

Patent Quality Conference

Alexandria, VA

Tuesday, December 13, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE





Welcome

Valencia Martin Wallace

Deputy Commissioner for Patent Quality

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Conference Information

- **Booklet**
- **Questions for online viewers:**
 - PatentQuality@uspto.gov
- **Wi-Fi Access:**
 - Scan for wireless devices and select **USPTOGuest**
 - Instructions in Booklet, inside front cover

Advancing Quality in the IP Community

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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Enhanced Patent Quality Initiative Results

PatentQuality@uspto.gov

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Clarity of the Record Pilot



Robin Evans

Director, Technology Center 2800

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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
- More precise reasons for allowance
- Pre-search interview - Examiner's option
- Enhanced documentation of 7 areas of claim interpretation:
 - **Special definitions of claim terms**
 - **Optional language**
 - **Functional language**
 - **Non-functional descriptive material**
 - **Intended use or result (preamble and body of claim)**
 - **Computer-implemented functions that invoke 35 U.S.C. §112(f)**
 - **"Means-plus-function" (35 U.S.C. §112(f))**
 - **("specialized" or "non-specialized")**

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

Interview Summaries – Key Drivers

- 22 pre-identified practices were used to evaluate the examiner's Office actions
- 11 were deemed **Key Drivers** of overall clarity of the interview summary form
- Top 3 identified **Key Drivers** include:

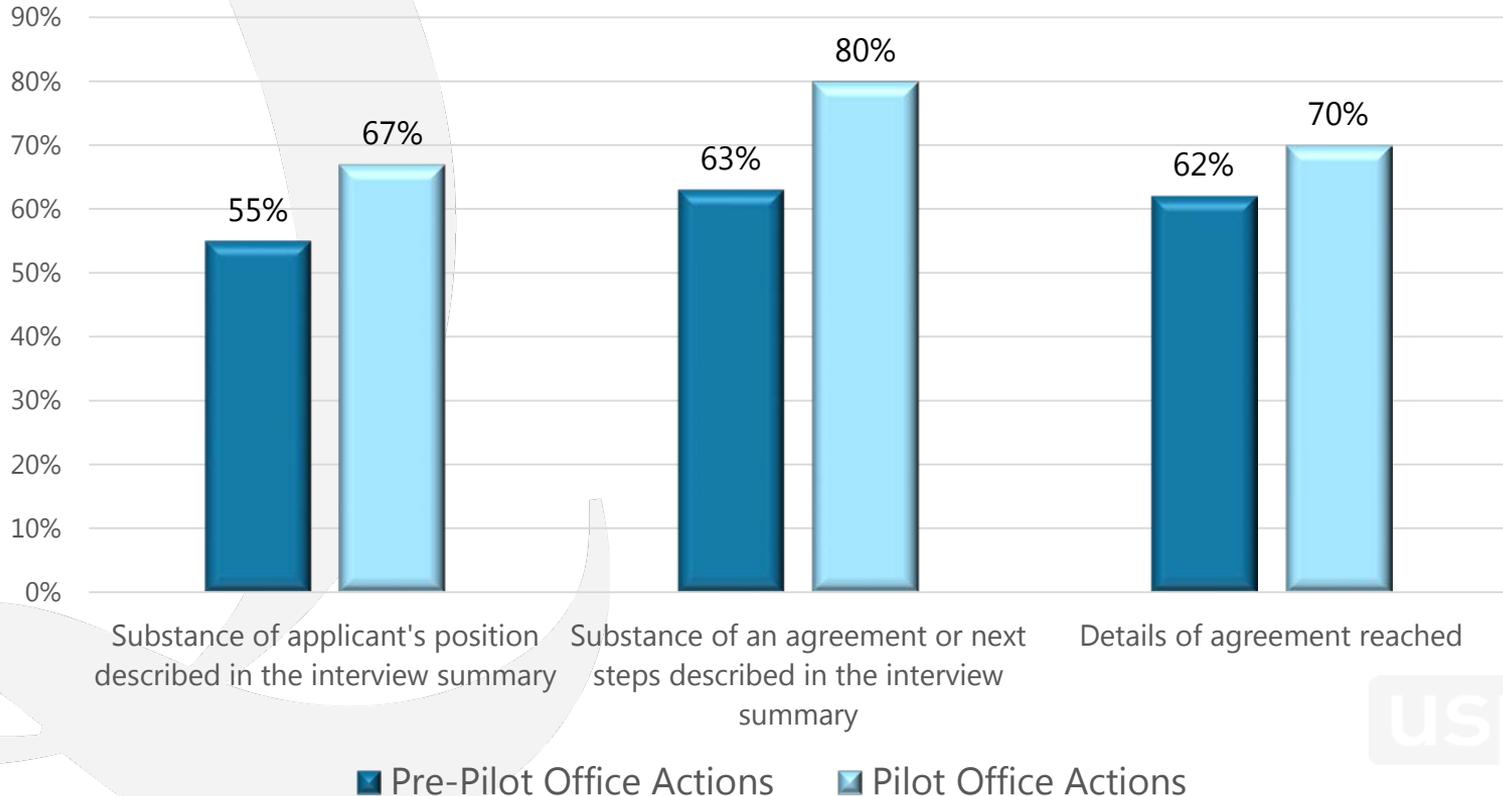
Was the substance of applicants position described in the interview summary form?

Was the substance of an agreement or next steps described in the interview summary?

Were the details of agreement reached recorded?

Interview Summaries – Key Drivers, cont.

% of Applicable Office Actions Exhibiting Key Drivers



112(f) Presumptions – Key Drivers

- 8 pre-identified practices were used to evaluate the examiner's Office actions
- 5 were deemed to be **Key Drivers** of overall clarity of the 112(f) evaluations
- Top 3 identified **Key Drivers** include:

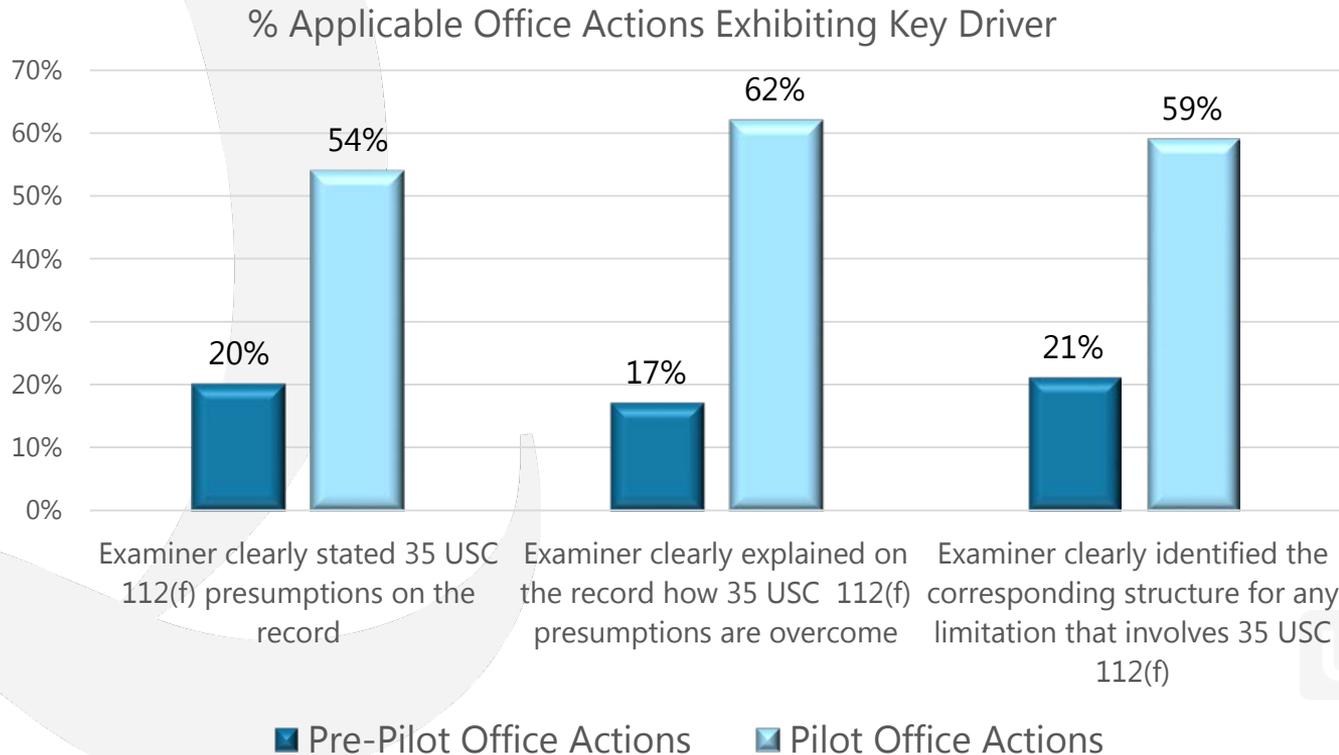
The examiner clearly stated 35 USC 112(f) presumptions on the record?

Has the examiner clearly explained on the record how 35 USC 112(f) presumptions are overcome, when applicable?

Has the examiner clearly identified the corresponding structure for any limitation that involves 35 USC 112(f)?



112(f) Presumptions – Key Drivers, cont.



102 Rejections – Key Drivers

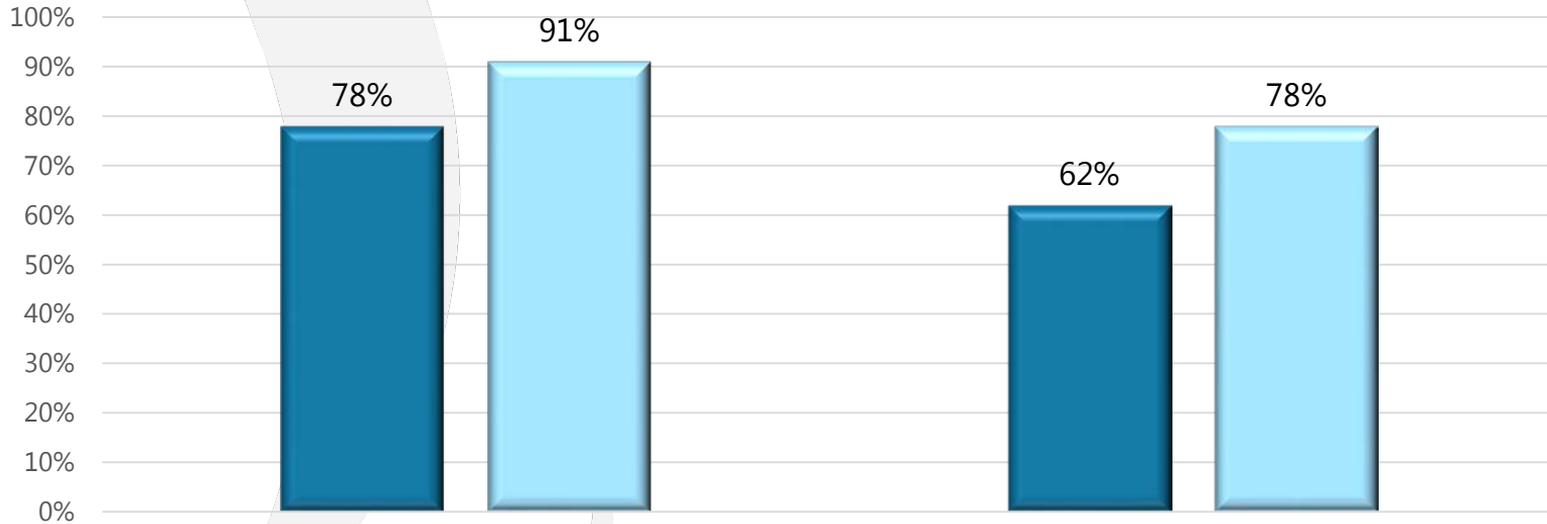
- 17 pre-identified practices were used to evaluate the examiner's Office actions
- 5 were deemed **Key Drivers** of overall clarity of the 102 rejections
- Top 2 identified **Key Drivers** include:

When claims were grouped for purpose of rejection, were all grouped claims' limitations clearly addressed?

If an intended use, purpose or result limitation is broader than applicant's presumed interpretation as described in the specification, did the explanation address why the broader interpretation is appropriate?

