

From: Keri Moss [email redacted]

Sent: Monday, May 04, 2015 5:18 PM

To: WorldClassPatentQuality

Subject: Docket No.: PTO-P-2014-0043

Good Afternoon:

Please see the attached comment to Docket No. PTO-P-2014-0043 from the American Chemical Society's Committee on Patents and Related Matters.

Best Regards,

Keri

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COMMITTEE ON PATENTS
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May 4, 2015

Re: Docket No.: PTO-P-2014-0043

The American Chemical Society (ACS)'s Committee on Patents and Related Matters appreciates this opportunity to provide comments on the United States Patent and Trademark Office's Request for Comments on Enhancing Patent Quality.

A. USPTO PROPOSALS

The ACS believes that the USPTO has identified a number of positive proposals that may enhance patent quality, specifically:

(1) Proposal 1 under Pillar 1, where an applicant can request the USPTO to conduct a review of a patent application by the Office of Patent Quality Assurance. The ACS supports this Proposal in that it would allow an applicant to bring issues to the attention of OPQA as they arise during the examination process. This may allow OPQA to identify trends in prosecution and perhaps modify or improve upon the Examiner training to improve the examination process. Presently, if an applicant is not happy with the examination of an application, he or she can contact the supervisor or the ombudsman. Since the applicant finds such efforts bring very little remedy, adding a structure for quality oversight is a step in a positive direction towards cutting down on repeated examination errors.

(2) Proposal 5 under Pillar 3, where an applicant who has received a first non-final office action may be able to pay for an additional response to be entered before a final rejection is issued, allowing for two non-final rejections. This could be coupled with an Examiner interview, leading to expedited and compact prosecution. The ACS supports this Proposal because it may lead to better resolution without the need for appeal or prosecution through use of Requests for Continued Examination (RCE), both of which can be quite costly for applicants. Even if an appeal or an RCE becomes necessary, this Proposal may allow the applicant to potentially have more time with the Examiner to reduce the issues for appeal or RCE.

(3) Proposal 6 under Pillar 3, which provides for in-person Examiner interview capability in satellite offices (Detroit and Denver) as well as in certain public libraries (Boston, Chicago, and Los Angeles). The applicant would be expected to pay an additional fee for this service. The ACS supports this Proposal because in-person interviews often are successful in advancing prosecution, and this would ensure the availability of in-person interviews for an increased number of applicants.

B. REMAINING CHALLENGES

While the above ideas would likely advance some of the goals of this Enhanced Patent Quality initiative, the USPTO's efforts do not address some of the persistent problems with current examination of patent applications, particularly in the chemical arts. Some of these problems are discussed below.

(1) **Composition, Method, and Process Claims:** Sequence can often be critical to the chemical mechanism and resulting composition being claimed. For example, the chemical properties or intermediates change during the sequence whereby two different sequences would have two different results. Examiners sometimes ignore the sequence aspects of a claim or assert general obviousness by combining several references that have no recognition or suggestion that a sequence would be important. Similarly, many Examiners appear to ignore portions of a prior art reference that make clear the disclosed process would actually be incompatible with the results of this claimed process, portions that obviate the obviousness rejection. For example, while a prior art document may show a general flow diagram that describes very general steps, the disclosure may make clear additional details concerning product and/or reactant streams that appear to be ignored despite the fact that this "ignored" disclosure results in different products or pathways from what the steps recited in the claim achieve. Avoiding these errors in examination would move prosecution forward faster in the chemical arts.

(2) **Understanding the Art:** With surprising frequency, an obviousness rejection results because the Examiner does not fully appreciate the chemistry that is occurring. In such instances, extension of the prosecution needlessly adds prosecution time for the Examiner and increases cost to the applicant. In addition, in setting forth prior art rejections, some Examiners appear to rely mainly on keyword searches of the prior art and the claimed invention. This is especially true in certain chemical inventions that may be rejected for obviousness. A complete review of the prior art and the claimed invention could avoid many obviousness rejections.

