Clarity of Articulated Rationale (Question 3)

96.6% with at least one clear rationale

"Yes"

89.1%

"In Part"

7.5%

"No"

3.4%

10.9% with at least one unclear rationale

"Yes" = All Rationale Statements Correct
"In Part = Some Rationale Statements Correct and Some Rationale Statement Incorrect
"No" = All Rationale Statements Incorrect

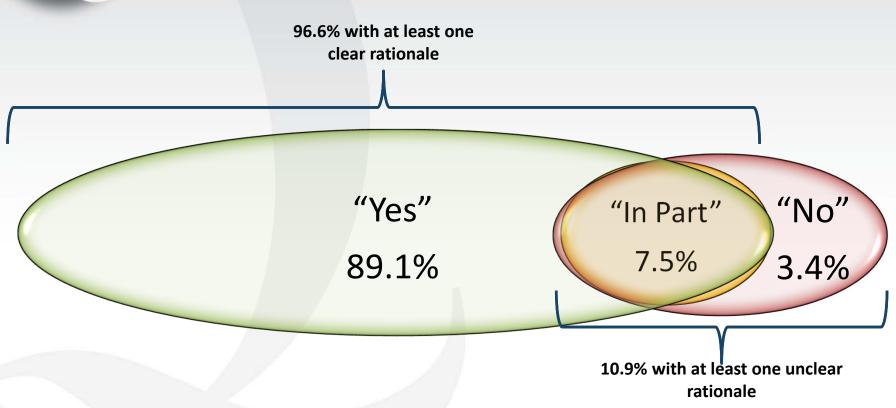United States Patent and Trademark Office

Clarity of Articulated Rationale to Overall 103 Correctness

	Overall 103 Correctness (Question 2)			
Clarity of Articulated Rationale (Question 3)	**OK**	**Needs Attention**	**Significant Deficiency**	**Total**
Yes	3761	427	192	4380
In Part	205	120	43	368
No	42	75	51	168

"**OK**" = No error that rises to the level of a significant deficiency as defined by the IPED standard
"**Needs Attention**" = Issues present that require attention generally formal in nature and are not found to have a significant impact on prosecution
"**Significant Deficiency**" = Issues present that have significant impact of prosecution

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By Action Type

Correct Articulated Rationale: By Action Type

ENHANCED PATENT QUALITY

	Non-Final - Correctness of Rationale	Final - Correctness of Rationale
Yes	85	87
In Part	10	9
No	5	4

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Clear Rationale: By Action Type

	Non-Final - Correctness of Rationale	Final - Correctness of Rationale
Yes	88	90
In Part	8	7
No	4	3

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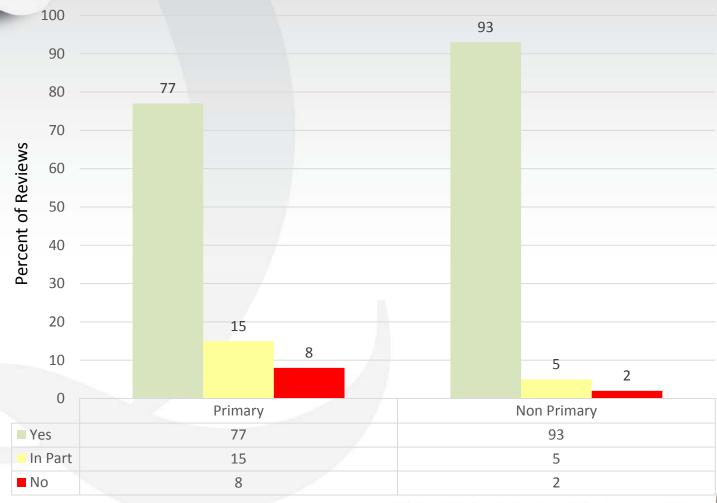
By Signatory Authority

Correct Articulated Rationale: By Signatory Authority

	Primary	Non Primary
■ Yes	77	93
■ In Part	15	5
■ No	8	2

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Clear Rationale: By Signatory Authority

Percent of Reviews

	Primary	Non Primary
■ Yes	82	95
■ In Part	12	4
■ No	6	1

- 95.3% of 103 rejections reviewed included at least one articulated rationale statement that was found to be correct; whereas, only 85.7% found all articulated rationale statements correct.

- 96.6% of 103 rejections reviewed included at least one articulated rationale statement that was found to be clear; whereas, only 89.1% found all articulated rationale statements clear.

- Even when the articulated rationale statement was found to be incorrect or unclear, prosecution was not impacted in a majority of instances.

Top Recommendations

- Provide refresher workshops with emphasis on identification of rationale statements and the handling of multiple modifications and/bases in support of the finding of obviousness.

- Reassess TC 2400 and TC 2800 data after implementation of formalized definitions for "In-Part". If data remains outlying, implement a root cause analysis to develop a targeted action plan for improvement.

Questions?