Patent Quality Update

Cary, North Carolina

Wednesday, January 25, 2017
Update on Patent Quality Programs

Kathleen Bragdon
Advisor to the Deputy Commissioner for Patent Quality
Enhanced Patent Quality Initiative

http://www.uspto.gov/patentquality
EPQI Programs

Under the three pillars of patent quality:

- Automated Pre-Examination Search Pilot
- Clarity of the Record Pilot
- ICR Training
- Post Grant Outcomes
- STIC Awareness Campaign
- Topic Submission for Case Studies

Master Review Form
Quality Metrics

Design Patent Publication Quality
Interview Specialist
Post-Prosecution Pilot (P3)
Reevaluate Quick Path Information Disclosure Statement (QPIDS)
Automated Pre-Examination Search
Automated Pre-Examination Search

Goal

• Provide a pre-examination search automatically in every application

Objectives

• Leverage modern technologies to identify prior art for the examiner prior to examination
• Optimize searching technology to keep pace with advancements in the field

Benefits

• Providing a useful prior art baseline that represents the current state of the technology in each patent application
• Improving examination quality by supplying that art to the examiners
High Level Project Release Plan

**Release 1**
- 7/20/16 – 9/20/16
- Goals:
  - Build out DEV, SIT, FQT
  - Deploy systems software in each environment
  - Install core proprietary search solution
  - Verify operation
  - Begin prior art ingest

**Release 2**
- 9/21/16 – 12/13/16
- Goals:
  - Complete ingest of prior art
  - Tune search solution to USPTO needs
    - Obtain all search input documents in text format
    - Done for test cases, waiting on Pilot member identification.
  - Perform searches (some completed)
  - Load search results

**Release 3**
- 12/14/16 – 2/14/17
- Goals:
  - Develop Web UI for result access by users
  - Automate document extraction and search
  - Streamline updates to search corpus
  - Automate loading of search results

**Business Pilot**
- To Be Announced
Clarity of the Record Training:
Improving Clarity and Reasoning in Office Actions

ICR Training
Improving Clarity and Reasoning – ICR Training Program Goals

• To identify particular areas of prosecution that would benefit from increased clarity of the record and develop training

• To enhance all training to include tips and techniques for enhancing the clarity of the record as an integral part of ongoing substantive training
<table>
<thead>
<tr>
<th>Course Title</th>
<th>Detailed Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>35 U.S.C. 112(f): Identifying Limitations that Invoke § 112(f)</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. 112(f): Making the Record Clear</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. 112(f): Broadest Reasonable Interpretation and Definiteness of § 112(f) Limitations</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. 112(f): Making the Record Clear</td>
<td></td>
</tr>
<tr>
<td>Broadest Reasonable Interpretation (BRI) and the Plain Meaning of Claim Terms</td>
<td></td>
</tr>
<tr>
<td>Examining Functional Claim Limitations: Focus on Computer/Software-related Claims</td>
<td></td>
</tr>
<tr>
<td>Examining Claims for Compliance with 35 U.S.C. 112(a): Part I Written Description</td>
<td></td>
</tr>
<tr>
<td>Examining Claims for Compliance with 35 U.S.C. 112(a): Part II – Enablement</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. 112(a): Written Description Workshop</td>
<td></td>
</tr>
<tr>
<td>§ 112(b): Enhancing Clarity By Ensuring That Claims Are Definite Under 35 U.S.C. 112(b)</td>
<td></td>
</tr>
<tr>
<td>2014 Interim Guidance on Patent Subject Matter Eligibility</td>
<td></td>
</tr>
<tr>
<td>Abstract Idea Example Workshops I &amp; II</td>
<td></td>
</tr>
<tr>
<td>Enhancing Clarity By Ensuring Clear Reasoning of Allowance Under C.F.R. 1.104(e) and MPEP 1302.14</td>
<td></td>
</tr>
<tr>
<td>35 U.S.C. 101: Subject Matter Eligibility Workshop III: Formulating a Rejection and Evaluating the Applicant’s Response</td>
<td></td>
</tr>
<tr>
<td>Advanced Legal Training Part I: Understanding Case Law and the Federal Court System</td>
<td></td>
</tr>
<tr>
<td>Advanced Legal Training Part II: How to Analyze and Respond to Case Law Related Arguments</td>
<td></td>
</tr>
</tbody>
</table>
Stakeholder Training on Examination Practice and Procedure (STEPP)

- 3-Day training on examination practice and procedure for patent practitioners
- Provide external stakeholders with a better understanding of how and why an examiner makes decisions while examining a patent application
- Aid in compact prosecution by disclosing to external stakeholders how examiners are taught to use the MPEP to interpret an applicant’s disclosure
Post Grant Outcomes
Post Grant Outcomes Program

• This program is to develop a process for providing post grant outcomes from various sources, such as the Federal Circuit and Patent Trial and Appeal Board (PTAB), to the examiner of record and the examiners of related applications.

