

From: Vanessa Pierce Rollins [email redacted]
Sent: Wednesday, May 06, 2015 4:10 PM
To: WorldClassPatentQuality
Cc: [redacted]
Subject: IPO Comment on Enhancing Patent Quality

Please accept the attached letter and report from the Intellectual Property Owners Association in response to the request for comments on Enhancing Patent Quality.

All my best,
Vanessa

Vanessa Pierce Rollins | Senior IP Law and Policy Counsel
Licensed in California, Registered Patent Attorney

Intellectual Property Owners Association
1501 M St. NW, Suite 1150 | Washington, DC 20005
t. 202-507-4503 c. 202-834-0833
[email redacted]





May 6, 2015

Hon. Michelle Lee
Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Michael Cygan, Senior Legal Advisor, Office of Patent Legal Administration,
Office of the Deputy Commissioner for Patent Examination Policy

Via email: WorldClassPatentQuality[at]uspto.gov

Re: Comments on Enhancing Patent Quality

Dear Director Lee:

Intellectual Property Owners Association (IPO) submits the attached report in response to the USPTO’s Request for Comments on Enhancing Patent Quality, 80 Fed. Reg. 6475 (Feb. 5, 2015). Our report comments on the six proposals set forth in the Federal Register notice.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association, either through their companies or through other classes of membership.

IPO appreciates the USPTO’s call for comments to enhance patent quality. As noted in the Federal Register notice, the innovation that is fostered by the patent system is a key driver of economic growth and job creation. Effectively promoting such innovation requires that patents fully comply with all statutory requirements and that the patent examination process must advance quickly, transparently, and accurately. We believe the USPTO and stakeholders should develop a comprehensive definition for patent quality. Changes to the existing compact prosecution model and manner in which patent examiners’ productivity and work product are measured may be needed.

We realize additional ideas for improving quality will emerge. You mentioned in a speech on April 29 that the USPTO might even recommend legislative changes. We would welcome any further dialogue or opportunity to provide additional information to assist your efforts on this matter.

Sincerely,

Handwritten signature of Herbert C. Wamsley

Herbert C. Wamsley
Executive Director

President
Phillip S. Johnson
Johnson & Johnson
Vice President
Carl B. Horton
General Electric Co.

Treasurer
Kevin H. Rhodes
3M Innovative Properties Co.

Directors
Steven Arnold
Micron Technology, Inc.
Edward Blocker
Koninklijke Philips N.V.
Tina M. Chappell
Intel Corp.
William J. Coughlin
Ford Global Technologies LLC
Robert DeBerardine
Sanofi-Aventis
Anthony DiBartolomeo
SAP AG
Daniel Enebo
Cargill, Inc.
Barbara A. Fisher
Lockheed Martin
Louis Foreman
Eventys
Scott M. Frank
AT&T
David A. Frey
Rolls-Royce Corp.
Darryl P. Frickey
Dow Chemical Co.
Krish Gupta
EMC Corporation
Henry Hadad
Bristol-Myers Squibb Co.
Michael Jaro
Medtronic, Inc.
Charles M. Kinzig
GlaxoSmithKline
David J. Koris
Shell International B.V.
William Krovatin
Merck & Co., Inc.
Allen Lo
Google Inc.
Thomas P. McBride
Monsanto Co.
Steven W. Miller
Procter & Gamble Co.
Micky Minhas
Microsoft Corp.
Douglas K. Norman
Eli Lilly and Co.
Elizabeth A. O'Brien
Covidien
Salvatore Pace
Praxair, Inc.
Richard F. Phillips
Exxon Mobil Corp.
Dana Rao
Adobe Systems Inc.
Curtis Rose
Hewlett-Packard Co.
Matthew Sarboraria
Oracle Corp.
Manny Schecter
IBM, Corp.
Steven Shapiro
Pitney Bowes Inc.
Dennis C. Skarvan
Caterpillar Inc.
Daniel J. Staudt
Siemens Corp.
Brian K. Stierwalt
ConocoPhillips
Thierry Sueur
Air Liquide
Brian R. Suffredini
United Technologies, Corp.
James J. Trussell
BP America, Inc.
Roy Waldron
Pfizer, Inc.
Michael Walker
DuPont
BJ Watrous
Apple Inc.
Stuart Watt
Amgen, Inc.
Charlotte Whitaker
Motorola Solutions, Inc.
Jon D. Wood
Bridgestone Americas
Holding Co.
Mike Young
Roche Inc.
General Counsel
Michael D. Nolan
Milbank Tweed
Executive Director
Herbert C. Wamsley

