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March 8, 2010

By Email: patent_quality_comments@uspto.gov
Mr. Kenneth M. Schor and Mr. Pinchus M. Laufer
United States Patent and Trademark Office
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Re: Comments on Enhancement in the Quality of Patents, in response to requests for comment at 74 Fed. Reg. 65093 (December 9, 2009), the period for comments having been extended to March 8, 2010 at 75 Fed. Reg. 5040 (February 1, 2010)

Dear Mr. Schor and Mr. Laufer:

The Boston Patent Law Association (BPLA) thanks the U.S. Patent and Trademark Office (USPTO) for the opportunity to comment on the USPTO's project related to enhancing the overall quality of patents (hereinafter "Project").

The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws in the Boston area. These comments were prepared with the assistance of the Patent Office Practice Committee of the BPLA. These comments are submitted solely by the BPLA as its consensus view. The stated arguments, contentions, or positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member.

We appreciate the effort that is involved in the USPTO's undertaking the Project, and applaud the USPTO in the Project's stated objectives "to improve the quality of the overall patent examination and prosecution process, to reduce patent application pendency, and to ensure that granted patents are valid and provide clear notice." 74 Fed. Reg. 65093. We acknowledge the benefits to the public, as well as examiners, patent practitioners, and applicants of achieving these objectives, and offer the following comments to assist the USPTO in achieving these objectives. Our comments are organized into the categories suggested by the USPTO.

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I. Quality Measures Used

In some areas, BPLA members note a general improvement in recent years in the quality of the art cited and the thoroughness of the examiner's initial Action. In other areas, members' experiences suggest that the quality of initial examination may have declined. The following suggestions for additional quality measures are presented:

1. Benchmark against other leading Patent Offices

The methodology of benchmarking, which has been successfully applied in corporations, entails identifying problem areas, identifying another leading patent office, interacting with the other leading patent office to determine "best practices," determining how to adopt those practices, and implementing the improved practices. Benchmarking can also be used to develop quality metrics.

Some of the identification of potential problem areas has already occurred in the Allowance Compliance Review and In-Process Review that the USPTO described in its Request for Review. We recommend that the USPTO also consider benchmarking against the operations of the European Patent Office. This would also comport with current trends towards harmonizing patentability standards worldwide and promoting worksharing among the world's patent offices.

The main problems of the benchmarking process are the time and cost involved. However, the results of the benchmarking process could provide useful insights to achieving improved quality and pendency.

2. Make USPTO data available

The best way to allow the public to help evaluate the quality of the USPTO's current quality metrics is to make the data available. The USPTO should make available the Office Actions that were evaluated and the scoring and evaluation sheets that were developed in response. Similarly, the USPTO should make available applications that were called back by Allowance Quality Review and the following Action. The samples should be large enough that no examiner will feel singled out.

II. Stages of Monitoring

In its Request for Comments, the USPTO indicated that it is considering monitoring quality at the following stages of prosecution of a patent application:

- (1) When the application is filed in the USPTO;
- (2) when the initial search for the application has been completed;
- (3) when the first Office Action for the application has been completed;
- (4) when an interview for the application has been conducted;

- (5) when a reply to the first or any subsequent non-final Office Action has been filed;
- (6) when an Office Action (non-final or final) or notice of allowance in response to a reply to a non-final Office Action has been completed;
- (7) when an after-final submission has been filed; and
- (8) when an appeal brief or other appeal-related paper has been filed.

While expressing agreement with the stages outlined in the Request for Comment, we think that the USPTO is probably in the best position to decide the adequacy of the stages of monitoring quality outlined in the Request for Comment. However, we note that increasing the quality of the earlier stages from the filing of the application to the completion of the First Office Action can have a significant effect on quality and on pendency. Further, we think that conducting an interview after the First Office Action can have a significant effect on quality and on pendency. Also, the Initial Review of the Appeal Brief provides, similar to the Pre-Appeal Brief Conference, an opportunity for a focused review of areas that need improvement in the examination process. Furthermore, improved quality assurance prior to the Appeal Brief ideally would lead to the need for fewer pre-Appeal Brief Conferences resulting in returning the application to prosecution.

