



**COMMENTS TO THE USPTO
ON IMPROVING PATENT QUALITY METRICS**

Submitted by: The National Association of Patent Practitioners (NAPP)

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To: Michael Cygan, Senior Legal Advisor
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Re: Docket No. PTO-P-2016-0006

DESCRIPTION OF COMMENTING PARTY

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents, patent attorneys, and others associated with patent practice. NAPP has approximately 400 practitioner members in the US and various foreign countries. The practices of the practitioner members are focused primarily on patent prosecution, namely practice before the USPTO. As part of NAPP's mission, we aim to create a collective nationwide voice to address issues relating to patent-prosecution practice. Additional information about NAPP can be found at <http://www.napp.org>.

The following comments are submitted in an effort to assist the United States Patent & Trademark Office (USPTO) in response to the request for comments, "Patent Quality Metrics for Fiscal Year 2017 and Request for Comments on Improving Patent Quality Measurement," published in the Federal Register at 81 Fed. Reg. 16142 (March 25, 2016).

NAPP welcomes this opportunity to assist and hopes that the USPTO will seriously consider the suggestions. NAPP is available to answer questions, comment further (formally or informally), or assist any other way considered useful. Please contact us at 919-230-9635.



NAPP COMMENTS

General Comment: (David – please revise as you may deem appropriate)

NAPP recognizes the efforts of the USPTO to foster and monitor patent quality among both the examining corps and the patent community, particularly through review of examiner office actions for correctness and clarity.

NAPP appreciates the numerous and substantial challenges in developing quantitative measurements over processes that are intrinsically complex and case-specific. The challenges are accentuated by the partly discretionary nature of the legal principles and standards set forth in the Patent Act and articulated by the courts, such as whether a set of references is amenable to combination under 35 U.S.C. § 103 to serve as the basis of an obviousness rejection.

NAPP generally agrees with the USPTO that, despite these challenges, the collection of data across the work product of the USPTO, and the formulation of metrics that illuminate “trends and outlier behavior” arising within the examining corps, will serve the interests of “increas[ing] the accuracy, consistency, transparency, clarity, and simplicity of USPTO quality review procedures.”

NAPP welcomes the opportunity to respond to the progress of the USPTO reported in the Federal Register Notice, both in general and in response to two specific questions:

- 1) Is the USPTO moving in the right direction by choosing to focus on two core metrics: A work product metric representing correctness of actions, and a clarity metric that more thoroughly explores the sufficiency of the examiner’s reasoning in an Office action, thus moving away from the prior goal-based quality “score” that reflected not only quality of work product but also results of surveys, used to discover both internal and external stakeholder opinions, and QIR process indicators?
- 2) How can patent metrics best provide objective, rather than subjective, measurements of quality-related features in clarity and correctness reviews?

The comments below are respectfully submitted for consideration within the Enhanced Patent Quality Initiative. These comments address areas that, in NAPP’s view, would improve the correctness and clarity of office actions.

Request for Comments #1: Is the USPTO moving in the right direction by choosing to focus on two core metrics: A work product metric representing correctness of actions, and a clarity metric that more thoroughly explores the sufficiency of the examiner’s reasoning in an Office action, thus moving away from the prior goal-based quality “score” that reflected not only quality of work product but also results of surveys, used to discover both internal and external stakeholder opinions, and QIR process indicators?

Response:

With noted reservations, NAPP agrees with and supports the USPTO’s shift from survey-based metrics to focused metrics, which may yield a rich data about “trends and outlier behavior” within the examination process.

Rationale:

NAPP has long noted the inherent limitations of the QIR process indicators that form the basis of the USPTO Data Visualization Center or “Dashboard.” For instance, the reporting of a “Quality Composite Score” as a numeric value in the range of “40” to “90,” provides little insight into any facet of patent examination. The specific components of the process that inform this decision are similarly unhelpful. For example, the “Final Disposition Compliance Rate” metric has historically been as percentile, with values reported for the period from 2009-2015 ranging between 94% and 97%. Similar metrics are reported for such topics as an “In-Process Compliance Rate,” and for internal and external “Quality Surveys.” Such topical descriptions and metrics are both absent any indication of the factual basis of such determinations, and so generalized as to be impenetrable to further evaluation and critical review.

