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Sent: Thursday, May 07, 2015 10:52 AM
To: WorldClassPatentQuality
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Subject: Patent-Quality Comment: Proposal 1 Under Pillar 1: OPOA Review

To Whom It May Concern:

Thank you for accepting comments as part of your Quality Initiative. Please see the attached comment. This particular comment corresponds to Proposal 1 Under Pillar 1: Applicant Requests for Prosecution Review of Selected Applications. Please let me know if you have any questions.

Best,
Richard Almon



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Proposal 1 Under Pillar 1: OPQA Review

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Quality, as it is used today at the USPTO can be assessed by the different customers of the Office in different ways. Most customers agree that high quality involves ensuring that patent applications are quickly and efficiently examined and ensuring that patents issue on only truly patentable inventions.

This proposal is an important step toward promoting the innovation incentive benefits of high-quality patents that result from both an efficient¹ and proper examination procedure.

I. An Additional Means of Review is Needed

Although the Office of Patent Quality Assurance (OPQA) conducts reviews, the undersigned believe random selection of applications by OPQA is not sufficiently effective. As discussed below, applicants should have an approach that does not rely upon random selection for considering specific issues in a timely fashion.

A. Ad-Hoc Review is not Enough

Currently, applicants are encouraged to reach out to an examiner's Supervising Patent Examiner (SPE) to resolve potential issues and impasses. Beyond reasoning with the examiner, this approach will continue to be effectively used by applicants. It should not be surprising however, that unreasonable positions taken by an examiner are often endorsed by the examiner's SPE. Any proposals should thus address situations where an examiner and his or her SPE are both taking a particular potentially improper position. Currently, no effective, fair, and efficient way of resolving such problems currently exists. As discussed below, the formal Patent Trials and Appeal Board (PTAB) review of a rejection does not provide an efficient and timely way of reviewing such issues. Due to the nature of current PTAB review, any resolution usually takes a significantly long amount of time, potentially longer than the useful life of the invention in question (e.g., for certain computer-related inventions).²

B. PTAB Appeal Availability is not Enough

Some representatives of the US Patent and Trademark Office (PTO) have shared strong opinions that the availability of PTAB appeal of a rejection renders this proposal unnecessary. While the PTAB appeal process is indeed important and useful, several related circumstances make the additional review offered by this proposal an important

¹ Some may argue that inefficient, drawn-out prosecution due to excessive delays may violate due process rights of applicants.

² Some may argue that these delays, which may extend beyond the useful life of the technology in question, may violate due process rights of applicants.

supplement. With the statutory mandate of the PTAB to handle IPR proceedings with priority, *ex parte* appeals have continued to experience long delays.

i. **PTAB Review is Inefficient for Some Issues**

Relying on the PTAB to intervene to evaluate certain minor types of rejection contentions is analogous to having an appeals court handle a minor discovery dispute in litigation—it is an inefficient use of the resources of the appellate tribunal. Many appealed rejections are complex. However, many others amount to an applicant arguing that not enough information and argument have been provided by an examiner, or that an improper, abbreviated approach is being taken. Based on their expertise, the OPQA could quickly and efficiently handle both minor disputes and major ones, without taking up valuable PTAB resources.

ii. **Unreasonable Delay harms Stakeholders**

The current average three-year pendency of PTAB appeals is caused, at least in part, by the review of the type of rejections that could be better addressed with this program by the OPQA. With the increasing popularity of prioritized IPR proceedings, delays will likely continue to become longer. The old adage about delayed justice being the equivalent of denied justice applies to PTAB appeals in many circumstances—especially with certain types of rejections. Delaying prosecution for extended periods of time (e.g., the average three years long pendency for reviewing rejections by the PTAB) harm stakeholders. The prosecution and technology experts at the PTO know how important time can be for some applications. Allowing a more expedited review process by the OPQA of some rejections would be a more efficient way to alleviate the damage caused by long prosecution delays.³

iii. **PTAB Pendency Leads to Lack of Incentive for Examiners**

The same examiners and SPEs who are exhorted by applicants to make more complete rejections, or consider other types of improper rejections, know that any binding review of their actions will come after the significant time and expense of a PTAB appeal. This same lack of incentive could apply to the ad-hoc review channels discussed above. When examiners know that review is far into the future for an aggrieved applicant, incentive to reconsider improper approaches is greatly reduced.

C. **Identifying Trends within the Office**

As identified at the Quality Summit, by allowing applicants to request review of applications, the Office would have the opportunity to analyze the data from the reviews to identify trends and challenges to better inform future training and improvements

³ It should be noted that long prosecution delays by the PTO are currently accounted for in part by patent term adjustment (PTA). However, PTA on its own is not a suitable solution, especially for technology that rapidly obsolesces.

to the examination process. It may be more appropriate to have this type of overarching analysis performed by prosecution experts at the Office, than it is to have private commentators identify and comment on potential problems. The clear issues that are noted with outlier low allowance rates for certain business method art units and the Sensitive Application Warning System (SAWS) program are examples of areas where the Office could leverage statistics to investigate a potential problem and work to develop a solution.

II. Specifics of Suggested OPQA Review

It is important to consider implementation specifics with this program. As evidenced by discussions at the Quality Summit, this program could be implemented in a variety of ways. Some approaches could reduce the usefulness of the program to the point that it would not be used.

A. Available After Exhausting Ad-Hoc Approaches

OPQA review should be available upon a certification that applicant has tried to discuss in-person, a specific issue with the SPE, and potentially, if resources allow, a TC Director. This requirement will not only potentially head-off OPQA review (saving resources at all levels), but will also provide an incentive for the SPE and TC Director to set up meetings that, currently, they may not be willing to have. Often this lack of willingness to meet about a troublesome issue—especially in person—is a cause of great frustration to applicants. Having the SPE and TC Director consider and argue the issue to the applicant could also act to head off review by persuading the applicant of the propriety of the rejection. Of course, if the SPE/Director do not make themselves available in a timely manner, then initiation of an OPQA review should be appropriate.

B. Limited to Presented Issue(s)

Review should be limited to issues presented by the applicant. A cornerstone of appellate review is the consideration only of issues presented for appeal. Longstanding and reasoned, this requirement not only promotes efficiency, but also helps to focus the tribunal on the issues of the most import to the larger matter. Some people strongly argue for a complete OPQA review of all aspects of an application. Not only would this be inefficient (and likely introduce OPQA delays similar to the PTAB), but we believe this proposal is made as a “poison-pill” that would make it less likely for the proposal, if implemented, to be used by applicants.

C. **OPQA Standard of Review and Results**

Currently the standard of review for the OPQA is “clear error.” I believe that it should instead mirror PTAB, at which the examiner’s current approach is not given any deference. As currently suggested by the proposal, the new OPQA review would assist the PTO in internal quality/training efforts, which is important. A timely review by prosecution experts, that is documented, and provided to the applicant, is also important. The system should also be structured such that an OPQA decision under this new review is binding upon the examiner (e.g., such that a rejection deemed to be erroneous must be withdrawn).

III. Conclusion

Proper examination is essential to a high quality patent system. A fair balance between the quality of prosecution and the quality of allowances requires a quick and efficient alternative be available for review inside the examining corps of the Office. Beyond the issues of fundamental fairness, efficiency of rejection review would be significantly improved by properly implementing this proposal.

When implementing this program, requirements should be specified that applicants continue to try to work with the examiner and their SPE, review should be limited to issues presented by the applicant, and decisions should be documented and binding.

Thank you for your consideration.

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