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Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Via email to: TopicSubmissionForCaseStudies@uspto.gov

Attn: Michael Cygan, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy

Suggested Case Study topics for the U.S. Patent and Trademark Office’s new pilot program as part of its Enhanced Patent Quality Initiative

These topics are presented on behalf of the Section of Intellectual Property Law of the American Bar Association (“ABA”). The views have not been approved by the House of Delegates or the Board of Governors of the ABA and, accordingly, should not be construed as representing the position of the ABA.

**Topic #1**

**Title:** “The search and its impact on examination and patent quality”

**Proposal for study:** A quality search results in prosecution focused on the invention, shorter timeline to issuance and higher quality issued patents.

**Explanation:** Initial searches that do not turn up the most relevant references often result in more relevant references being applied after one or more office actions. New grounds of rejection relying on the later found references delay prosecution, increase cost to applicants necessitating new amendments or RCE’s. Measuring the number of second or later office actions containing new grounds of rejection may provide insight into the quality of original searches. The results of measurements of RCE filings may also be indicators. Any correlation between search quality and extended prosecution may identify process changes for search procedures resulting in reduced timelines, decreased costs to applicants, and improved quality of issued claims.
**Topic #2**

Title: “Applicant entitlement to face-to-face interviews upon request”

Proposal for Study: “If you’re an applicant, the ability to sit down and look your patent examiner in the eye, to point to diagrams, to explain your invention, makes a huge difference in terms of customer satisfaction but also the quality and the speed with which you get the patent” – Michelle Lee

Explanation: Undersecretary of Commerce for Intellectual Property Michelle Lee has expressed a hope that hiring more patent officers and stationing them at outposts across the country will speed up the patent prosecution process. For example, the Dallas office will employ 80 patent examiners, meaning for the first time, Applicants in the region will not have to travel to the beltway to meet face-to-face with their assigned examiners. And yet, Applicants have found examiners consistently resist face-to-face interviews, standing behind alleged union-based rules that do not take into account Applicants’ need for those interviews. Examiners often insist on telephone or videoconference interviews, which almost always result in frustrating technological failures. Applicants have been advised to request a face-to-face “host” (a Primary or a Supervisory Examiner), but even those requests are met with resistance and lack of preparation. The issue has been raised at USPTO Quality summits and webinars for years, but the problem has only worsened over time. Because the Undersecretary includes the availability of face-to-face interviews as a justification for opening the satellite offices, the USPTO should assign a high priority to facilitating those interviews. A study should determine how examiner resistance to face-to-face interviews affects customer relations with the USPTO, efficiency of prosecution, and ultimately patent quality. The study should also consider any correlation between face-to-face interviewing and the geographic location of an office. Such a study could lead to improved procedures for encouraging, or making mandatory, face-to-face interviews when they are requested. Appropriate consideration should also be given to the financial and work flow implications of implementing such procedures.

**Topic #3**

Title: “The impact of 35 U.S.C. § 101 on examination and patent quality”


Explanation: There is some inconsistency regarding how rejections are made for failing to meet the requirements of 35 U.S.C. § 101. Many rejections do not address the claims as a whole. In addition, many rejections appear to improperly incorporate by clear implication prior art grounds of rejection as part of the utility (§ 101) assessment. Looking at applications in the bio/pharma art units that include utility rejections may identify patterns and allow for training to make rejections more consistent and focused on lack of utility.
Topic #4

Title: “Training of and proper application by Examiners on Section 112(a) rejections.”

Proposal for study: A quality review of the proper use, or in most cases, the lack of use, of Section 112(a) rejections, especially in view of recent Federal Circuit case-law.

Explanation: A quick survey of recent allowed cases in the biotech field has identified a large number of granted patents that have either misapplied or not applied clear precedent from the Federal Circuit regarding a proper written description. For example, the representative number of species test as recently described in AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc., 759 F.3d 1285, 1300, 111 U.S.P.Q.2d 1780, 1790 (Fed. Cir. 2014) and in Section 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. § 112(a) or Pre-AIA 35 U.S.C. § 112, para. 1, “Written Description” Requirement [R-07.2015] does not seem to be considered in recently allowed biotech cases. A quality review of recently granted cases may highlight the need to develop and implement proper training materials for the Examiners to continue to improve their skills, which will lead to improved quality of granted US patents.

Very truly yours,

Theodore H. Davis Jr.
Section Chair
American Bar Association
Section of Intellectual Property Law