Moreover, the QIR process indicators suggest a self-assessment perception of a consistently outstanding examination quality, with an error rate often below 5%. These outstanding internal conclusions exhibit a significant discrepancy as compared with extrinsic indicators of examination quality – *e.g.*, the typical PTAB reversal rate of 33% of *ex parte* appeals that reach a decision, which does not include *ex parte* opinions resulting in a reopening of prosecution at either the pre-appeal or briefing stage. In addition to raising questions of reliability, the discrepancy suggests a significant disconnect between USPTO administration and external observers about the assessment of examination quality.

Accordingly, NAPP notes with approval the replacement of the QIR process indicators with more specific core metrics directed to the correctness and clarity of patent examination and office actions. NAPP concurs with the USPTO’s position that such focused metrics will provide a more comprehensive review of specific “trends and outlier behavior” arising during patent examination, which may in turn inform administrative efforts to respond, *e.g.*, with additional examiner training, internal memoranda, and advisory notices to patent applications that may guide the presentation of new applications and replies to office actions. Additionally, the reporting of focused metrics enables greater transparency into the criteria of the USPTO’s self-assessment, and public scrutiny of the objective data.

However, two reservations are noted with respect to general omissions in the types of inquiries posited by the Master Review Form, and which therefore appear to be underserved in the types of data gathered and reported thereby. These reservations are presented as suggestions for supplementing the Master Review Form with additional inquiries that reveal additional factors relevant to the measurement of examination quality.

Reservation #1: Inadequate reflection of the responsiveness of an office action to the arguments presented in a preceding reply.

From the applicant's perspective, the patent examination process begins with a first action on the merits that is principally directed to the application as filed. Each subsequent office action is responsive to the applicant's reply, where such replies include claim amendments and arguments presented in response to the immediately preceding office action.

However, this process framework permits two distinct forms of subsequent office actions. Some office actions principally respond directly to the applicant's reply, such as:

- Affirmative statements of arguments that have been accepted, and why a new rejection addresses the deficiencies of the previous rejection. For example:

The examiner is persuaded that the Smith reference does not present subject matter corresponding to the portion of claim 1 providing: "calculate a trajectory from the radar data." However, the Jones reference presents subject matter corresponding to these elements – *e.g.*, Jones col. 9, lines 9-12, provide: "Using the radar data gathered from radar element 48, the tracking component 52 calculates a vector indicating a heading of the object." The examiner interprets "heading" as synonymous with the "trajectory" of claim 1.

- Responsive explanations of why an argument is deemed unpersuasive. For example:

The applicant's reply asserts that the term "trajectory" is not equivalent to the terms "heading" as provided in the Jones reference, and specifically identifies Jones Fig. 3, element 42 as showing a "heading" that includes direction but not velocity. However, this argument is found unpersuasive because Jones Fig. 4 presents an alternative example (element 58) in which "heading" explicitly includes a velocity component. The examiner therefore interprets Jones as presenting a "heading" comprising a heading component and/or a velocity component, which corresponds to the term "trajectory" in claim 1.

Office actions of this type provide insight into the examiner's construction of claim terms and mapping of cited references thereto. Patent practitioners equipped with such information can evaluate the merit of the examiner's position and the prognosis of the application, as well as formulate claim amendments that are specific to the examiner's rationale.

However, other office actions do not provide meaningful responses to the applicant's reply, but principally maintain or update the *prima facie* case with only formulaic reply. For example:

- A withdrawal of a rejection that was successfully traversed and presentation of a new rejection, but without an explanation of how the new rejection improves upon the withdrawn rejection. For example:

The applicant presented arguments with respect to the subject matter of the Jones reference. These arguments are deemed moot as not applying to the present rejection is based upon the Smith reference.

- Conclusory statements that an argument has been found unpersuasive. For example:

The portion of claim 1 providing: "calculate a trajectory from the radar data" is rejected in view of Jones (*see* Jones Fig. 3, element 42, "heading").