Regarding Feedback from the USPTO, while a quality measure reported to the public could be useful, it is probably more important that, at each stage, the significant stakeholder be apprised of the quality measure and the quality comments; for example, quality comments back to the applicant after initial review of the application and quality comments back to the examiner after review of the initial search and first Action.

1. Analyze results of Pre-Appeal Brief Conferences and Appeal Brief Conferences

We recommend using the Pre-Appeal Brief Conference and Appeal Brief Conference as formal quality check points, with formal collection, analysis, and compilation of quality analysis of the rejections presented for review. This seems to be a point at which the USPTO could collect a rich source of data into examination delays at low cost—the per-case analysis is done, all that needs to be done is to collect it into a form that permits broader analysis.

While these results from the appeal process may be skewed in the sense that there is already an indication of disagreement between the applicant and the examiner, and in the sense that some worthy applications in which there are legitimate areas of disagreement may not enter the appeal stage for lack of funding, the Request for Review operates as an executive summary of the outstanding areas of dispute in the prosecution of an application. The follow-on Decision on the Request is also a summary of the issues. Thus, the results of the Pre-Appeal Brief Conference Pilot program can provide a focused view of areas of prosecution in need of improvement. Possible inquiries include:

- whether the rejection was procedurally complete—did the examiner make all the showings required by the relevant section of the MPEP? Did the examiner answer all

material traversed? Did the examiner provide supporting evidence for all points on which the examiner bears the prima facie burden of proof?

- whether the rejection reflected a correct understanding of the technology recited in the claims and shown in the prior art.

2. Focus on the quality of the prior art search, the first Office Action, and the interview.

In its Request for Comments, the USPTO identified a number of areas where quality can be monitored and potentially improved. Although all the areas listed in the Request for Comments contribute to quality and pendency, the following areas may contribute more significantly to quality and pendency:

- the prior art search has a significant impact on quality and pendency since it presents to the applicant the most relevant prior art;
- the first Office Action has a significant impact on quality because a failure to properly identify areas of concern, in terms of breadth of coverage of the claims, can result in ambiguities and inconsistencies, and it has a significant impact on quality because any ambiguities and inconsistencies presented therein can lead to delays in prosecution;
- an interview has a significant impact on quality and pendency because it properly provides an opportunity for obtaining an understanding of the issues and potential resolution, and it can expedite prosecution.

The quality of the prior art search can be measured, for example, by 1) identifying the frequency of occurrence of new references not cited in the first Office Action, and 2) (where applicable) identifying the correlation (same art cited) between the prior art search and a PCT search conducted by a different authority, or other corresponding international searches, e.g., by the European Patent Office for a corresponding European application. In particular, the presentation of new references not cited in the first Office Action should be monitored and discouraged, except where it is required in view of amendments presented after the first Office Action. Repeated presentation of new prior art after the first Office Action can greatly increase pendency and frustrate the process of expeditiously focusing the claims on allowable subject matter.

As for the first Office Action, and as discussed below, the quality of the first Office Action could be monitored and improved by an expansion of the First Action Interview Pilot program. As noted above, conducting an interview after (or even before) the first Office Action can have a significant effect on quality and pendency. We support efforts to encourage, as well as monitor and enhance the quality of examiner interviews early in prosecution.

III. Category 3—Pendency

We firmly believe that the quality of the prosecution and examination of the application and quality of the resultant patent can be improved at the same time as the overall pendency of an application is reduced. The goal of compact prosecution is not inconsistent with the goal of high patent quality, but is more easily achieved when quality is pursued by both examiner and applicant.

However, we note that application pendency before first Action has grown worse and now averages over three years. It is our opinion that the filing of continuation applications or voluntary divisional applications has less impact on pendency than the quality of the early stages of prosecution and examination. A good initial search of the prior art, a well focused first Office Action and a productive interview can lead to early and crisp resolution of the patentability issues resulting in a reduced pendency and a quality patent.

