

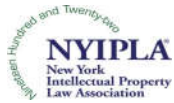
Inside View for Working with the USPTO

November 13, 2019

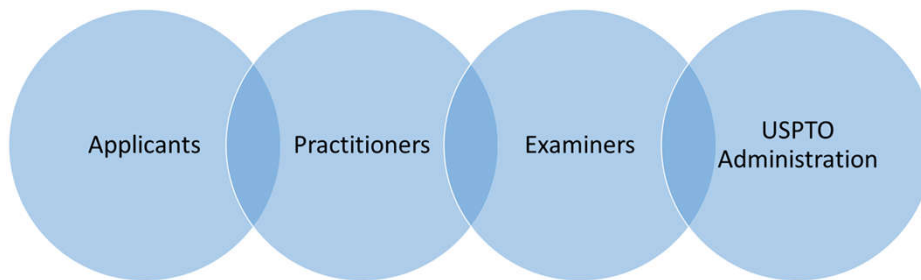
Panelists: Elana Araj, Associate, Greenberg Traurig LLP
Andrew Berks, Founder, Berks IP Law LLP
Stefanos Karmis, Director of the Office of Patent Quality Assurance, USPTO

Moderator: Jonathan Berschadsky, Partner, Merchant & Gould PC

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The Players



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UNITED STATES
PATENT AND TRADEMARK OFFICE



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Assuring Quality Patents

Stefanos Karmis
Director, Office of Patent Quality
Assurance



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Optimizing patent quality

- Initiatives that support the issuing of high quality patents:
 - Increase examiners' ability to locate prior art
 - Improve content, delivery, and timeliness of technical and legal training
 - Leverage patent quality data for improvements

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Quality patents

- Patents that are issued in compliance with all requirements of Title 35 of United States Code as well as relevant case law
- Can withstand post-grant challenges that may arise

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Application quality

- Filing a high quality application helps examiners with their search and overall prosecution quality
- Application readiness studies
 - Attributes integral to the patent application file that enhance the ability of examiners to efficiently and effectively navigate through examination



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Phase I: Identify patent application attributes critical to examination

- Examiner perception survey (850 responses)
 - Identified application attributes that examiners felt best enhance their ability to efficiently and effectively navigate through examination
- Attributes measured on scale of 0 to 10
 - Importance (need) scale ranged from
 - “Not Necessary” (0) to “Always Essential” (10)
 - Frequency (experience) scale ranged from
 - “Almost Never” (0) to “Almost Always” (10)



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Summary of findings

Top Needs

		Need	Experience	Gap
Specifications	Having the inventive concept clearly set forth	8.07	5.06	3.0
	Having the specification clearly describe the referenced features in the drawings	7.89	6.88	1.0
	Having the Drawings show the inventive concept	7.83	5.94	1.9
	Having the "Detailed Description of the Invention" expand on the invention disclosed in the "Summary"	7.59	7.07	0.5
	Having the preferred embodiments described in detail	7.43	6.07	1.4
	Using clear terms and correct grammar and syntax	7.74	5.50	2.2
Claims	Having claims that are clear and correct in syntax and grammar	8.76	5.85	2.9
	Having independent claims that capture the same inventive concept disclosed in specification	8.59	4.77	3.8
	Having claim terminology that is highly correlated with language disclosed in the specification	8.23	5.92	2.3
	Having claims that are solely directed to the inventive concept (not broader than the inventive concept)	7.45	3.08	4.4
	Having a reasonable/manageable number of claims	8.74	4.97	3.8
IDS	Having all citations in IDS in English (translations are provided with submission)	7.53	3.91	3.6
	Having a reasonable/manageable number of references cited in IDS	7.88	5.37	2.5



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Phase II(b): Diagnostic interview pilot

- Examiners identified applications in which a diagnostic interview would help clarify misunderstandings and facilitate a more focused search
- Readability data of the claims and specification of applications in the pilot were analyzed for trends



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Improving search

- Increase examiners' ability to locate prior art
- Challenges to locating prior art
 - Ever-accelerating publication of prior art
 - Many ways in which prior art can be accessed

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Training and resources

- Provide examiners with additional training specific to searching
 - Global Dossier
 - Non-patent literature
- Provide additional resources for examiners to get assistance
 - Search experts and trainers
 - Feedback on searches and located prior art

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Pilots focused on search

- Peer Search Collaboration Pilot
 - Paired examiners each independently search an application
- International Search Pilots
 - Collaborative Search Pilot
 - PCT Collaborative Search & Examination Pilot



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Training

- The USPTO continues to develop training for both examiners and external stakeholders, based on
 - Data from quality reviews
 - Feedback from internal and external stakeholders
 - Customer perception surveys
 - Changes in law
- Examination guidance and training materials can be found on USPTO website in the [Examiner Training Materials](#) section



¹⁴ [*www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials](http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials)

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Examiner training

- New examiners
 - Patent Training Academy
- Experienced examiners and managers
 - Legal training
 - Some may be mandatory
 - Masters and refresher classes



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Stakeholder training of examiners

- Patent Examiner Technical Training Program (PETTP)
 - Opportunity for experts from industry and academia to voluntarily provide technical training and expertise to patent examiners in-person or virtually from their location
- Site Experience Education (SEE)
 - Opportunity for commercial, industrial, and academic institutions, within the continental U.S., to voluntarily host patent examiners



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Training opportunities for stakeholders

- **Stakeholder Training on Examination Practice and Procedure (STEPP):**
 - 3-day in-person training on introductory patent examination practice and procedure in a workshop setting derived from training delivered to new USPTO examiners
- **Virtual instructor-led training (VILT)**
 - Short training on one or more focused topics related to examination practice and procedure derived from recent training delivered to experienced USPTO examiners
- Courses are free to attend and are led by USPTO trainers
- CLE credit may be available; generally in the state the course is delivered.