• Post Grant Outcomes Pilot: April-August, 2016
  – Identify those patents being challenged at the PTAB under the AIA trials that have pending related applications in the Patent Corps
  – Provide the examiners of those pending related applications access to the contents of the AIA trial
## Pilot Statistics by Technology Center

### DISTRIBUTION OF PILOT APPLICATIONS BY TECHNOLOGY CENTER

<table>
<thead>
<tr>
<th>Technology Center</th>
<th>Number of Pilot Applications</th>
</tr>
</thead>
<tbody>
<tr>
<td>1600</td>
<td>121</td>
</tr>
<tr>
<td>1700</td>
<td>56</td>
</tr>
<tr>
<td>2100</td>
<td>55</td>
</tr>
<tr>
<td>2400</td>
<td>102</td>
</tr>
<tr>
<td>2600</td>
<td>82</td>
</tr>
<tr>
<td>2800</td>
<td>65</td>
</tr>
<tr>
<td>3600</td>
<td>138</td>
</tr>
<tr>
<td>3700</td>
<td>160</td>
</tr>
<tr>
<td><strong>Grand Total</strong></td>
<td><strong>779</strong></td>
</tr>
</tbody>
</table>
Pilot Statistics – Relevant Art For Child Case

In the Office action of the child case, did the examiner refer to any of the references cited in the AIA trial petition of the parent case?

- **No**: 56%
- **Yes**: 44%
Did the examiner write a new grounds of rejection using NPL or foreign art cited in the PTAB petition?

- **No** (i.e. used a U.S. Patent) 90%
- **Yes** 10%

- **Used NPL** 7%
- **Used Foreign Art** 1%
- **Used Both** 2%

Based on 285 Survey Responses
Pilot Statistics – Enhancing the Record

Were the references from the AIA trial cited in an IDS of the child application?

- Patent references
  - None were already cited in the IDS: 27%
  - Some were already cited in the IDS: 30%
  - Most were already cited in the IDS: 24%
  - All were already cited in the IDS: 38%

- Foreign references
  - None were already cited in the IDS: 21%
  - Some were already cited in the IDS: 9%
  - Most were already cited in the IDS: 17%
  - All were already cited in the IDS: 13%

- NPL references
  - None were already cited in the IDS: 25%
  - Some were already cited in the IDS: 12%
  - Most were already cited in the IDS: 14%
  - All were already cited in the IDS: 17%

Based on 129 Survey Responses
Post Grant Outcomes Looking Forward

Next Steps
- Develop training and best practices collected from pilot
- Implement the program corps-wide
- Continue to collect suggestions from stakeholders about how to improve the program

For more information
- Email is at [PostGrantOutcomes@uspto.gov](mailto:PostGrantOutcomes@uspto.gov)

More information at the Pilot home page:
STIC Awareness Campaign
STIC Awareness

- Highlighting internal tools for patent examiners
Clarity and Correctness Data Capture:
Master Review Form (MRF)
Master Review Form Background

• USPTO has a long history of reviewing its own work
  – Office of Patent Quality Assurance (OPQA)
  – Regular supervisor reviews
  – Other formal review programs
  – Informal feedback

• Reviews, using different formats, focused on correctness and provided feedback on clarity

• Review data was routinely analyzed separately
MRF Program Goals

• To create a **single, comprehensive** tool (called the Master Review Form) that can be used by all areas of the Office to **consistently** review final work product
  – Common review standard
  – Common data points

• To better collect information on the **clarity and correctness** of Office Actions

• To collect review results into a **single data warehouse** for more **robust analysis**
  – Increased precision in metrics
  – More granular levels of analyses to detect anomalies, inconsistencies, and hot spots
## MRF Design

<table>
<thead>
<tr>
<th>Correctness</th>
</tr>
</thead>
<tbody>
<tr>
<td>Overall, were the 35 U.S.C. 102 rejection(s) in compliance?</td>
</tr>
<tr>
<td>□ Yes  □ In-Part  □ No</td>
</tr>
<tr>
<td>Claimed features are explicitly/inherently disclosed in the prior art relied upon?</td>
</tr>
<tr>
<td>□ Yes  □ In-Part  □ No</td>
</tr>
</tbody>
</table>