Toward both goals of reduced pendency and increased quality, we provide the following suggestions:

A. Vigorously enforce 37 C.F. R. § 1.104(c)(2).

37 C.F.R. § 1.104(c)(2) requires, “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” We recommend that 37 C.F. R. § 1.104(c)(2) be thoroughly enforced, and compliance monitored as part of quality monitoring.

1. Cite the best reference and make the best rejections immediately.

Patent prosecution before the U.S. Patent Office is conducted under a policy of compact prosecution. Under this policy, prosecution of an application is generally designed to conclude with the Examiner’s consideration of one response to one non-final Office Action. That is, a second Office Action, responding to an applicant’s reply to a first Office Action, is usually final, unless an applicant places the application in condition for allowance. Stated goals of this policy of “compact” prosecution are to provide applicants with prompt and complete examination of their applications. To achieve these goals, the policy imposes specific obligations on Examiners.

As the Office has explained, “[t]he Office’s policy of compact prosecution requires that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability expeditiously.” (Official Gazette of 07 November 2003). A first Office Action on the merits should ordinarily identify every issue that stands between the applicant and allowance of the application. (See The Manual of Patent Examining Procedure (MPEP) §707.07(g)).

And, the Office Action should do so by presenting the best case against patentability. (See, for example, MPEP §§2164.04 and 2106 II). In theory, this provides an applicant with the opportunity to respond to each issue so that, if each issue is successfully rebutted or otherwise addressed, the application would be condition for allowance. Conversely, if the applicant is not successful, the

application should be in condition for appeal. A failure to provide the best case such that a new rejection, new art, and/or expanded arguments are required in a subsequent Office Action generally precludes the finality of that subsequent Office Action (See MPEP §706.07(a)). In practice, this can result in piecemeal prosecution of the application, which the MPEP instructs should be avoided. (MPEP §707.07(g)).

In the experience of at least some BPLA members, applicants often find themselves spending time and money addressing incomplete first Actions. For example, applicants may need to overcome broad rejections under 35 U.S.C. § 102 in the first Office Action, only to face a more specific, more carefully targeted rejection under 35 U.S.C. § 103 in the second Office Action, which has now been made final. BPLA members have been told by some examiners that they are instructed to hold back the best art—while we cannot confirm that that is indeed what the examiners were told, it appears that this is at the very least a misunderstanding that should be corrected.

We are pleased to note that, in almost every conversation on the subject with examiners and supervisory patent examiners (SPEs) today, reference is made to the goals of “compact prosecution.” Whereas even nine months ago, it appeared that applicants’ duties of compact prosecution (rather than examiners’ duties) were emphasized, the treatment today seems to be more even handed. The fact that the examiners are focusing on compact prosecution means that the Office’s message regarding pendency is being received. If examiners understand that the first Office Action must be complete or the second Action will not close prosecution, then examiners will be strongly incentivized to give a complete and precise examination in the first Action.

We also recommend that the USPTO consider ways in which to encourage examiners to make the rejections or objections of appropriate scope earlier in the prosecution of an application. 37 C.F.R. § 1.104(c)(2) requires that “the examiner must cite the best references at his or her command.” In some cases, this might imply that a first Action that raises a rejection under 35 U.S.C. § 102 also consider combinations with other art under 35 U.S.C. § 103. The Office should encourage examiners to communicate *all* their best thoughts to applicants as early as possible.

Further, in some instances additional detail about the pertinence of a reference would lend clarity to a rejection. The pertinence of a reference may not be apparent on its face, such that additional explanation is appropriate and required by 37 C.F. R. § 1.104(c)(2). Also, now that a significant number of pre-grant publications are cited as references in Office Actions, it may enhance the quality and clarity of rejections to provide detail as to which particular portions of a paragraph are relevant, rather than simply citing to a paragraph number of a published application.

2. Enforce correct examination practices.

The following are a few examples of common examination practices that, when carried out correctly, can greatly enhance patent quality and also reduce pendency. Some BPLA members are currently observing inconsistent quality in these areas, suggesting potential opportunities for improvement.

First, instruction and guidance given to Examiners should emphasize the importance of considering each claim as a whole, giving weight to every limitation, as well as the interconnections and relationships among claimed elements.