IPO REPORT ON THE SIX USPTO PROPOSALS FOR ENHANCING PATENT QUALITY

Proposal 1: Applicant Requests for Prosecution Review of Selected Applications

Two mechanisms for an applicant to request Office of Patent Quality Assurance (OPQA) review of an examination quality issue could be implemented under Proposal 1.

1. Informal Mechanism: At any time during prosecution, an applicant would be able to request OPQA review of a particular application by contacting an appropriate ombudsman who would have discretion as to whether to forward the request to OPQA for their independent review or to resolve the quality issue raised by applicant in some other manner such as by discussion with the examiner, SPE, or Group Director.
2. Formal Mechanism: At any time after receiving a third office action (or after a first office action in an RCE), an applicant would be able to request review of a particular application by submitting, directly to OPQA, a petition identifying an issue and requesting independent review.

The following would apply to both the Informal and Formal Mechanisms:

- OPQA review would be available for both substantive and procedural issues;
- Only applicants would be permitted to request OPQA review – requests from third parties would not be accepted;
- Applicants would be required to identify a particular issue or issues for OPQA review, but OPQA would be free to address any other issues; and
- OPQA resolution of the issue or issues would be timely and binding on the examiner.

Proposal 1 would complement other existing applicant-initiated options for resolving examination quality issues, including requests for an SPE, Group Director, tQAS, work group lead and/or USPTO subject matter expert to be present at an examiner interview; requests via the Patents Ombudsman Program; petitions and other written requests for relief; requests for pre-appeal conferences; and PTAB appeal. As implemented by the Informal and Formal Mechanisms proposed above, Proposal 1 would fill a gap in these existing options by enhancing internal oversight of quality by OPQA. With the exception of PTAB appeals, the various Technical Centers are primarily responsible for responding to applicant's attempts to resolve issues using the existing options.¹

The Informal and Formal Mechanisms are consistent with existing USPTO policy. The ombudsmen (along with tQAS, SPEs and Group Directors) are currently permitted to request that OPQA independently review a particular application. Implementation of the proposed Informal Mechanism would simply involve appropriate training of ombudsmen and recognition of the option by applicants. As proposed, the Formal Mechanism would not be available to applicants until after receipt of a third office action (or first office action in an RCE). Applicants would be

¹ Although the Office of Petitions is responsible for deciding various petitions (*see* MPEP § 1000.02(b)), many are handled within the Technical Centers (*see* MPEP § 1000.02(c)), along with the appeal conference stage of PTAB appeals.

incentivized to first pursue other options for resolving issues (although they would not be required to do so). Independent OPQA review at this stage is also consistent with the spirit of MPEP § 707.02 (“The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent office action with a view to finally concluding its prosecution.”).

Proposal 2: Automated Pre-Examination Search

An automated pre-examination search tool that is open to the public, covers all categories of prior art, provides a concise list of relevant prior art, and utilizes modern search techniques would be ideal. Identification of prior art is a critical USPTO function that is vital to quality examination and ensuring patents are issued with appropriate scope. Early identification of relevant prior art references will improve patent quality and assist with compact prosecution.

Expansion of the automated pre-examination search program to conduct searches in all applications should be implemented as a standard procedure. Presently, the USPTO’s Scientific and Technical Information Center (STIC) performs an automated pre-examination search only upon an examiner’s request. Such searches are requested in only about 11% of cases.² Expansion of the program to all applications will improve prosecution by informing examiners prior to their manual searches and by providing applicants an opportunity to revise claim scope before examination. For this latter advantage, the pre-examination search results should be made available to the applicant upon completion, even before the first office action is issued.