### Clarity

<table>
<thead>
<tr>
<th>Examiners's role</th>
</tr>
</thead>
<tbody>
<tr>
<td>Overall, how was the clarity of the 35 U.S.C. 102 rejection(s)?</td>
</tr>
<tr>
<td>□ Above Average  □ Average  □ Below Average</td>
</tr>
<tr>
<td>Effective date was sufficiently documented?</td>
</tr>
<tr>
<td>□ Above Average  □ Average  □ Below Average</td>
</tr>
<tr>
<td>Sufficient explanations were provided to clarify the basis of the rejection so as to allow applicant to understand rejection.</td>
</tr>
<tr>
<td>□ Above Average  □ Average  □ Below Average</td>
</tr>
<tr>
<td>The Office action contained clear support for the rejection.</td>
</tr>
<tr>
<td>□ Above Average  □ Average  □ Below Average</td>
</tr>
</tbody>
</table>

### Modular designed smart-form
- 20+ modules
- Omitted/Made Rejections, Search, etc.

### 330 question library
- Correctness, clarity, best practices

### Auto-populated case details

### Integrated system with sampling and workflow features
MRF Looking Forward

• The MRF’s single data warehouse facilitates:
  – Better quality metrics
  – Case studies without the need of directed, *ad hoc* reviews
  – Rapid measurement of the impact due to training, incentives, or other quality programs on our work product
  – Quality monitoring tools, such as dashboards

• Developing quality metrics from MRF review data
Quality Metrics
Historical Perspective on Measuring Quality

- 1978: Patent Quality Review established
- 1983: Allowance error rate
- 2005: In-Process error rate (Non-final and final rejections)
- 2007: External Quality Survey begins
- 2008: Quality Index Reports (QIR) begin
- 2011: Final Disposition & In-Process Compliance Rates
- FY 2017: Quality Composite Score begins

Supplemented with: regular supervisory reviews; formal review programs; informal feedback; ad-hoc studies

Where are we today?
# Quality Metrics - Redefined

<table>
<thead>
<tr>
<th><strong>Product Indicators</strong></th>
<th><strong>Master Review Form</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Capturing both correctness and clarity of examiners’ final work product using uniform criteria gathered in a single database</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>Process Indicators</strong></th>
<th><strong>Transactional QIR</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Tracking the efficiency and consistency of our processes (for example, to identify “churning”)</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>Perception Indicators</strong></th>
<th><strong>Survey Results</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Continuing to internally and externally poll perceptions of patent quality</td>
</tr>
</tbody>
</table>
Quality Metrics Website

https://www.uspto.gov/patent/initiatives/quality-metrics-1#step2

About Quality Metrics

We have had quality metrics since at least 1983. Committed to self-improvement, we continue to identify new metrics to gain a more thorough understanding of our work products and processes. Learn more about our Quality Metrics evolution in the Quality Metrics Timeline.

Resulting from stakeholder feedback, in fiscal year 2015, we launched the Enhanced Patent Quality Initiative (EPQI) Quality Metrics Program. In a March 2016 Federal Register Notice, we announced a new quality metrics approach, categorizing quality metrics as follows:

- **Product Indicators** include metrics on the correctness and clarity of our work products. We formulate these metrics using data from reviews conducted by the Office of Patent Quality Assurance using the Master
Quality Metrics FY17 Targets

- **35 USC 101 Compliance**
  - Expected performance based on current resources and initiatives
  - >98%
  - 98%-93%
  - < 93%

- **35 USC 112 Compliance**
  - >92%
  - 92%-87%
  - < 87%

- **35 USC 102 Compliance**
  - >95%
  - 95%-90%
  - < 90%

- **35 USC 103 Compliance**
  - >93%
  - 93%-88%
  - < 88%

Expected performance based on current resources and initiatives.
Design Patent Publication Quality
Design Patent Publication Quality

Goal

• Improve the quality of images printed in design patent grants

Results

• New process implemented October 4, 2016 wherein:
  – Images of design patent grants are clearer and more reflective of the electronically filed images and
  – Electronic file wrappers of design patent grants contain PDF copies of the design patent grants

Looking Forward

• Uploading enhanced quality patent images into search systems to enhance patent search capabilities
Enhancing Design Patent Images

**FIG. 1**

BEFORE

AFTER
Interview Specialist
TC Interview Specialists

• Subject matter expert on interview practice and policy in each Technology Center

• The list of TC Specialists can be found here: http://www.uspto.gov/patent/laws-and-regulations/interview-practice/interview-specialist

• Specialists can provide One-on-One Training to help applicants utilize WebEx video conferencing tools (email your request to ExaminerInterviewPractice@uspto.gov)
Making Collaboration Easier

• Fully equipped video conference rooms are available for reservation on each USPTO campus

• Internet Usage Policy has been updated to permit verbal authorization for video conferencing tools
  – MPEP § 502.03 now allows a verbal request to authorize a video conferencing, instead of submitting a written request.