Response to Arguments:

The applicant's reply asserts that the term "trajectory" is not equivalent to the terms "heading" as provided in the Jones reference. This argument is unpersuasive because Jones provides: "calculate a trajectory from the radar data" (*see* Jones Fig. 3, element 42, "heading").

Although this type of office action acknowledges the presence of the arguments and suggests due consideration by the examiner, the absence of substantive responses to the merit of such arguments precludes a meaningful evaluation of the merit of the examiner's position. The applicant is often left to wonder whether the examiner's disagreement pertains to the examiner's construction of claim terms; to the examiner's understanding of the invention or the disclosure; and/or to the examiner's understanding of the cited references. Such lack of information often prompts unnecessarily protracted examination and invocation of the *ex-parte* appeal process.

It is noted that only one review item of the Master Review Form addresses this issue:

Were all of applicant's arguments addressed in the Office action (whether examiner's position was correct or not) including arguments with respect to art still relied upon? Yes In-Part No N/A

However, this question is not well-drawn to the sufficiency of the office action in this regard. For example, reviewers may very well answer this question "Yes" even for the deficient reply noted above, since simply acknowledging the existence of the applicant's argument and indicating that it is "unpersuasive" may be construed as having "addressed" the argument.

Based on these observations, NAPP recommends a significant expansion of this portion of the Master Review Form to enquire about the examiner's responsiveness to the applicant's arguments.

Reservation #2: Reduced reliance on direct feedback from applicants.

The USPTO’s Data Visualization Center (“Dashboard”) includes a metric labeled: “External Quality Survey,” which is derived from “a “survey conducted semi-annually and solicit[ing] input from stakeholders who are frequent customers of the USPTO on their perceptions of examination quality.”

This metric has been the subject of interest by the patent community for several reasons. First, like the other metrics, the “External Quality Survey” is presented on a scale from 1 to 8, without any indication of the basis for such evaluation. Second, the contents of the survey were not of public record, and therefore difficult to evaluate the basis for serving as a generalized representation of the public perception of patent examination quality. Third, public information has been scant about which “frequent customers” are included in the survey. Inquiries to be included in such a survey were commonly submitted, but not publicly acknowledged.

Nevertheless, NAPP believes that direct customer feedback about patent examination quality is a rich source of information. Patent applicants, especially applicants that encounter a significant cross-section of the patent examining corps in a variety of technical areas, may possess perspectives about patent quality that may not be visible to internal review processes. For example, patent applicants may bear observations of the relationship between patent examination trends (such as claim styles that patent examiners are inclined to allow or reject) and the impact on resulting patent value, including the protection of such patents from validity challenges, the practical scope of patent enforcement, and patent licensing value.

Accordingly, it is NAPP’s opinion that the USPTO’s patent quality initiatives are well-served by incorporating direct customer feedback. Based on the Federal Register notice, it is unclear how the initiative to substitute the Master Review Form for the Quality Index Reporting applies to the collection of customer feedback via the External Quality Survey or another mechanism.

Based on these observations, NAPP recommends a continuation, and indeed expansion, of the collection of customer feedback in the measurement of patent quality. For example:

- Customer feedback should be collected more frequently – even on a continuous basis.
- Greater transparency should be provided about the composition of the customer feedback survey, such as the questions presented and specific aggregate results.
- The collection of customer feedback should be presented as part of the USPTO’s electronic services, possibly with incorporation in PAIR and EFS-Web.
- The collection of customer feedback should be expanded to include all applicants who wish to participate. Receipt of feedback from a large cross-section of applicants enables an analysis of how patent quality affects different types of applicants, such as large vs. small entities, and applicants from different areas of technology.

Request for Comments #2: How can patent metrics best provide objective, rather than subjective, measurements of quality-related features in clarity and correctness reviews?

Response:

NAPP recommends, as an additional signal to enhance the objectivity of examination quality metrics, an evaluation of applicants' decisions in response to office actions.

Rationale:

NAPP appreciates the challenge of developing metrics around decisions with an inherent component of deference, reflecting statutory processes and legal principles that rely upon the judgment of the reviewer.

