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Request for Comments on Enhancing Patent Quality

Comment On: PTO-P-2014-0043-0001
Patent Quality Enhancements; Meeting

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General Comment

Deputy Under Secretary Michelle K. Lee,

I am writing to respond to the request of the United States Patent and Trademark Office for comments on Enhancing Patent Quality, published on January 6, 2012 in the Federal Register, 80 Fed. Reg. 6475 (herein enhancing patent quality notice). Comments for this upcoming meeting regarding enhancing patent quality were also called for in the context of the 2014 Interim Guidance on Patent Subject Matter Eligibility published on December 16, 2014, in the Federal Register, 79 Fed. Reg. 74618 (herein subject matter notice).

Specifically, the subject matter notice noted that examiner training would need to be adjusted as a result of numerous Supreme Court decisions. One of these cases was Alice Corp. Pty. Ltd. v. CLS Bank Intl, 573 U.S. __, 134 S. Ct. 2347 (2014). I believe the changes that have/will result from this case call into question the new quality proposals under the enhancing patent quality notice. In the wake of the Alice decision, the Commissioner for Patents noted that several applications that were deemed allowable, but had not issued, had their notice of allowance withdrawn for further examination. http://www.uspto.gov/blog/director/entry/update_on_uspto_s_implementation#comments. The Commissioner did not indicate that any issued patents had been notified or made aware of potentially illegible claims that existed post-Alice. To this end, I believe several things can be done in regards to enhancing patent quality.

Proposal 2 Under Pillar 1: Automated Pre-Examination Search

The USPTO has used the Scientific and Technical Information Center (STIC) to run pre-examination searches using certain algorithms. I would propose that, where feasible, a mid-examination or pre-issuance search should also be run, in order to anticipate potentially upending Federal Circuit or Supreme Court decisions. While it may be imprudent for the USPTO to withhold an application before a decision has been made by the court(s), a notice procedures should be in place to anticipate such issues. This would help to prevent a situation in which an inventor/practitioner receives a notice of allowance, which is unexpectedly revoked a short time late.

Proposal 3 Under Pillar 1: Clarity of the Record

The USPTO notes that the clarity of the record is important for the owner, courts, third-parties, etc. This is a legitimate reason for extending this Federal Circuit/Supreme Court search to recently issued patents. The Commissioners blog entry does not indicate whether any patents which had been issued immediately before the Alice decision were notified of the change. It would seem unfair to have a system in place where a patent that receives of notice of allowance, but does not issue, receives re-examination, but a patent that has issued days earlier does not. I do not suggest that the USPTO should search all patents that have been affected by a recent court opinion, because this would be unbearably time consuming. Rather, the USPTO should determine an appropriate time frame (perhaps 6 or 9 months) in which a recent patent will be notified under the same search suggested above for Proposal 2. While there is a duty to ensure ones patent still is legally enforceable, in the immediate aftermath of a patent issuance this may not be as closely monitored.

Also speaking to this proposal, and the clarity of the record, a notation in the record that such a notification has been supplied to the applicant/patent holder would be appropriate. This should not prejudice the applicant as they will undergo a re-examination after the notice has issued that some of their claims may be ineligible. Notation in the record will also not prejudice the holder of patent, as a time frame for which patents can be issued such a notice is limited.