102 Rejections – Key Drivers, cont.

% Applicable Office Actions Exhibiting Key Driver



When claims were grouped for purpose of rejection, all claim limitations from all grouped claims were clearly addressed

If an intended use, purpose, or result limitation is broader than applicant's presumed interpretation as described in the spec, the explanation addressed why the broader interpretation is appropriate

■ Pre-Pilot Office Actions

■ Pilot Office Actions



Data -103 Rejections

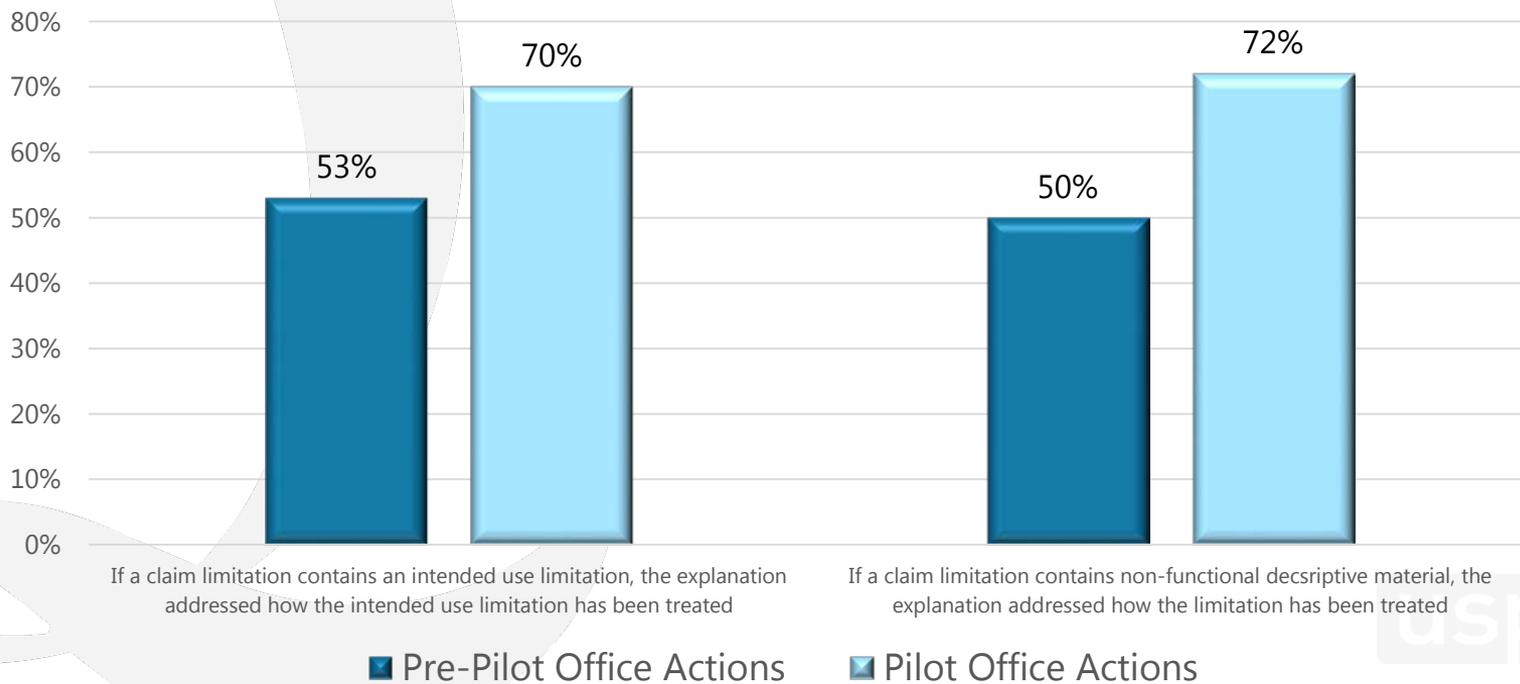
- 26 pre-identified practices were used to evaluate the examiner's Office actions
- 7 were deemed to be **Key Drivers** of overall clarity of the 103 rejections
- Top 2 identified **Key Drivers** include:

If a claim contains an intended use limitation, did the explanation address how the intended use limitation has been treated?

If a claim limitation contains non-functional descriptive material, did the explanation address how this limitation has been treated?

Data -103 Rejections, cont.

% Applicable Office Actions Exhibiting Key Driver



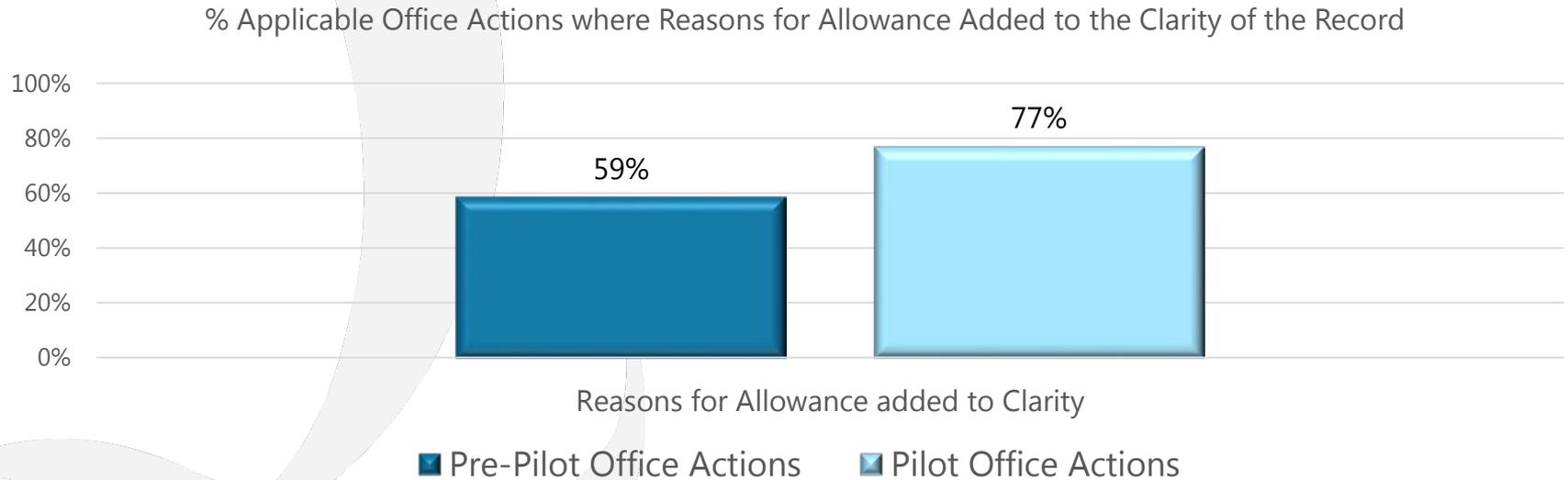
Data – Reasons for Allowance

2 questions on the overall clarity of Reasons for Allowance include:

Does the Office action contain Reasons for Allowance?

Did the reasons for allowance add to the clarity of the record?

Data – Reasons for Allowance, cont.



Lessons Learned

- Require examiners to complete more comprehensive, but balanced, interview summaries
- Provide corps-wide training on enhancing the clarity of interview summaries that focuses on the identified best practices/key drivers
- Utilize the identified best practice of recording claim interpretation to improve the clarity of Office actions *without* detracting from clarity
- Require more comprehensive reasons for allowance
- Provide training on best practices (key drivers)
- Have Examiners share their best practices with other Examiners by utilizing QEMs consistently across Technology Centers

Clarity of the Record – Post Pilot Activity

Surveys

- Surveyed Pilot examiners
- Collected data

Quality Chat

- Shared data results of Pilot

Focus Sessions

- Are best practices still being used?
- Discussed amended cases resulting from Pilot

Clarity of the Record - Next Steps

Monitor Pilot Treated Cases

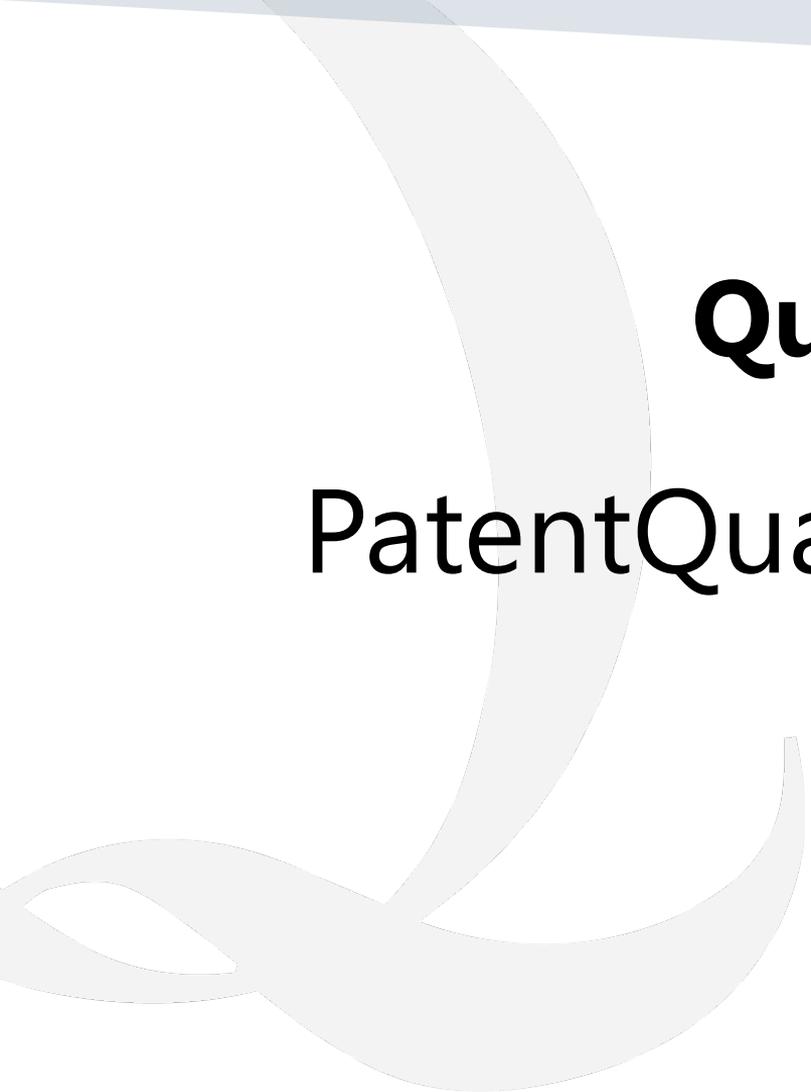
- Are applicant's arguments more focused?
- Average time to disposal compared to pre-pilot cases?

Applicant Quality Chat

- Focused only on applicants with at least one pilot treated case
- Gather information/thoughts on any differences seen during Pilot time period
- Discuss/share best practices

Full Detailed Report

- 2nd Quarter FY17



Questions?

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Clarity of the Record Training: Improving Clarity and Reasoning in Office Actions, STEPP & Automated Pre-examination Search



Greg Vidovich

Associate Commissioner for Patent Quality

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Clarity of the Record Training: Improving Clarity and Reasoning in Office Actions & STEPP

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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

ICR Training

- The Office is working to identify ways to improve training delivery
 - Using workshop-style training for certain topics
 - Delivering training by small groups of select trainers to improve consistency

Fiscal Year 2016 Training

- In Fiscal Year 2016, the Office completed many training modules for examiners, including:
 - 4 workshops
 - 3 PowerPoint training presentations

ICR Training: Impacts

- After training, examiners are surveyed on the following:
 - Class format
 - Course materials and/or examples
 - Length of the training
- Over 80% of those taking the survey agree that the format, materials, and length of the training was appropriate for their learning and retention

ICR Training – Examiner Feedback

	Fiscal Year 2016 – Training Completed						
	Levels that "Strongly Agree" and "Agree"						
Level of "agreement" from workshop participants	112(a) Workshop	112(b) Training	101 Workshop II	101 Workshop III	112(b) Workshop	Improve Reasons for Allowance	FY16 Interview Practice Training
The training format was effective in increasing my understanding of the course content	85.5%	78.1%	82.3%	85.4%	85.6%	91.7%	85%
Course materials and/or examples were favorable to learning	83.5%	77.7%	80.4%	82.1%	81.7%	N/A	72.4%

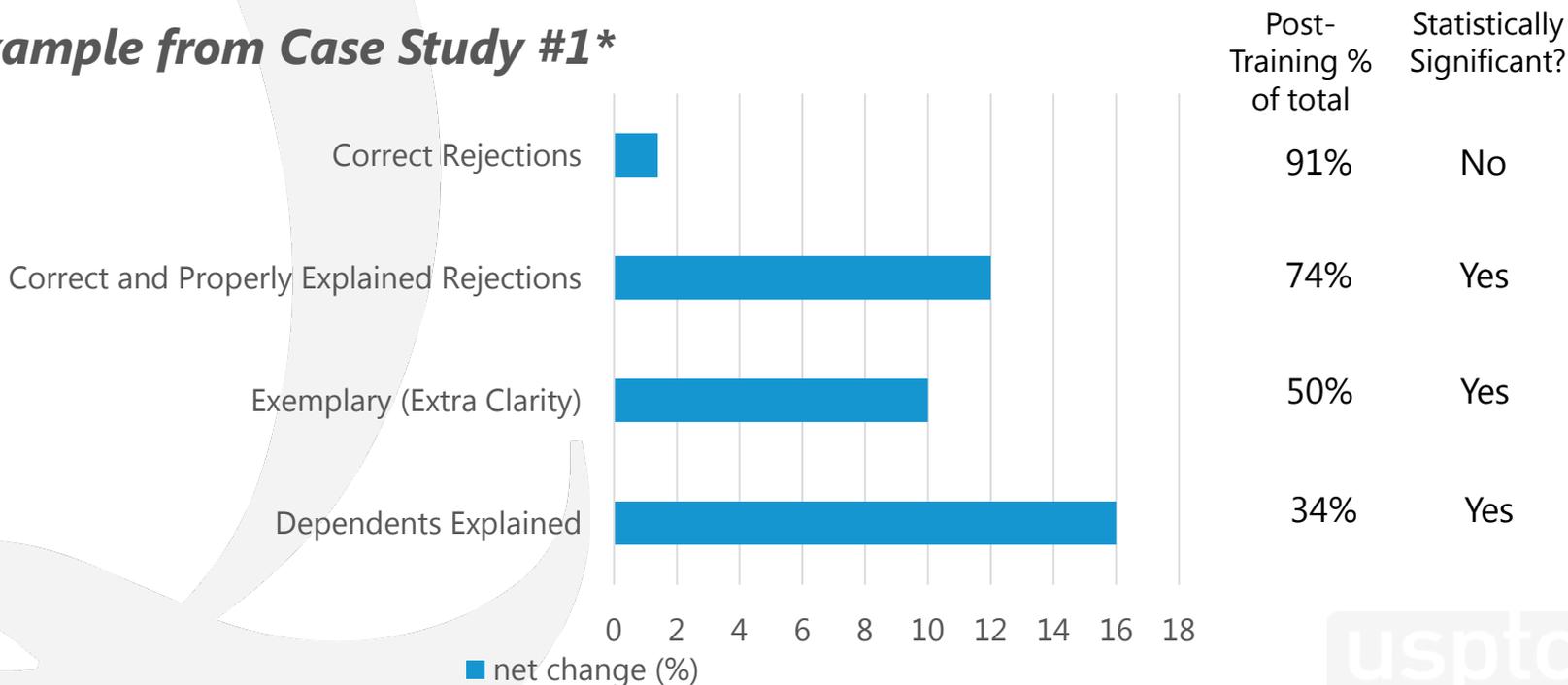
Workshop Structures

	101 Workshop III	112(b) Workshop
Number of Trainers	44	71
Training Sessions	300	539
Art Units	369	All
Number of examiners	5,079	8,200
Training Duration*	5 weeks	5 Weeks

