

PIPLA/USPTO Quality Check Where Are We Now?

September 22, 2016

UNITED STATES
PATENT AND TRADEMARK OFFICE





Update on Key EPQI Programs

Andrea Wellington

Senior Advisor to the Deputy Commissioner for Patent Quality

UNITED STATES
PATENT AND TRADEMARK OFFICE



EPQI Programs

Focused on three implementation areas:



Data Analysis

Pillar 1

- **Topic Submission for Case Studies**

Pillar 2

- **Clarity and Correctness Data Capture (Master Review Form or MRF)**
- **Quality Metrics**

Examiners' Resources, Tools & Training

Pillar 1

- **Automated Pre-Examination Search Pilot**
- **STIC Awareness Campaign**
- **Improving Clarity and Reasoning in Office Actions Training (ICR Training)**
- **Post Grant Outcomes**

Pillar 3

- **Interview Specialist**

Changes to Process/Product

Pillar 1

- **Clarity of the Record Pilot**

Pillar 3

- **Post-Prosecution Pilot**
- **Reevaluate QPIDS**
- **Design Patent Publication Quality**

First Action Interview Pilot Program

Tariq Hafiz

Director, Technology Center 2600

UNITED STATES
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First Action Interview (FAI) Pilot Program

- Promotes personal interviews prior to issuance of a first Office action on the merits
- Advances examination of applications once taken up in turn
- Facilitates resolution of issues for timely disposition of an application
- Gives applicants more options in regards to the amount of notice and procedure needed



FAI Pilot History

Original Pilot

- **4/28/2008 – 11/1/2008**
- In two small, computer technology areas

Enhanced Pilot

- **10/1/2009 – 3/31/2011**
- In one technology area in **each** Technology Center

Full Pilot

- **5/15/2011 – present**
- All technology areas are eligible



FAI Pilot Program Requirements

An application suitable for the FAI pilot MUST:

- be a non-reissue, nonprovisional utility application under 35 U.S.C. 111(a) or national stage application under 35 US.C. 371
- contain three or fewer independent claims and twenty or fewer total claims
- not contain any multiple dependent claims
- claim only a single invention and
- not have a first Office action on the merits as of the date Applicant requests participation in program



FAI Prosecution Begins: Pre-Interview Communication

The examiner will:

- 1) Follow current restriction policy and practice
- 2) Conduct a prior art search
- 3) Follow current policy and practice if a determination of allowability is made
- 4) Issue a Pre-interview Communication (PTOL-413FP) setting a one month (30 day) time period to request or decline an interview
 - o The time period to respond to the Pre-Interview Communication may be extended for one additional month (30 days)



Pre-Interview Communication (PTOL-413FP)

Pre-Interview Communication <small>(For use in the First Action Interview Pilot Program)</small>	Application No.		Applicant(s)	
	Examiner	Art Unit	Page 1 of	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

This time period for reply is NOT extendable under 37 CFR 1.136(a). This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

To avoid abandonment of the application, applicant must, within this time period for reply, file:

- (1) A letter requesting not to have a first-action interview, or
- (2) A completed Applicant Initiated Interview Request Form (PTOL-413A) accompanied by a proposed amendment or arguments.

Inventor participation in the Pre-First Action Interview is encouraged if it would expedite resolution of the application.

Disposition of Claims

- 3) Claim(s) _____ is/are pending in the application.
- 3a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 4) Claim(s) _____ appear to be allowable.
- 5) Claim(s) _____ appear to be rejectable.
- 6) Claim(s) _____ may be subject to an objection.
- 7) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 8) The specification may be subject to an objection by the Examiner.
- 9) The drawing(s) filed on _____ is/are: a) accepted or b) may be subject to an objection by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) The oath or declaration may be subject to an objection by the Examiner.

Priority under 35 U.S.C. § 119

- 11) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: _____
 Examiner's Typical Work Schedule: _____
 Supervisor's Name: _____
 Supervisor's Telephone Number: _____

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Pre-Interview Communication <small>(For use in the First Action Interview Pilot Program)</small>				Application No.		Applicant(s)	
				Examiner	Art Unit	Page 2 of	

Notification of Potential Rejection(s) and/or Objection(s)				
#	Claim(s)	Reference(s) (if applicable)	Statutory Basis	Brief Explanation of the Potential Rejection

Expanded Discussion/Commentary				

DATE:	Examiner Signature:	Primary Examiner Signature:
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PTOL-413FP Example

