IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Request for Comments on Enhancing Patent Quality	Docket No. PTO-P-2014-0043 80 Fed. Reg. 6475

COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION, ENGINE ADVOCACY, AND PUBLIC KNOWLEDGE

Attn: Michael Cygan, Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy
Mail Stop Comments—Patents
PO Box 1450
Alexandria, VA 22313-1450
WorldClassPatentQuality@uspto.gov

Charles Duan
Director, Patent Reform Project
USPTO Reg. No. 65,114
Public Knowledge
1818 N Street NW, Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Julie P. Samuels
Executive Director
Ange Royall-Kahin
Program Manager
Engine Advocacy
414 Brannan St.
San Francisco, CA 94107
(646) 856-9449
julie@engine.is

Daniel Nazer
Staff Attorney
Vera Ranieri
Staff Attorney
Electronic Frontier Foundation
815 Eddy Street
San Francisco, CA 94109
(415) 436-9333
daniel@eff.org

May 6, 2015

COMMENTS OF THE ELECTRONIC FRONTIER FOUNDATION, ENGINE ADVOCACY, AND PUBLIC KNOWLEDGE

The Electronic Frontier Foundation, Engine Advocacy, and Public Knowledge respectfully submit the following comments in response to the Request for Comments dated February 5, 2015. The commenters represent the public and small technology business interests, who advocate for a balanced patent system that promotes invention without dampening the innovative space upon which the public and the economy rely.

We strongly support the USPTO's efforts to improve patent quality by ensuring that issued patents satisfy the statutory requirements, do not impinge upon the public domain of prior art, are clear as to their scope, and have a fully developed record of proceedings in the file history. Improperly issued patents can cause enormous harm, as such patents are undeserved monopolies that can force the marketplace to spend millions of dollars and countless hours dealing with them.

The USPTO and its examiner corps are the first line of defense against bad patents. At the Quality Summit held earlier this year, former Federal Circuit Chief Judge Paul Michel expressed concern that patent prosecutors routinely seek "grossly overbroad" claims, suggesting that 70–90% of patents he reviewed contained one such overbroad claim.[1] He stated that the patent examiner, who "first and foremost is an adjudicator" of patentability, must act as "the guardian of the public domain" to prevent issuance of overbroad patents that might drag down industries and future inventors.[2] It is the duty of the USPTO and every examiner to defend the public and to defend the future from the momentous external costs created by low quality patents, by diligently reviewing applications and weeding out invalid claims at the outset.

"The public . . . is demanding higher quality" in patents, in the words of Director Michelle Lee.[3] We strongly urge the Office to focus its energy on creating data, training materials, and enhanced quality reviews targeted at reducing errors in allowances. Only then can we create a patent system that serves its true customers, the public.

---

[1] Patent Quality Summit—March 2015, at 1:33, *available at* http://livestream.com/uspto/PatentQualitySummit.

[2] *Id.* at 1:31, 1:37.

[3] *Id.* at 0:08.

I. General Comment: The USPTO Should Add an Additional Pillar of "Excellence to the Public"

In its Request for Comments, the USPTO asks whether there are any "aspects of enhanced quality other than the three 'pillars' . . . that should guide the USPTO's enhanced quality initiative." We believe that the suggested pillars miss, or at least underemphasize, the importance of the USPTO's work to the public as a whole. While the Office should strive to improve its service to applicants, its first goal must always be to ensure that patent applications receive adequate scrutiny.

A. Protection of the Public Interest Is Central to the Patent System and to the Mission of the USPTO

Excellence to the public should be the central focus of the USPTO's quality initiative, because the USPTO is the agent of the public and owes its responsibility to the public. Patents are granted because the public has decided it is to the benefit of the overall population to do so. This sentiment is embodied in the Constitution itself, which enables the grant of patents not for any purpose, but to "promote the Progress of Science and useful Arts."[4] As the Supreme Court has said, the public "has a 'paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.'"[5] This paramount interest should be the starting point for all that the USPTO does.

