



Biotechnology/Chemical/Pharmaceutical Customer Partnership

June 1, 2010

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Efficiency Improvements Patent Prosecution

Implemented/In Process:

- Ombudsman Pilot Program
- Compact prosecution initiatives – interview, prosecution, and claim interpretation; statistical analysis to target areas for improvement
- Revisions to the examiner count system
 - Internal review and changes
 - External study of relative complexity of patent examiner goals
 - Improved docket management
- Quality study to identify methods for enabling compact prosecution
 - USPTO is conducting two roundtable meetings in May (Alexandria & California) to obtain public input from diverse organizations and individuals on proposed USPTO quality metrics



Ombudsman Program - Purpose

- Facilitate complaint-handling when applications become stalled in examination process
- Track complaints to ensure each is handled within 10 business days
- Provide feedback and early warning alerts to upper management regarding training needs based on complaint trends



Ombudsman Program – Implemented April 6, 2010

- Federal Register Notice Published 4/6/10
- Responds to Public Comments
- Tracking Database Developed
- Ombudsmen within each Patent area have been identified and trained
- Working with Coalition of Federal Ombudsmen to ensure program accomplishes goals



Ombudsman Program – Process

- Applicant/Attorney will access through USPTO.gov website
- Ombudsman will call within one business day to obtain details
- Complaint will be routed to the person who can address it (SPE, TC Director, etc)
- Ombudsman will not address the complaint directly



Ombudsman Program – Tracking Database

- Complaints will be tracked to ensure each is addressed
- Database will contain only high level information; the application itself will show details of resolution
- Database will be used to identify trends that indicate training needs.



USPTO.GOV Website – Ombudsman Program

Ombudsman Pilot Program - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites

Address <http://www.uspto.gov/patents/ombudsman.jsp> Go Links SnagIt

Google Go Bookmarks 266 blocked Check AutoLink AutoFill Settings

On the "Public Patent Hearing" business day, you will receive a phone call from the TC Ombudsman representative who will ask for further details regarding the problem for which you are requesting assistance.

Enter Requesting Information:
(* items are mandatory)

Ombudsman*:
Please select a TC Ombudsman mailbox Required

First Name*:
 Required

Last Name*:
 Required

E-mail Address*:
 Required

Telephone Number*:
 Required. You can use spaces/hyphens if you wish.

Best Time to Reach:

If you have any feedback, questions or comments regarding the Ombudsman Pilot Program, please email us at OmbudsmanProgram@uspto.gov.

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the submission of your ombudsman request. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process your submission related to a request for ombudsman assistance. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process your assistance request. [Privacy Act Statement](#)

Accessibility Federal Activities Inventory Freedom of Information Act Strategy Targeting Organized

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Ombudsman Program – Tracking Database

Form on ISSUES notes test - Microsoft Internet Explorer provided by USPTO

Address: http://etc-db5.etc.uspto.gov:7777/pls/apex/f?p=166:44:547497232026801::NO::P44_ISSUE_ID:747

Change Password Logout

Data Entry Reports

ISSUES

Issue Id 747 Cancel Submit

Brief Description: Fee Issue

Ombudsman POC: Lake, Carol // 3600

Serial #: 11111111 (e.g., 60123456) PALM

Assigned To: Mindy Fleisher

Status: Active

Opened By: Celsa, Bennett // 1600

Category: Filings

Opened Date: 01/20/2010

Closed Date:

Due Date: 02/03/2010

Applicant: Hope, Bob Add Applicant

Applicant Details: Hope, Bob 555-55-5-12 Add Note

Send Email

Notes on this Issue

Created Date	User Name	Note
20-JAN-10	JMADDEN	this is the second note
20-JAN-10	JMADDEN	This is a add on note

1 - 2

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Backlog & Timely Patents Matter

Issuing timely and quality patents is key to USPTO's Mission

Backlog Clogs Recovery

- ↪ Places Inventors at risk of loosing their ideas to savvy competitors at home and abroad
- ↪ Applications languish so long that the technology they seek to protect becomes obsolete
- ↪ Slows down job creation
- ↪ Ties up investment



Compact Prosecution

- Principles of Compact Prosecution
 - Search and Claim Interpretation
 - Clear and Concise First Action on the Merits
 - Treating Applicant's Reply
 - Help Facilitate Prompt Disposal



Why is Compact Prosecution so Important?

- Why is Compact Prosecution so important?
 - Will facilitate first action issue, abandonment after first action, or a substantive amendment in order to avoid reopening of prosecution
 - Reduces actions/disposal
 - Examiner gets:
 - More efficient update searching after the First Action on the Merits
 - Higher production for the same amount of work (potential bonus money)
 - Demonstrated indicia for Commendable/Outstanding performance rating
 - USPTO gets:
 - Improved overall application pendency
 - Ability to complete its mission and continue operations at current staffing levels
 - Timely examination which will spur innovation
 - Applicant gets:
 - Better ability to make an educated business decision whether to continue prosecution
 - Faster resolution of issues leading to either allowance or abandonment



Definition of Compact Prosecution

Compact Prosecution is:

- Conducting an initial search which is as complete as possible;
- Citing pertinent art on the record in keeping with the scope of the claims as well as significant aspects of the disclosed invention;
- Issuing a complete first Office action which clearly explains the examiner's position on each essential issue; and
- Identifying allowable subject matter in an effort to expedite prosecution.