Notification of Rejection(s) and/or Objection(s)				
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection
1	1-8		101	Claim 1 recites a binary translator with various components. The binary translator as claimed is software per se and software in not considered patentable subject matter. Claims 2-8 depend on 1 and do not include hardware so as to overcome the rejection.
2	1-8		112, 1 st	Claim 1 recites the limitation of “replace disabled legacy binary instructions with native instructions”. However, according to the specification, on page 6, lines 1-3, “...used to disable...insert new instruction without (see continuation below)
3	1-5, 7-8	U	102(b)	Claim 1 (Figure 1, 1 st para, 3 rd para, Section 3.1 Components. 4 th paragraph—note the claimed “processor means” is interpreted as the CPU in figure 1; 2 (Fig. 1); 3 (section 3.1, 4 th para); 4 (section 4.2, para 9—note) (see continuation below)
4	6	U,V	103(a)	U does not disclose said native instruction processor as claimed. V discloses at section 2.1, 2 nd para. As one would want better code for hot spots to improve performance (see V, Section 2.1), it would have been (see continuation below)

Response to Pre-Interview Communication

Applicants properly respond to the Pre-Interview Communication by filing one of the following:

1. Request not to have the interview
 - Acts as removal from the Pilot
 - FAI-FAOM will be mailed (PTOL-413FA); extensions of time are limited
2. Request not to have the interview AND submit a reply in accordance with 37 CFR 1.111
 - Pre-Interview Communication (PTOL-413FP) serves as FAOM
3. "Applicant Initiated Interview Request" form (PTOL-413A) along with a proposed amendment and/or arguments via EFS-Web, and conduct the interview within 60 days from the filing of the Applicant Initiated Interview Request



FAI Pilot Interview

- Conducted in accordance with current policy and practice (See MPEP 713) for the purpose of:
 - Assisting the examiner in obtaining a better understanding of the claimed invention
 - Establishing the relevant state of the art
 - Discussing all relevant prior art teachings
 - Focusing on what claimed features establish patentability over the prior art
 - Discussing proposed amendments or remarks
- ❖ Applicant may request waiver of the First Action Interview-Office Action and enter a proposed amendment that complies with 37 CFR 1.111



Interview → Agreement on Allowability

The examiner will:

- Document the substance of the interview and reasons for allowance on an Interview Summary form (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Generate a Notice of Allowability (PTOL-37), if applicant requests an unofficial, courtesy copy
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Perform an updated search and interference review before issuing an official Notice of Allowability



Interview \neq Agreement on Allowability

The examiner will:

- Document all requirements, objections, and rejections in a FAI Office Action form (PTOL-413FA)
- Document the substance of the interview on an Interview Summary form (PTOL-413)
- Note and attach all relevant amendments and/or arguments
- Attach a copy of a completed copy of the Applicant Initiated Interview Request form
- Make all documents and forms of record
- Upon request, provide unofficial, courtesy copies

- ❖ Upon request for a waiver of the FAI Office action, enter a proposed amendment that complies with 37 CFR 1.111



Post-FAI Interview Process

- Applicants must timely respond to all outstanding issues in accordance with current policies and practice
- Applicants must make the substance of the interview of record when filing a timely response
- Examiners must proceed in accordance with current examination procedures and also ensure the substance of the interview made of record by applicants is accurate



How Well Does FAI Work?

Results
as of
June 6, 2016

Total Overall	Original	Enhanced	Full Pilot (since 5/16/11)	
7278	502	6776	6082	Applicants have joined the pilot program
400	392	8	3	Pre-interview Communications (PFA OA) have been mailed
4201	12	4189	3708	Pre-interview Communication (MPICO) have been mailed
4417	390	4027	3563	Interviews have been conducted
2257	294	1963	1723	First Action Interview Office Actions have been mailed
618	23	595	507	Final Rejection mailed with No FAI Office action
4177	345	3832	3325	Allowances
1247	62	1185	1046	Allowed after pre-interview communication but before FAI office action
2422	257	2165	1835	Allowed after the FAI office action
508	26	482	444	Allowed without/before pre-interview communication
1275	76	1199	1040	First Action On the Merits without a Pre-Interview Comm
25	3	22	17	Quayle Actions
29.6%	18.2%	30.6%	31.2%	First Action Allowance rate



More Information about FAI

- For more details about FAI, including eligibility information and TC POCs, visit <http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program>
- For Notice/Legal questions, contact Joseph Weiss in OPLA 571-272-7759 or email first.action.interview@uspto.gov
- For EFS-Web questions contact the Electronic Business Center (EBC) at 866-217-9197





Post-Prosecution Pilot (P3)

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Introduction to the Post-Prosecution Pilot (P3)



- Advanced as a program of the Enhanced Patent Quality Initiative (EPQI) under Pillar 3, Excellence in Customer Service
- Developed to test its impact on enhancing patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal



Overview of the Post-Prosecution Pilot (P3)

- Retains popular features of the Pre-appeal Brief Conference Pilot and After Final Consideration Pilot (AFCP) 2.0 programs:
 - Consideration of 5-pages of arguments after final
 - Consideration of non-broadening claim amendments after final
- Adds requested features:
 - Presentation of arguments to a panel of examiners
 - Explanation of the panel's recommendation in a written decision after the panel confers