Indeed, patent examiners are representatives of the public every time that they examine a patent application.[6] Their task, in applying the patent laws, is to ensure that they only allow patent applications that the public would have approved. This is why Judge Michel, speaking at the Quality Summit, called patent examiners "the guardian of the public domain."[7]

---

[4] U.S. Const. Article 1, § 8; *see also Crown Die & Tool Co. v. Nye Tool & Mach. Works*, 261 U.S. 24, 35 (1923) ("The sole reason and purpose of the constitutional grant to Congress to enact patent laws is to promote the progress of science and useful arts.").

[5] *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 851 (2014) (quoting *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 816 (1945)).

[6] *See Smith v. Hayward*, 193 F.2d 198, 199 (C.C.P.A. 1951) ("Every application for a patent is affected with the public interest.").

[7] Patent Quality Summit, *supra* note 1, at 1:37.

It is unfortunate that the USPTO's quality efforts make virtually no mention of this public interest. Instead, the Request for Comments refers to patent applicants as "customers," suggesting that the examiners' duty is to applicants, not to the public. An overly narrow focus on "customer service" to applicants risks prioritizing prompt issuance over quality. Even Judge Michel criticized the USPTO at the Quality Summit for this "customer service" language, noting that outside industries and future inventors—"remote customers"—deserved equal attention.[8] The current emphasis on "customers" is a mistaken view of the importance of patent quality and, more fundamentally, of the public service role of patent examiners and the USPTO.

B. Low-Quality Patents Have Costly, Concerning Consequences for the Public Interest, Small Businesses, and the Technology Economy

If the patent system fails to work toward the public interest and if low-quality patents continue to issue, then many serious harms will follow—indeed, the issuance of low-quality patents in the past has already substantially harmed the public.

First, improperly issued patents restrict what ought to be in the public domain, and that is a serious loss in itself. Central to all aspects of patent law, especially requirements of patentability such as novelty and non-obviousness, is that the promotion of innovation and progress depends just as much on what is not patentable as on what is patentable.[9] When invalid patents issue, the "the public may continually be required to pay tribute to would-be monopolists without need or justification."[10]

Second, low-quality patents can impose undue costs on the economy. Once issued, invalid patents are very expensive to invalidate. Patent litigation can cost millions of dollars[11]—an unreachable sum for many members of the public wishing to

[8] *Id.*

[9] *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989) ("The efficient operation of the federal patent system depends upon substantially free trade in publicly known, unpatented design and utilitarian conceptions.").

[10] *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969).

[11] *See* Meaghan Kent *et al.*, Mondaq, *10 Reasons Every Defendant in Patent Litigation Should Consider Inter Partes Review* (April 26, 2014), Available at http://www.mondaq.com/unitedstates/x/309504/Patent/10+Reasons+Every+Defendant+in+Patent+Litigation+Should+Consider+Inter+Partes+

reclaim property that ought to have been the public's from the start. Inter partes review and other AIA proceedings cost less, but still may run an estimated $200,000 to $750,000 per proceeding—a substantial cost to innovators and the economy.[12]

The historical issuance of low-quality patents in the software space exemplifies the public problems that such patents create. It is well known that the software industry has suffered a plethora of problematic patents: one study estimated that, if challenged in court and litigated to judgment, approximately 50 percent of software patents would be found invalid.[13] These patents have served as the basis for all sorts of unfair and problematic patent assertion activities that continue to this day, and that have been acknowledged by the USPTO.[14] In short, there is a patent quality crisis where massive numbers of poor-quality patents have been and continue to be issued. This crisis can only be solved by ensuring that applications get adequate review. Protecting the public from overbroad patents that ought not be issued under the laws and under the public interest should be the central mission of the USPTO.