The specific inquiries presented in the Master Review Form are well-targeted to factual questions, such as whether the examiner did or did not correctly cite legal support for various rejections, and did or did not follow the USPTO's indicated formulation for a prior art rejection. Many such inquiries may be subject to a degree of latitude – *e.g.*, whether an examiner “specifically” cited a portion of a prior art reference with respect to a claim element may be a matter of opinion – but more fine-grained answers that are consistent among reviewers may be difficult to ascertain through question-and-answer metrics.

However, a valuable source of information exists that does not appear to be included in the review process: the applicant's actions taken in response to the office action.

When examiners articulate a substantively valid rejection with due specificity and technical accuracy, the applicant is more likely to take actions that do not contest such rejection, including significant claim amendments, substantial claim cancellation, the filing of continuation-in-part applications, and intentional abandonment. Conversely, when examiners articulate a rejection that is deficient – *e.g.*, a rejection that is unclear, that expresses a technically incorrect summary of the claimed invention or the prior art, or that exhibits a defect of the *prima facie* case (such as an incorrect legal basis, or a citation of references that are disqualified as prior art) – applicants are more likely to remain steadfast, and to take actions such as traversing without amendment or invoking the *ex-parte* appeal process.

It is certainly appreciated that applicants also choose to act for other reasons. A legally flawed office action may prompt an abandonment due to the applicant's change of heart or financial pressures, while a strong office action may prompt an appeal from an applicant who is less familiar with principles such as broadest reasonable interpretation or claim construction. However, it is submitted that while an applicant's decision in a specific case may not be informative, *aggregated* metrics of applicants' responses may serve as a strong indicator of patent applicants' assessment of patent examination quality.

Based on these observations, NAPP recommends reviewing applicants' choices following to office actions as an additional, objective information source about patent examination quality.

Request for Comments #3: The USPTO welcomes comments on any and all areas of quality measurement. Suggestions for rephrased or additional quality metrics review items, especially quality indicators, are welcomed.

Response:

The following remarks are directed to the substance of the Master Review Form (MRF). Several of these observations derive in part from a group-based exercise involving a review of the MRF during the Patent Quality Community Symposium held on April 27, 2016. During this exercise, the USPTO presented a set of questions about the structure, clarity, and comprehensiveness of the MRF as a tool for gathering metrics about examination quality. Responses to selected questions are provided below.

Topic #1: Master Review Form (MRF) Level of Detail

Specifically regarding the format of the Master Review Form (MRF), it is suggested that more “granularity” be built into the responses available for the reviewer. For some review questions, the answer button format “yes”, “in part”, “no”, and “N/A” may be sufficient; however, NAPP suggests adding to the form answer buttons on a percentage basis, perhaps subdivided by 10% (100%, 90%, 80%, etc.).

Topic #2: 35 U.S.C. § 112(a) Written Description (MRF Review Items 37-41)

Regarding Review Item 37 (“Claim limitations rejected as new matter do not have support in the specification”):

NAPP suggests the addition of a sentence such as: “All other limitations presently recited in the claims find support in the specification (including the original claims).” This would promote certainty and compact prosecution. If the Examiner is using a certain interpretation of a claim term for written description analysis, this should be made of record.

Regarding Review Item 38 (“Specification fails to describe claimed invention in sufficient detail that one skilled in the art can conclude the inventor was in possession of the claimed invention”):

NAPP recommends the introduction of review item 38 with a statement, with answer buttons, regarding whether or not there was an attempted “written description of the invention” with the “as submitted” application, as called for by the statute (“The specification shall contain a written description of the invention...”). Otherwise, NAPP anticipates that some Examiners, knowing they must have a statement as worded in Question 38 in their office action in order to receive a higher score, may jump to the “conclusion” that there is insufficient detail in the specification, divorced from the claims.

Regarding Review Item 39 (“Does the office action clearly state that the rejection is based on the lack of written description?”):

NAPP suggests a modification of this question as follows: “Does the office action clearly state that the rejection of at least one claim is based on the lack of written description in the specification (which includes the original claims)?”

