

From: Jim Brookshire [email redacted]
Sent: Wednesday, May 20, 2015 9:33 PM
To: WorldClassPatentQuality
Cc: brookshire1@fedcirbar.org
Subject: RE: Please accept these comments on the Enhanced Patent Quality Initiative from the

Slight revision. Thanks so much for your patience. Jim Brookshire

From: Jim Brookshire [[email redacted](#)]
Sent: Wednesday, May 20, 2015 9:23 PM
To: [WorldClassPatentQuality\[at\]uspto.gov](mailto:WorldClassPatentQuality[at]uspto.gov)
Cc: [[email redacted](#)]
Subject: Please accept these comments on the Enhanced Patent Quality Initiative from the

Federal Circuit Bar Association. If more information would be helpful, please contact James E. Brookshire, 202 558 2421 or [\[email redacted\]](#).

Thank you in advance.

Jim Brookshire

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May 20, 2015

VIA EMAIL

Michelle K. Lee

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

P.O. Box 1450

Alexandria, VA 22313-1450

Re: Request for Comments on the Enhanced Patent Quality
Initiative (EPQI)

Dear Director Lee:

The Federal Circuit Bar Association ("FCBA") appreciates the opportunity to comment on the USPTO's "Enhanced Patent Quality Initiative" ("EPQI"), which focuses on improving patent quality by building confidence in the U.S. patent system, making the patent system understandable and usable by all inventors, and ensuring fair and professional treatment of all customers during the patent application process.¹

The FCBA, a national bar association, unites the different interests drawn before the Court of Appeals for the Federal Circuit (CAFC) and the tribunals which it reviews. Congress conferred on the Federal Circuit national appellate jurisdiction in a number of complex litigation areas, including matters involving intellectual property. The FCBA seeks to serve the administration of justice in the CAFC by maintaining and raising the standards of proficiency, integrity, and ethics in the practice of law before the Federal Circuit. In the context of this letter, we speak on behalf of our private sector members. Given their own roles, government members have not participated in the preparation or submission of this letter.

We commend the USPTO's continued efforts towards enhancing patent quality through the targeting of the "patent quality pillars." Excellence in USPTO work products (e.g., issued patents, Office Actions, and other official communications) will lead to high quality patents that provide certainty and clarity of rights, fuel

¹ See Request for Comments on Enhancing Patent Quality, by Michelle K. Lee Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, 37 CFR Part 1, Docket No.: PTO-P-2014-0043, published February 5, 2015, pp. 6475-6481.

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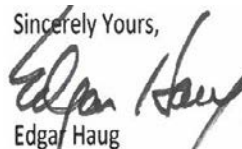
innovation, and likely reduce needless litigation. Training modules, which focus on evaluating functional claiming and improving the clarity of the examination record, new legislation, and developments in case law, will be a key component of the patent quality initiative.

Several of the proposals would require additional effort by Examiners. For example, supplemental statements of reasons for allowability make additional work for Examiners, and are typically excepted to by Applicants. These exchanges make the record less, not more, clear. We submit that far greater improvement can be achieved through additional training and improving the quality and thoroughness of searching. The proposals the Office makes in this regard for preliminary electronic searching are favorable and the Office should give continuing attention to improving the quality of Examiner training and devote greater resources to effective and thorough searching to ensure that all relevant art is made of record during examination. Proposals such as the glossary program and enhanced search tools are favorable developments in this regard.

With respect to the clarity of the record, we encourage the Office to make the construction it is applying of record, at least to the extent material to the references being applied, and to record and document all communications with Applicants. A detailed and thorough construction need not be made of record and would unduly burden examination. Nonetheless, making clear the construction of the material terms of the claims would improve clarity. Similarly, the technology available to the Office enables easy and simple recording and memorialization of all communications with the Examiner. This would also enhance the clarity of the record. A patent is a grant of a public right and private, off-the-record conversations impair the public's access to information.

We emphasize the importance of an unambiguous and accurate examination record.³ Clear articulation of the two-part subject matter eligibility analysis for both favorable and unfavorable determinations would foster a greater understanding and appreciation of what constitutes a measure for patent eligible inventions. Prospectively, a clear record on the subject matter eligibility analysis would foster a stakeholder's ability to discern those research and development products and technologies that are likely to be patent eligible. Greater clarity would also allow stakeholders to challenge more selectively subject matter eligibility at the PTAB and ultimately the CAFC.

In closing, the FCBA recommends that the USPTO encourage the examining corps to articulate clearly its findings, favorable and unfavorable. Record building will enhance USPTO customer confidence in the Nation's patent system, foster reduction of issues in post-grant proceedings or appeals, and reduce the impact that a growing number of PTAB matters are having on CAFC caseload. If we can provide further information or assistance, please contact James E. Brookshire, Executive Director, [\[email redacted\]](#).

Sincerely Yours,

Edgar Haug
President-Elect

"Make a Difference"