C. Patent Quality Should Be Defined in Terms of the Public Interest

In view of the centrality of the public interest to the patent system and patent examination, the USPTO should work from a definition of patent quality based on those public interest principles. In particular, a high quality patent should exhibit the following four characteristics:

- **The patent must not claim matter that is in the prior art or otherwise in the public domain.** Existing technologies, as well as the categories of subject matter deemed ineligible, are reserved exclusively to the public, and a properly issued patent should not claim what the public already possesses.

Review (noting that defending a patent case in federal court costs an "average of $530,000 - $3.6 million through the end of discovery, and $970,000 - $5.9 million through final disposition").

[12] *Id.*

[13] Shawn P. Miller, *Where's the Innovation? An Analysis of the Quantity and Qualities of Anticipated and Obvious Patents*, 18 Va. J.L. & Tech. 27 (2013), available at http://www.vjolt.net/vol18/issue1/v18i1_1-Miller.pdf.

[14] Larry Downes, *Everyone Hates Patent Trolls, but Here's the Root Problem with our Broken System*, Washington Post, May 4, 2015, http://www.washingtonpost.com/blogs/innovations/wp/2015/05/04/everyone-hates-patent-trolls-but-heres-the-root-problem-with-our-broken-system/.

- **The patent must make its scope clear.** A patent with "fuzzy boundaries" invites unnecessary litigation and leaves the public uncertain as to what it is allowed to do without infringing the patent.
- **The patent must include a complete and detailed file wrapper that sufficiently informs the public as to what transpired during prosecution.** If the public grants a patent through its authorized representative, namely the patent examiner, then the public expects a record of its representative's acts. Public notice as to patent scope depends on these detailed records.
- **The patent must satisfy the statutory requirements**, which are designed to ensure that the above three characteristics are met.

These characteristics should motivate all efforts toward improving patent quality.

II. Pillar 1, Proposal 1: Applicant Requests for OPQA Review Provide Little Information of Value and Could Easily Be Abused

The USPTO proposes that the patent applicants themselves be able to recommend Office Actions for secondary review by the Office of Patent Quality Assurance.

First, this does not necessarily improve patent quality, insofar as patent quality is about whether the patent is novel and nonobvious, and meets other statutory requirements. Applicants would bring only adverse Office Actions—that is, *rejections* of applications—to the attention of OPQA. Applicants are highly unlikely to bring an *allowance* to that office's attention. This proposal does nothing to address the issue of examiners who approve patent applications that they should not approve—the major problem of low-quality patents.

Second, if suggesting an Office Action for review has any negative consequences for the patent examiners *at all*, then this proposal is incredibly problematic because it could turn into a mechanism for threatening examiners. A patent applicant who is facing an Office Action might use the possibility of sending the Office Action up for review to discourage the examiner from maintaining the Office Action. This sort of intimidation tactic would be unacceptable, but there is no easy way for the

USPTO to detect patent applicants who do it. Even if the applicant is acting in good faith, the prospect of that an unfavorable Office Action might lead to review will discourage examiners from rejecting claims. We have serious concerns that this proposal will *worsen* quality outcomes by creating an incentive for examiners to respond to applicant dissatisfaction by simply allowing claims.[15]

Third, the USPTO should instead focus its energy on reviewing the quality of allowances. Only by focusing on reducing the error rate regarding allowances can the Office address the problem of improperly issued patents. In its recent report regarding patent quality, the Office of the Inspector General found that the USPTO does not collect sufficient data for improving patent quality.[16] The OIG also noted that the agency devotes more energy to monitoring examiner productivity.[17] To address this imbalance, the Office should develop a specific program for reviewing allowances for errors, and use the data to identify failures in the examining procedure.

III. Pillar 1, Proposal 2: Automated Examiner Tools Should Focus on Better Understanding the Specification

The USPTO is interested in automated tools that will help examiners search for prior art. In particular, the Office is looking for tools that can linguistically analyze the application and then automatically do a search for relevant prior art documents for the examiner to review.