*Additional time was also given for make-up sessions

Example of Improvements Pre-Training to Post-Training – From 101 Workshop III

*Example from Case Study #1**



*From Topic Submission for Case Studies

"Compliance of rejections with 35 U.S.C. 101 Official Guidance

Written Description and Enablement

- **Examining Claims for Compliance with 35 U.S.C. 112(a): Part II – Enablement**

Completed October 2015

- Focus on Electrical/Mechanical and Computer/Software-related Claims
- Determining whether the specification enables the full scope of claims with functional language

- **35 U.S.C. 112(a): Written Description Workshop**

Completed February 2016

- Used as companion to 35 U.S.C. 112(a) Written Description and Enablement training modules
- Reinforced the principles of the previous training

Clarity in Subject Matter Eligibility Analysis

- **Abstract Idea Workshop II**

Completed February 2016

- For use with the examples published January 27, 2015 and with the July 2015 Update
- Focus on identifying abstract ideas, evaluating additional elements, how to write a proper rejection, and identifying statutory subject matter

- **May 2016 Update: Memorandum - Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant's Response to a Subject Matter Eligibility Rejection**

Issued May 4, 2016

- **May 2016 Subject Matter Eligibility Update**

Federal Register Notice May 6, 2016

Clarity in Subject Matter Eligibility Analysis

- **Memorandum – Recent Subject Matter Eligibility Decisions (Enfish, LLC v. Microsoft Corp. and TLI Communications LLC v. A.V. Automotive, LLC)**
Issued May 19, 2016
- **Abstract Idea Workshop III: Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection**
Completed June 2016
 - Designed to supplement the May 4, 2016 Memorandum and assist examiners in applying the 2014 Interim Eligibility Guidance and the July 2015 Update
 - Focus on evaluating the adequacy of a 35 USC 101 rejection and also evaluating applicant’s response
- **Memorandum – Recent Subject Matter Eligibility Rulings (Rapid Litigation Management v. CellzDirect and Sequenom v. Ariosa)**
Issued July 14, 2016

Utilizing 35 U.S.C. 112(b) to Clarify the Record

- **35 U.S.C. 112(b): Enhancing Clarity By Ensuring That Claims Are Definite Under 35 U.S.C. 112(b)**

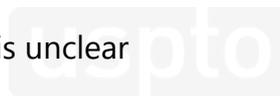
Completed May 2016

- Understand how enforcing the § 112(b) definiteness requirement enhances patent quality and clarity
- Identify the critical roles of examiners and applicants in enhancing clarity of the claims and the prosecution record
- Recognize the importance of explaining the grounds of rejection when the boundaries of the claim are unclear to provide a thorough written record

- **35 U.S.C. 112(b): Interpreting Functional Language and Evaluating Claim Boundaries – Workshop**

Completed August 2016

- Examples from each discipline
- Tips on making suggestions for resolving issues of unclear boundaries
- Focus on writing a complete explanation when the metes and bounds of certain language is unclear



Highlighting Reasons for Allowance as a Tool for Clarity

- **Enhancing Clarity By Ensuring Clear Reasoning of Allowance Under C.F.R. 1.104(e) and MPEP 1302.14**

Completed April 2016

- Improve the quality and reliability of issued patents by providing a complete file history
- Facilitate the public's evaluation of a patent's scope and strength, as well as simplification of any potential patent litigation related thereto
- Remind examiners that reasons for allowance should be provided in an application when the examiner believes that the record as a whole does not make clear his/her reasons for allowing a claim or claims

Upcoming Training Topics

- **Advanced Legal Training**

- To be completed Fiscal Year 2017 2nd Quarter**

- Provide advanced legal training to the examiners
 - Focus on the proper use of case law and addressing applicant arguments which may incorporate case law

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

STEPP Course Descriptions

- The training is broken into three separate modules
 - Day 1 focuses on the role of an examiner and the steps an examiner would take when reading an application for the first time. Claim interpretation and 35 USC 101 and 112 are emphasized on Day 1.
 - Day 2 uses the information gathered during Day 1 to plan a search, conduct a search, and map prior art to claims using 35 USC 102 and 103.
 - Day 3 focuses on writing of an office action, including a discussion of restriction practices, as well as post-examination options such as the Patent Trial and Appeal Board (PTAB) and the Central Reexamination Unit (CRU).

STEPP Participant Feedback

Survey Questions	Average Score
I understood the learning objectives	4.8/5
This course was easy to follow.	4.8/5
There was a sufficient amount of time for me to understand the content.	4.4/5
The information in this course is relevant and applicable to me.	4.9/5
The knowledge and experience shared by the instructor(s) enhanced my learning experience.	4.9/5

STEPP Participant Feedback, cont.

Survey Questions	Average Score
I was given ample opportunity to discuss and ask questions about the course material.	4.8/5
The materials aided in my learning.	4.8/5
My knowledge and skills increased as a result of this course.	4.8/5
I plan to apply the knowledge and skills learned in this course.	4.9/5
I would recommend this course to someone else.	4.8/5

Training Resources

All examiner training, including the above ICR Training, is publicly available

- <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials>

Stakeholder Training on Examination Practice and Procedure (STEPP) launched July 12th

- Training series planned at regular intervals in Alexandria and at regional offices
- <https://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp>



Automated Pre-Examination Search

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Automated Pre-Examination Search

Goal

- Provide a pre-examination search automatically in every application

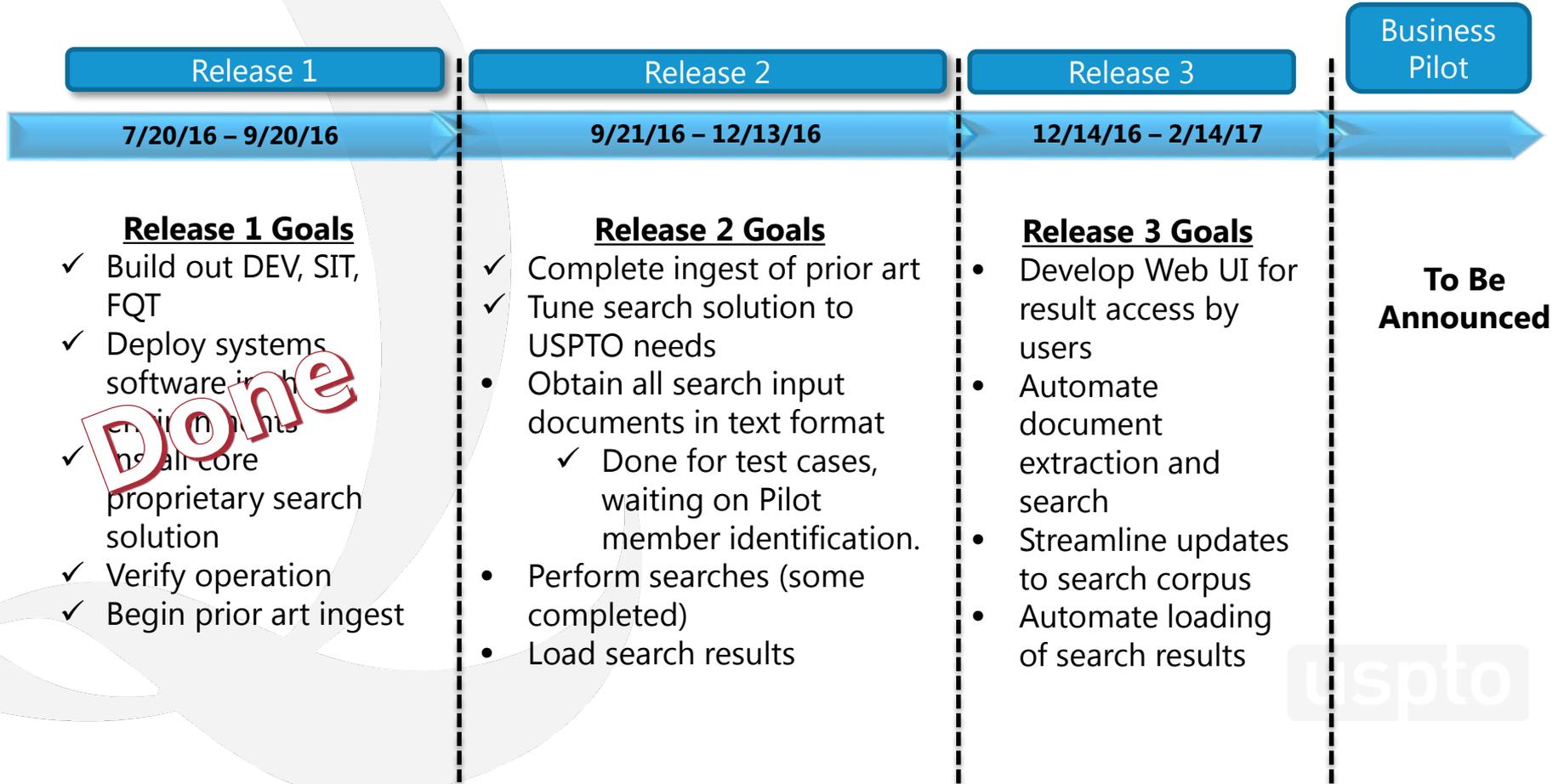
Objectives

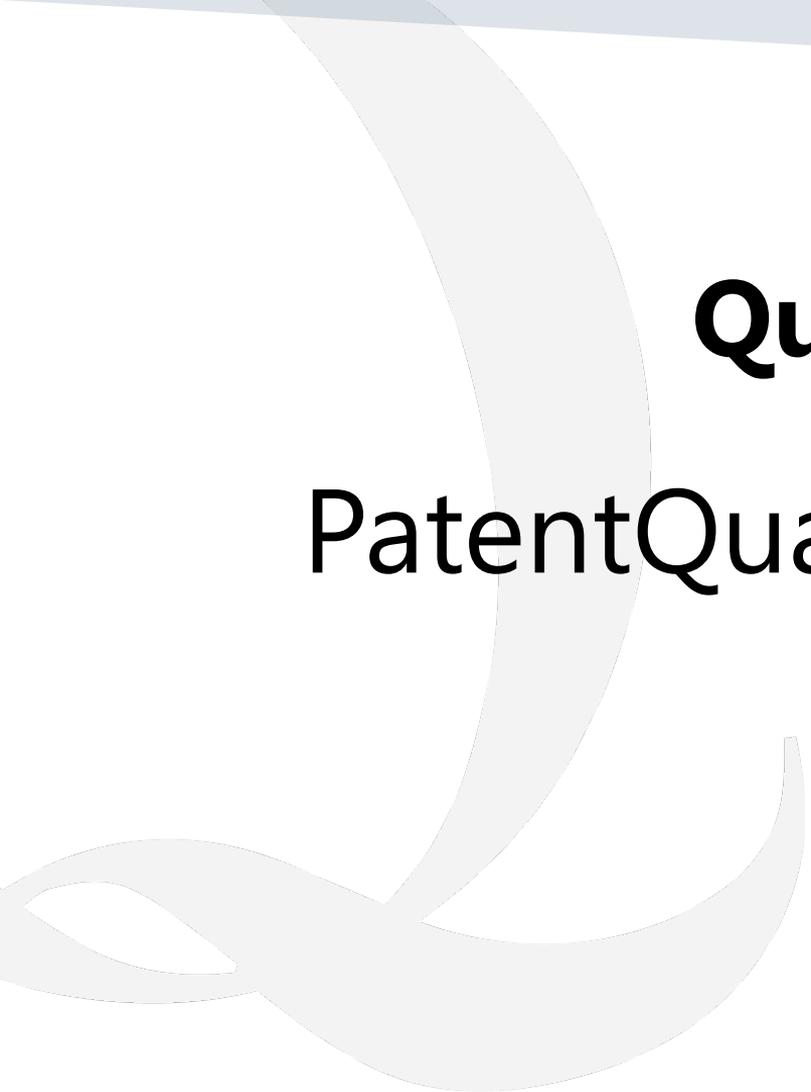
- Leverage modern technologies to identify prior art for the examiner **prior to** examination
- Optimize searching technology to keep pace with advancements in the field

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





Questions?

