

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:
Patent Quality Metrics for Fiscal Year
2017 and Request for Comments on
Improving Patent Quality Measurement

Docket No. PTO-P-2016-0006
81 Fed. Reg. 16142

**COMMENTS OF PUBLIC KNOWLEDGE AND THE ELECTRONIC FRONTIER
FOUNDATION**

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Public Knowledge and the Electronic Frontier Foundation respectfully submit the following comments in response to the Request for Comments dated March 25, 2016.

We commend the USPTO for its ongoing efforts to improve patent quality, here through improved metrics for measuring quality. Yet we continue to urge the USPTO to focus on patent quality as it affects the public at large, namely ensuring that only clear and statutorily compliant patents issue, rather than diverting efforts too far toward improving examination efficiency, which may benefit patent applicants but not necessarily the broader public. In particular, the USPTO should separate its metrics for patent quality per se from metrics for other examination outcomes and efficiencies. Additionally, as discussed in detail below, the Master Review Form should be augmented with several pertinent questions that would better assess the quality of patents as they issue from the USPTO. Such changes will help to promote the issuance of patents that are high quality assets beneficial to the public, rather than those that unnecessarily burden the public with improper monopolies, uncertainty, and litigation.

I. Focus on Two Core Metrics

The Request seeks comment on whether the USPTO is 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 on the sufficiency of examiners' reasoning. While this dual focus on correctness and clarity is a substantial improvement to the prior single aggregate score, the quality metrics could be even further improved by disaggregating the quality of issued patents from the quality of intermediate examination outcomes, particularly with respect to the work product metric.

As explained in our previous comments, a high-quality examination process is not necessarily synonymous with high-quality patents, and the latter form of quality is far more important in the broader scheme. A poorly reasoned rejection might cost a single applicant a modicum of time and money, but a poorly crafted and erroneously granted patent harms the entire public, who "may continually be required to pay tribute to would-be monopolists without need or justification."¹

Disaggregating output quality from examination quality is a simple matter of identifying which elements of the Master Review Form are directed to each type of quality. For example, the metrics directed to rejections made will affect examination quality, whereas the metrics directed to rejections omitted and to allowable subject matter will affect output quality.

Failure to disaggregate these two different types of quality leads to the same problem that the USPTO observed in aggregating all the quality metrics into a single number: a dilution of useful but distinct pieces of information. A middling composite score will not indicate to the USPTO whether it is patent output quality or examination quality that is lacking. More worryingly, aggregation of those distinct concepts might lead to attempts to trade one type of quality off for another: a group that is struggling with high-quality patent output, for example, might try to raise its examination clarity scores to make its overall composite score look better, without addressing the underlying problems of its output quality.

¹ *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969).

More generally, the patent quality data that the USPTO captures will be most useful to the extent that it is released in raw or minimally aggregated form. Outside researchers, using the raw patent quality data obtained through this process, may discover further patterns or insights beyond what the USPTO might have anticipated. It is not clear that the release of such data would raise any substantial privacy concerns, and in any event, anonymization technologies could remedy such concerns. Patent quality is an area where sunlight has proved to be incredibly valuable to the public and to the USPTO, and providing more granular data would usefully advance that necessary transparency.

II. Objective Measurements of Quality

The USPTO asks next how patent metrics can best provide objective, rather than subjective, measurements of quality-related features in clarity and correctness reviews.

One way to do so, which we presented in our prior comments, would be to use standard scientific and statistical trial techniques such as blind experiments (i.e., having an examiner repeat review of an application without seeing the previous examiner's work). Obviously one would not expect two examiners to come to the exact same result, but if they arrive at vastly different conclusions—one would allow while another would reject, for example—that would be valuable objective evidence of areas for improvement in examination and training.

The USPTO correctly rejects the use of measurement of transactions to provide a numerical measurement of quality. While transaction measurements are objective and easy to analyze statistically, they can easily mislead. For example, a high number of RCEs in an art unit could indicate a problem with the art unit, but it could also indicate a stubborn applicant pursuing unpatentable subject matter. The Request for Comments explains that such numbers will only be used to “reveal trends and outlier behavior that will draw attention to potential quality concerns.” That is the correct approach, and the USPTO should be cautiously aware of all of the circumstances and possibilities, often beyond the USPTO's control, that can explain such trends and outliers.