While there is nothing wrong with giving examiners new tools, any automated searching system must be used with important caveats. Patent searching is difficult. Especially in new, rapidly-changing technology fields where new terms are invented all

[15] The Office of the Inspector General raised a similar concern in its discussion of the PTO's performance reviews. *See* Office of Inspector General, Final Report No. OIG-15-026-A, *USPTO Needs to Strengthen Patent Quality Assurance Practices* 6-7 (April 10, 2015), *available at* http://www.oig.doc.gov/OIGPublications/OIG-15-026-A.pdf. The OIG noted that supervisors were deterred from charging errors to examiners because of the laborious rebuttal process. *Id.* The PTO's proposal here raises an analogous problem: examiners will be reluctant to reject claims (or otherwise displease applicants) because of the risk that such actions will be recommended for review by the OPQA. Far from improving quality, it is likely to have the opposite result.

[16] *See id.* at 3.

[17] *Id.* at 16-17.

the time—even new terms that describe old things—the mental creativity of a human examiner will almost surely outperform an automated system. Thus, examiners should be instructed to not rely solely on the output of an automated search.

There are at least two reasons why it is particularly important for examiners not to over-rely on automated tools. First, applicants can invent their own terms, and even "be their own lexicographer" and redefine well-known terms to mean completely different things, which an automated system will not detect. We are concerned that applicants are already able to evade prior art by using new words for old things.[18] Automated tools risk compounding this problem. The risk is that examiners will simply use obscure or invented words as search terms instead of carefully considering the substance of the application.

Second, automated tools can be subject to manipulation. Even if exact functioning of a tool is not disclosed, through time applicants will learn how the automated tool performs.[19] Applicants would then be incentivized to choose wording that causes the tool to fail to return relevant prior art. Thus, if the USPTO adopted an automated patent searching tool, and that tool were publicly available, then examiners would have to contend potentially with claims specifically designed to thwart the tool.

A better use of an automated tool would be not for prior art searching, but for understanding the specification. For example, a tool that simply searched the text of a patent application for mentions of a claim term, and put those mentions into an easy-to-read table for the examiner, would potentially greatly help the examiner. Such a tool could help the examiner interpret the claim language, spot enablement or indefiniteness issues, and develop a better prior art search.

In sum, automated tools should assist examiners, but not supplant or replace their role as the fact finder responsible for determining patentability.

---

[18] As one technology company lawyer recently explained: "I can take something where the prior art is so obvious and turn it into something that the Patent Office thinks is novel. There is no one set of shared terminology for how these things work. It's easy to come up with a term that sounds technical or real . . . that the Patent Office will think is real." Elec. Frontier Found., *Defend Innovation* 5 (2015), https://www.eff.org/files/2015/02/10/eff-defend-innovation.pdf.

[19] An analogous situation exists in the field of search engines. An entire industry has developed in order to optimize search results for websites. *See, e.g.*, Eric Enge et al., *The Art of SEO: Mastering Search Engine Optimization* 593–94 (2d ed. 2012).

IV. Pillar 1, Proposal 3: Clarity of the Record Should Be Enhanced at All Stages of Prosecution

Clarity of the record is fundamental to a well-functioning and balanced patent system. Patent rights are supposed to issue only for claims that are novel, non-obvious, and non-abstract. Claims must also meet all of Section 112's requirements for definiteness, specificity and clarity in the claims. Because the record is so important to defining the parameters of patent claims, additional steps to improve the quality of the record are clearly warranted, and the three proposals put forward by the USPTO would certainly serve to improve the quality of the record and should therefore be adopted.

1. The suggestion to make claim construction explicit in the record is essential to providing clear and adequate notice to both the applicant and the public. It is a simple matter of fairness that companies and individuals know what is covered by a patent and what is not. This can only be achieved if it is clear to all what the patent claims purport to cover. Otherwise, inventors may be discouraged from innovating, since it may be unclear what has already been patented.