Post-Prosecution Pilot (P3) Begins

- Federal Register Notice (81 FR 44845) July 2016
- Pilot began July 11, 2016
- Runs six (6) months or upon receipt of 1,600 compliant requests, whichever occurs first
 - 200 per Technology Center
- Formal comments about P3 will be received through November 14, 2016 at AfterFinalPractice@uspto.gov

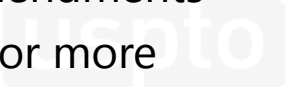


P3 Pilot Participation

Open to nonprovisional and international utility applications filed under 35 USC 111(a) or 35 USC 371 that are under final rejection.

The following are required for pilot entry:

- A **request**, such as in **PTO/SB/444**, must be filed via EFS-Web
 - within 2 months of the mail date of the final rejection and prior to filing notice of appeal
- A **statement** that applicant is willing and available to participate in P3 conference with the panel of examiners
- A **response** comprising no more than five (5) page of arguments under 37 CFR 1.116 to the outstanding final rejection, exclusive of any amendments
- Optionally, a proposed non-broadening amendment to one (1) or more claim(s)



P3 Pilot Requirements

- No fee to participate
- No previously filed proper request to participate in the Pre-Appeal or AFCP 2.0 programs to the same outstanding final rejection
- Once a P3 request has been accepted:
 - no additional response(s) under 37 CFR 1.116 will be entered unless requested by examiner
 - impermissible to request participation in Pre-Appeal or AFCP 2.0 programs once a P3 request has been accepted



P3 Pilot Compliance

For requests considered timely and compliant, the Office will enter the application into the pilot process.

For requests considered untimely or otherwise non-compliant (or if filed after the technology center has reached its limit):

- The Office will treat the request as in the same manner it would treat any after final response absent the P3 request.
 - No conference will be held.
- The next communication issued by the Office will indicate:
 - the reason why the P3 request was found to be untimely or otherwise non-compliant;
 - the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment; and
 - the time period for the applicant to take further action.



P3 Pilot Process

1. The Office will contact the applicant to schedule the P3 conference.
2. The applicant will make an oral presentation to the panel of examiners with such participating being limited to 20 minutes.
3. The applicant will be informed of the panel's decision, in writing, following complete consideration of the P3 request.



P3 Pilot Notice of Decision

Applicant will be informed, in writing via a Notice of Decision from Post-Prosecution Pilot Program (P3) Conference (PTO-2324), as to the outcome of the conference.

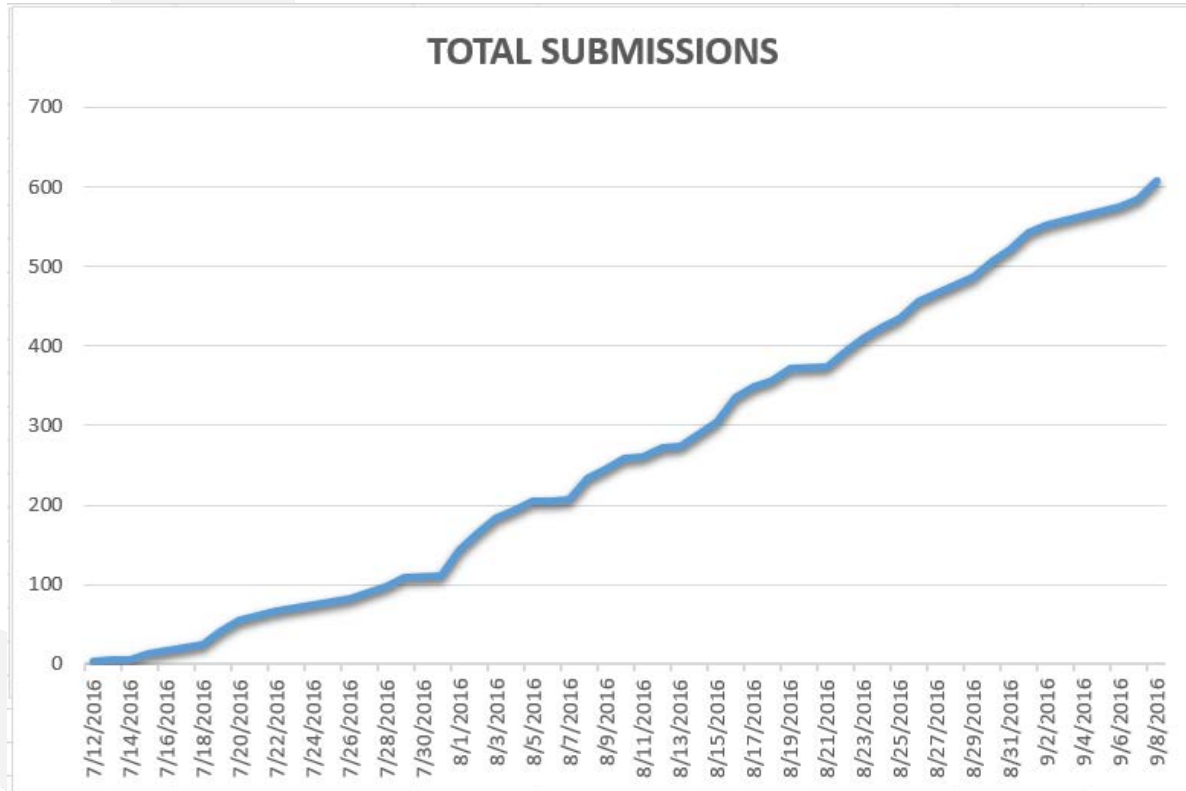
Three possible outcomes are:

- A. Final Rejection Upheld
 - The status of any proposed amendment(s) will be communicated
 - The time period for taking further action will be noted
- B. Allowable Application
- C. Reopen Prosecution

All of the above outcomes will include an Explanation of Decision

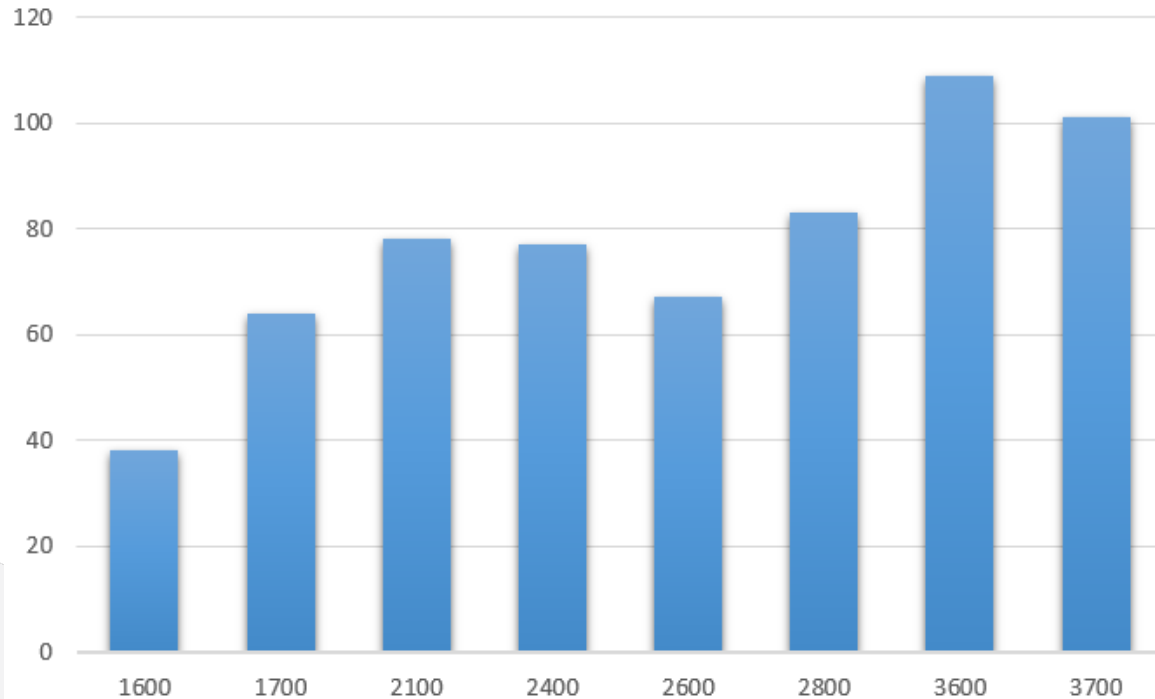


P3 Pilot – Submissions to Date



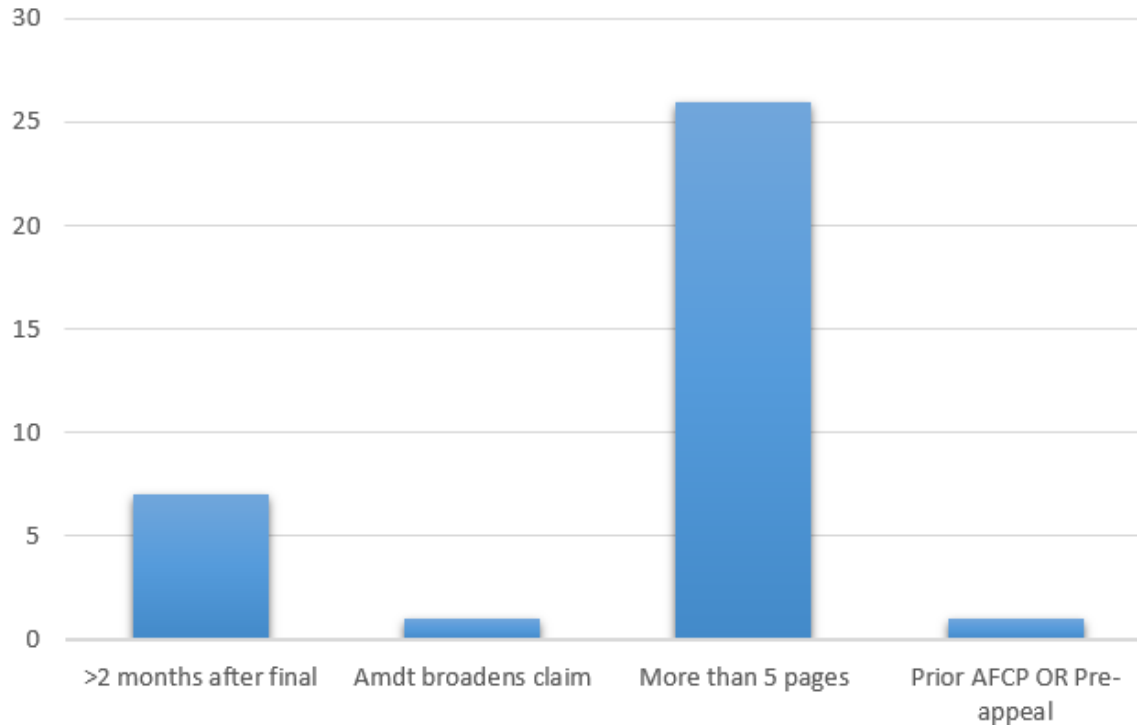
P3 Pilot – Submissions to Date

SUBMISSIONS BY TC



P3 Pilot – Improper Requests

IMPROPER REQUESTS



P3 Pilot – Looking Ahead

- ❖ Consider:
 - Internal and external survey results
 - Formal Comments from FR Notice
 - Stakeholder feedback about the program from other sources
- ❖ Decide:
 - Whether or not to continue the program, optionally with modifications



For More Information on P3

- Visit our website:
<http://www.uspto.gov/patent/initiatives/post-prosecution-pilot>
 - Program details and forms
 - Examiner training materials
 - Statistics
 - FAQs
- Contact us by email: PostProsecutionPilot@uspto.gov



A blurred background image of a person's face, showing eyes and a red tongue, positioned at the top of the slide.

Post Grant Outcomes

Jack Harvey

Assistant Deputy Commissioner for Patent Operations

UNITED STATES
PATENT AND TRADEMARK OFFICE



Introduction to Post Grant Outcomes



- Advanced as a program of the Enhanced Patent Quality Initiative (EPQI) under Pillar 1, Excellence in Work Products
