From: Gianola, Adam [email redacted]
Sent: Wednesday, May 06, 2015 1:15 PM
To: WorldClassPatentQuality
Cc: Lezak, Angel; Franklin, Thomas; Almon, Rich; Kitces, Matt; Gaudry, Kate
Subject: Patent Quality Comment: Automated Pre-Examination Search

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 2: Automated Pre-Examination Search. Please let me know if you have any questions.

Best regards,
Adam J. Gianola

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The following comments are attributable only to the undersigned author and indicated supporters, and do not represent the opinions or beliefs of any other individuals, companies, or organizations.

Regarding USPTO Proposal 2: Automated Pre-Examination Search

We generally support the U.S. Patent and Trademark Office (USPTO) having a modern, automated search tool for purposes of placing the most relevant and prior art in front of Examiners at an early stage of examination. It is believed that having access to such a tool may increase examination quality and resultant patent quality and decrease overall pendency of applications.

However, the introduction and use of such a tool is not without potential downsides. For example, it may be possible that an Examiner will *only* rely on the search results uncovered by the search tool and not perform a full examination of an application that is processed using the search tool, resulting in an overall decrease in examination quality and potentially increasing overall pendency. Additionally, it may be possible that an Examiner will accord excess weight to the search results generated by the search tool, regardless of their overall relevance, simply by virtue of the fact that the search results were uncovered by the automated tool, again decreasing overall examination quality.

The training for the examining corps associated with such an automated search tool will need to address and accommodate these potential risks. For example, guidelines should be put in place to instruct Examiners as to the proper role of the automated search tool and its results and how to properly weigh and/or make combinations with the references generated. For the sake of transparency, the USPTO should make any examination guidelines regarding the automated search tool publicly available, allowing Applicants the opportunity to understand how the Examiners have been instructed to use, combine and weigh the results of the search tool.

Additionally, details of the how the search tool operates should be made publicly available. For example, the USPTO should clearly identify which search algorithms are available and/or utilized for analyzing and searching an application, how parts of an application are extracted and used for analyzing and searching an application, and how keywords and concepts in an application are identified, etc. This information should be published for the tool overall to provide Applicants and the public with a full understanding of the tool's abilities and how the tool is used internally at the USPTO.

In addition, the specific algorithm utilization, application part/extracts, keywords and concepts identified, and search tool results should be documented in each application file wrapper in

which the search tool is utilized, to provide clarity to the record, similar to the inclusion of Examiner's search queries commonly provided as appendices to Office Actions.

Several modifications to the Enhanced Patent Quality Initiative Automated Pre-Examination Search proposal are also proposed to leverage the automated search tool to obtain additional quality benefits.

Proposal: Allow Public Access to Any Newly Utilized Automated Search Tool
We propose allowing public access to any new automated search tool utilized by the USPTO. Making such a tool publicly available will have an increased benefit of allowing Applicants to quickly and efficiently conduct pre-filing searches, potentially providing Applicants with the ability to identify whether novelty destroying prior art exists prior to filing and/or to aid in drafting original claims so as to have a focus and scope appropriate in view of the prior art. This will provide the added benefit of improving the overall quality of newly filed patent applications where an Applicant makes use of the search tool prior to filing and revises, refines, or otherwise improves their invention and the associated disclosure in their patent application, and may also result in decreased prosecution time.

Further, as described above, the specific algorithm utilization, application part/extracts, and keywords and concepts extracted should be documented in each application file wrapper in which the search tool is utilized, to provide clarity and to effectively provide Applicants with the search tool inputs needed to replicate the automated search.

Proposal: Allow Applicants the Opportunity to Amend Claims After the Automated Search is Performed and Prior to Examination
Since it is understood that the results of the automated search will be available prior to Examination, we propose providing the Applicant with the search results generated by the automated search tool prior to receiving a First Action on the Merits and allowing the Applicants an opportunity make a preliminary amendment prior to Examination. For example, a two month window may be provided after the automated search results are sent to the Applicant during which the Applicant may make preliminary amendments that will be considered by the Examiner, by right. In this way, Applicants can evaluate the search results and submit amended claims to further prosecution at an early stage. Such an opportunity will further leverage the utility of the automated search tool and may result in expedited prosecution.

Proposal: Periodic Evaluation of Automated Tool and Publication of Metrics Related to Quality of Automated Tool.
We propose establishing a system for periodically or continuously evaluating the quality of the automated tool to ensure that the tool operates effectively and accurately. Evaluating the quality of the automated tool may include requesting feedback from Examiners, Applicants, and/or Attorneys/Agents, or may include comparing manual search results with results from the automated tool. For example, a quality committee can review an Examiner's manual search results for a case and compare them to the automated search results to determine a level of quality of the automated tool. As another example, a quality committee can periodically run the automated tool on an expired or abandoned patent or application and compare the automated results to the results from the Examiner's search of record. In addition to performing periodic

evaluation of the automated tool, the metrics related to the quality of the automated tool should be published.

Thank you for your consideration.

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	Matthew T. Kitces,
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