• Examiners set up video conferencing for interview using WebEx, a web-based service that you can use it from any computer (Windows, Mac, Linux, or Solaris) with no software needed.
Interview Practice Webpage

http://www.uspto.gov/patent/laws-and-regulations/interview-practice

AIR form allows applicants to schedule an interview with an examiner for their pending patent application.
Post-Prosecution Pilot (P3)
Post-Prosecution Pilot (P3) Goal

• Developed to impact patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal

• Adding to current programs:
  – After final Consideration Pilot (AFCP 2.0)
  – Pre-appeal Brief Conference Pilot
Post-Prosecution Pilot (P3) Overview

• Retains popular features of the Pre-appeal Brief Conference Pilot and AFCP 2.0 programs:
  – Consideration of 5-pages of arguments
  – Consideration of non-broadening claim amendments
  – Consideration by a panel

• Adds requested features:
  – Presentation of arguments to a panel of examiners
  – Explanation of the panel’s recommendation in a written decision after the panel confers
Post–Prosecution Pilot (P3) Summary

• Ran July 11, 2016 – January 12, 2017

• Accepted over 1500 submissions across all technologies

• Formal comments about P3 were collected July 11 – Nov 14, 2016 and are now posted at https://www.uspto.gov/patent/laws-and-regulations/comments-public/comments-post-prosecution-pilot-program
P3 Looking Forward

Metrics for Consideration
- Internal and external survey results
- Formal comments from FR Notice
- Stakeholder feedback about the program from other sources

Program Decision
- Whether to continue the program, optionally with modifications

For more information
- Email us at PostProsecutionPilot@uspto.gov
Re-Evaluation of Quick Path Information Disclosure Statements (QPIDS)
QPIDS Re-Evaluation

- Approximately 3,000 QPIDS requests/FY
- Many requirements, including an e-Petition for withdraw from issue after payment of the issue fee
- Updating resources on Patent Application Initiatives (PAI) webpage
- Developing training for QPIDS experts and technical support staff to improve processing
- Considering improvements for internal tracking
Patent Application Initiatives (PAI)

https://www.uspto.gov/patent/initiatives/uspto-patent-application-initiatives-timeline
Clarity of the Record Pilot

Jim Dwyer
Senior Advisor to the Deputy Commissioner for Patent Quality
Clarity of Record Pilot - Purpose

This program is to develop **best Examiner practices** for enhancing the clarity of various aspects of the prosecution record and then to **study the impact** on the examination process of implementing these best practices.
Clarity of Record Pilot Goals

Identify Examiner Best Practices

Find Correct Balance for Appropriate Recordation

Use Data/Feedback to Assist Other Programs

Enhance Clarity of Prosecution Record
Clarity of Record Pilot - Areas of Focus

- More detailed interview summaries
- Enhanced documentation of claim interpretation

<table>
<thead>
<tr>
<th>Special definitions of claim terms</th>
<th>Optional language</th>
</tr>
</thead>
<tbody>
<tr>
<td>Functional language</td>
<td>Non-functional descriptive material</td>
</tr>
<tr>
<td>Intended use or result</td>
<td>Computer-implemented functions that invoke 35 U.S.C. §112(f) (&quot;specialized&quot; or &quot;non-specialized&quot;)</td>
</tr>
<tr>
<td>&quot;Means-plus-function&quot; (35 U.S.C. §112(f))</td>
<td></td>
</tr>
</tbody>
</table>

- More precise reasons for allowance
- Pre-search interview - Examiner’s option
Clarity of Record Pilot - Participants

- 125 Examiners participated
  - Advanced Training
  - Met regularly
  - Recorded time spent
- 45 Supervisors (SPEs) participated
  - Managed program
  - Provided reviews
  - Provided direct assistance
Clarity of Record Pilot - Evaluation

• 2,600 Office actions (reviewed and recorded)
  – Included a statistical mix of:
    • Pre-Pilot Office actions
    • Pilot Office actions
    • Control group

• Key Drivers were determined

• Best practices were gathered
Results and Recommendations – Interview Summaries

Identified Best Practices/Key Drivers:

- Adding the substance of the Examiner’s position
- Providing the details of an agreement, if reached
- Including a description of the next steps that will follow the interview

Recommendations:

- Provide corps-wide training on enhancing the clarity of interview summaries that focuses on the identified best practices/key drivers
- Consider whether to require examiners to complete more comprehensive interview summaries
- Continue to evaluate Pilot cases to see whether improved interview summary clarity has a long-term impact on prosecution
Results and Recommendations – 112(f) Limitations

Identified Best Practices/Key Drivers:

• Explaining 112(f) presumptions and how the presumptions were overcome (when applicable)
• Using the appropriate form paragraphs
• Identifying in the specification the structure that performs the function

Recommendation:

• Consider whether to require examiners to use the 112(f) form paragraph
Results – 102 and 103 Rejections (Claim Interpretation)

Identified Best Practices/Key Drivers:

• Clearly addressing all limitations in 35 U.S.C. 102 rejections when claims were group together
• Explaining the treatment of intended use and non-functional descriptive material limitations in 35 U.S.C. 103 rejections

Overall Pilot Determination:

• Examiners currently doing a good job with clarity in claim interpretation
Results and Recommendations – 102 and 103 Rejections (Claim Interpretation)

Key Drivers that Added to and Detracted From Clarity:

• Providing, in 35 U.S.C. 102 rejections, an explanation for limitations that have been identified as inherent
• Providing, in 35 U.S.C. 103 rejections, annotations to pin-point where each claim limitation is met by the references

Recommendation:

• Assess how to use the identified best practice of recording claim interpretation to improve the clarity of Office actions without detracting from clarity
Results and Recommendations – Reasons for Allowance

**Identified Best Practices/Key Drivers:**

- Identify specific allowable subject matter or where found, if earlier presented, during prosecution
- Confirm applicant’s persuasive arguments
- Address all independent claims

**Recommendations:**

- Provide training on best practices
- Require more comprehensive reasons for allowance
Results – Additional Practices

Identified Best Practice:

- Pilot Examiners shared best practices with non-Pilot Examiners

Practices that did NOT significantly impact overall clarity:

- Providing an explanation regarding the patentable weight given to a preamble
- Providing an explanation of how relative terminology in a claim is being interpreted
- Providing an explanation for how a claim limitation that was subject to a rejection under 35 U.S.C. 112(b) has been interpreted for purposes of applying a prior art rejection
Clarity of the Record - Next Steps

Surveys
- Internal surveys sent to Pilot examiners
- Data currently being collected

Quality Chat
- Gather information/thoughts on any differences seen during Pilot time period
- Share data results of Pilot
- Discuss/share best practices

Focus Sessions
- Are best practices still being used?
- Discuss amended cases resulting from Pilot
Clarity of the Record - Next Steps (cont.)

Monitor Pilot Treated Cases

- Are applicant’s arguments more focused?
- Average time to disposal compared to pre-pilot cases?

Recommendations

- Discuss implementation of training and best practices in all Technology Centers
- Consider further efforts to enhance claim interpretation including key drivers that did not significantly impact clarity
- Expand Pilot to gather additional data

http://www.uspto.gov/patent/initiatives/clarity-record-pilot
Topic Submission for Case Studies

Jim Dwyer
Senior Advisor to the Deputy Commissioner for Patent Quality
Topic Submissions - Background

• Case studies used internally on an *ad hoc* basis to study particular issues

• Federal Register Notice on Topic Submissions
  – USPTO invited stakeholders to submit patent quality-related topics for study
  – Submissions were accepted through December ’15 through February ’16
Topic Submissions and Selection

Submissions:

- Received over 135 ideas for case studies from 87 stakeholders
  - Intellectual property organizations, law firms, companies, and individuals

Process of review and selection:

1. Appropriate or capable of being timely assessed via a case study
2. Whether other programs or mechanisms within the USPTO were more appropriate
3. Grouped the remaining submissions by subject matter
## Topics Selected for Case Studies

<table>
<thead>
<tr>
<th>Patent Quality Topic</th>
<th>Project Status</th>
</tr>
</thead>
<tbody>
<tr>
<td>2. Consistency of application of 35 U.S.C. 101 across Art Units/Technology Centers</td>
<td>In-Progress</td>
</tr>
<tr>
<td>3. Use of compact prosecution when making 35 U.S.C. 101 rejections</td>
<td>In-Progress</td>
</tr>
<tr>
<td>5. Enforcement of 35 U.S.C. 112(a) written description in continuing applications</td>
<td>In-Progress</td>
</tr>
</tbody>
</table>
Compliance of Rejections with 35 U.S.C. 101 Official Guidance

Objective: This study evaluates whether rejections made under 35 U.S.C. § 101 were correct under USPTO Guidance and clearly communicated their reasoning.