- This program is to develop a process for providing post-grant outcomes from sources, such as the Federal Circuit, District Courts, Patent Trial and Appeal Board (PTAB), and Central Reexamination Unit (CRU), to the examiner of record and the examiners of related applications.

Objectives of Post Grant Outcomes

The purpose of this program is to learn from all post grant proceedings and inform examiners of their outcomes.

Propose **three** objectives to accomplish this:

1. Enhanced Patentability Determinations in Related Child Cases

- Providing examiners with full access to trial proceedings submitted during PTAB post AIA Trials

2. Targeted Examiner Training

- Data collected from the prior art submitted and examiner behavior will provide a feedback loop on best practices

3. Examining Corps Education

- Provide examiners a periodic review of post grant outcomes focusing on technology sectors



Objective 1 - Enhanced Patentability Determinations in Related Child Cases

- Identify those patents being challenged at the PTAB under the AIA Trials that have pending related applications in the Patent Corps
- Provide the examiners of those pending related applications full access to the AIA trial proceedings of the parent case



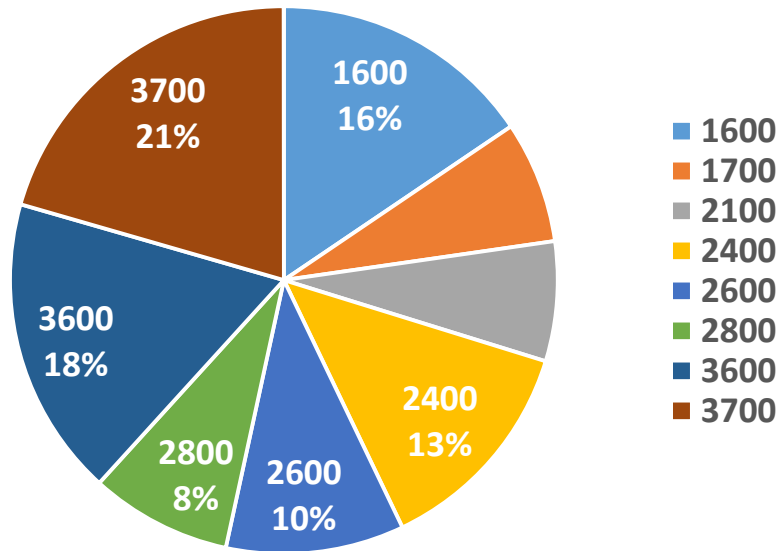
Post Grant Outcomes Pilot Addresses Objective 1