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Clarity and Correctness Data Capture: Master Review Form (MRF) & Quality Metrics



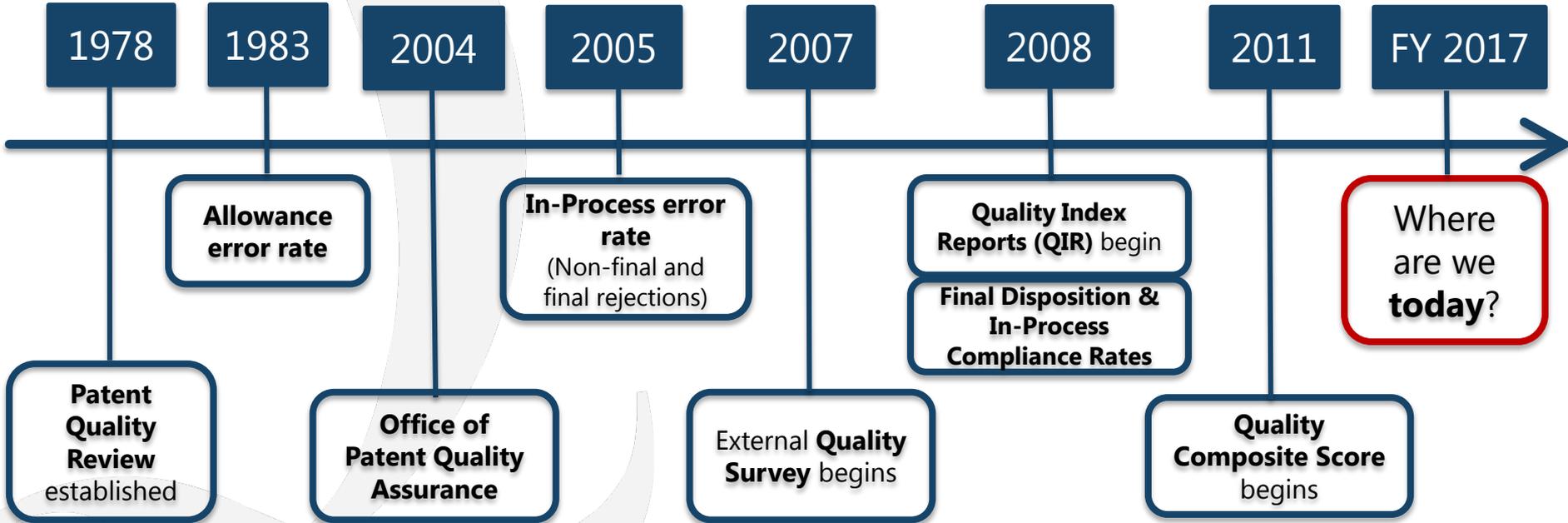
Marty Rater

Acting Director, Office of Patent Quality Assurance

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Historical Perspective



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

Challenges in Measuring Quality

- Big Q vs. little q
- Objectivity vs. Subjectivity
- Leading vs. Lagging indicators
 - What we are doing rather than what we did
- Balloon-effect
- Variance and controlling for a wide range of factors

Variance, Consistency, & Quality

Consistency is a key driver of quality perceptions and there are numerous factors that contribute to potential inconsistencies.

1.5 million
Office
Actions

8,300
Examiners

45,000
Agents /
Attorneys

530 Art
Units

65 OPQA
Reviewers

260,000
CPC
symbols

Examiner
Production
Goals

15,000
pro se
Applicants

Pilot
Programs &
Initiatives

Changes in
law or
policy

and other factors...

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Master Review Form

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Master Review Form (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

Correctness

Overall, were the 35 U.S.C. 102 rejection(s) in compliance? Yes In-Part No

Claimed features are explicitly/inherently disclosed in the prior art relied upon? Yes In-Part No N/A

Clarity

Examiner's reliance on the prior art is sufficient? Above Average Average Below Average

Overall, how was the clarity of the 35 U.S.C. 102 rejection(s)? Above Average Average Below Average

Sufficient explanations were provided to clarify the basis of the rejection so as to allow applicant to understand rejection. Above Average Average Below Average

Applicant's explanation clearly explained their claim interpretation. Above Average Average Below Average N/A

Applicant's explanation clearly pin-pointed where the Office action contained clear sufficient reasons for the rejections. Above Average Average Below Average N/A

The Office action contained clear sufficient reasons for the rejections. Above Average Average Below Average N/A

Clarity Comments:

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

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Quality Metrics - Redefined

Metrics Today

Product Indicators

Master Review Form

Capturing both correctness and clarity of examiners' final work product using uniform criteria gathered in a single database

Process Indicators

Transactional QIR

Tracking the efficiency and consistency of our processes (for example, to identify "churning")

Perception Indicators

Survey Results

Continuing to internally and externally poll perceptions of patent quality

Key Product Indicators

Product Indicators Master Review Form

Capturing both correctness and clarity of examiners' final work product using uniform criteria gathered in a single database

Process Indicators

Transactional QIR

Tracking the efficiency and consistency of our processes (for example, to identify "churning")

Perception Indicators

Survey Results

Continuing to internally and externally poll perceptions of patent quality

- Correctness and Clarity Reviews
- Correctness: Statutory Compliance
- Clarity
- Various levels of reporting

Key Process Indicators

Product Indicators

Master Review Form

Capturing both correctness and clarity of examiners' final work product using uniform criteria gathered in a single database

Process Indicators

Transactional QIR

Tracking the efficiency and consistency of our processes (for example, to identify "churning")

Perception Indicators

Survey Results

Continuing to internally and externally poll perceptions of patent quality

- Focus: Quality Index Reporting (QIR) Database
- Outliers
- Root-cause

Key Perception Indicators

Product Indicators

Master Review Form

Capturing both correctness and clarity of examiners' final work product using uniform criteria gathered in a single database

Process Indicators

Transactional QIR

Tracking the efficiency and consistency of our processes (for example, to identify "churning")

Perception Indicators

Survey Results

Continuing to internally and externally poll perceptions of patent quality

- Internal and external perception surveys
- Validate other metrics and identify quality hot spots

Quality Metrics Website

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

Timeline

We have had quality metrics based on independent reviews of Office actions since at least 1983. Our initial reviews focused solely on allowances. Over time, we included additional types of reviews to provide a more thorough understanding of the quality of our work products and processes.

FY 1983	FY 2005	FY 2007
<ul style="list-style-type: none">• Reviews of Allowances begin• Reviews occur prior to the patent grant	<ul style="list-style-type: none">• Reviews of In-Process Office Actions begin• Includes non-finals and finals	<ul style="list-style-type: none">• External Quality Surveys begin
FY 2008	FY 2010	
<ul style="list-style-type: none">• Quality Index Reports begin	<ul style="list-style-type: none">• Grouping Reviews into Final Disposition Reviews and In-Process Reviews begin• Final Disposition Reviews include allowance and final office actions• In-Process Reviews include non-final office actions	
FY 2011	FY 2016	
<ul style="list-style-type: none">• Quality Composite Score begins, which is	<ul style="list-style-type: none">• Enhanced Patent Quality Initiative (EPQI)	

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Initiatives / Quality Metrics

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Quality Metrics

... to self-improvement, developing and implementing new measures for understanding, evaluating, and reporting the correctness and quality of our work products.

- Quality Metrics
- Product Indicators
- Quality Indicators
- Quality Indicators
- Quality Indicators
- 5 Timeline**
- 6 Contact Us

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 Website

- Product Indicators

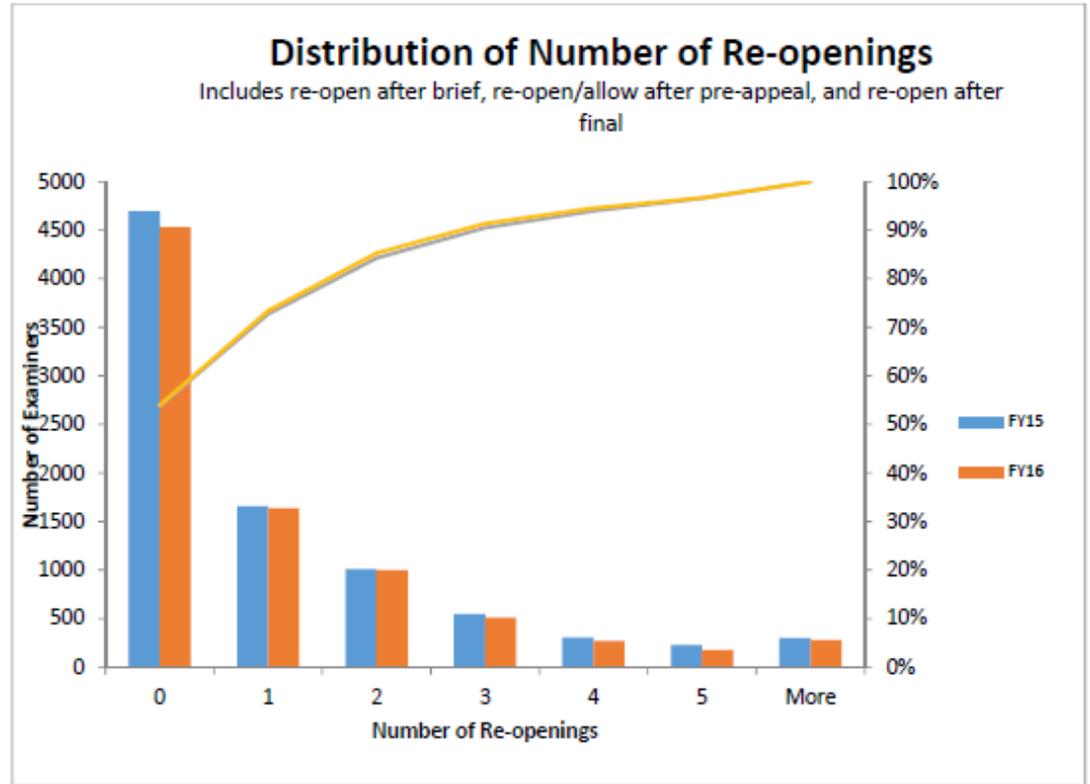
USPTO Correctness Indicators for Q4 of FY 2016		All Reviews	
		Count	Percent
Quality Metric Category: Prior Art (35 USC 102 and 103)	Compliant	3527	88.4%
	Not Compliant	461	
	Total	3988	
Quality Metric Category: 35 USC 101 (including utility and eligibility)	Compliant	3883	
	Not Compliant	105	
	Total	3988	
Quality Metric Category: 35 USC 112 (35 USC 112 (a),(b) including (a)/(b) rejections related to 35 USC 112(f))	Compliant	3738	
	Not Compliant	250	
	Total	3988	

35 USC 112 Statutory Compliance Metrics

Quality Metric Category		All Reviews		Non-Final		Final		Allowance	
		Count	Percent	Count	Percent	Count	Percent	Count	Percent
Quality Metric Category: 112 Overall	Compliant	3738	93.7%	2874	92.7%	146	90.1%	718	98.8%
	Not Compliant	250	6.3%	225	7.3%	16	9.9%	9	1.2%
	Total	3988		3099		162		727	
Quality Metric Category: 35 USC 112(a) - Enablement	Compliant	3938	98.7%	3058	98.7%	158	97.5%	722	99.3%
	Not Compliant	50	1.3%	41	1.3%	4	2.5%	5	7%
	All Reviews	3988		3099		162		727	
Quality Metric Category: 35 USC 112(a) - Written Description	Compliant	3928	98.5%	3048	98.4%	156	96.3%	724	99.6%
	Not Compliant	60	1.5%	51	1.6%	6	3.7%	3	4%
	All Reviews	3988		3099		162		727	
Quality Metric Category: 35 USC 112(b)	Compliant	3847	96.5%	2968	95.8%	157	96.9%	722	99.3%
	Not Compliant	141	3.5%	131	4.2%	5	3.1%	5	.7%
	All Reviews	3988		3099		162		727	
Quality Metric Category: 35 USC 112(a)(b), (f)-related	Compliant	3961	99.3%	3074	99.2%	161	99.4%	726	99.9%
	Not Compliant	27	.7%	25	.8%	1	.6%	1	.1%
	All Reviews	3988		3099		162		727	

