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Sent: Wednesday, May 06, 2015 12:58 PM
To: WorldClassPatentQuality
Cc: Almon, Rich; Franklin, Thomas; Lezak, Angel; Gianola, Adam; Kitces, Matt
Subject: Patent-Quality Comment: Pre-Search Interview Program

To Whom It May Concern:

Thank you for accepting comments as part of your Quality Initiative. Please see the attached comment. This particular comment does not specifically correspond to any of the six identified proposals but instead outlines another proposed program to improve examination and patent quality. Please let me know if you have any questions.

Best,
Kate Gaudry



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Pre-Search Interview Program

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A high priority for the USPTO and for applicants is to promote compact prosecution – that is, to reach a final disposition (i.e., allowance or abandonment) as quickly as possible – while preserving quality of examination. Efficient prosecution requires:

- That the examiner understand the invention. Accurate understanding can allow the examiner to appropriately focus a search (e.g., to target art applicable, not only to the current claims, but so as to also consider potential claim amendments) and to detect allowable subject matter; and
- That applicants draft claims to be reasonably and clearly focused on the invention. Overly broad claims require the examiner to cite art, potentially from non-analogous fields, that do not pertain to an invention but do apply to a pending claim.

Thus, efficient prosecution requires that both the examiner and applicant understand the invention and understand the breadth of pending claims. Establishing these understandings early in prosecution should aid in reaching a final disposition early during prosecution.

First Action Interview Program

In 2011, the USPTO launched the Full First Action Interview Pilot Program. In this program, examiners perform a search and issue a Pre-Action Communication that very briefly outlines contemplated rejections. The applicant is then allowed to participate in an interview with the examiner to discuss the preliminary rejections, prior to issuance of any office action.

Advantages

These early discussions can facilitate enhancing an examiner's understanding of the invention, before the examiner writes up a complete office action. Further, these discussions can provide applicants with insights as to whether pending claims' scopes seemingly are too broad. Statistical analyses have shown that this program indeed improves examination efficiency, as it reduces applications' pendencies and office-action counts.¹

Problems

Nonetheless, there are two key, related problems with this program. The first is that the interview is conducted **after** the examiner has performed a search. Thus, when an examiner did not properly understand the claimed technology, an examiner may have already devoted time to searching the mistaken claim interpretation.

Second, because the examiner performs a search prior to the interview, applicants are limited in their ability to amend the claims. Entering of amendments can cause a next office action to be declared final. Therefore, during the interview, the applicant and examiner may discuss the claims and agree that one or more claim limitations are unclear, unsupported or reach beyond an

¹ Gaudry, K.S. "A look at the results of USPTO's interview program," *Law360*, Jan. 9, 2014.

intended scope. However, applicants cannot thereafter amend the claims without risking that the next (and first) office action be made final.

Proposal: Initiate a Pre-Search Interview Program

Therefore, we propose initiating a corollary of the First Action Interview Program: a Pre-Search Interview Program. We propose that, for applications enrolled the program, applicants be sent a notice when the examiner is ready to begin examining the application. Similar to the First Action Interview Program, the applicant would be given one month to schedule the interview and file an Interview Request, and the interview should be conducted within two months from the date of filing of the Interview Request.

The focus of the interview should be for the applicant to explain the invention, and for the applicant and examiner to consider whether the claim language appropriately corresponds to the described invention. The examiner should identify indefiniteness-type issues during the interview, as well as any claim terminology that the examiner believes may be interpreted differently or more expansively than intended by the applicant.

Following the interview, the applicant should be afforded a two-week period to submit any preliminary amendments to be entered as a matter of right. Subsequently, examination should proceed as normal, with any office action serving as a first, non-final office action.

This program should promote initial searches being directed to claims that are clear and corresponding to an applicant-intended scope. This claim focusing should improve the quality of an initial search and office action. Further, this program should help examiners to understand the invention and to clarify any questions early during prosecution. Again, such understanding should improve search and action quality and should further save the examiner time: Rather than needing to analyze an entire specification to understand an underlying the invention, the examiner should be able to more briefly review the specification to merely ensure that the description is consistent with (and enables) the invention description provided by the applicant.

In summary, the proposed Pre-Search Interview Program should improve PTO efficiency, promote clear and reasonably focused claims, and decrease applications' pendency.

Thank you for your consideration.

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