Second, we recommend that the USPTO could provide more detailed training and guidance to the Examining Corps on the proper use of Official Notice and Finality of Office Actions. We recommend that the USPTO provide more specific guidelines as to how to use Official Notice and when to make actions final, including providing more examples as to when Official Notice and finality are and are not appropriate.

We further recommend that SPEs reviewing Office Actions place particular emphasis on whether correct examination practices have been followed in these areas.

B. Increase the number of examples and case citations in the MPEP.

The MPEP is a robust document that provides significant guidance to examiners and applicants alike. In addition, because it applies the laws and rules governing the USPTO, the MPEP is a practical document that includes multiple examples which provide clarification to various hypothetical situations.

However, the MPEP is not uniform in its use of examples. For example, Section 2106 of the MPEP currently provides examples of claim language that do and do not constitute statutory subject matter. Providing additional examples like those in section 2106 in a variety of sections of the MPEP would be useful to examiners, practitioners and applicants. Such examples would help to promote consistent interpretation and application of the examination instructions, thus streamlining rejections, reducing the burden and cost of response and appeal on the applicants and potentially reducing the current backlog at the Office.

Without examples, examiners may be left with insufficient guidance to make important judgments, and applicants may be compelled to make abstract arguments rather than to construct specific arguments based on analogies to sections of the MPEP. Providing concrete examples and additional text may result in a more efficient and faster examination process, and reduce the number of appeals. Accordingly, we recommend including as many examples as possible in the MPEP to facilitate clarification.

In addition, we recommend increasing the number of case citations in the MPEP. For example, the USPTO's Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101 lack citations to the Court and Board decisions from which the law of subject matter eligibility springs. Citations to the case law would make it easier to fully understand the statements of law made in the Interim Instructions and, put the statements into appropriate context. This would make it easier for examiners to properly interpret the Interim Instructions and render appropriate rejections.

Including citations to the relevant court and Board decisions will allow examiners, practitioners, and applicants alike to understand instructions in more depth, as well as to put instructions into appropriate context.

If the omissions of citations or examples in the text of the MPEP arise from a concern that the MPEP would become too detailed or too long, we suggest promulgating two versions of certain sections of the MPEP, in much the same way that the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005) were promulgated. A comprehensive version of the section (annotated, with citations, and having numerous examples) could be available on the USPTO website, and a condensed version of the section could be published as the printed MPEP.

C. Provide balanced guidelines under 35 U.S.C. § 103.

In order to improve the Examination process, with the goal of improving both patent quality and pendency, we recommend that the Patent Office Guidelines providing rationale to support rejections under 35 U.S.C. § 103 be revised. The USPTO issued a set of guidelines for the examiner's consideration in view of the Supreme Court Decision in *KSR International v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). These guidelines are directed to a list of seven rationales to support a rejection under 35 U.S.C. § 103. Such rationales were alluded to in the *KSR* decision and are provided as an aid to examiners.

Since the present guidelines are directed to rationales for supporting rejection under 35 U.S.C. § 103, we recommend that the USPTO amend the guidelines to also include a separate set of criteria entitled something like "Rationale to Support Allowance Under 35 U.S.C. § 103." This separate section may be directed to a non-exclusive list of specific criteria supported in present law that the examiner may consider in determining when allowance of claims is in order under 35 U.S.C. § 103. This will place the document in a proper balance and provide in one document an outline of the USPTO's suggestions for the examiner's consideration in evaluating patentability of claims under 35 U.S.C. § 103.

D. Identify enumerated species claims groupings in restriction/election practice.

Many BPLA members have perceived that the USPTO has been relying more on restriction/election practice in recent years as a means of reducing the number of claims which may be examined in a given application. This reliance may grow particularly in the wake of the USPTO's recent abandonment of the proposed rules designed to restrict the number of claims filed in a given application and number of follow on continuation applications. In many applications, for example, in chemical cases, the Office often requires provisional election of claimed species in addition to election of claim groups. While the election choices for claim groups in a restriction requirement are usually clearly given, some BPLA members have experienced that the election requirement as to species may often be more vaguely worded. To promote clarity and efficiency of the prosecution process, the applicant should in every instance be given clearly enumerated species and claims groupings to choose from, so that it is clear which election choices with respect to species the examiner has in mind. Further, some examiners have provided a restriction/election Office Action, and then provided a species restriction for the elected invention group as a separate Office Action after an invention has been elected. Examiners should be strongly encouraged to provide the species restriction for each invention group with the first restriction Office Action.