Quality Metrics Website

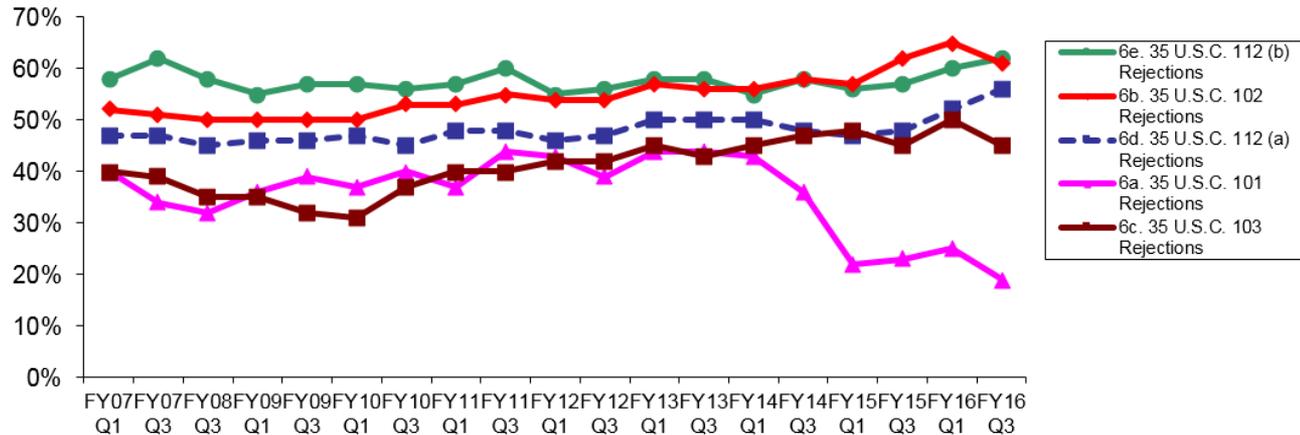
- Process Indicators
 - Consistency of Decision Making
 - Rework
 - Reopening Prosecution



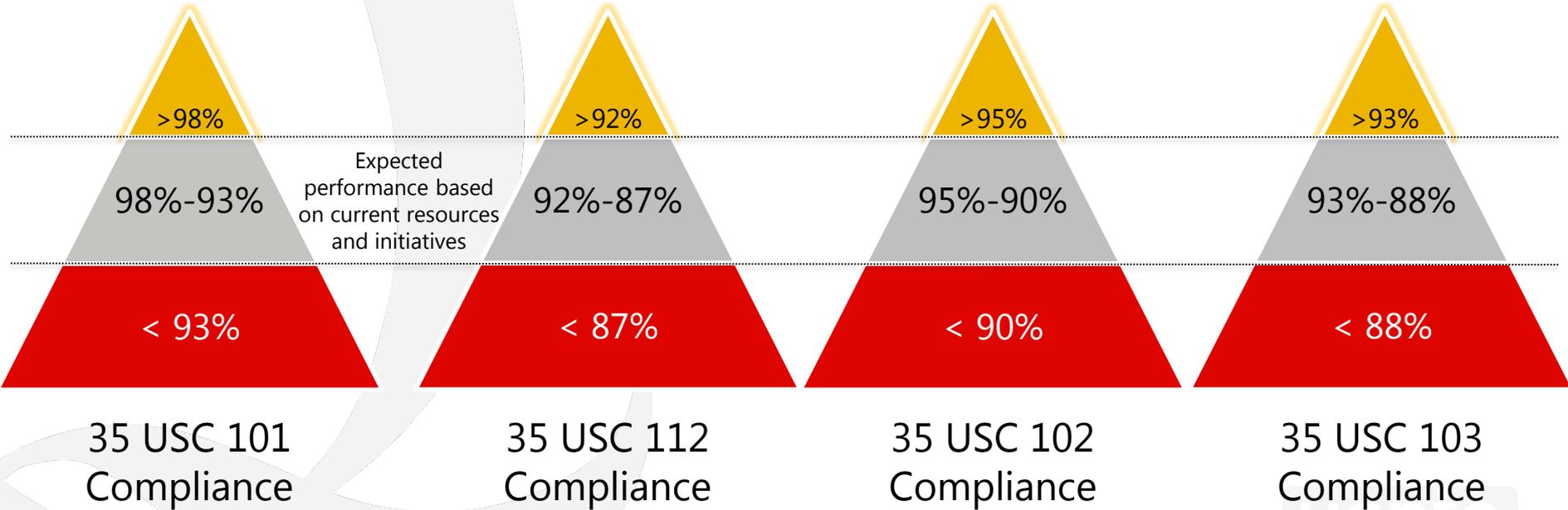
Quality Metrics Website

- Perception Indicators
 - Select data points from External Quality Survey

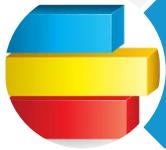
Frequency of Technically, Legally, and Logically Sound Rejections
(Percent reporting “most” or “all” of the time)



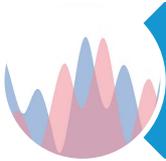
Quality Metrics FY17 Targets



Quality Metrics - Next Steps



Publish Clarity Data



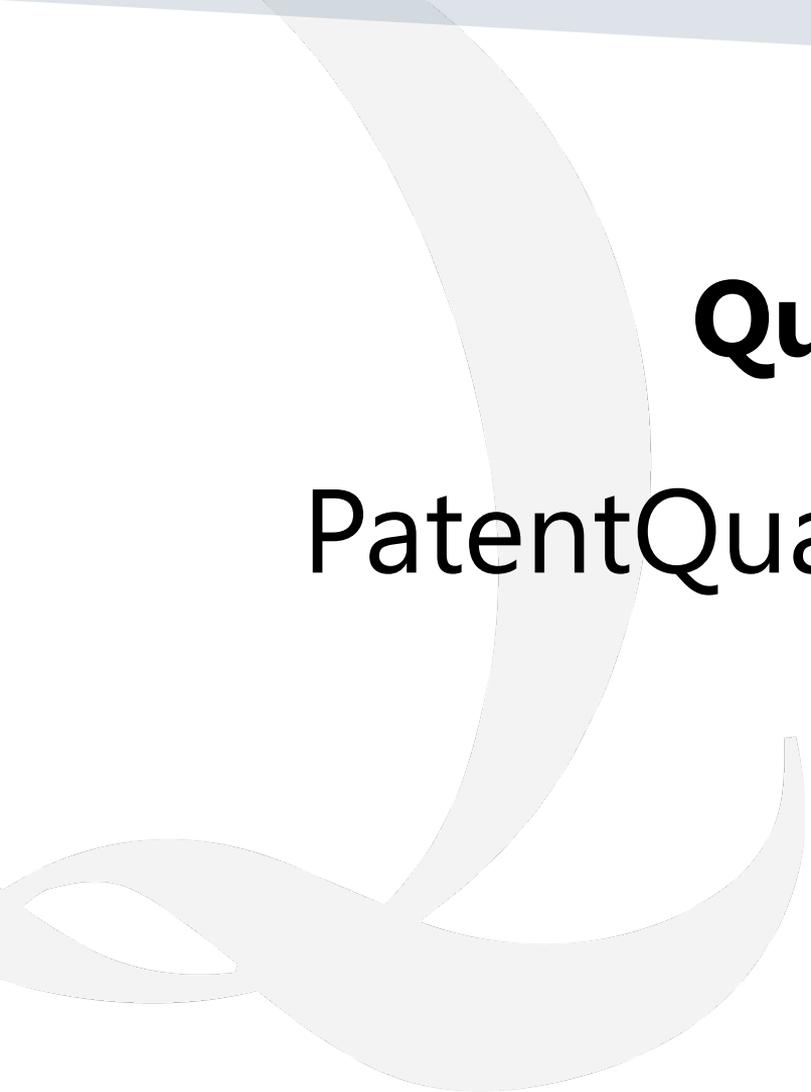
Develop Dashboards for Monitoring



Quality Assurance Action Plans



Evaluate Perception Indicators



Questions?

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**BREAK
(10 MINS)**

Topic Submission for Case Studies



Brian Hanlon

Director, Office of Patent Legal Administration

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PATENT AND TRADEMARK OFFICE



Topic Submissions - Background

- Case studies used internally on an *ad hoc* basis to study particular issues
- Federal Register Notice initiated this formal program on December 21, 2015
 - USPTO invited stakeholders to submit patent quality-related topics for study
 - Submissions were accepted through February 12, 2016

Topic Submissions and Selection

Submissions:

- Received over 135 ideas for case studies from 87 stakeholders
 - Intellectual property organizations, law firms, companies, and individuals
 - <https://www.uspto.gov/patent/laws-and-regulations/comments-public/topics-submitted-quality-case-studies>

Process of review and selection:

1. Assessed whether the topic was appropriate or capable of being timely assessed via a case study
2. Determined whether other programs or mechanisms within the USPTO were more appropriate
3. Grouped the remaining submissions by subject matter

Topics Selected for Case Studies

Patent Quality Topic	Project Status
1. Compliance of rejections with 35 U.S.C. 101 official guidance	Being Finalized
2. Consistency of application of 35 U.S.C. 101 across Art Units/Technology Centers	In-Progress
3. Use of compact prosecution when making 35 U.S.C. 101 rejections	In-Progress
4. Correctness and clarity of motivation statements in 35 U.S.C. 103 rejections	Being Finalized
5. Enforcement of 35 U.S.C. 112(a) written description in continuing applications	In-Progress
6. Consistent treatment of claims after May 2014 35 U.S.C. 112(f) training	Being Finalized

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

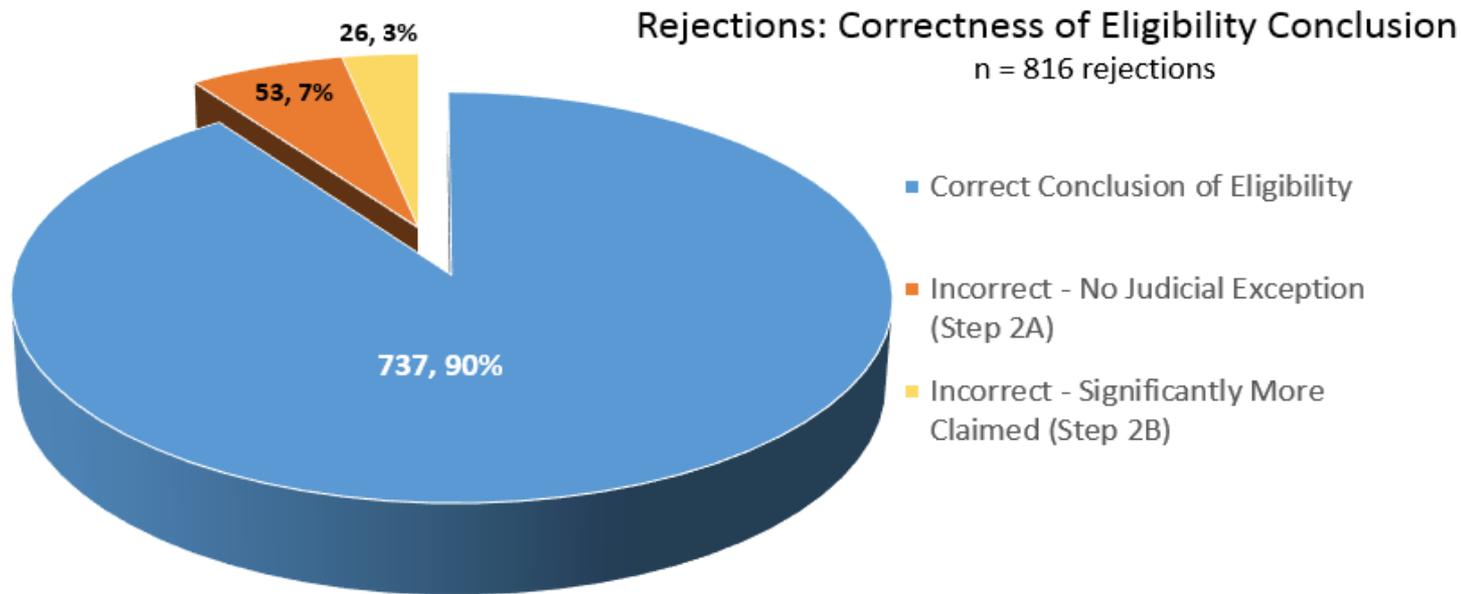
- Study was designed to provide these findings:
 - I. Are examiners following § 101 Guidance?
 - a. How often were the rejected claims actually ineligible?
 - b. How often were the rejections properly explained?
 - II. What improvements were found due to the June 2016 training?
 - III. What are the drivers 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

- A representative sample of Office actions across all Technology Centers having an *Alice/Mayo*-type 101 rejection was chosen for study through a random selection process.
 - Actions were issued January 2016-August 2016
 - May-June 2016 training on formulating 101 rejections occurred. Results before and after the training were compared to determine the effect of the training.
 - 394 were Office actions issued pre-training; 422 were post-training.
 - Review was limited to the first claim in the Office Action rejected under 101 and its dependent claims
 - To maximize the breadth of cases/art areas/technologies studied

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

Reviewers were instructed on the following points of compliance to find a “proper explanation” for Step 2A - 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
 - For abstract ideas, it should be similar to a court-identified abstract idea
 - For products of nature, it should be shown to not have markedly different characteristics from a natural product.

