



July 6, 2017  
Marylee Jenkins, Chair  
Patent Public Advisory Committee  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

*Via email: ppac@uspto.gov*

Dear Ms. Jenkins:

American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present potential discussion points to the Patent Public Advisory Committee (PPAC) in the Committee's efforts with the United States Patent and Trademark Office (USPTO) in improving the U.S. patent system for this year.

AIPLA is a national bar association of approximately 14,000 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA notes with appreciation the public services rendered by the PPAC and its members in guiding the policies of the USPTO. AIPLA solicited input from its members for consideration by the PPAC. Topics identified by our members included:

1. Reform of the Patent Trial and Appeal Board (PTAB). Current policies and practices seem tilted toward the challenger and they should be reformed to be more neutral and fair to both parties.
2. Transparent disclosure of the shared services initiative from the Department of Commerce (DOC). What is gained by the USPTO from participation and are any of the user fees being utilized by other agencies or DOC?
3. Improved patent process with better, more consistent quality and supervision of the work
4. More consistent application of 35 U.S.C. § 101
5. Lack of after-final practice
6. Institution of search metrics
7. Reduce the burden on applicants due to unnecessary procedural requirements
8. Address the inconsistent information technology infrastructure
9. A less cumbersome interface between the Office and the users of patent services

Our members expressed concern about the current practice and policies in place at the PTAB. We understand that the USPTO implemented these procedures to ensure the highest quality for the granted patents. However, many of our members commented that the rules as

implemented are biased toward the challenger and unfairly place the patent owner at a disadvantage. It is suggested that the rules be reviewed and revised to provide a level playing field for all participants. Also, our members request clarification and simplification of the rules and procedures for making claim amendments or substitutions in Inter Partes Reviews (IPRs) and Post Grant Reviews (PGRs). This may help address concerns relating to the fairness of IPRs and PGRs to patent owners.

We are concerned about the Shared Services Initiative and the possibility of user fees being diverted to other agencies or the DOC itself. Ensuring that the USPTO retains all user fees paid by patent applicants to fund the examination of patent applications has been and remains a high priority of the patent community.

The quality and efficiency of the patent process varies across the technology centers. We suggest that more consistent outcomes and better quality could be achieved with more training and, importantly, better supervisor oversight of work product. Our members are increasingly concerned about the overall quality of office actions. Our members note that the Appeal-Brief and Appeal Conference statistics show about a 30 percent error rate in the final rejections that are appealed. The Office should be urged to review the decisions overturning an examiner's rejection to identify areas where additional training or supervision may be warranted.

We urge the Office to consider implementing a concise set of guidelines on 35 USC § 101 rejections that is applied consistently across all art units. In addition to new guidelines, this effort requires monitoring to ensure that every technology center examines claims that may be subject to section 101 in the same way.

Our members continue to be concerned about after final practice. We ask PPAC to urge the Office to work with the Patent Office Professional Association (POPA) to develop and implement a clear set of policies on the types of amendments that may be made and to provide examiners with sufficient motivation to find a path to allowance, without filing an RCE, for applications that are close to being allowable.

Our members also ask the PPAC to urge the Office to consider reducing the burdens imposed on the USPTO's customers. One specific example concerns the amount of data that applicants are required to enter in the Application Data Sheet (ADS). Our members note that the Office of Management and Budget (OMB) cost estimate for preparing an ADS appears to be lower than what is actually the case, considering the data that is required to be provided. The Office should be encouraged to review this form and eliminate unnecessary data. Furthermore, the Office should conduct periodic reviews of all forms with the goal of eliminating unnecessary data requirements.

Concerning the IT infrastructure and accommodation of stakeholders, the PPAC should urge the Office to consider revamping the data input modules for its various databases to provide more uniform and flexible data entry formats. Data entry fields on many databases require the same data to be entered differently. For example, the publication number field in the PAIR requires a different format than the publication number field in the USPTO Patent Assignment Search Database; some fields allow commas in patent and application numbers while others do not. A consistent set of interfaces would save the users of patent services time and thus money. This may well be in development with the investments being made to the IT system but it still remains an issue until those improvements are completed.

In addition, patent practitioners using the help line for the Examination Assistance Center are required to listen to a long introductory message before receiving service. The cumulative loss of time due to this message alone is very large. The PPAC should urge the Office to provide an option to allow this message to be skipped or to allow users of the Center to leave a call-back message. Our members are also frustrated by the Office of Patent Application Processing (OPAP). Many of the Notices to Correct Application Papers issued by OPAP are obtuse and require applicants to call the Application Assistance Unit (AAU) for clarification. The Office should consider how OPAP notices could be made clearer.

AIPLA supports the PPAC's continuing efforts on improving the patent system, welcomes the opportunity to answer any questions these comments may raise, and looks forward to a continuing dialogue on this very important subject.

Sincerely,

A handwritten signature in cursive script that reads "Mark L. Whitaker". The signature is written in black ink and is positioned below the word "Sincerely,".

Mark L. Whitaker

President

American Intellectual Property Law Association