The search tool should be made available to the public to identify relevant prior art before the filing of a provisional or non-provisional application. Currently, many applicants are unlikely to have the expertise necessary to conduct a quality search and are often unable to bear the expense of private, professional searches. Opening the tool to the public will allow applicants to craft initial claims that more accurately reflect the scope to which the applicants are entitled. Moreover, if applicant utilizes the search tool within a predefined time frame of filing and provides the results to the USPTO with the filing, a fee discount could be provided for saving the USPTO from having to do the same post filing.

Once an application is filed, and if the applicant did not conduct and provide automated search reports to the USPTO, an automated search should occur as early as possible and be provided to the application upon completion, with an updated search occurring when the examiner chooses to begin examination. Providing early search results to applicants, such as within the first three months after filing, will provide applicants sufficient opportunity to review the search results and present preliminary amendments or abandon applications, if appropriate. The later search results will ensure the examiner has the most up-to-date information available prior to beginning examination.

Examiners should be obligated to consider the automated search results and be required to sign off on the search results in a manner similar to current information disclosure practice. This will

² Approximately 58,000 Patent Linguistic Utility Service (PLUS) automated pre-examination searches were conducted in 2014 compared to approximately 531,000 applications filed in 2012. See USPTO Fiscal Year 2014 Performance & Accountability Report, p. 168 tbl. 28, <http://www.uspto.gov/about/stratplan/ar/USPTOFY2014PAR.pdf>.

avoid applicants unnecessarily having to submit information disclosure statements with the automated search results. Additionally, there should be no presumption that applicants have considered the automated search results. This is in accordance with the current situation regarding prior art made of record but not relied upon in office actions.

The search tool should search as many sources of prior art as possible. For example, in addition to U.S. patents and patent publications, the tool should search foreign patent documents and non-patent literature. Improving the scope of searches will improve the quality of prior art results applied during examination. Furthermore, the use of modern search algorithms should be used in the automated search. For example, the search tool should employ contextual searching and learn context by understanding multiple words in a section of the application. Moreover, additional features such as stemming and natural language searching should be employed for improved accuracy.

The search should include a concise set of search results with highlighting of particularly relevant portions of the results. Providing a larger number of results may result in reduced attention being paid to any particular reference, especially if many of the references appear to lack significant relevance. In contrast, a concise list of references (e.g., 5-15 documents) will be more likely to be given appropriate consideration by examiners and applicants. The list of search results should also be provided using a hit-based ranking that treats hits differently for different document types. For example, overall ranking of relevant documents may treat hits within a patent document differently than hits within a non-patent literature document.

Proposal 3: Clarity of the Record

A. Improved clarity of the record and reduced claim ambiguity.

More could be done to clarify the record and reduce claim ambiguity. Examiners should ensure that the scope of claim terms and phrases are reasonably certain when considered in view of the specification and prosecution history by issuing indefiniteness rejections under Patent Act section 112 where required. Claim elements that meet the definiteness standard should not, by definition, need clarification. Rather than introducing a specific examiner claim construction task into the prosecution process, appropriate section 112 rejections can address ambiguities. If claim scope is indefinite or ambiguous, the examiner should be encouraged to issue a 112 rejection explaining the multiple potential interpretations, and requiring the applicant to amend and/or clarify the claim term.

The USPTO should not require explicit construction of most or all claim terms. In many instances, it is conceivable that an applicant would not disagree with the examiner's interpretation of much of the claim language. Requiring a claim interpretation to be expressly stated on the record for each claim term would pose an extra burden on the examiner. For those claim elements for which the applicant disagrees with the examiner's expressly stated interpretation, an additional burden would be imposed on the applicant to provide a counter interpretation. Neither the Office's nor the applicant's interest is best served in bogging down prosecution with unnecessary exchanges as to a particular interpretation of those elements not central to patentability over the art of record.