This was the top study suggested by the public.
Overview

• Primary Study – Compliance of § 101 Rejections
  – Scope of the Study
  – Methodology
  – Findings

• Secondary (Additional) Study – Further Prosecution
Scope of the Primary Study

• Study was designed to provide these findings:

I. Are examiners following § 101 Guidance?
   a. Ineligible rejections correct?
   b. Properly explained?

II. What improvements were found due to the June 2016 training?

III. What are the drivers of compliance with Guidance for § 101 rejections?
   a. Which parts of the 101 Guidance are most/least followed?
   b. Where can future efforts move the quality needle?
Methodology of the Primary Study

- Alice/Mayo-type 101 rejections randomly sampled across Corps
  - Actions were issued January 2016-August 2016
    - 394 Office actions reviewed (prior to the 101 training of Spring 2016)
    - 422 were post-training
  - Review was limited to the first claim in the Office Action rejected under 101 and its dependent claims
Findings of the Primary Study

I.a) How often were the rejected claims actually ineligible

99% of dependent claims were correctly treated where the independent claim was correctly rejected.
Findings of the Primary Study

I(b). Were The Claims Properly Explained

Is the claim directed to a judicial exception?

1. Rejection should identify the judicial exception; i.e., “a method of hedging”.
   - Should be more than “claim recited an abstract idea”
   - Should be more than simply repeating the limitations of the claim

2. The judicial exception should be correctly determined under USPTO Guidance
   - The explanation should correspond to the claim limitations
   - Similar to a court-identified abstract idea
   - For products of nature, markedly different characteristics from a natural product.
Findings of the Primary Study

I(b). Were The Claims Properly Explained

Is significantly more than the judicial exception claimed?

1. Rejection; explanation of why the additional elements do not provide significantly more

2. The explanation should be reasonably correct
   • Should account for each additional element
   • Should be correct in concluding that an element is, e.g., merely routine, conventional, well-understood
   • Should be based upon USPTO Guidance
Findings of the Primary Study

I(b). Were The Claims Properly Explained

- **Out of 816** Total Rejections:
  - **737** Correct Conclusions (Step 2A + 2B) Total
    - Rejected claim is ineligible under Guidance
  - **657** Step 2A-Proper Explanations
    - 87% of Rejections with Correct Conclusions
  - **624** Step 2B-Proper Explanations
    - 85% of Rejections with Correct Conclusions
  - **554** Proper Explanations (Step 2A + 2B)
    - 75% of Rejections with Correct Conclusions
    - 68% of All Rejections
Findings of the Primary Study
II. Improvements Due to May 2016 Training

Improvement from Pre-Training to Post-Training

- Correct Rejections
- Correct and Properly Explained Rejections
- Enhanced Clarity - Claim limitations
- Dependents Explained

<table>
<thead>
<tr>
<th>Category</th>
<th>Pre-Training</th>
<th>Post-Training</th>
<th>Improvement (% of total rejections)</th>
<th>Statistically Significant</th>
</tr>
</thead>
<tbody>
<tr>
<td>Correct Rejections</td>
<td></td>
<td></td>
<td>90% → 91%</td>
<td>No</td>
</tr>
<tr>
<td>Correct and Properly Explained Rejections</td>
<td></td>
<td></td>
<td>62% → 74%</td>
<td>Yes</td>
</tr>
<tr>
<td>Enhanced Clarity - Claim limitations</td>
<td></td>
<td></td>
<td>40% → 50%</td>
<td>Yes</td>
</tr>
<tr>
<td>Dependents Explained</td>
<td></td>
<td></td>
<td>18% → 34%</td>
<td>Yes</td>
</tr>
</tbody>
</table>

net change (%)
Findings of the Primary Study

III. Drivers of § 101 Compliance with Guidance – Step 2A

Total: 763 of 816 Rejections with Correct Step 2A Conclusion

Explanations for Rejections with “Correct” Step 2A

- 657, 86%: Total With Correct Step 2A Conclusion
- 88, 12%: No JE Identified
- 18, 2%: JE Identified Not Consistent With Guidance
Findings of the Primary Study

III. Drivers of § 101 Compliance with Guidance – Step 2B

Total: 737 of 816 Rejections with Correct Step 2B Conclusion

Explanations for Rejections with “Correct” Step 2B

- Total With Correct Step 2B Conclusion: 624, 85%
- No Identification of Additional Claim Elements: 31, 4%
- Explanation Not Consistent With Guidance: 82, 11%
Primary Study - Summary

**Results:**

- 90% of rejections that were made were of claims that are actually ineligible.