Findings of the Primary Study

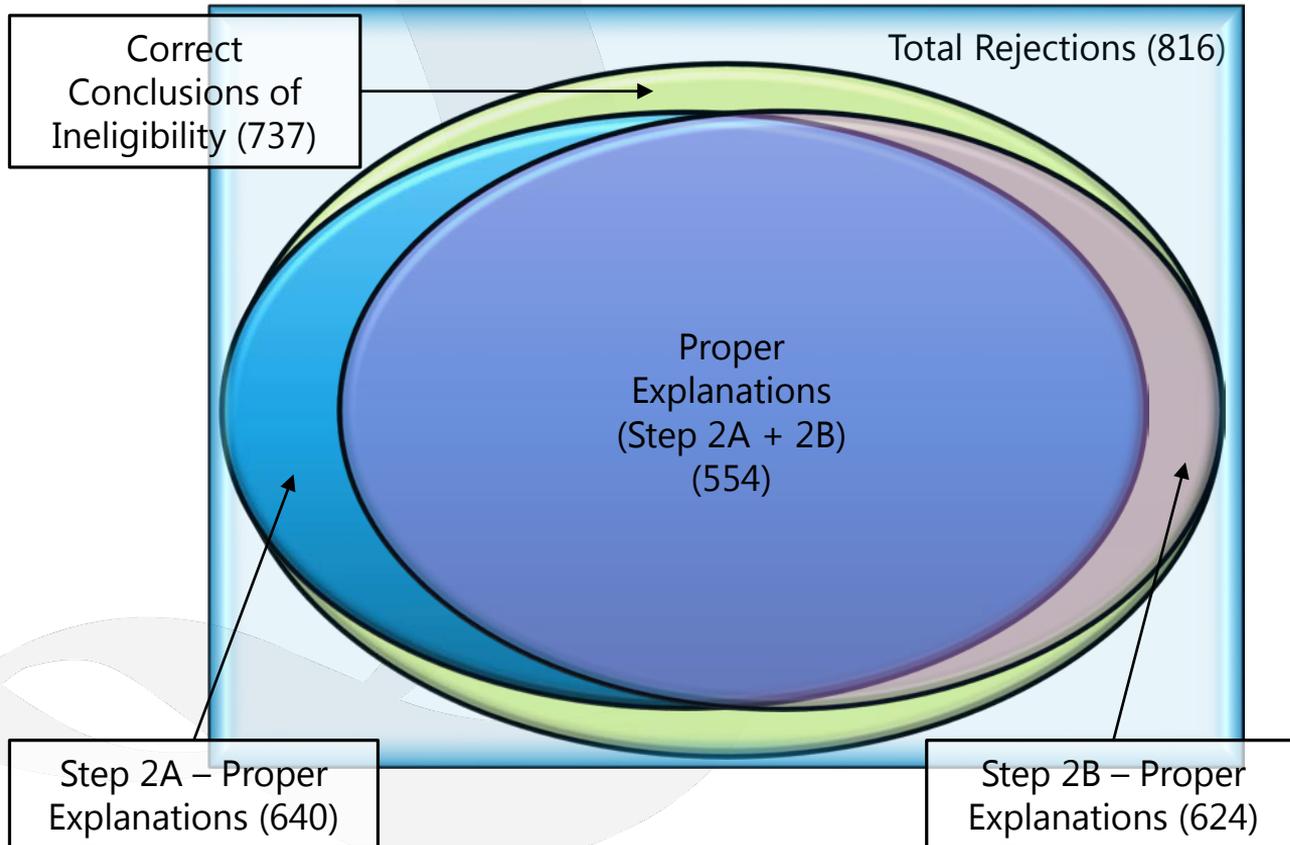
I(b). Were The Claims Properly Explained

Reviewers were instructed on the following points of compliance to find a “proper explanation” for Step 2B - Is significantly more than the judicial exception claimed?

1. Rejection should provide an 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
 - Where there are no elements in addition to the judicial exception, a Step 2B statement is not required.

Findings of the Primary Study

I(b). Were The Claims Properly Explained



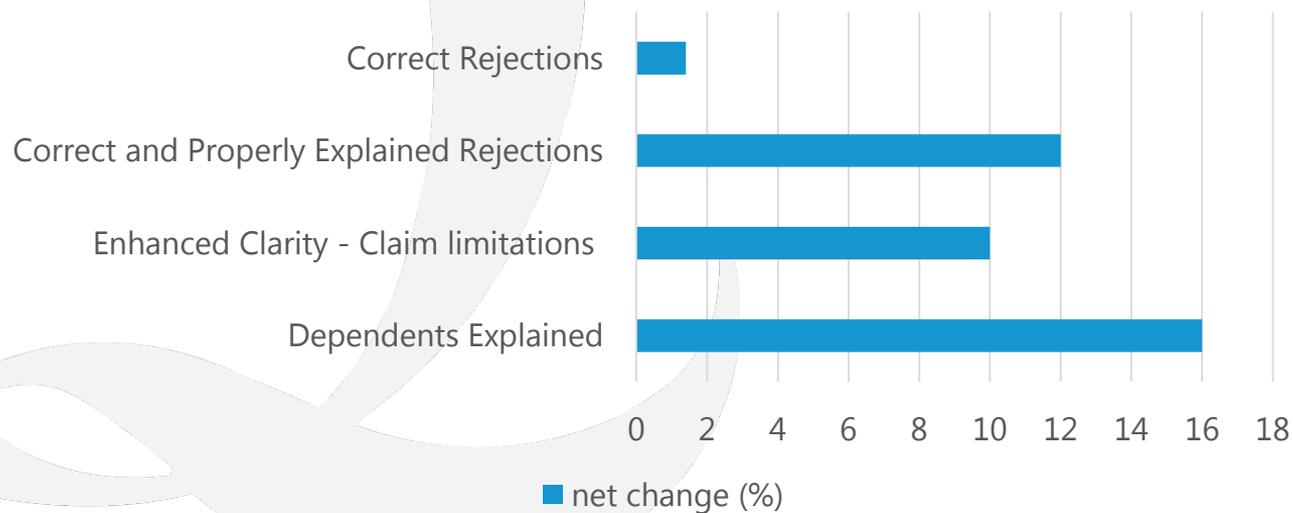
A proper explanation of ineligibility was interpreted as explaining why the claimed invention was directed to a judicial exception (Step 2A) and did not amount to significantly more than that judicial exception (Step 2B).

- Mere conclusory statements or boilerplate language were insufficient.

Findings of the Primary Study

II. Improvements Due to May 2016 Training

Improvement from Pre-Training to Post-Training



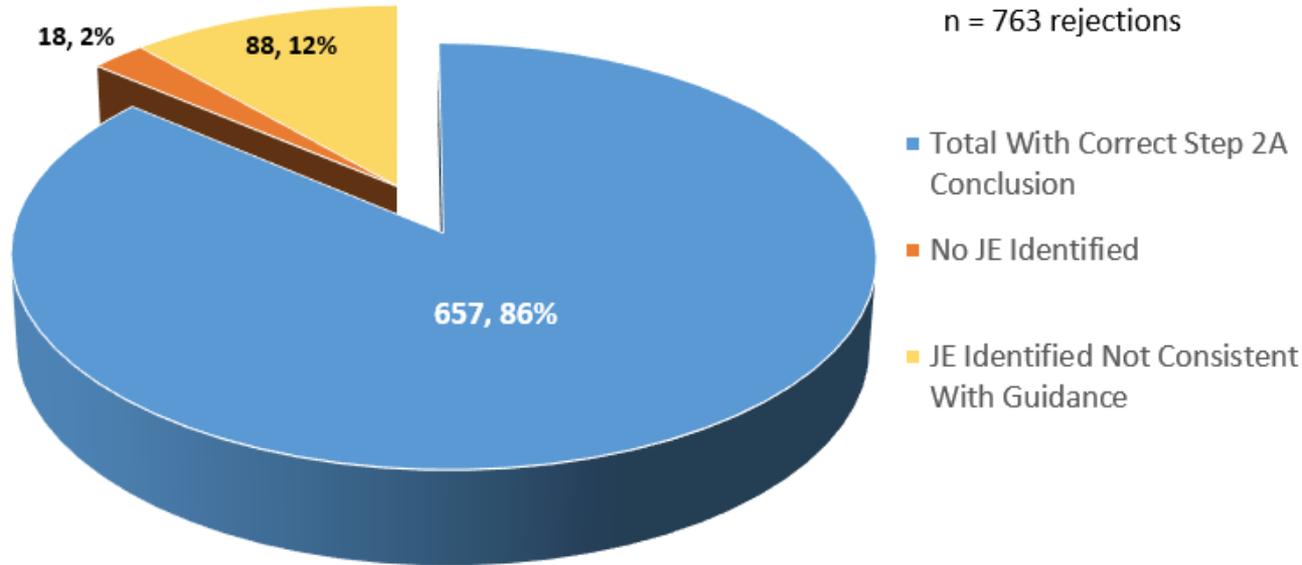
Improvement (% of total rejections)	Statistically Significant ?
90% → 91%	No
62% → 74%	Yes
40% → 50%	Yes
18% → 34%	Yes

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
n = 763 rejections



Findings of the Primary Study

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

Key Drivers for Step 2A

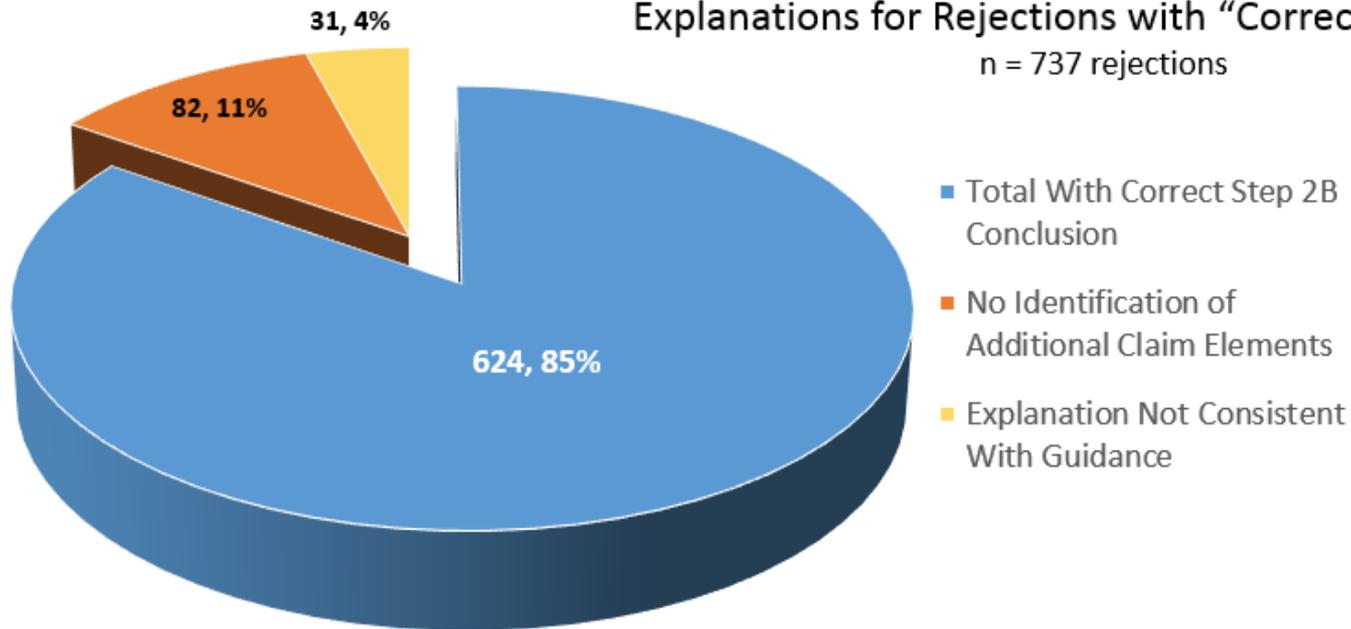
1. Judicial exception is identified in rejection
 - Requires mere recordation
2. Judicial exception is similar to those identified by courts.
 - Greatest room for USPTO improvement for 2A.
 - Certain technology areas have high compliance rates
 - *i.e.*, business methods and biotech at 90%
 - Sample size for individual TCs too small to draw significant, reliable conclusions.