Regarding Review Item 41 (“Was the subject matter purported to be unsupported matter clearly identified and discussed?”):

NAPP recommends the inclusion of additional answer buttons, particularly for the “discussed” part of the question. For example, a reviewer would be forced to answer “yes” if the subjected matter purported to be unsupported matter was indeed clearly identified, but was not discussed at all, or discussed only with conclusory statements. For this reason, NAPP suggests supplementing this review item (for the benefit of the reviewer) as follows: “If no or only conclusory discussion statements are made by the examiner, the reviewer should answer “no”.

During the USPTO Patent Quality Community Symposium held April 27, 2016, the reviewing group expressed an interest in determining whether the Examiner has clearly identified on the record subject matter that is deemed to be supported, or has clearly stated that “all other claim terms are clearly supported.” Therefore, NAPP Recommends the addition of a Question 41A such as the following: “Was subject matter purported to be supported matter clearly identified, or a statement made that all other claim terms are clearly supported?”

Topic #3: 35 U.S.C. § 112(a) Enablement (MRF Review Items 42-48)

Regarding Review Item 42 (“The specification fails to describe the claimed subject matter in such a way as to enable one skilled in the art to make and/or use the invention”):

NAPP suggests changing “and/or” to “and”, as per the statute. Additionally, NAPP suggest adding a question 42A: “Was the art to which the claimed invention pertains, or with which it is most nearly connected, clearly identified?” as per the statute.

Regarding Review Item 43 (“The rejection made a proper prima facie case, including Wands factors discussion”):

NAPP suggests an annotation of this query to solicit further input about the Wands factors (noted in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) regarding undue experimentation. Such factors include:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Regarding Review Item 46 (“Was the lack of enablement sufficiently explained?”):

NAPP suggests a modification of this question as follows: “Was the lack of enablement sufficiently explained for all claim terms that were deemed lacking?” NAPP further suggests more granularity in the presented response options.

Topic #4: 35 U.S.C. § 112(b) Definiteness (MRF Review Items 49-59)

Regarding Review Items 51-54 and 56:

NAPP notes the description of these inquiries as including the term “vague.” However, “vague” in this context has no distinct legal meaning, and is synonymous with the term “indefinite,” which both relates to 35 U.S.C. § 112(b) and is included in the review items. As such, the term “vague” is redundant and perhaps confusing, and NAPP therefore recommends its removal.

Regarding Review Items 51-52, regarding relative terminology in the form of terms of degree and/or subjective claim elements:

NAPP believes that both items may be reformulated as a series of more specific that provide more detail about the treatment of terms of degree. For example, Review Item 51 may present a series of inquiries such as the following:

51A. Terms of degree in the claims were identified. “yes”, no”, “N/A”

51B. For identified terms of degree, the office action indicates the prior art was searched, and a record made whether prior art does or does not provide meaning for every term of degree identified. “yes”, no”, “N/A”

51C. For identified terms of degree that the search found no meaning in the prior art, the office action states whether or not the specification states the meaning that the term of degree is intended to have. “yes”, no”, “N/A”

51D. For identified terms of degree where neither the prior art nor the specification provides meaning, the term is deemed prima facie indefinite. “yes”, no”, “N/A”

Regarding Review Item 58 (“Did the examiner clearly state which limitation(s) does not meet 112(b)?”):

NAPP believes that this review item may further enquire whether the examiner has clearly identified, on the record, subject matter that the examiner has deemed definite. Alternatively, NAPP recommends the inclusion of a standard, positive statement that all subject matter not specifically identified in a 35 U.S.C. § 112(b) rejection is deemed sufficiently definite. NAPP therefore recommends a supplemental Review Item 58A, such as the following: “Was definite subject matter clearly identified, or a statement made that all other claim terms are definite?”



This concludes the comments of the National Association of Patent Practitioners regarding the request for input on the topic of improving patent quality metrics. NAPP thanks the USPTO for the opportunity to provide input, and hopes that these remarks facilitate the efforts of the USPTO in this endeavor.

Signed,

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