Principles of Compact Prosecution

- Examiner should always search the claimed subject matter and the **INVENTION** (i.e. disclosed subject matter which is likely to be claimed)*
- Examiner makes all suitable rejections, objections and indications or suggestions of allowable subject matter appropriate for Applicant to bring in on amendment
- Applicants and **EXAMINERS** should request interviews to advance prosecution
 - A telephone interview coupled with an Examiner's Amendment is a preferred practice for placing the application in condition for allowance

* See MPEP 904.03



Principles of Compact Prosecution (cont'd)

- Examiner need only update the prior search in most instances and not “re-search” the application
- A proper second action should, in most instances, close prosecution. For example, the examiner may:
 - Allow the application;
 - Write a final rejection* treating applicant’s arguments on the merits; or
 - Issue an Ex Parte Quayle* when only formal issues remain.

* The examiner should always attempt to advance prosecution and resolve remaining issues through a telephone interview
- **Examiners should always try to facilitate allowance where appropriate!**



Overview of Examiner Training

By reviewing how examiners

- interpret the claims and search;
- write clear and concise first Office action on the merits;
- treat applicant's reply; and
- expedite prosecution through responsible docket management,

examiners will

- save themselves valuable time by minimizing their searching after the first action on the merits;
- improve efficiency and productivity with same level of effort; and
- further promote innovation.



Count System Reform: Director's Objectives

- Provide examiners with incentives to:
 - Address issues early in the examination process
 - Reach out to applicants
- Reduce rework
- Deliver net gain for all stakeholders
- Improve working conditions
- Develop initial plan and institute an iterative process for improvement



Overview of Count System Package

- Combination of count system changes and more time for examiners
 - More time overall (increase in Hours/Balanced Disposal)
 - More time for First Action On the Merits (FAOM) (shift in counts so FAOMs get more credit)
 - Provide time for examiner-initiated interviews
 - Diminish credit for Requests for Continued Examination (RCEs)
 - Consistent credit for transferred or “inherited” amendments



New Count System Impact on RCEs

- The revised Examiner Count System gives examiners more time up front for the first action, to enable them to address all issues early in the examination process.
- Examiners are given time to initiate interviews with applicants, to enable them to reach out to applicants to address issues.



New Count System Impact on RCEs

- Change to Docketing Practice:
 - The docketing practice change applies to RCEs filed on or after November 15, 2009.
 - RCEs are now placed on examiners' "Special New" application docket, rather than the prior practice of placing them on the "Amended" docket.
 - The Special New docket also includes divisional and continuation applications, and other applications accorded special status under 37 C.F.R. 1.102.
 - The minimum requirement for examiners is to work on one application from the Special New docket every two biweeks.
 - In contrast, under the prior practice, RCEs on the Amended docket were due for action 2 months from the date they were placed on the docket.
 - Examiners have more flexibility to manage their workload and allocate their time between RCEs and new applications.



New Count System Impact on RCEs

- Change to Work Credits for RCEs:
 - The revised Examiner Count System reduces the amount of work credit for the first action in an application in which an RCE has been filed compared to the amount of credit for the first action in a new application.
 - The amount of credit is further reduced for first actions in applications in which a second or subsequent RCE has been filed.



New Count System Impact on RCEs

Prior Count System Original Case (Non-RCE)			1st RCE			2nd & Subsequent RCEs			Prior Counts	
FAOM	Final	All/Abn	FAOM	Final	All/Abn	FAOM	Final	All/Abn		
1.00		1.00							2	Original
1.00		1.00	1.00		1.00				2	1st RCE
1.00		1.00	1.00		1.00	1.00		1.00	2	2nd & Subsequent RCEs

Pilot Count System Original Case (Non-RCE)			1st RCE			2nd & Subsequent RCEs			Pilot Counts	
FAOM	Final	All/Abn	FAOM	Final	All/Abn	FAOM	Final	All/Abn		
1.25	0.25	0.5							2.00	Original
1.25	0.25	0.5	1.00	0.25	0.5				1.75	1st RCE
1.25	0.25	0.5	1.00	0.25	0.5	0.75	0.25	0.5	1.50	2nd & Subsequent RCEs

In new pilot count system, after an FAOM the examiner gets the remainder of counts (0.75) either by:

- Getting a Disposal (0.75) with no previous Final Rejection, or
- Doing a Final Rejection (0.25) then subsequently getting a Disposal (0.50)



Thank you