- 75% of those rejections of claims that are actually ineligible properly explained why the rejection was made.

- 68% of all studied rejections were correct and properly explained.
Secondary Study
Applicant’s Response and Next Office Action

• Prosecution subsequent to the Office Action having the 101 rejection was studied
  – Cases from study having Office Action issued in January – April 2016

<table>
<thead>
<tr>
<th>January-April 2016 Cases</th>
<th>394</th>
</tr>
</thead>
<tbody>
<tr>
<td>Responses filed</td>
<td>315 (81%)</td>
</tr>
<tr>
<td>Subsequent Office action</td>
<td>189 (48%)</td>
</tr>
</tbody>
</table>

• What did applicant argue/amend?
  • What were the most common arguments?
  • Did the Examiner provide a detailed response to the applicant’s arguments?
• Was 101 rejection maintained or withdrawn?
  • How often was the application allowed on the next action?

Can any correlations be identified?
Secondary Study
Applicant’s Response and Next Office Action

Characteristics of the next Office action:

<table>
<thead>
<tr>
<th>January-April 2016 Cases</th>
<th>394</th>
</tr>
</thead>
<tbody>
<tr>
<td>Responses filed</td>
<td>315 (81%)</td>
</tr>
<tr>
<td>Subsequent Office action</td>
<td>189 (48%)</td>
</tr>
<tr>
<td>101 rejection not maintained (including where claims were cancelled)</td>
<td>86 (45%)</td>
</tr>
<tr>
<td>101 rejection maintained</td>
<td>103 (55%)</td>
</tr>
<tr>
<td>• Specifically addressed arguments</td>
<td>78 (76%)</td>
</tr>
</tbody>
</table>
Secondary Study - Correlations

Which aspects of the rejection correlate with withdrawal of the 101 rejection in the next Office action?

<table>
<thead>
<tr>
<th>Did the study find the claim directed to an abstract idea?</th>
<th>How often was the rejection withdrawn in the next Office action?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>40%</td>
</tr>
<tr>
<td>No (claim was eligible at 2A)</td>
<td>76%</td>
</tr>
</tbody>
</table>

Yes 40%
No (claim was eligible at 2A) 76%
Facilitate complaint handling when applications become stalled in the examination process

Track complaints to ensure each is handled within 10 business days (FY 2016 average resolution 6.2 business days)

Provide feedback regarding training needs based on complaint trends
Ombudsman Webpage Access
http://www.uspto.gov/patent/ombudsman-program

Enter Requesting Information

*items are mandatory

*Ombudsman: Please select a TC Ombudsman mailbox
*First Name: Required
*Last Name: Required
*E-mail Address: Required
*Telephone Number: Required. You can use spaces/nyphens if you wish.
Best Time to Reach:

Submit

TC1600
TC1700
TC2100
TC2400
TC2600
TC2800
TC3600
TC3700
Ombudsman Program
Other Ombudsman Contact Info

• For a phone consultation
  – (800) 786-9199
  – (571) 272-5555

• For direct email
  – ombudsmanprogram@uspto.gov
Service Hours via Regional Offices

Dallas-Fort Worth  Denver  Detroit  Silicon Valley

8:30 AM-8PM ET
Quantity of Ombudsman Inquiries

<table>
<thead>
<tr>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>0</td>
<td>1000</td>
<td>2000</td>
<td>3000</td>
<td>4000</td>
<td>5000</td>
<td>3000</td>
</tr>
</tbody>
</table>
Top Inquiries of 2016
First Office Action Estimator


First Office Action Estimator

Check current estimates on how long it will take for a first office action on a patent application by entering an Art Unit or Class and Subclass associated with a current or potential application.

Group Art Unit (four digits) [input field] Search by Art Unit  - Or -

Class (three characters) [input field] Subclass (three or seven characters) [input field]

Search by Class/Subclass
Estimator Results

**Search Results**

Search based on Art Unit 1652. Estimated time to First Office action is **17** months.

This is an estimate that is based on the current inventory level of applications filed in this art area and the current staffing levels in this Art Unit. The USPTO is dedicated to minimizing first action and total pendency, and we are targeting resources to help address backlogs in art areas with high new application filings. Thank you for your inquiry.


**Search Results**

Search based on Class 435 / Subclass 195000 (Art Unit 1652). Estimated time to First Office action is **17** months.

This is an estimate that is based on the current inventory level of applications filed in this art area and the current staffing levels in this Art Unit. The USPTO is dedicated to minimizing first action and total pendency, and we are targeting resources to help address backlogs in art areas with high new application filings. Thank you for your inquiry.