In a common examination scenario, a first office action simply applies teachings from prior art to the various claim elements. No claim interpretation is actually expressed on the record, but instead is only implicit in the application of the prior art to the claim elements. Often, an examiner will issue a first action rejecting a claim based on teachings of the prior art, causing the applicant to file a response disagreeing with the particular application of the cited art. In both the office action and applicant's response, there is an implicit claim interpretation offered on each side. This interpretation is typically not made explicit on the record. Where the examiner continues to disagree with the applicant's response, it may be beneficial for the examiner to provide an explicit claim interpretation with respect to the element or terms in dispute. This would not only bring clarity to the record, but would also advance compact prosecution by better articulating for the applicant the point(s) of disagreement.

On the other hand, it is unclear as to how an applicant could challenge an examiner's interpretation (whether by appeal or petition). Statutorily, an applicant may only appeal second or subsequent rejections of claims. Applicants should have the right to appeal any claim interpretation about which they disagree. Accordingly, if the examiner presents any explicit claim interpretation, it should be presented only in the context of a second, or subsequent, rejection of a claim. Explicit claim interpretations should not be presented in an office action section separate from a rejection, in notices of allowances, or in any other non-appealable manner.

The presumption of validity of issued patents is very important, and the public should be adequately informed as to how the examiner interpreted the claims in granting a patent to allow this presumption to take hold. Reducing claim ambiguity at the patent prosecution stage is also important, since ambiguity can breed future disputes post-issuance. This report should not be construed as either a blanket approach of providing an express interpretation in the record for each and every word in a claim, or limiting claim interpretation to just a single point-of-novelty element. Examiners should make it clear whenever a decision has been made as to what a specific term or phrase means.

In the event an examiner finds that the applicant is arguing limitations from the specification not recited in the claims, the examiner should indicate on the record whether the rejection at issue would be overcome if the applicant were to amend the claims to expressly recite the features from the specification. In addition to promoting clarity of the record, this would also foster a more efficient examination. Under current practice, an applicant in this situation often must decide whether to amend the claims without knowing whether the amendment will advance prosecution. Examiners should be encouraged to inform applicants about amendments that could result in allowance.

B. Further detail in the recordation of interviews, pre-appeal conference decisions, and appeal conferences.

Additional details with respect to pre-appeal and appeal conferences may be helpful to applicants, in particular for those appeals and pre-appeals that are denied. More specific details for reasons why pre-appeal or appeal conferences were decided against the applicants' position would provide applicants with better information with respect to whether or not it may be possible to advance prosecution and, if so, whether claim amendments or specific evidence might be helpful.

Additionally, in the case where the pre-appeal or appeal panel agreed with applicants' position, it would also be helpful to understand which argument the panel agreed with so applicants can better formulate a prosecution strategy and ensure the examiner does not re-apply prior art with the same deficiency.

With regard to recording additional details on examiner interviews, more accurate written interview summaries on the record, including any reasons for a change in the examiner's position, would be helpful. On the other hand, including excessive details in a written interview summary may operate to limit the willingness of applicants and examiners to participate in interviews, and also perhaps limit the extent of the discussion undertaken during interviews. The recordation of interviews and including interview transcripts on the record would not be helpful. This could discourage applicants without strong oral advocacy skills from participating in interviews, over-formalize what is generally an informal discussion, and create a chilling effect on both applicants (including inventors) and examiners.

C. Do not provide a more detailed summary of the reasons for allowing a claim.

Once an application has been allowed, there is little benefit for providing further details in a statement of reasons for allowance, particularly for applications that have had exchanges of written correspondence on the record (e.g., one or more office actions and responses). At this stage, the record should already be clear with respect to the reason(s) for allowance. Additional statements for reasons for allowance provided by examiners will likely lead to additional responses from applicants, who may feel compelled to respond to an examiner's reasons for allowance in order to minimize potential estoppel issues. However, in the case of a first action allowance, some reasons for allowance may be necessary.

