17th Annual Berkeley - Stanford Advanced Patent Law Institute

Perspectives from the USPTO

December 9th, 2016

John Cabeca
West Coast Regional Director
United States Patent and Trademark Office
Agenda

• 2016 Year in Review
• Enhancing Patent Quality
• Subject Matter Eligibility
• Open Data Portal
FY 2016 Patent Filings

608,555 Utility, Plant & Reissue

+ 5.1% over FY 2015

+ 1.6% Serialized over FY 2015

75% Large  21.8% Small  3.2% Micro
Unexamined Patent Application Inventory
FY 2011 – FY 2016

FY 2015 Result: 553,221.

537,655 Unexamined Applications in FY 2016.
First Action Pendency and Total Pendency
FY 2011 – FY 2016

FY 2016 Total Pendency: 25.3 months.
FY 2016 First Action Pendency: 16.2 months.
Enhancing Patent Quality

Update on Pilots and Initiatives
Patent Quality Pillars

Pillar 1 – Excellence in Work Products

Pillar 2 – Excellent in Measuring Patent Quality

Pillar 3 – Excellence in Customer Service
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 (P3)
- Reevaluate QPIDS
- Design Patent Publication Quality
Quality Metrics Redefined

<table>
<thead>
<tr>
<th>FY 2011 – FY 2015</th>
<th>Moving Forward</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Final Disposition Compliance</strong></td>
<td><strong>Product Indicators</strong></td>
</tr>
<tr>
<td><strong>In-Process Compliance</strong></td>
<td><strong>Master Review Form</strong></td>
</tr>
<tr>
<td><strong>First Action (FAOM) Review</strong></td>
<td>Capturing both correctness and clarity of examiners’ final work product using uniform criteria gathered in a single database</td>
</tr>
<tr>
<td><strong>Search Review</strong></td>
<td><strong>Process Indicators</strong></td>
</tr>
<tr>
<td><strong>Quality Index Reporting (QIR)</strong></td>
<td><strong>Transactional QIR</strong></td>
</tr>
<tr>
<td><strong>External Quality Survey</strong></td>
<td>Tracking the efficiency and consistency of our processes (for example, to identify “churning”)</td>
</tr>
<tr>
<td><strong>Internal Quality Survey</strong></td>
<td></td>
</tr>
<tr>
<td><strong>Composite Score</strong></td>
<td><strong>Perception Indicators</strong></td>
</tr>
<tr>
<td></td>
<td><strong>Survey Results</strong></td>
</tr>
<tr>
<td></td>
<td>Continuing to internally and externally poll perceptions of patent quality</td>
</tr>
<tr>
<td></td>
<td><strong>Composite Score</strong></td>
</tr>
</tbody>
</table>
Clarity of Record Pilot
Goals

Enhance Clarity of Prosecution Record

Use Data/Feedback to Assist Other Programs

Find Correct Balance for Appropriate Recordation

Identify Examiner Best Practices
Clarity of Record Pilot - Areas of Focus

- More detailed interview summaries
- Enhanced documentation of claim interpretation

<table>
<thead>
<tr>
<th>Special definitions of claim terms</th>
<th>Optional language</th>
</tr>
</thead>
<tbody>
<tr>
<td>Functional language</td>
<td>Non-functional descriptive material</td>
</tr>
<tr>
<td>Intended use or result (preamble and body of claim)</td>
<td>Computer-implemented functions that invoke 35 U.S.C. §112(f) (&quot;specialized&quot; or &quot;non-specialized&quot;)</td>
</tr>
<tr>
<td>&quot;Means-plus-function&quot; (35 U.S.C. §112(f))</td>
<td></td>
</tr>
</tbody>
</table>

- More precise reasons for allowance
- Pre-search interview - Examiner’s option
Improving Clarity and Reasoning Training

35 U.S.C. 112(f): Identifying Limitations that Invoke § 112(f)

35 U.S.C. 112(f): Making the Record Clear

35 U.S.C. 112(f): Broadest Reasonable Interpretation and Definiteness of § 112(f) Limitations


Broader Reasonable Interpretation (BRI) and the Plain Meaning of Claim Terms

Examining Functional Claim Limitations: Focus on Computer/Software-related Claims

Examining Claims for Compliance with 35 U.S.C. 112(a): Part I Written Description

Examining Claims for Compliance with 35 U.S.C. 112(a): Part II – Enablement

35 U.S.C. 112(a): Written Description Workshop

§ 112(b): Enhancing Clarity By Ensuring That Claims Are Definite Under 35 U.S.C. 112(b)

2014 Interim Guidance on Patent Subject Matter Eligibility

Abstract Idea Example Workshops I & II

Enhancing Clarity By Ensuring Clear Reasoning of Allowance Under C.F.R. 1.104(e) and MPEP 1302.14

35 U.S.C. 101: Subject Matter Eligibility Workshop III: Formulating a Rejection and Evaluating the Applicant’s Response


Advanced Writing Techniques utilizing Case Law
Stakeholder Training on Examination Practice and Procedure (STEPP)

• 3-Day training on examination practice and procedure for junior patent practitioners
• Provide external stakeholders with a better understanding of how and why an examiner makes decisions while examining a patent application
• Aid in compact prosecution by disclosing to external stakeholders how examiners are taught to use the MPEP to interpret an applicant’s disclosure
## STEPP Course Schedule