Furthermore, recordation of claim construction will facilitate examination. Patent quality depends on the examiner understanding the application: a patent application cannot be properly examined if the applicant thinks that the text of the application means something different from what the examiner thinks. A clear and complete record is thus vital to ensuring that the applicant, the USPTO and the public are all on notice of the understandings that support the allowance of patent claims.

2. There was broad consensus at the USPTO's Quality Summit that poor and incomplete recording of examiner interviews is widespread and that it undermines patent quality. Prosecuting attorneys seek to limit the record in many instances so that their client is not limited by the record and can later claim that the allowed patent claims cover more than was actually agreed to at issuance. This practice clearly subverts the examination process; the whole point of having a record is to write down with specificity and clarity what the applicant and examiner have agreed constitutes the invention. Yet, we know that too often examiners succumb to pressure to exclude things from the record or allow the prosecuting attorney to essentially dictate what goes into the record.

Requiring additional detail in interviews is critical to ensuring that the examiner, applicant, and public are all equally informed about the record. Interviews are incredibly useful: they offer applicants an opportunity to engage in an efficient dialogue with examiners. But they also offer applicants an opportunity to keep arguments off the record, by orally presenting them and then convincing the examiner not to include them in the written record. Besides being unfair to the public, which never gets to see those arguments, it enables less scrupulous applicants to deceive the public by making one argument before the examiner and another before the courts. Thus, the entire substance of interviews must be recorded and should be placed on the record as well.

This gaming of the system is one more way that startups, other inventors, and the public are deprived of the public notice that the law requires. Several suggestions were made at the Quality Summit for addressing this weakness in the system: recording every interview and having it transcribed onto the record; making the record available to the public; allowing the examiner and applicant to agree on an edited transcript; or requiring the examiner to fully summarize the interview after the interview is concluded, with perhaps an opportunity for the applicant to contest it. We believe that all of these suggestions are worthy of more serious consideration.

3. Statements of reasons for allowance need to be far more detailed and explicit. Too often the statement of reasons for allowance simply quotes an element of a claim or—worse—quotes the entire claim without further explanation. Instead, the statement should specifically identify what part of the claim was not found in the prior art, what prior art comes closest to that part, and why the prior art is insufficient to disclose that part of the claim. Furthermore, even in situations where stating reasons for allowance is not necessary, the examiner might still be strongly recommended to write one in certain situations. For example, if the applicant makes two arguments for patentability and the examiner allows based on one of the arguments, then the examiner should indicate which of those two arguments was successful and which was not in order to avoid uncertainty in the future.

Any additional burden on examiners or applicants should be minimal, and is clearly outweighed by the fact that such recordation is necessary to ensure a clear and

complete record. A complete record is necessary to ensure that the public, who ultimately is the source of the power under which all patents are granted, is fully aware of the scope of the patent grant. The public should get a fair bargain on fully disclosed terms in exchange for the time-limited monopoly rights that patents confer.

V. Pillar 2, Proposal 4: Metrics for Quality Should Focus on Outputs, Not Process Efficiency

The USPTO proposes reassessing its Quality Composite Metric. Currently, that metric is a single number calculated based on seven component metrics, two of which are based on surveys and five of which are computed based on numerical patent prosecution data.[20]

Quality is a measurement of output, not process. The quality of a manufactured food, for example, is measured by the aspects of the food, not how fast the food was made. So should it be with patents: quality should be measured based on the attributes of the patent that comes out of the process, not how efficiently the patent issued from filing.

But the current metric is largely focused on the process of patent prosecution, and thus fails at its intended purpose of measuring "patent quality." The Quality Index Report (QIR) is purely composed of process data, such as the number of actions per final disposal of an application.[21] Of the component metrics based on OPQA review (final disposition compliance rate, in-process compliance rate, FAOM search review, and complete FAOM merits review), only one, the disposition compliance rate, actually measures outputs.[22] And the external survey largely asks about patent practitioners' experiences in working with examiners.[23] Furthermore, the only metric that directly considers quality of allowances fails to disaggregate from measurements of final

[20] *See* U.S. Patent & Trademark Office, *Adoption of Metrics for the Enhancement of Patent Quality* 3 (2011) [hereinafter *Quality Metrics Report*], *available at* http://www.uspto.gov/patent/initiatives/joint-uspto-and-ppac-quality-task-force.