This is another instance where quality control monitoring may also be appropriate and productive.

E. Encourage more examiner suggestions as to how to advance prosecution

In order to reduce application pendency and promote more efficient examination of the Application, we recommend that the PTO officially encourage examiners to take the initiative where appropriate in communicating suggestions to the applicant on how to advance prosecution.

In typical prosecution, claims are either rejected or allowed. With respect to rejected claims, the examiner does not usually reveal his or her own leanings as to which claims may stand a better chance of allowance if the applicant were to submit additional persuasive arguments directed particularly at those claims. Such examiner input could lead to a more efficient examination process and also improve patent quality.

In addition, we recommend that examiners be encouraged to take the initiative where appropriate in providing additional input to the applicant as to how to advance prosecution, including suggesting possible amendments to claims. The initiative could include providing the input in both Office Actions and during Interviews. This could be part of the above-mentioned policies encouraging interviews early in the examination process to streamline prosecution.

As a general matter, BPLA concurs with a statement that Director Kappos made at a breakfast meeting in Boston on January 26, 2010: “interview early, interview often.” BPLA believes that the most valuable interview would be early in prosecution, possibly even before first action, to discuss the invention to be claimed. In many cases, the examiner can raise a “red flag” issue to which the applicant can file a preliminary amendment before the examiner invests more than an hour or two. In many cases, the applicant can direct the examiner’s attention to the most important claim language.

A policy shift to examiners providing input to advance prosecution could reduce the adversarial nature of the examination process and provide applicant and attorney with a sense of the examiner’s inclinations which are not normally apparent in the typical prosecution of a patent application. This can lead to a more efficient examination process and also improve patent quality.

In addition to interviews, one manner of providing examiner input regarding how to advance prosecution could be to add a new section of an Office Action to contain the input. For example, a new section headed “Additional Examiner Comments” could be attached at the conclusion of the Examiner’s Reasons for Rejection. In such “Additional Examiner Comments,” the examiner may provide the examiner’s own present thinking about the patentability of the subject invention and provide comments about possible claim amendments to further prosecution. For example, the examiner could indicate that, while the bases for rejection may persist and the examiner gives no assurance of allowance, the examiner nevertheless would be disposed towards a renewed focus on certain dependent claims (or specifically amended claim sets) provided that applicant’s next supporting arguments for patentability of those claims can be made persuasive.

Such comments would give the attorney an inkling of the examiner's own present thinking of what he/she may likely allow, although those claims presently stand rejected. It would not prevent the applicant from trying to obtain allowance of broader claims in the next Response, but would provide an indication of the claim scope that might be obtained most expeditiously.

Similarly, in the "Additional Examiner Comments," the examiner could propose an interview with the applicant with respect to certain designated claims or claim sets. In the interview itself, the examiner could, for example, indicate that he/she would focus on such amendments with specificity in the next Action, and that allowance may or may not follow depending on the persuasiveness of the applicant's arguments in support of the amendment.

We note that MPEP § 706 already encourages similar types of action by examiners, and would welcome more widespread use of this practice.

IV. Category 4—Pilot Programs

In its Request for Comments, the USPTO requested comment on the effect on patent quality and examination quality resulting from pilot programs such as Peer-to-Patent, Pre-Appeal Brief Conference Pilot, First Action Interview Pilot, and the Continuing Education for Practitioners (CEP) Pilot.

Without taking away from the benefits of the Peer-to-Patent and the CEP Pilots, we particularly encourage the USPTO to continue the First Action Interview Pilot program. The First Action Interview Pilot program has proven to be a useful tool in identifying the examiner's present thinking on the allowability of pending claims and thus aiding in reducing pendency and increasing patent quality. The First Action Interview Pilot program is a significant step in the right direction toward compact prosecution.

