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Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting – Part 2 of 8

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The United States Patent and Trademark Office (the Office) and the Patent Public Advisory Committee (PPAC) recently held their Patent Public Advisory Committee Quarterly Meeting to review policies, goals, performance, budget, and user fees. Topics addressed included 1) Update on Patents business units; 2) [Finance/Budget](#); 3) [IT update](#); 4) Artificial Intelligence; 5) International update; 6) Pendency and Quality; and 7) [PTAB update](#).

This is the second of eight alerts Vorys will publish to summarize topics discussed at the Quarterly Meeting. This note summarizes comments made by Commissioner for Patents Drew Hirshfeld regarding Office procedures and initiatives to increase effectiveness of the examination process.

Commissioner Hirshfeld noted that the Office has been diligently working to address increasing application filings in a way that appropriately balances timely examination with continued improvement in patent quality. The Office issued 370,430 new patents in FY2019, which join nearly 3 million patents currently in force in the United States.

The Office has been in the midst of unprecedented levels of improvements that address significant and long-standing stress points in patent prosecution and better position the Office for the future. Examples include:

- Creating and issuing new subject matter eligibility guidance, which has provided greater predictability, reliability, and quality;
- Adjusting examination time, including allowing examiners more time where appropriate, and aligning examination time with particular attributes of each patent application;

- Implementing an improved patent examiner performance appraisal plan, which will better align with the Office goals related to patent examination quality;
- Developing an automated patent application docketing system to improve the assignment of work to patent examiners; and
- Developing enhanced automation tools for patent examiners.

The foregoing changes are expected to be fully implemented by October 2020.

The Office seeks to improve how cases are routed to the appropriate Examiner and how examination time is allocated to each examiner. One goal for the Office is to issue a first Office action in as many applications as possible in no more than 14 months.

The new time allotment methods will allot examination time based on an application's classification "picture" representing the full scope of technology covered in the application and accounting for multi-disciplinary inventions. At this time, all examiners have begun receiving additional examination time tailored to specific attributes of an application, including the overall number of claims, the length of the specification, and the number of pages in any filed information disclosure statements. Examiners with the least amount of examination time in the production system of the Office have also begun receiving additional time to align their time allotments with the requirements for current patent examination.

Improved Office processes have also been implemented to automatically match each application to the examiner best suited to examine the application, taking into account the complete technological profile of the applications, the work experience of each patent examiner, and the workload balancing needs of the agency. This update effectively completes the Office's transition from the United States Patent Classification system to the new Cooperative Patent Classification system, used by over 45 IP offices around the world.

Further, a new performance evaluation implemented by the Office will improve patent quality by providing examiners with an enhanced list of exemplary practices for searching, improving clarity of the written prosecution record, and adhering to principles of compact patent prosecution. The evaluation provides a greater emphasis on the examiner's prior art search by highlighting the importance of searching the inventive concept as disclosed in an application so as to identify the best prior art in the case at the earliest possible time in prosecution.

Over the past year, the Office has focused on improving examiners' ability to search and locate prior art through the following initiatives:

- **Training:** The Office has increased training opportunities to improve examiners' ability to identify relevant prior art. This includes training on proper search techniques and search strategies, training on search tools to facilitate locating and translating foreign patents, and discipline-specific training on relevant databases to identify non-patent literature.

- **Quality assurance measures:** Quality assurance reviewers perform searches in a random sample of applications and provide the examiner a feedback report, which includes the reviewer's search strategy along with feedback related to the examiner's search to identify best practices and potential areas of improvement.
- **Providing additional resources to examiners:** Additional resources are provided to examiners to assist with prior art searches when needed. This includes making available internal experts to help with search strategies based on technology and classification as well as assistance with available search tools. Additionally, a task force has been created by the Office to determine how IT, such as artificial intelligence, can be leveraged to assist with locating and retrieving relevant prior art for examiners.
- **Exploring new processes:** The Office has been also testing new processes that can help with enhancing prior art searches, including pilot programs that set forth new search processes and collaborations. This includes, for example, collaborative search pilots between multiple examiners, including examiners from foreign patent offices.