[21] *See id.* at 11.

[22] *See id.* at 4–10.

[23] *See id.* at attach. 3, at 5.

rejections or other actions, and it only considers situations of "clear error" in those allowances, making even that individual metric unhelpful for assessing output quality.[24]

The component metrics are useful metrics of *examination* quality, which are certainly useful in improving efficiency and examiner interactions with applicants. They may even be useful for diagnosing the prosecution stages that lead to low output quality. But the component metrics are not measurements of *patent* quality, which is the type of quality that is of interest to the public at large.

This suggests two changes to the USPTO's quality measurements. First, measurements of patent quality (output quality) must be disaggregated from measurements of examination quality (process quality). Second, much more robust measurements of patent quality are needed beyond the few contemplated by the current Quality Composite Metric.

Obviously, quality in the strictest sense (validity in view of prior art) is not amenable to simple quantitative metrics. But there are at least two categories of quality metrics that would be much more indicative of patent quality, and that the USPTO could easily implement.

First, the USPTO could measure completeness of the record. For example, interview summaries could be reviewed to ensure that they contain a complete and detailed summary of what was discussed, rather than, for example, a mere cursory identification of the application and prior art (which all too often now is what the interview summaries look like). Office Actions could be reviewed to ensure that they state which limitations are being interpreted as means-plus-function, that they properly apply the patent subject matter eligibility guidelines, and so on. This would essentially be an expansion of the review that OPQA currently conducts for first actions, final disposals, and other actions.[25]

Second, the USPTO could run internal redundancy checks to ensure that its examination processes are consistent. The hallmark of a good scientific process is

[24] *See id.* at 4–5 (final disposition compliance rate, which aggregates substantive review of notices of allowance with review of final rejections).

[25] *See id.* at 4.

repeatability, and patent examination should be no different: if two examiners come to widely different results on the same patent application record, then this indicates a problem with training or policy to be corrected. This differs from the "clear error" and "unreasonableness" reviews that OPQA currently conducts,[26] because the review would ideally be done blind to the initial examiner's decision.

VI. Pillar 3, Proposal 5: Modifications to Compact Prosecution Should Focus on Greater Flexibility and Increased Time for Examiners

The USPTO proposes modifying the general compact prosecution practice, to allow for applicants to submit more than one response before receiving a final rejection. The rationale is that if applicants can submit more than one response before getting the final rejection, then they may be able to better explain their arguments to the examiner, thus allowing for the two to come to a better understanding of the patent application.

The USPTO should relax the compact prosecution requirement, but for a different reason: the expectation that the examiner get all the rejections out in the first rejection round is too onerous a requirement on examiners.

Consider, for example, an application that is written using particularly vague and ambiguous language. The examiner should reject such an application under § 112(b). But under the rules of compact prosecution, if the examiner is able to divine some meaning for the claim, then the examiner must enter a prior art rejection under § 102 or § 103 at the same time.[27] This obviously puts the examiner in a strange position of finding the claim not amenable to interpretation for § 112 purposes and simultaneously interpreting that same claim for prior art purposes. But more problematically, if the examiner learns that the chosen interpretation was wrong, then the examiner may have to withdraw the original prior art rejection, conduct a prior art search anew, and enter a new rejection.