(3) **Species Election Requirement:** Species elections are particularly problematic in chemical and biotechnology inventions. Examiners issue species election requirements routinely, often with more than one species (including even as many as 12 species) to be elected, with the result that the patent that eventually issues contains narrow claims. This requirement also unduly increases the burden on patent applicants in the chemical arts, particularly start-up companies, by having to file and prosecute several patent applications instead of having just one application.

(4) **New Office Action after "patent mortgaging":** One of the items the April 13, 2015 Commerce Department Office of the Inspector General Report on Patent Quality discusses is "patent mortgaging." This refers to the Examiners' practice of submitting incomplete office actions in order to secure credit. Although quality review catches some of these actions, most of them escape detection. When undetected, applicants receive incomplete office actions, and then carry the time and cost burden of extended prosecution. Applicants fully respond to the mortgaged office action with the expectation that they would receive a notice of allowance, only to receive a new office action with new issues and new prior art and removal of the issues in the previous office action. Applicants now respond to the new office action by addressing the new issues, only to receive yet another office action with additional new issues. Most of this seemingly endless loop of office actions and responses, and the associated cost and waste of time could have been avoided had the Examiner conducted his search thoroughly and completely the first time around. This patent mortgaging is particularly common in chemical and pharmaceutical cases where the invention is defined in the form of multiple Markush groups (such as, for example, compounds defined by substituents R1, R2, R3, R4, etc.). It appears that

some Examiners search for prior art only on R1 in the first office action, then on R2 in the second office action, and so on, instead of searching all of the substituents at the same time.

(5) General comments relating to efficiency in the patent prosecution process and excellence in USPTO work product:

(a) Claim Construction: Although claim terms are to be construed during examination under the “broadest reasonable interpretation” standard, often Examiners interpret claim terms under their own broadest interpretation standard, lacking reasonableness. This practice needlessly prolongs patent prosecution and produces the possibility that the claims granted are too narrow.

(b) Accountability for MPEP-compliance: Some Examiners practice counter to established patent law practice in setting forth rejections under the various sections of the patent statute. Sometimes, the problem is so extreme, it is necessary to call the Examiner’s supervisor to have the issue with the Examiner properly addressed. Most often, those who do not subscribe to MPEP practice are Primary Examiners who operate with infrequent review of their work. The USPTO should establish supervision of all Examiners, including Primary Examiners. It is possible that giving Examiners more instruction on how to examine patent applications in the chemical and pharmaceutical context may lead to more consistency in the examination. More technical instruction may also reduce the number of obviousness rejections raised and therefore lead to reduced prosecution times and cost. Another consideration may be to increase the amount of time that an Examiner has to examine each application.

(b) Examiner Data: The USPTO has a large amount of data on Examiner performance, and this data could be used to track examiners to ensure fairness and quality of examination. Data on each Examiner’s allowance rate, allowance rate on RCE, appeals, and examiner interviews can provide the USPTO a check on examination quality.

(c) Amendments to the Claims: There are instances where the Examiner fails to address new claim limitations provided in a response to an office action, whereas the new office action is simply a copy/paste of the prior action. While there may be some acknowledgement of arguments or amendments made, there is no actual substantive analysis, response, or rejection of the argument/amendment.

(4) Misclassified applications: The Examiner’s background has a huge impact on the Examiner’s ability to understand and appreciate the chemistry that is the inventive step. A problem occurs when an application’s novelty is chemical but it is misclassified and sent to a different technology center. This also lengthens the prosecution time and cost to the applicant, at no fault to the applicant. Applicants provide a classification, but this guidance is not always adhered to.

The ACS Committee on Patents and Related Matters welcomes the opportunity to discuss with the USPTO any of the above comments further and work with you to address them.

Respectfully,

A handwritten signature in black ink, appearing to read "Keri Moss". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

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