- Post Grant Outcomes Pilot launched April 2016, continues through August 2016
- Pilot notifies examiners when they have a pending application related to an AIA trial, and provides full access to the trial proceedings
- Pilot participants are surveyed to identify best practices to be shared corps-wide



Objective 1 – Pilot Statistics

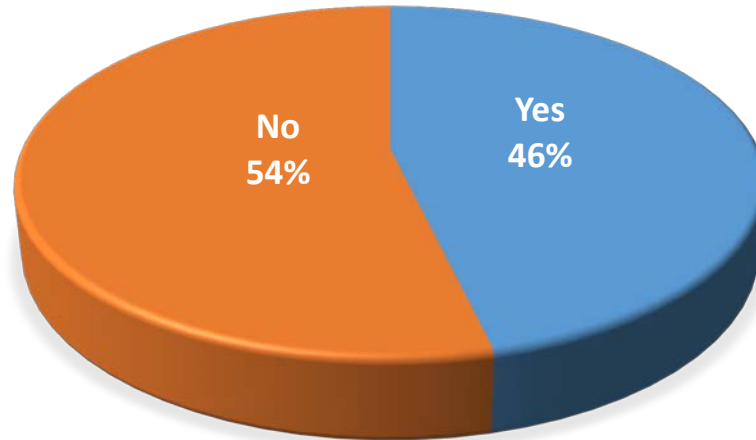
DISTRIBUTION OF PILOT APPLICATIONS
BY TECHNOLOGY CENTER



Technology Center	Number of Pilot Applications
1600	121
1700	56
2100	55
2400	102
2600	82
2800	65
3600	138
3700	160
Grand Total	779

Objective 1 – Pilot Statistics cont.

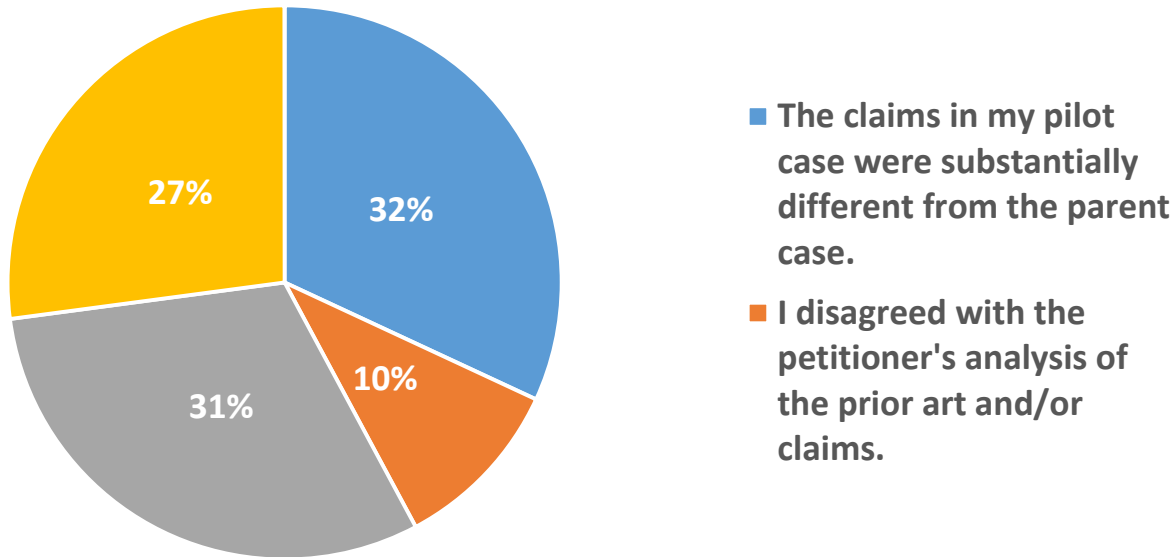
In the Office Action of the child case, did the examiner refer to any of the references cited in the AIA trial petition of the parent case?



Based on 270 Survey Responses

Objective 1 – Pilot Statistics cont.