## Petitions Timeline


<table>
<thead>
<tr>
<th></th>
<th>PRIOR TO EXAMINATION</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>DURING EXAMINATION</td>
</tr>
<tr>
<td>2</td>
<td>AFTER CLOSE OF PROSECUTION</td>
</tr>
<tr>
<td>3</td>
<td>ALLOWANCE/AFTER PAYMENT OF ISSUE FEE</td>
</tr>
<tr>
<td>4</td>
<td>POST ISSUANCE</td>
</tr>
</tbody>
</table>

- Specifies the types of petitions that can be filed during the various stages of prosecution
- Hyperlinks to pendency data, historical grant rates and deciding official
- Links to the Manual of Patent Examining Procedure
## Petition Timeline Example

### Abandonment Related Petitions

**Generally Available**

<table>
<thead>
<tr>
<th>Petition Type</th>
<th>Avg. Days Pending of Decided Petitions</th>
<th>Grant Rate Percentage</th>
<th>Deciding Office</th>
<th>ePetition Option</th>
</tr>
</thead>
<tbody>
<tr>
<td>502 - To Revive an Abandoned Application-Unintentional Delay (37 CFR 1.137(a))</td>
<td>144</td>
<td>83%</td>
<td>OPET</td>
<td><img src="https://www.uspto.gov/" alt="ePetitions" /></td>
</tr>
<tr>
<td>510 - To Accept Late Payment of Issue Fee - Unintentional Late Payment (37 CFR 1.137(a))</td>
<td>104</td>
<td>86%</td>
<td>OPET</td>
<td><img src="https://www.uspto.gov/" alt="ePetitions" /></td>
</tr>
<tr>
<td>525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - Failure to receive an Office Action</td>
<td>212</td>
<td>51%</td>
<td>OPET</td>
<td><img src="https://www.uspto.gov/" alt="ePetitions" /></td>
</tr>
<tr>
<td>525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - Reply</td>
<td></td>
<td></td>
<td></td>
<td><img src="https://www.uspto.gov/" alt="ePetitions" /></td>
</tr>
</tbody>
</table>

**Abbreviations**

- IPLA – International Patent Legal Administration
- ODM – Office of Data Management
- OPET – Office of Petitions
- TC – Technology Center

---

**Note:**

- ePetitions: Get Immediate Decisions
Application Data Sheet (ADS)
Up Next in the Patent Quality Chat Webinar Series

Feb 14th  Understanding the ADS:
Little Things Make a Big Difference

Patent Quality Chat

The Patent Quality Chat series is designed to provide information on patent quality topics and gather your input on a regular basis via an easy, webinar format. Each Patent Quality Chat webinar includes a speaker(s) presentation for approximately 20 minutes with the remaining time for questions and comments from the participants by email.

All Patent Quality Chats are free and open to all on a first-come, first-served basis. Video recordings and any presentation materials from the Patent Quality Chats will be posted on this website after the event has concluded.
Pro Bono Program

Kathleen Bragdon
Senior Advisor to the Deputy Commissioner for Patent Quality
Independent Inventors Clients

- Believe in their invention
  - May have invested significant personal resources
- Often not familiar with patent prosecution
  - Statutes, rules, and procedures appear complex
  - May not know what to expect from an attorney/client relationship
- Often lack financial resources to retain a registered patent practitioner
USPTO Patent Pro Bono Program

- Nationwide network of independently operated universities/colleges and non-profit organizations that:
  - Assists financially under-resourced independent inventors and small businesses
    - Coverage in all 50 states achieved and maintained since August 2015
  - Promotes small business growth and development
  - Helps ensure that no deserving invention lacks patent protection because of a lack of money for IP counsel
  - Opportunity for patent practitioners to serve in their area of expertise
The North Carolina Program

- NC LEAP Inventors Assistance Program
  - Managed by:
    - North Carolina Bar Association Foundation

- Focus
  - Business assistance to small business owners through education and legal representation
  - Expanded service to include helping qualified inventors and small businesses to obtain pro bono access to registered patent professionals

- To volunteer:
  - Register Online - https://www.ncbar.org/giving/volunteer-now/nc-leap-inventor-assistance-program/
  - Contact Administrator - M’Lea Peak, mpeak@ncbar.org
USPTO Patent Pro Bono Program: Coordination Team

John Kirkpatrick
john.kirkpatrick@uspto.gov
571-270-3343

Grant Corboy
Grant.corboy@uspto.gov
571-270-3102

Oleg Asanbayev
oleg.asanbayev@uspto.gov
571-270-7236