III. Comments on the Master Review Form

In addition to the two specific questions discussed above, the Request asks for comments on the Master Review Form.

A. Review of Quality of Search

The form should ask more detailed questions about the quality of the search. The form currently only asks whether the examiner's search logic was recorded, and whether two specific types of searches, a classification search and an inventor name search, had been conducted.

Reviewers should consider the substantive quality of the search. Among other things, the form should ask whether sufficient synonyms were used in the search terms, whether the classifications searched were sufficiently broad and comprehensive, and whether the search history record demonstrates that the examiner sufficiently reviewed the results.

This sort of review should not be unfamiliar to the USPTO. In reviewing a petition to make special for the accelerated examination program, examiners review the quality of searches conducted by applicants. Quality reviewers could use a very similar type of review to ensure that examiners' searches are of sufficiently high quality.

Additionally, the form suggests that reviewers may conduct a search in order to find omitted prior art. It is not clear whether reviewers are required to conduct a search or in what circumstances a reviewer may be allowed to forgo such a search. The USPTO should make these procedures clear, and generally should require reviewers to conduct a search.

B. Allowable Subject Matter

The Master Review Form asks only two questions about allowable subject matter: whether the examiner wrote a statement of reasons for allowance, and whether the reasons "add substance to the record." These two questions are vastly insufficient to

capture necessary information at the time of allowance. This section should be augmented.

First, for any notice of allowance, the reviewer should consider whether a statement of reasons for allowance should have been included, or if the entire record as a whole makes reasons for allowance discernible and clear. *See* 37 C.F.R. § 1.104; MPEP § 1302.14. If the application is allowed on first action or if the applicant makes only sparse explanation of reasons for distinguishing the prior art, then the examiner ought to include a statement of reasons for allowance, and the Master Review Form should identify such situations.

Also, the form should be more specific than asking whether the reasons for allowance “add substance to the record.” Consistent with MPEP § 1302.14, the reviewer should look to whether any such statement identifies “(1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record.”

C. Clarity of Claims at Time of Allowance

As the USPTO proposed previously, examiners should clarify the record to ensure that claim language is unambiguous and that any claim construction applied during examination is made explicit. The Master Review Form should check to ensure that these are done where appropriate.

Primarily, at the time of allowance, the reviewer should consider the application as a whole to determine whether the claim language is clear in view of the specification. Examiners are already required to ensure that “the language of the claims is enabled by, and finds adequate descriptive support in, the application disclosure as originally filed. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.” MPEP § 1302.01. An examiner thus must make efforts to explain any interpretations of the claims upon which the examiner may have relied in order to allow an application. Assessment of clarity of issued patents is a core part of the

USPTO's patent quality initiative, and so reviewing notices of allowance for compliance with this provision of the MPEP is a critical part of advancing that initiative.

D. Recordation of Interviews

While the Master Review Form asks several questions about interview summaries in an application, it only asks one conclusory question about the quality of those summaries: "Is the record of the interview clear and complete." Because of the unrecorded nature of interviews and the known propensity of applicants to use interviews as a tactic to keep relevant information off the record, the USPTO should at a minimum require comprehensive interview summaries, and the Master Review Form should reflect that minimum requirement.

The USPTO's rules require interview summaries to be "a complete written statement of the reasons presented at the interview as warranting favorable action." 37 C.F.R. § 1.333(b).² In particular, MPEP § 713.04 lays out eight specific requirements for what interview summaries must contain. It would be simple to include the key requirements from that list (e.g., identification of the principal proposed amendments, the general thrust of the principal arguments of applicant, and the general results or outcome of the interview) as checklist items in the Master Review Form.

² While this is a requirement imposed on applicants, not examiners, it is nevertheless incumbent on the examiner to reject an interview summary that fails to meet the necessary requirements. See MPEP § 713.04, ¶ 7.84.

IV. Conclusion

Public Knowledge and the Electronic Frontier Foundation thank the USPTO for the opportunity to submit these comments. If any further information or assistance would be helpful, please contact the undersigned attorneys using the information below in the signature.

Respectfully submitted,

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