The reason(s) for allowance should be included somewhere in the record, even if not necessarily by way of a formal statement accompanying a notice of allowance. If an examiner issues an art-based rejection that is successfully rebutted by the applicant, it is acceptable for an examiner to be persuaded by applicant's argument and allow the case. Here, the applicant has presumably put the reason for allowance on the record. On the other hand, if the applicant's successful rebuttal was provided during an interview, then the applicant's argument should be summarized in the record. If an examiner issues a first action allowance, there should be an explanation of why the examiner found the claims patentable, such as an identification of what was believed to be the closest prior art and how it failed to suggest the claimed subject matter as a whole.

Proposal 4: Review of and Improvements to Quality Metrics.

The USPTO has crafted a quality composite metric that has been successful in helping achieve higher patent examination quality and improving USPTO practices. The USPTO should consider the following adjustments to the components used to determine the quality composite metric.

A. Suggestions to Further Improve the Quality Composite Metric

The quality composite metric currently measures seven components, which are weighted according to perceived reliability and importance.³ The seven components and weighted percentages are:

1. Quality of the action setting forth allowance or final rejection of the application (Final Disposition Compliance Rate - 20% of composite weight).
2. Quality of the actions taken during the course of examination (In-Process Compliance Rate - 15%).
3. Use of best search practices in the examiner's initial search for prior art (Pre-FAOM Search Review - 10%).
4. Use of best examination practices in the first action on the merits, (Complete FAOM Review - 10%).
5. Trends in compact and efficient examination as reflected in aggregate USPTO data (Quality Index Report - 20%).
6. Perceptions of applicants and practitioners as measured by surveys (External Quality Survey - 15%).
7. Perceptions of examiners as measured by surveys (Internal Quality Survey - 10%).⁴

The weight of the Complete FAOM Review component should be increased from 10% to 15%. A complete first action is an important factor for compact prosecution and the data indicate no improvement in this measure. The increased weight of the Complete FAOM Review component can be offset by reducing the weight of the Internal Quality Survey component from 10% to 5% because improvements in subjective examiner survey scores are less likely to result in improvements to patent prosecution.

An "Advisory Action Compliance" component should be added to the quality composite metric.⁵ Relative to other actions, advisory actions are more likely to be of poor quality and may result from an examiner's desire to push applicants to file an unnecessary RCE to meet production goals. Adding this component will serve the purpose of promoting compact prosecution.

As an alternative to adding an eighth component to the quality composite metric, the already existing Quality Index Report component could be adjusted to promote resolution of issues with after-final practice. The Quality Index Report is comprised of five factors: (1) actions per disposal; (2) RCEs of total disposals; (3) reopenings after-final; (4) non-FAOM non-final actions; and (5) restrictions after first action.⁶ Doubling the weight of the RCEs of total disposals factor (i.e., % disposals that are not RCEs) would increase the importance of this factor, and thus also promotes compact prosecution.

The Quality Index Report could be refined in other ways. Because non-first action restrictions are rare and not a significant impediment to compact prosecution, the restrictions after first action factor should be removed from the Quality Index Report. This would emphasize the

³ See http://www.uspto.gov/blog/director/entry/august_patents_dashboard_overview.

⁴ See *id.*

⁵ See http://www.uspto.gov/sites/default/files/patents/init_events/qual_comp_metric.pdf.

⁶ See *id.*

importance of the four other factors, which are more significant to assessing patent examination quality.

The USPTO should consider breaking out the Final Disposition Compliance Rate, In-Process Compliance Rate, and Complete FAOM Review components of the quality composite metric into (a) measure of rejections that should not have been made; and (b) measure of allowances that should not have been made. Currently, the USPTO combines both measures together, which allows these components to be improved by improving (b) without improving (a).