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
n = 737 rejections



Findings of the Primary Study

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

Key Drivers for Step 2B

1. Additional elements explained in rejection
 - Greatest room for USPTO improvement for 2B.
 - Requires mere recodation
 - 82 rejections failed to record additional elements.
 - 23 of these did not record the presence of a generic processor.
 - Certain technology areas have high compliance rates
 - Business methods and gaming identified additional elements in all rejections studied.
2. Rejection correctly explains why additional elements did not amount to significantly more
 - Less room to move the needle (only 31 [4%] of explanations were inconsistent with Guidance)

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

January-April 2016 Cases	394
Responses filed	315 (81%)
Subsequent Office action	189 (48%)

- 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:

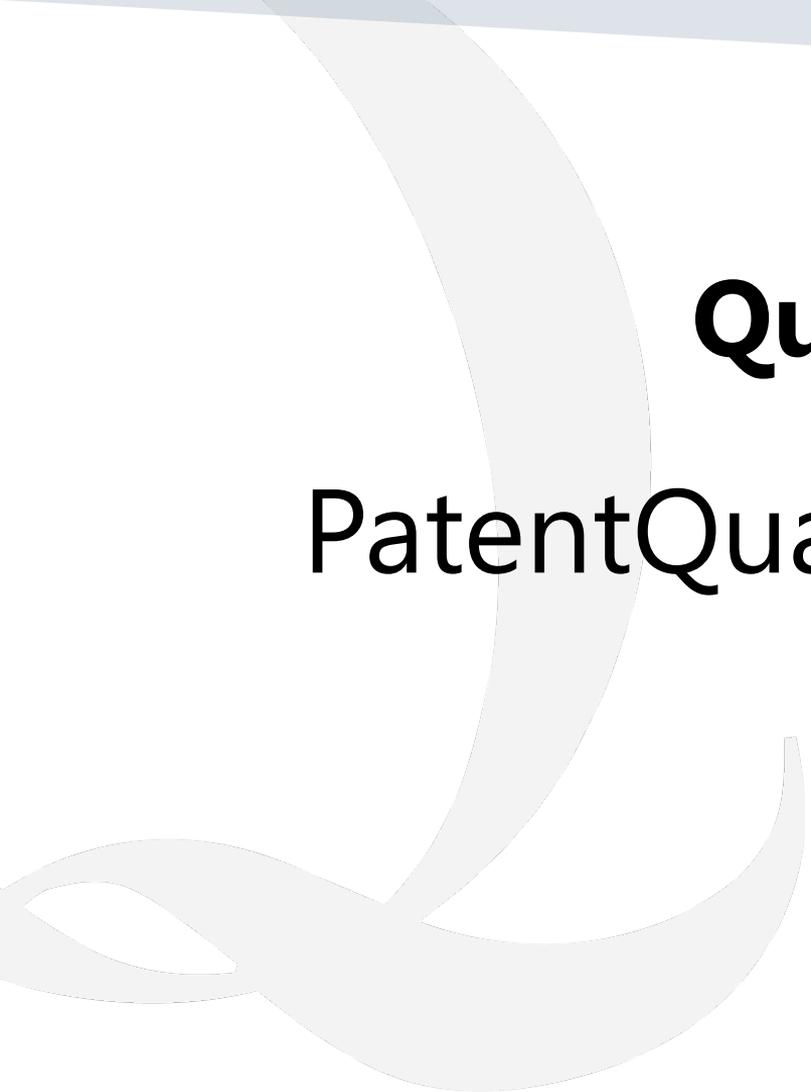
January-April 2016 Cases	394
Responses filed	315 (81%)
Subsequent Office action	189 (48%)
101 rejection not maintained (including where claims were cancelled)	86 (45%)
101 rejection maintained	103 (55%)
• Specifically addressed arguments	• 78 (76%)

Secondary Study - Correlations

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

One statistically significant correlation was found between an incorrect 2A analysis and withdrawal of the 101 rejection in the next Office action:

Did the study find the claim directed to an abstract idea?	How often was the rejection withdrawn in the next Office action?
Yes	40%
No (claim was eligible at 2A)	76%



Questions?

PatentQuality@uspto.gov

Panel Discussion:

Patent Quality in USPTO – Our Next Steps

- **Valencia Martin Wallace**, *Deputy Commissioner for Patent Quality*
- **Andy Faile**, *Deputy Commissioner for Patent Operations*
- **Bob Bahr**, *Deputy Commissioner for Patent Examination Policy*
- **Kevin Rhodes**, *President and Chief IP Counsel, 3M Innovative Properties Company*
- **Hans Sauer**, *Deputy General Counsel, Biotechnology Innovation Organization*

Moderator: Jack Harvey, Assistant Deputy Commissioner for Patent Operations

PatentQuality@uspto.gov



Professional Responsibility and Practice Before the USPTO

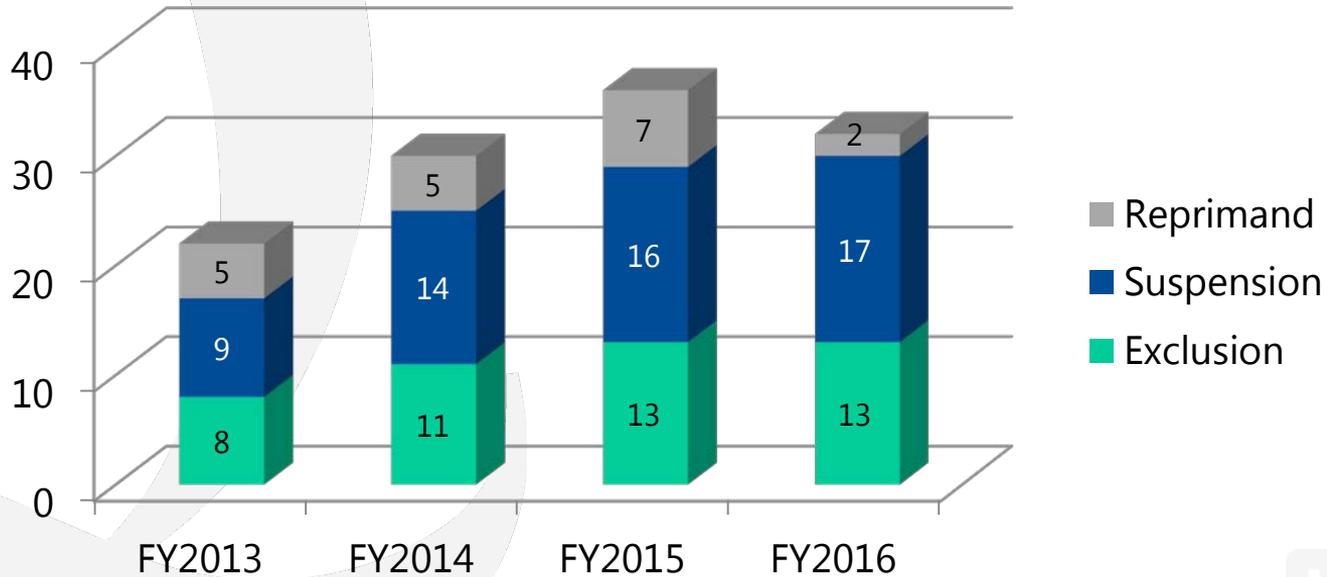
William R. Covey

Deputy General Counsel and Director
Office of Enrollment and Discipline

UNITED STATES
PATENT AND TRADEMARK OFFICE

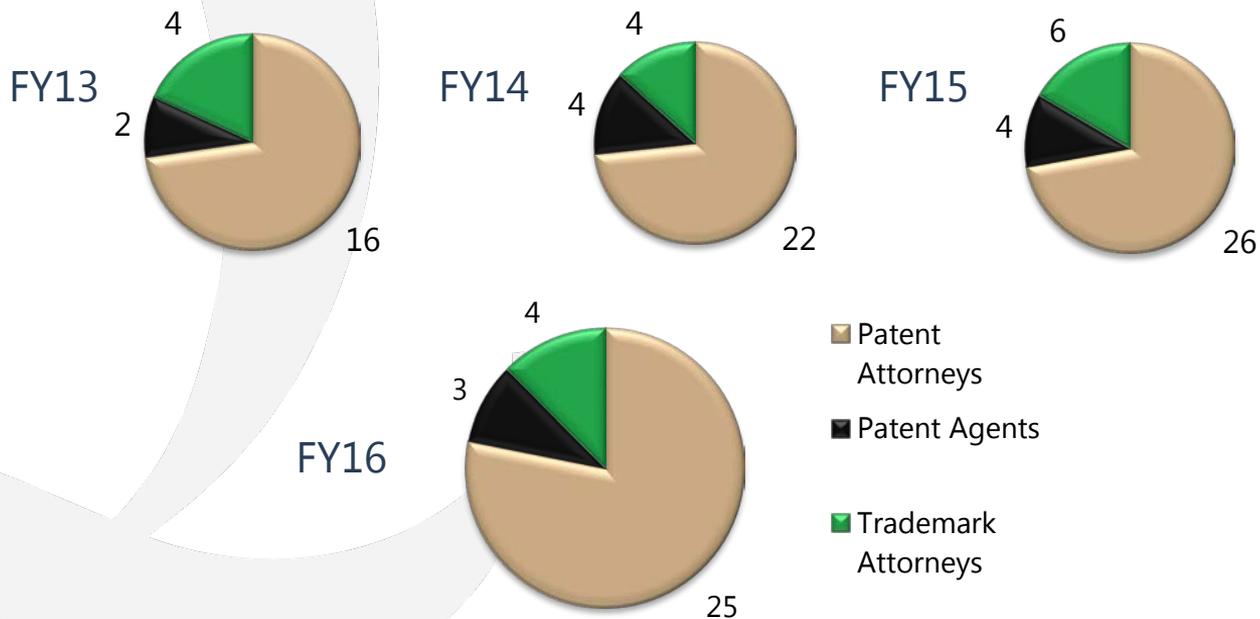


USPTO Disciplinary Decisions



USPTO Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type



OED Discipline: Grievances and Complaints

- An investigation of possible grounds for discipline may be initiated by the receipt of a grievance. *See* 37 C.F.R. § 11.22(a).
- Grievance: “a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.” 37 C.F.R. § 11.1.
- Common Sources of Information:
 - External to USPTO: Clients, Colleagues, Others.
 - Internally within USPTO: Patent Corps, Trademark Corps, Other.
 - Other: News Articles.
- Duty to report professional misconduct:
 - 37 C.F.R. § 11.803.

Limited Recognition for Visa Holders

- 37 C.F.R. 11.9(b) provides for the grant of limited recognition to practice before the USPTO in patent matters to nonimmigrant aliens residing in the U.S.
- Limited recognition is based on the visa authorizing employment in the U.S.
 - In many instances, visa must explicitly authorize employment or training involving practice before the USPTO in patent matters.
- Practitioners granted limited recognition are not “registered.”
 - Biographical information must indicate their limited recognition status.
- Limited recognition terminates when visa expires; employment authorized under the visa terminates; or practitioner departs the U.S.
 - New or extended visa requires extension or reinstatement from OED.

Register of Patent Practitioners

- Register of persons authorized to practice before the USPTO in patent matters is found on USPTO website: <https://oedci.uspto.gov/OEDCI/>.
- New web portal enables practitioners to:
 - Indicate whether they are currently accepting new clients;
 - Change official address with OED;
 - Change name;
 - View certain transactions with OED;
 - Add email addresses to receive certain communications and reminders from OED.
- Register now lists persons granted limited recognition.
- More updates to come.

Duties of Candor, Disclosure, and Good Faith

- 37 C.F.R. § 1.56 - Duty to disclose information material to patentability.
- 37 C.F.R. § 1.555 - Information material to patentability in *ex parte* and *inter partes* reexamination proceedings.
- 37 C.F.R. § 11.18(b) - Signature and certificate for correspondence filed in the Office.
- 37 C.F.R. § 11.106(c) - Confidentiality of information.
- 37 C.F.R. § 11.303(a)-(e) - Candor toward the tribunal.
- 37 C.F.R. § 11.801(a)-(b) - Registration, recognition, and disciplinary matters.
- 37 C.F.R. § 11.804(c) - Misconduct (dishonesty, fraud, deceit, misrepresentation).
- 37 C.F.R. § 42.11 - Duty of candor; signing papers; representations to the Board; sanctions.

Current 37 C.F.R. § 1.56

- (a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section."
- (b) . . . information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability.
- (b) . . . A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(emphasis added)

Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276 (Fed. Cir. 2011)

- Materiality standard is “but-for” materiality.
 - Prior art is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art.
- Materiality prong may also be satisfied in cases of affirmative egregious misconduct
- Intent to deceive USPTO must be weighed independent of materiality.
 - Courts previously used sliding scale when weighing intent and materiality.
- Intent to deceive must be single most reasonable inference to be drawn from evidence.

2011 Proposed Changes to 37 C.F.R. § 1.56

- Initial NPRM issued on July 21, 2011 (76 FR 43631)
- 2011 Proposed Amendment to 37 C.F.R. § 1.56(b)
 - Information is material to patentability if it is material under the standard set forth in [*Therasense*]. Information is material to patentability under *Therasense* if: (1) The Office would not allow a claim if it were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction; or (2) The applicant engages in affirmative egregious misconduct before the Office as to the information.
- Similar proposed amendment to 37 C.F.R. § 1.555.
- USPTO received feedback from 24 commenters.

2016 Notice of Proposed Rulemaking

- NPRM issues October 28, 2016; <https://www.federalregister.gov>.
- Comments due 60 days after publication date.
- 2016 NPRM addresses comments received to 2011 proposed rules.
- Proposed amendment to 37 C.F.R. § 1.56 (emphasis added):
 - (a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office **all information known to that individual** to be material to patentability under the **but-for materiality standard** as defined in paragraph (b) of this section. . . . Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. . . . However, no patent will be granted on an application in connection with which **affirmative egregious misconduct** was engaged in, fraud on the Office was practiced or attempted, or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine: (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
 - (b) Information is but-for material to patentability if the Office would not allow a claim if the Office were aware of the information, applying the preponderance of the evidence standard and giving the claim its broadest reasonable construction consistent with the specification.



Case Law Review

Conflict of Interest: *Maling v. Finnegan*

- ***Maling v. Finnegan,***

473 Mass. 336 (2015)

- Plaintiff engaged defendant firm to prosecute patents for screwless eyeglass hinge.
- After patents were obtained, plaintiff learned that firm had simultaneously represented another client in the same industry.
- Plaintiff's work was done in firm's Boston office; 2nd party's work was done in D.C. office.
- Plaintiff alleges that firm belatedly commenced preparation of one of his applications and that it inexplicably took a long time to do so.
- Plaintiff alleges he would not have made investment in developing his product if firm had disclosed its conflict and work on 2nd party's patents.