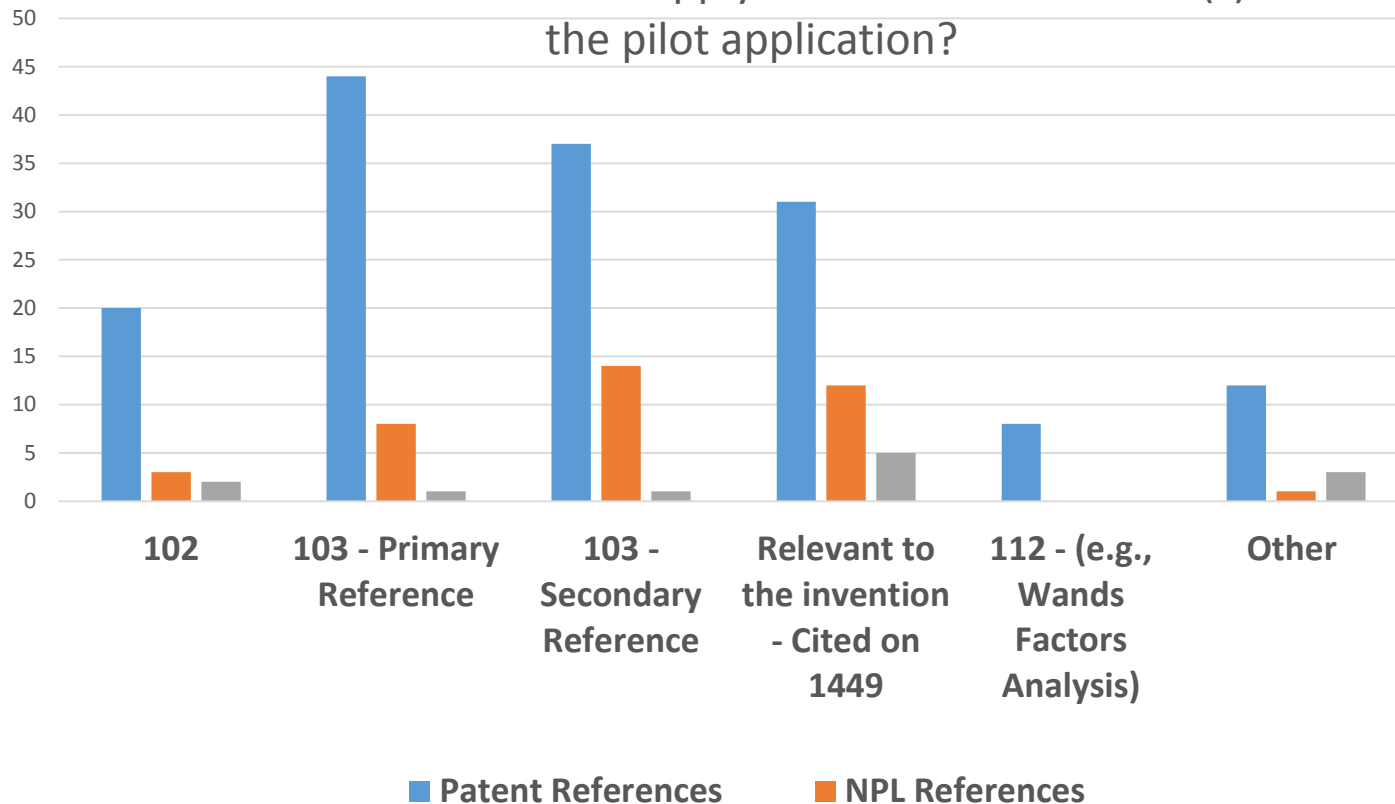
If the examiner did not use any references cited in the AIA Trial Petition, why?



Based on 136 Survey Responses

Objective 1 – Pilot Statistics cont.

How did the examiner apply the AIA Trial reference(s) in the pilot application?