Finally, the USPTO could further improve quality and transparency by separately providing data regarding specific errors identified by OPQA. As part of determining the Final Disposition Compliance Rate, In-Process Compliance Rate, and Complete FAOM Review, OPQA reviews issued actions to identify various errors.⁷ Having OPQA separately identify the types of errors, as opposed to identifying a generally non-compliant action, could help target specific areas where improvement is needed. In addition to the errors that OPQA already searches for, OPQA should separately identify the following errors:

- Raising an indefiniteness rejection when the specification expressly defines the claim term; and
- Alleging that an applicant has not shown any criticality to a distinguishing feature when the specification includes comparative data on point.⁸

B. Measuring the Impact of Examiner Training

Revisions to the External Quality Survey and Internal Quality Survey would be helpful in measuring the impact of examiner training. For example, questions could be asked of both stakeholders and examiners to rate their assessment of each of the training sessions on examination quality. Although the External Quality Survey asks stakeholders for text comments on training sessions and the Internal Quality Survey asks examiners to generally rate their satisfaction with training, a more systematic way to assess the impact of training is warranted.

In particular, both the Internal and External Quality Surveys should note that a training session occurred on a specified date, and ask both stakeholders and examiners to gauge whether there has been no change, minor improvement, or major improvement in USPTO practice with regard to the training subject matter after the training session occurred. Asking stakeholders and examiners to individually score the impact of each training session on a numeric scale will better aid the USPTO's understanding of the direct impact of each training session.

Certain stakeholders may value individual components of the quality composite metric differently. Since the USPTO has made the components publicly available as both raw data in a spreadsheet and through the online Dashboard, the USPTO has taken proper action to address these concerns.⁹ The USPTO should continue to make the individual components of the quality composite metric publicly available, as well as any future measurements of the impact of examiner training.

⁷ *See id.*

⁸ http://www.uspto.gov/sites/default/files/patents/law/opqa_review_forms-table_format.pdf.

⁹ *See* <http://www.uspto.gov/dashboards/patents/main.dashxml>.

Proposal 5: Review of the Current Compact Prosecution Model and the Effect on Quality

The efficiency of the current compact prosecution model could be enhanced by eliminating current “final” rejection practice. Final rejections insert an artificial and unnecessary pause into the prosecution flow for approximately 25% of applications that do not reach final disposition (allowance or abandonment) within two office actions. Final disposition would be achieved more efficiently by continuing the prosecution flow for these applications. Elimination or curtailment of final rejection would provide the following benefits:

- Eliminate the cost and uncertainty associated with unproductive after-final exchanges for both the USPTO and applicants;
- Eliminate the need for programs such as AFCP 2.0 and QPIDS; and
- Maintain prosecution momentum.

As long as progress is being made, it is inefficient to thwart that progress by inserting an artificial pause during prosecution. The complexity of the technology may be such that additional rounds of prosecution are helpful to achieving the level of understanding that is needed to achieve final disposition. The total number of office actions needed in such situations will be fewer if the examiner and applicant are permitted to continue to collaborate to reach the mutual understanding on which successful final disposition is based.

The USPTO could implement measures to address the underlying reasons in situations in which progress is not being made. Interviews are an excellent way to facilitate mutual understanding of issues and should be strongly encouraged. If the applicant and the examiner have reached an impasse, final disposition would be achieved more efficiently by mediation than by issuance of a final rejection. Such mediation in extended prosecution scenarios is envisioned by MPEP § 707.02 (“The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent office action with a view to finally concluding its prosecution.”).

There is potential for nonproductive extended prosecution scenarios, such as those in which the applicant is not vigorously pursuing final disposition. For example, the applicant may be unable to devote sufficient internal resources to prosecution for various reasons, such as a temporary lack of personnel or funding. For nonproductive extended prosecution scenarios that result from applicant behavior or circumstances, the applicant should be incentivized to pursue other options, such as filing a continuation or requesting suspension of prosecution under 37 CFR § 1.103. Likewise, for nonproductive extended prosecution that results from examiner behavior or circumstances, supervisory intervention could encourage appropriate final disposition in the spirit of MPEP § 707.02 (“Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered ‘special’ by the examiner.”).