<table>
<thead>
<tr>
<th>Description</th>
<th>Date(s)</th>
<th>Duration</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>November 15-17, 2016</td>
<td>3 Days</td>
<td>Alexandria, VA Campus</td>
</tr>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>January 10-12, 2017</td>
<td>3 Days</td>
<td>Dallas, TX – Texas Regional Office</td>
</tr>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>March 14-16, 2017</td>
<td>3 Days</td>
<td>San Jose, CA – Silicon Valley Regional Office</td>
</tr>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>May 9-11, 2017</td>
<td>3 Days</td>
<td>Denver, CO – Rocky Mountain Regional Office</td>
</tr>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>July 11-13, 2017</td>
<td>3 Days</td>
<td>Alexandria, VA Campus</td>
</tr>
<tr>
<td>3-Day Training on Examination Practice and Procedure</td>
<td>September 19-21, 2017</td>
<td>3 Days</td>
<td>Detroit, MI – Midwest Regional Office</td>
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Post Prosecution Pilot (P3) Pilot

The Office will contact applicant to schedule P3 conference.

The applicant makes a 20 minute oral presentation to panel of examiners.

The Office will inform applicant in writing of decision.
Post Prosecution Pilot – P3  (through Oct. 27, 2016)

<table>
<thead>
<tr>
<th>Total Submissions</th>
<th>1222</th>
</tr>
</thead>
<tbody>
<tr>
<td>Approved</td>
<td>1023</td>
</tr>
<tr>
<td>Defective</td>
<td>113</td>
</tr>
<tr>
<td>Conferences Held</td>
<td>614</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Conference Outcomes</th>
<th>Count</th>
</tr>
</thead>
<tbody>
<tr>
<td>Allowed</td>
<td>118</td>
</tr>
<tr>
<td>Final Maintained</td>
<td>368</td>
</tr>
<tr>
<td>Reopened</td>
<td>102</td>
</tr>
<tr>
<td>Awaiting Decision</td>
<td>588</td>
</tr>
</tbody>
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P3 Outcomes

Program Outcomes – 10/24/16

AFCP 2.0 data is from start of program; Final Maintained is RCEs + Advisories
Pre-Appeal data is for FY15 + FY16
Post Grant Outcomes - Objectives

- **Purpose:** To learn from all post grant proceedings and inform examiners of their outcomes.

<table>
<thead>
<tr>
<th>1. Enhanced Patentability Determinations in Related Child Cases</th>
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<tbody>
<tr>
<td>• Providing examiners with full access to trial proceedings submitted during PTAB post AIA Trials</td>
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<tr>
<th>2. Targeted Examiner Training</th>
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<tr>
<td>• Data collected from the prior art submitted and examiner behavior will provide a feedback loop on best practices</td>
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<th>3. Examining Corps Education</th>
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<tbody>
<tr>
<td>• Provide examiners a periodic review of post grant outcomes focusing on technology sectors</td>
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Post Grant Outcomes

Pilot Statistics

DISTRIBUTION OF PILOT APPLICATIONS BY TECHNOLOGY CENTER

<table>
<thead>
<tr>
<th>Technology Center</th>
<th>Number of Pilot Applications</th>
</tr>
</thead>
<tbody>
<tr>
<td>1600</td>
<td>121</td>
</tr>
<tr>
<td>1700</td>
<td>56</td>
</tr>
<tr>
<td>2100</td>
<td>55</td>
</tr>
<tr>
<td>2400</td>
<td>102</td>
</tr>
<tr>
<td>2600</td>
<td>82</td>
</tr>
<tr>
<td>2800</td>
<td>65</td>
</tr>
<tr>
<td>3600</td>
<td>138</td>
</tr>
<tr>
<td>3700</td>
<td>160</td>
</tr>
<tr>
<td>Grand Total</td>
<td>779</td>
</tr>
</tbody>
</table>
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

No 54%
Yes 46%
If the examiner did not use any references cited in the AIA Trial Petition, why?

- The claims in my pilot case were substantially different from the parent case.
- I disagreed with the petitioner's analysis of the prior art and/or claims.
- I was able to find better art on my own.
- Other

Based on 136 Survey Responses
1 Hour Ethics CLE available!

Patent Quality Conference

Advancing Patent Quality across the IP Community

Tuesday, Dec 13, 2016 | 8:30 a.m. – 5 p.m. EST
USPTO Headquarters – Madison Auditorium

Livestream: Silicon Valley USPTO – 9:00 a.m. to 5:30 p.m.

Presentations, Panel Discussions, and Insights into the Future of Patent Quality
Examination Time Analysis - Roundtables

Upcoming ROUNDTABLES

- **Alexandria**
  - November 14

- **Dallas**
  - November 29

- **Denver**
  - December 15

- **Detroit**
  - December 15

- **San Jose**
  - January 11

For additional information and ways to provide feedback please see our website at [https://www.uspto.gov/patent/initiatives/eta-external-outreach](https://www.uspto.gov/patent/initiatives/eta-external-outreach)
Patent Subject Matter Eligibility Roundtable Wrap-Up

Public Comment Period Closes Soon!

USPTO seeks public input on patent subject matter eligibility in view of recent decisions by the Supreme Court of the United States. The roundtable focused on receiving feedback regarding larger questions concerning the legal contours of eligible subject matter in the U.S. patent system.
Patent Trial and Appeal Board
Open Data Portal

developer.uspto.gov
Open Data @USPTO

Become innovative.

Data can be beautiful.
Our growing library of visualization »

Share with us.
An Open Data community »

Explore our data.
A catalog of our data products »

Make something.
Our library of APIs »