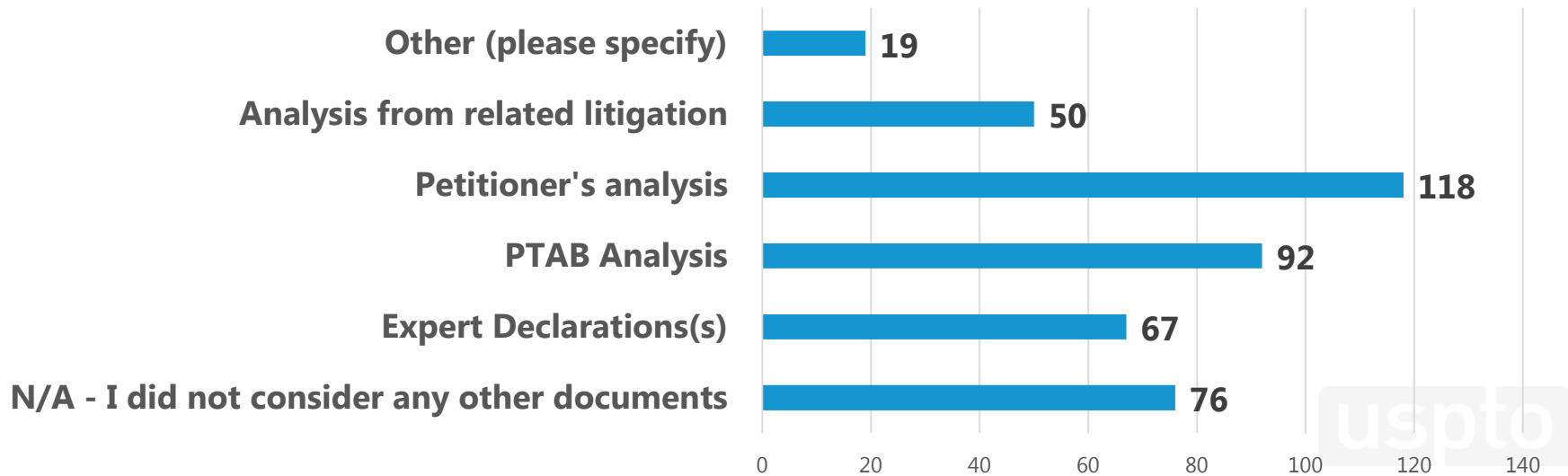


Based on 112
Survey
Responses



Objective 1 – Pilot Statistics cont.

Did the examiner consider any other documents submitted with the petition, e.g., expert declarations, PTAB analysis?



Based on 240 Survey Responses

Objective 2 – Targeted Examiner Training

- Data collected from the prior art submitted and resulting examiner behavior will provide a feedback loop on best practices
- Educate examiners
 - Prior art search techniques
 - Sources of prior art beyond what is currently available
 - Claim interpretation
 - AIA Trial proceedings



Objective 3 – Examining Corps Education

- Leverage results of all post grant proceedings to educate examiners on the process and results
 - Provide examiners a periodic review of post grant outcomes focusing on technology sectors
 - Utilize the proceedings to give examining corps a fuller appreciation for the process



Post Grant Outcomes Summary

- Learn from the results of post grant proceedings
- Shine a spotlight on highly relevant prior art uncovered in post grant proceedings
- Enhance patentability of determination of related child cases
- Build a bridge between PTAB and the examining corps



Next Steps

- Develop training and best practices gleaned from pilot and implement corps-wide
- Send your feedback to:
WorldClassPatentQuality@uspto.gov
- More information at the Pilot home page:
<http://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot>





Pro Bono Program

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Pro Bono Clients

- Believe in their invention
 - Can be emotionally involved
 - May have invested significant personal resources
- Often not familiar with patent prosecution
 - Statutes, rules, and procedures appear complex
 - May not know what to expect from an attorney/client relationship



USPTO Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses
 - Coverage in all 50 states achieved and maintained since August 2015
- Promotes small business growth and development
- Helps ensure that no deserving invention lacks patent protection because of a lack of money for IP counsel
- Opportunity for patent attorneys to serve in their area of expertise



Pro Bono Program – September 2016



Volunteer Patent Attorneys Are the Linchpins for Program Success

- The program can't work without you!
- Improved patent quality - a *pro se* inventor is now a represented inventor
- Professional advice:
 - Inventor is educated about the patent system
 - "No" may be what the inventor needs to hear
- Gives a person a chance to be a job creator and paying client
- Consumer protection



Get Involved with your Regional Program!

- Regional programs match underserved inventors and small businesses with volunteer attorneys to file and prosecute patent applications
- Regional programs offer a better experience
 - Inventions are screened
 - You choose your client
 - Malpractice coverage offered by some of the programs
- **Get your feet wet by volunteering to help screen applications**



The Pennsylvania Program

- Operated by the Philadelphia Volunteer Lawyers for the Arts (PVLA)
 - To volunteer contact:
 - Rachael Nave, PVLAlegal@artsandbusinessphila.org
- All types of technological areas available for volunteering (vlany.org/patent-caselist/):
 - Fashion
 - Music
 - Mixed



USPTO Patent Pro Bono Program: Coordination Team

John Kirkpatrick

john.kirkpatrick@uspto.gov

571-270-3343

Gautam Prakash

gautam.prakash@uspto.gov

571-270-3030

Oleg Asanbayev

oleg.asanbayev@uspto.gov

571-270-7236



Panel Discussion



Panelists:

- **Jack Harvey**, Assistant Deputy Commissioner for Patent Operations
- **Tariq Hafiz**, Director, Technology Center 2600
- **Andrea Wellington**, Senior Advisor to the Deputy Commissioner for Patent Quality





Thank You!

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