We also strongly encourage the USPTO to continue the Pre-Appeal Brief Conference Pilot program, which has proven to be effective in quick resolution of outstanding disputes in the examination of an application. In particular, the Pre-Appeal Brief Request for Review, with its five-page limitation, is a useful summary of the disputes and focuses the outstanding issues. However, as noted above, a focus on improving quality earlier in the prosecution process is preferable to resolving issues at the immediate pre-appeal brief stage.

We also recommend that the Office consider changing the constitution of the three-person panel for the Pre-Appeal Brief Conference. At present, the panel includes the Examiner, his or her SPE, and one new SPE. In the frequently occurring case where the Examiner is junior, the Examiner's SPE has already signed off on the last Office Action for the instant application. Therefore, only one panel member is neutral to the prosecution. We recommend that the panel include an additional neutral party, for example, consisting of the Examiner and two SPEs who have not been involved in the prosecution of the instant application or any related applications.

We believe that expanded or continued First Action Interview Pilot programs and Pre-Appeal Brief Conference Pilot programs can have a significant effect in expediting prosecution (reducing

pendency), providing a view on the quality of examination, and potentially resolving issues identified in the quality of examination. We enthusiastically suggest expanding both of those pilot programs.

V. Category 5—Customer Surveys Regarding Quality

In its Request for Comments, the USPTO requested input on customer surveys. We applaud the USPTO in wanting to obtain input from its applicants, and look forward to providing input in response to future surveys.

We believe that future USPTO surveys should ask questions that focus on the substance of applications, prosecution, and the quality of the final product (the issued patent). The surveys should solicit meaningful answers that identify the kinds of issues that create costs in time and money for the Office and for applicants, and that guide attention to areas where quality can be improved.

We recommend that the questions be specific as to the practices of the examining corps in examining applications and the practices of the USPTO staff in administering the USPTO. Some possible topics for survey questions include whether, in applicants' experience, examiners are consistently following the guidelines set out in the MPEP for rejections under §§ 101, 102 and 103 (including inherency, official notice and examiner's personal knowledge), 112 and double patenting.

VI. Category 6—Tools for Achieving Objectives

In its Request for Comments, the USPTO requested input on the tools that could be made available to users and the USPTO to enhance the quality of the USPTO's processes. The BPLA recommends that the USPTO consider developing links within its own document management system and with the document management systems of other nation's and regional patent offices to streamline citation of references, office actions, and search reports.

The current Information Disclosure Statement procedures that applicants must follow, requiring the compilation of search reports, references, and office actions from various related prosecutions, can become onerous, especially when a family of applications is filed to obtain protection for a major research project. In addition, the timing of an applicant's IDS submissions can cause applicant to lose PTA or file unwanted RCEs.

The BPLA recommends a "tool" that allows the applicant to identify/link to related cases (US or foreign) that have prosecution histories of possible interest to the examiner. With such a tool, the required submission of search reports, references, and office actions from related prosecutions would be streamlined, and the information needed by an examiner would be efficiently provided.

VII. Category 7—Incentives

In its Request for Comments, the USPTO requested input on the types of incentives that it could use to promote its goals. We recommend, above all, tying compensation and advancement of examiners to compliance with correct examination practices and cooperative, high quality, compact, and speedy prosecution. In particular, we recommend tying compensation and advancement to the extent to which the examiner consistently applies correct examination practices and takes the initiative

where appropriate in providing additional input to the applicant/attorney as to how to advance prosecution, including promoting interviews with applicants and suggesting possible amendments to claims.

Available incentives should be structured to encourage examiners to correctly examine completely in the first action, including clearly grouping and restricting claims, citing the best references and making the best rejections immediately, properly explaining the pertinence of the references, and taking the initiative to advance prosecution.

The USPTO may also consider having the examiner periodically report to his or her peers the activities taken in various prosecutions to reduce issues, help to resolve conflict, and expedite prosecution. The reports could describe actions taken in written communications or during applicant interviews. Such proactive efforts may be considered and rewarded during the examiner's annual review process.

Thank you for consideration of our comments.

Sincerely,

Boston Patent Law Association

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