Requiring the examiner to guess at the meaning of the application, and conduct two full prior art searches if that guess is wrong, places an unnecessary and excessive

[26] *See, e.g.*, *id.* at 4–5.
[27] *See* MPEP § 2173.06 (9th ed. 2014).

burden on examiners already pressed for time to conduct a single high-quality search. The better option for all parties would be to allow the examiner to issue just the § 112 rejection, determine the proper scope of the claims from the response thereto (or, alternately, issue a request for information under 37 C.F.R. § 1.105), and then conduct a single prior art search based on a correct understanding of the claims. This would require an additional non-final action, and thus violate the general principle of compact prosecution, but it would overall improve the examination process and lead to a better dialogue between applicants and examiners.

The USPTO is concerned with ensuring good communication between the applicant and the examiner. That communication must go both ways. The USPTO's proposal helps the applicant better explain the application through multiple rounds of responses. So the USPTO should also help the examiner better explain the defects of the application through multiple rounds of rejections.

VII. Pillar 3, Proposal 6: Expansion of In-Person Interviews Must Be Accompanied by Further Transparency in the Record

The USPTO is proposing a program that would enable examiners to travel to locations outside the Washington, DC area in order to conduct in-person interviews.

In-person interviews are often considered effective in helping examiners understand patent applications and conduct examination, but as we have indicated in our response to Proposal 3 above, they also lend themselves to gaming and abuse. If properly conducted and fully and clearly recorded, in-person interviews are a useful tool for ensuring examiners and applicants have a clear understanding of the patent application. The text of patents can often be confusing, and new inventions by definition are unfamiliar, so having the applicant and examiner in the same room, asking questions of each other, should lead to a clearer understanding of the claims being prosecuted. If it is efficient and cost-effective to have examiners travel to other locations, and if it would not further contribute to the backlog of applications, then expanding the interview program to other locations should be considered.

But it should only be considered if certain conditions are met. As with interviews at the USPTO or by phone, any additional information provided to the examiner to support a claim must be recorded and made known to the public as well. If, for example, the applicant explains to the examiner that some term in the patent application has a special meaning, then the public must also be given notice of that special meaning. This is especially important given the ability to manipulate the undisclosed interpretation years down the road. While being a matter of fairness, notification of agreements made during interviews also prevents improper behavior in which the patent applicant says that the patent application means one thing to the examiner and another thing to the public, or to a court if the patent is litigated.

Thus, if the USPTO wants to expand the use of in-person interviews, then it must also expand the mechanisms for recording the discussions of those interviews. Currently, examiners and applicants simply write their own free-form summaries of what was discussed. As previously considered in response to Proposal 3, these write-ups are often sparse and lacking in sufficient detail to be useful.

One potential solution is to tape-record these interviews, regardless of where they take place. Another option would be to establish more robust guidelines for what needs to be included in the record, or perhaps create a more detailed, structured form that must be completed at the end of an interview. Also, additional materials that applicants bring into these interviews, such as PowerPoint presentations, should be included in the patent application file.

Applicants have sometimes pushed back on these ideas, indicating that such requirements would make interviewees too cautious. But the applicants' desires for unrestricted discussion by keeping material off the record is clearly outweighed by the compelling public interest in having the same information that the examiner has and in having a complete and clear record. There is a clear need for further measures to ensure that more information from interviews—regardless of where they are held—be included in the written patent application record.

VIII. Conclusion

The commenters commend the USPTO for redoubling its efforts on patent quality, and thank the USPTO for the opportunity to submit these comments on this important issue. If there are any remaining questions, please contact the undersigned submitters at the addresses listed below.

Respectfully submitted,

Charles Duan
Director, Patent Reform Project
USPTO Reg. No. 65,114
Public Knowledge
1818 N Street NW, Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Daniel Nazer
Staff Attorney
Vera Ranieri
Staff Attorney
Electronic Frontier Foundation
815 Eddy Street
San Francisco, CA 94109
(415) 436-9333
daniel@eff.org

Julie P. Samuels
Executive Director
Ange Royall-Kahin
Program Manager
Engine Advocacy
414 Brannan St.
San Francisco, CA 94107
(646) 856-9449
julie@engine.is

May 6, 2015