Extending prosecution beyond two office actions will involve additional examination resources and supports appropriate cost recovery by the Office, such as by charging appropriate fees for additional office actions. Since the vast majority of all applications reach final disposition in four office actions or fewer, the fee for the first two additional office actions should be the same

as for filing an RCE. An escalating fee schedule for office actions after the first four could be implemented. Such a fee escalation would provide an appropriate disincentive for applicant-related nonproductive extended prosecution scenarios.

While certain cost recovery would be appropriate, applicants should not have to pay an additional office action fee for every interaction with the USPTO. For example, IDS filings do not require a new search and rarely result in an additional office action. After an examiner affirmance on appeal, an applicant should be permitted to place into independent form any objected to but allowable dependent claims without incurring the cost of additional office actions or filings.

With regard to the customer service pillar associated with this proposal, the USPTO should consider reengineering the petition system. Petition decisions by the USPTO play a key role in ensuring quality examination by providing feedback to both examiners and applicants regarding a wide variety of procedural matters. However, the current petition system falls short of the standards of transparency, consistency and timeliness that are practiced in other areas of the USPTO. For example, unlike petition decisions, PTAB decisions are available to the public on an organized and searchable part of the USPTO website, the PTAB designates some decisions as precedential or informative, and the consistency of the decisions is relatively high. An effort by the USPTO to bring petition decisions up to this standard would be an important aspect of ensuring quality examination.

Proposal 6: In-Person Interview Capability With All Examiners.

The USPTO should attempt to make in-person interviews possible in every application. As the state of the art, inventions, and legal issues are becoming more complicated, examiner interviews are becoming more essential to the patent examination process. At present, applications that happen to be assigned to examiners that work in Alexandria or the fully operational USPTO satellite offices can benefit from in-person interviews. Conversely, applications that happen to be assigned to hoteling examiners (or examiners with hoteling supervisors) only can have telephone or WebEx interviews. These limitations should be removed.

In-person interviews can be more helpful than telephone, WebEx, or even video interviews for a number of reasons. First, most people find it easier to communicate in person. This is especially true when the topic is complex or one or more of the participants is not a native English speaker. Under those circumstances, it can be essential to be able to read body language to make sure that people are understanding what is being said, and are (or are not) receptive to the explanations being made. Second, in-person interviews tend to foster cooperation among all involved, while it is easier to stay in “us versus them” roles during telephone and WebEx interviews. Third, in-person interviews increase productivity by reducing the total number of office actions.

The USPTO proposed that in-person interviews with remote examiners could be conducted at USPTO satellite offices, federal facilities, or at regional repository libraries. Logistically, remote interview sites should provide meeting places where confidential discussions can be held, such as in meeting rooms that can accommodate 4-8 people and be closed off from public access. Ideally, the meeting rooms also would have conference call, WebEx, and/or video conference capabilities to enable those who cannot travel to participate. Geographically, off-campus interview sites

should be a reasonable distance from a major airport, and accessible by public transportation from a major airport and other nearby metropolitan areas.

According to the USPTO's proposal, an interview site for a given application would be the interview site closest to where the examiner is. The examiner should provide that information in each office action, as well as indicate the day(s) of the month when the examiner generally is or is not available for interviews. Having this information in office actions would enable applicants to determine whether an in-person interview is feasible, and encourage them to plan ahead early in the response period.

A reasonable amount of lead time is required to schedule and conduct an in-person interview at a remote site. A request for an in-person interview at a remote site should be made at least two weeks in advance of the interview, barring special circumstances that require shorter lead times.

Because the need for off-campus interview sites stems from the USPTO's liberal hoteling policy, the USPTO should consider absorbing some of the costs. If the USPTO decides to fund the program by charging a new fee for interviews, the fee should be applied to all in-person interviews conducted at a site other than a USPTO campus.

The success of an off-site in-person interview program could be measured by requests for and participation in such interviews. Success should not be measured based on substantive metrics such as impact on examination time or allowance rates because applicants are likely to self-select more complicated or difficult cases for this program.

* * *