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Chats with stakeholders

- **Patent Quality Chat series**
 - Webinar format with a focus on providing information on patent quality topics and gathering input on a regular basis
- **Inventor Info Chat series**
 - Hosted by the Office of Innovation Development
 - Webinar with a focus on providing inventors with relevant information on topics that assist with applying for a patent

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Patent quality data

- Random reviews of examiner work product
- Ad hoc reviews and case studies
- Process data
- Customer perceptions of examination quality
- Examiner perceptions of quality environment



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Office of Patent Quality Assurance (OPQA)

- Provides assessment and analysis of quality at the USPTO through work product reviews
 - Organization consists of approximately 65 reviewers (RQAS) organized by technical discipline
 - Review work product using a review form which includes over 300 inquiries
 - Data is collected from the completed reviews.



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Statutory compliance

- Each review assesses an office action's "compliance" with respect to each statutory basis under 35 USC § 101, 102, 103, and 112
- To be "compliant":
 - Non-final or final action, all claims must:
 - Contain only properly made rejections and
 - Not omit any rejections that should have been made
 - Allowances must not omit any rejections that should have been made



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Quality metrics

- Process data
- Perception data
 - External
 - Internal



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Use of quality data

- Facilitates our quality metrics
- Enables the USPTO to identify quality trends and focus on areas for improvement
- Used to track impacts from case law and training
- Steers the development of training curriculum
- Provides technology centers with analytics to construct their quality action plans



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Questions and comments

Please send questions or comments to:

PatentQuality@uspto.gov




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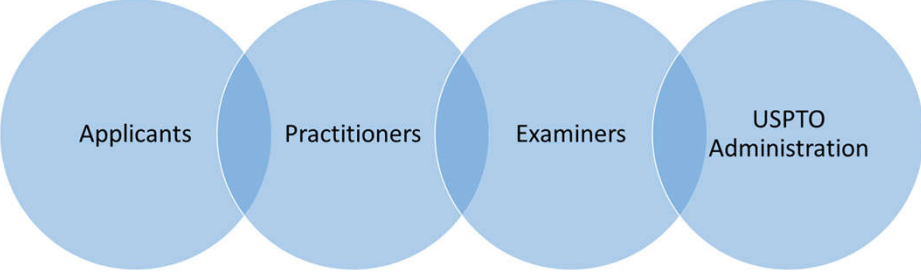
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 **NYIPLA**
New York
Intellectual Property
Law Association

The Players



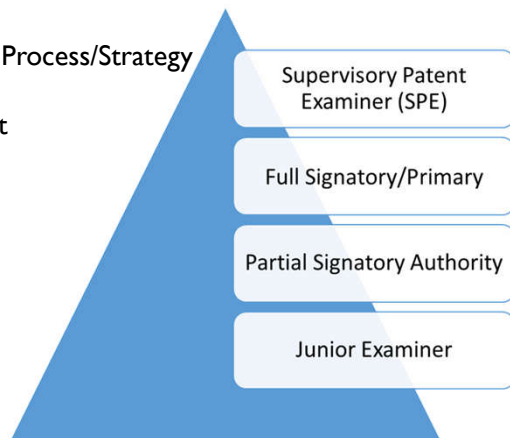
Applicants Practitioners Examiners USPTO Administration

New York Intellectual Property Law Association (NYIPLA) 26

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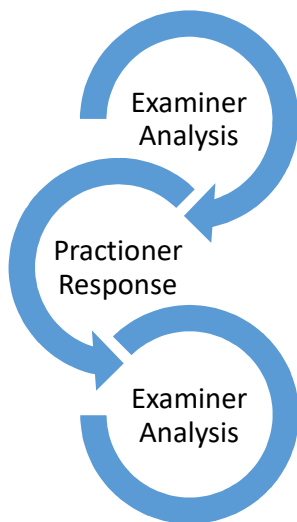
Examiners/Practitioners

- Typical Process/Strategy
- Tools
- Mindset



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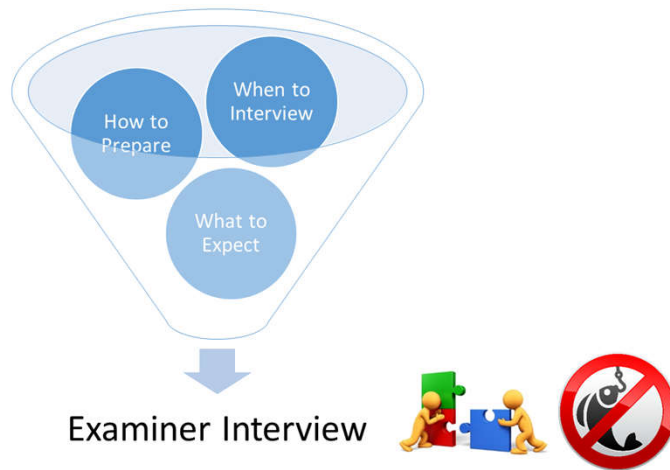
Office Actions



John McEnroe antics: News, courtesy BBC

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Examiner Interviews



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USPTO Administration



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