Conflict of Interest: *Maling v. Finnegan (cont.)*

- ***Maling (cont.)***

- Appellate court stated that subject matter conflicts may present a number of potential legal, ethical, and practical problems, but they do not, standing alone, constitute actionable conflict of interest that violates Mass. Rule of Professional Conduct 1.7 (Conflict of Interest).
- Court did not find that competing for patents in the same space placed clients directly adverse to one another.
 - Analogized with two clients attempting to obtain radio broadcast licenses.
- Court discussed likelihood of interference as a barometer for conflict between two clients in same space.
- No evidence or even allegation that Plaintiff's claims were altered because of simultaneous representation.

Conflict of Interest: *In re Radanovic*

- ***In re Radanovic*** (USPTO D2014-29)
 - Patent attorney:
 - Represented two joint inventors of patent application.
 - No written agreement regarding representation.
 - Attorney became aware of a dispute wherein one inventor alleged that the other did not contribute to allowed claims.
 - Continued to represent both inventors.
 - Expressly abandoned application naming both inventors in favor of continuation naming one.
 - Mitigating factors included clean 50-year disciplinary history.
 - Received public reprimand.

Conflict of Interest: *Additional Cases*

- ***In re Newman*** (USPTO D2015-14)
- ***In re Blackowicz*** (USPTO D2015-13)
 - Newman asks Blackowicz to represent Client 1 & Client 2, who co-own TM application.
 - Newman and Blackowicz also represent Client 2's father (Client 3), Client 2's uncle (Client 4), and the uncle's company (Client 5).
 - No disclosures to Clients 1 & 2 regarding potential effects of co-representation or in light of representation of Clients 3, 4 & 5.
 - Work on Client 1 & 2's application is billed to Client 5.
 - No disclosures are made regarding possible issues with this arrangement.
 - Clients 3 and 4 were copied on confidential emails with Clients 1& 2.
 - Dispute develops between Client 1 and Client 2.

Conflict of Interest: *Additional Cases (cont.)*

- ***In re Blackowicz*** (USPTO D2015-13)
- ***In re Newman*** (USPTO D2015-14)
 - Blackowicz and Newman correspond with Client 2 and Client 3 regarding the TM application and the dispute between Client 1 and Client 2.
 - Discussed abandonment of joint application in favor of new applications for the same mark owned by Client 3's company (Client 6).
 - Blackowicz abandoned co-owned application. Did not consult with Client 1.
 - Filed new applications on behalf of Client 3's company (Client 6) for same mark.
 - Client 1 complained and Blackowicz filed petition to reinstate the co-owned application, even though, if granted, the co-owned application would have been directly adverse to Client 6 applications.

Conflict of Interest: *Additional Cases Decisions*

- ***In re Blackowicz*** (USPTO D2015-13)
 - 30-day suspension.
 - Required to take MPRE & attain score of 85 or better.
 - 13-month probation with practice monitor.
 - Mandatory conflicts CLE attendance.
- ***In re Newman*** (USPTO D2015-14)
 - 30-day suspension.
 - Required to take MPRE and attain score of 85 or better.
 - 18-month probation.
 - Mandatory practice management or conflicts CLE attendance.

Disreputable or Gross Misconduct

- ***In re Schroeder*** (USPTO D2014-08)
 - Patent Attorney:
 - Submitted unprofessional remarks in two separate Office action responses.
 - Remarks were ultimately stricken from application files pursuant to 37 C.F.R. § 11.18(c)(1).
 - Order noted that behavior was outside of the ordinary standard of professional obligation and client's interests.
 - Aggravating factor: has not accepted responsibility or shown remorse for remarks.
 - Suspended from practice before USPTO for 6 months.

Legal Fees

- ***In re Neeser*** (USPTO D2015-16)
 - Patent Agent:
 - Formed a partnership w/ non-lawyer practicing patent law.
 - Failed to maintain trust accounts for clients' funds.
 - Neglected applications.
 - Suspended from practice before USPTO for 12 months.
 - Mitigating factors included remorse, cooperation w/ investigation, and no prior discipline.

Neglect

- ***In re Tachner*** (USPTO D2012-30)
 - Patent attorney; disciplinary complaint alleged:
 - Failed to report Office communications and docket due dates.
 - Apps. became abandoned; patents expired for failure to pay maint. fees.
 - Used handwritten docket book and “white board” for docketing due dates.
 - Staff was undertrained and underequipped.
 - Suspended from practice before USPTO for 5 years.
- ***In re Kubler*** (USPTO D2012-04 and 10-06)
 - Patent attorney:
 - Lacked uniform system of client communication in his office. Caused inconsistent client communications practices and communications delay.
 - Received Public Reprimand:
 - Practitioner also agreed to attend practice-management classes.

Dishonesty, Fraud, Deceit or Misrepresentation

- ***In re Hicks*, D2013-11 (USPTO 2013)**

- Attorney sanctioned by EDNY for non-compliance with discovery orders.
- Federal Circuit affirmed sanction and found appellate brief to contain “misleading or improper” statements.
 - Brief reads, “Both the Magistrate and the District Court Found that RTI's and its Litigation Counsel Hicks' Pre-Filing Investigation Was Sufficient.” However, neither the magistrate judge nor the district court ultimately found that RTI's or Mr. Hicks's pre-filing investigation was “sufficient.”
 - Mr. Hicks also failed to inform the court that a case citation was non-precedential and therefore unavailable to support his legal contentions aside from “claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like.”
 - *Rates Technology, Inc. v Mediatrice Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012)
- Received public reprimand and one-year probation.

Dishonesty, Fraud, Deceit or Misrepresentation (cont.)

- ***In re Goldstein*** (USPTO D2014-10)
 - Patent attorney; disciplinary complaint alleged:
 - Falsely informed clients he filed patent and TM applications on their behalf and that applications were being examined.
 - Created and sent clients fake filing receipts for patent applications.
 - Created fake cease-and-desist letters allegedly sent to potential infringers.
 - Created phony response to fictitious inquiry from patent examiner.
 - Billed clients for services he did not perform and fees he did not pay.
 - Excluded from practice before the USPTO.

Fee-Related Issues

- ***In re York*** (USPTO D2013-19)
 - Patent attorney:
 - Contract attorney to law firm, claimed firm owed him money.
 - *Inter alia*, deposited payments from firm client into personal account without informing firm.
 - Used firm's deposit account in violation of firm policy.
 - Received public reprimand and 2 year probation.
- ***In re Lane*** (USPTO D2013-07)
 - Patent agent:
 - Sent notice of charges to client without demand for payment, as parties were working on potential business relationship that would subsume the charges.
 - Later sent an invoice and added an 18% interest charge from first notice.
 - Because client was unaware that interest was accruing, interest charge was excessive fee and disreputable conduct.
 - 18-month suspension added to earlier discipline.

Unauthorized Practice of Law

- ***In re Pham*** (USPTO D2015-01)
 - Patent Agent (Former Attorney):
 - Represented ex-wife in trademark dispute.
 - Signed emails as “Associate General Counsel”
 - Emails contained legal opinions.
 - Received public reprimand.
- ***In re Campbell*** (USPTO D2014-11)
 - Patent agent:
 - Represented person in Colorado matter involving DUI charges.
 - Attempted to claim he was “attorney in fact” for driver.
 - Sued City of Colorado Springs in civil court on behalf of driver.
 - Appeared on behalf of driver in license revocation hearing.
 - Excluded from practice before the USPTO.

Unauthorized Practice of Law (cont.)

- ***In re Dao*** (USPTO D2015-23)
 - Attorney:
 - Became administratively suspended in Wisconsin (only state jurisdiction where he was licensed to practice law).
 - Knowingly continued to represent clients in TM matters after administrative suspension.
 - Failed to withdraw from TM cases after administrative suspension.
 - This conduct violated 37 C.F.R. § 11.505 (unauthorized practice of law).
 - For this and other conduct, suspended from practice before the USPTO for 6 months.

Improper *ex parte* Contact

- ***In re Caracappa*** (USPTO D2014-02).
 - Registered patent attorney was counsel of record in *inter partes* review proceeding.
 - Co-counsel sent an email to PTAB email address, naming a specific judge as the addressee.
 - The email explained a mathematical error in a paper filed by the opposing side.
 - Opposing counsel was not copied on the email.
 - Attorney authorized and had full knowledge of the email, including the fact that opposing counsel was not copied.
 - PTAB held that the email was an improper *ex parte* communication.
- Received public reprimand.

Duty to Supervise

- ***In re Druce*** (USPTO D2014-13)
 - Non-lawyer assistant fabricated filings and office communications
 - Signed patent attorney's signature to filings.
 - Failure to adequately supervise non-lawyer assistant.
- 2-year stayed suspension and 2-year probation upon reinstatement

Inequitable Conduct

- ***In re Tendler*** (USPTO D2013-17)

- Patent attorney filed Rule 131 declaration re: reduction to practice with USPTO.
- Soon after, attorney learned that the inventor did not review the declaration and that declaration contained inaccurate information.
- Respondent did not advise the Office in writing of the inaccurate information and did not fully correct the record in writing.
- District court held resultant patent unenforceable due to inequitable conduct, in part, because of false declaration. *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. 2012). Federal Circuit upheld.
 - 1st requirement is to expressly advise PTO of existence of misrepresentation, stating specifically where it resides.
 - 2nd requirement is that PTO be advised of misrepresented facts, making it clear that further examination may be required if PTO action may be based on the misrepresentation.
 - It does not suffice to merely supply the Office with accurate facts without calling attention to the misrepresentation.
- 4 year suspension (eligible for reinstatement after 2 years).

Decisions Imposing Public Discipline Available In FOIA Reading Room

- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
 - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
 - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).
- ▶ Official Gazette for Patents
 - http://www.uspto.gov/news/og/patent_og/index.jsp Select a published issue from the list, and click on the "Notices" link in the menu on the left side of the web page.

Terminating Representation

- Terry, a registered practitioner, takes over prosecution of a U.S. utility patent application for Company A, who changes the correspondence address to Terry's business address.
- A power of attorney is not filed in the application, but Terry files an Office Action response in a representative capacity pursuant to 37 CFR § 1.34.
- Terry then learns that she must withdraw from representation of Company A due to a conflict with another firm client. Terry is unable to change the correspondence address for the application under 37 C.F.R. § 1.33 because she does not hold power of attorney.
- She requests that Company A change the correspondence address, but Company A is slow to do so.
- The USPTO continues to send correspondence regarding the application to Terry.

Terminating Representation

- Registered practitioner Trent represents Maria in a U.S. utility application that recently received a Notice of Allowance.
- Trent reported the Notice of Allowance to Maria and requested pre-payment of the issue fee.
- Maria has not yet provided pre-payment of the issue fee to Trent. The payment date for the issue fee is approaching.

Terminating Representation

- Gail is a patent attorney who works as an associate for Firm W. Gail handles all of the patent prosecution matters for Firm W's clients and is the only practitioner associated with Firm W's USPTO customer number.
- Gail accepts an in-house position at Technology Incorporated and gives 2 weeks notice to Firm W. Firm W wants to continue to represent its patent clients.
- Resources with additional information on withdrawal:
 - 37 C.F.R. § 11.116.
 - MPEP 402.06.
 - USPTO form PTO/AIA/83 (04-13).

Contacting OED

For Informal Inquiries, Contact OED at
571-272-4097

THANK YOU



Post Grant Activity

PatentQuality@uspto.gov

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PATENT AND TRADEMARK OFFICE



Patent Quality and Post Grant Activities

Russell Slifer

Deputy Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

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Effect of Patent Quality in the U.S. Courts

Judge Ray Chen

U.S. Court of Appeals for the Federal Circuit

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Panel Discussion: Patent Quality Impact in U.S. Courts

- **Honorable Ray Chen**, *Circuit Judge CAFC*
- **Honorable Sheldon Jay Plager**, *Circuit Judge, CAFC*
- **Honorable Paul Michel**, *Retired Chief Judge, CAFC*
- **Paul Grewal**, *former US Magistrate, California, North District; Vice President and Deputy General Counsel Facebook*

Moderator: Charles Molster, *Law Offices of Charles B. Molster, III PLLC*

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International and Stakeholder Cooperation

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Panel Discussion: International Quality Efforts

- **Mark Powell**, *Deputy Commissioner for International Patent Cooperation*
- **Dr. Stuart Graham**, *Associate Professor, Scheller College of Business, Georgia Institute of Technology*
- **Roger Gobrogge**, *IP Counsel, ITIP ProFiciency, LLC*
- **Alfred Spigarelli**, *Principal Director of Quality Management, European Patent Office*

Moderator: Colleen Chien, *Professor, Santa Clara Law School*

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Panel Discussion:

What can Applicants do to Enhance Patent Quality?

- **Russ Slifer**, *Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office*
- **Bob Armitage**, *Consultant, IP Strategy & Policy*
- **Mark Vallone**, *Lead IP Counsel, IBM*
- **Prof. Saurabh Vishnubhakat**, *Associate Professor of Law and Engineering, Texas A&M University*
- **Vera Raineri**, *Attorney, Electronic Frontier Foundation*

Moderator: Arti K. Rai, *Elvin R. Latty Professor of Law, Duke Law School*

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Next Steps of Enhancing Patent Quality & Closing Remarks

Drew Hirshfeld

Commissioner for Patents

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