

FW Thank you for an excellent presentation on fee setting
From: Ernie Beffel [mailto:ebefel@hmbay.com]
Sent: Saturday, February 25, 2012 1:28 PM
To: Picard, Michelle
Cc: Benjamin Borson; cip@parc.com
Subject: Thank you for an excellent presentation on fee setting

Dear Michelle,

1) Thank you for a most excellent presentation on fee setting. I think that the emphasis on cost recovery as opposed to changing applicants' behavior set the right tone.

Your presentation was much better than the Executive Summary posted at http://www.uspto.gov/ai_implementation/. I encourage you to post your materials and include a link to the video segment of your remarks.

Your transparency put me in your camp.

2) There is one data point that I seriously question: whether it costs almost \$2000 to process an RCE. That is, whether it costs as much to write an office action on an RCE as an original office action?

I assume that \$2000 corresponds to two and one half or three days of work by an examiner with partial signing authority. Is that close?

In my view, only 5-10 percent of post-RCE office actions in my practice represent that level of effort. Half of the particularly diligent post-RCE office actions are written by a young examiner who may be well-intended, but who is far from the norm in their opinion of what is obvious.

3) From a policy perspective, I'm not sure how I feel about cost recovery in appeals when BPAI reverses the examiner. My customers typically expect me to absorb the cost of correcting my mistakes. Maybe it would make sense for some of the costs on appeal to be assessed to the losing party.

4) In today's world of games, you might consider an educational game that encourages your public to contribute their detailed views of the pricing proposal. Crowd-source this and look at the aggregate results.

From an OR/math modeling perspective, I assume that the major inputs are: A) willingness to fund hiring of new examiners and IT improvements -- to fully fund USPTO operations; B) willingness to fund an operating reserve; C) distribution of cost recovery between up front and maintenance fees; and D) tweaks to individual fee amounts. The main outputs (MOEs) are A) total cost from filing through first or second maintenance fee; B) reduction of pendency over time, taking into account cash flow; and C) elasticity induced reductions in activity.

You may already have built this kind of scenario analyzer in a spreadsheet for your own use. How about having your dashboard folks create an app that lets your public play with the parameters and submit their dream scenarios? Make the controls nested, so that setting A+B determines the

FW Thank you for an excellent presentation on fee setting total amount of fees and C+D control the distribution of fees among individual items. Collect TC segment information at the same time that you collect user scenarios.

5) Jonathan Barney of Ocean Tomo's Patent Ratings has studied elasticity very closely. You should talk to him about his stratification of maintenance renewal fee behavior. He has had a huge budget to focus on just that issue, because he uses it to rate patents and even to make investments in companies based on the strength of their patent portfolios, as rated. There is a patent that describes an early incarnation of his work.

6) The focus group results from Partnering in Patents are attached, in case you want to pass them along. I cannot find them posted either on USPTO's web site or anywhere else on the web -- I'll probably post them on our web site and send them to the PPAC so that they get better visibility.

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UNITED STATES PATENT AND TRADEMARK OFFICE AND
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Partnering in Patents

*Focus Session on Ways to Streamline
and Expedite Prosecution of
Patent Applications*

October 19, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE AND AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Focus Session Participants

- **Member of AIPLA**
- **Patent Examiners**
- **Supervisory Patent Examiners**



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Focus Session Questions

Question 1: What behaviors or actions do you see that slow down the progress of an application as it is being prosecuted?

Question 2: What behaviors or actions do you see that speed up the progress of an application as it is being prosecuted?

Question 3: What suggestions do you have for ways to speed up the progress of an application as it is being prosecuted?



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Results – Q1 What behaviors or actions do you see that slow down the progress of an application as it is being prosecuted?

Votes	Ideas
14	Better foreign translation
12	Failure to explain claim interpretations
11	Not having detailed agenda for interview
7	More discussion (compromise) in interviews
4	More claim interpretation in Office Action (OA)
4	General arguments of claim items not taught without specifics
4	Lack of quality in IDS references
3	Broad claims
3	Piecemeal rejection; not all rejections in first OA
3	Too large citations of where things are taught
3	More guidance on restriction practice
3	Tailor patent tract to customer's need; maybe also need a "slower" track, examiner quick time for first action, long time to dispose begging and end points
3	Sync examiner/attorneys dockets
2	Increase extensions of time fees after 3 months
2	Quick response incentive
2	IDS after allowance
2	Repeating arguments
2	Need earlier indication of allowable subject matter (both ways)
2	More telephonic interviews; phone calls are good
1	New arguments late in prosecution
1	Clearly non-statutory claims (20 years)
1	Person making decision not present at interview, i.e. TQAS, SPE, such as 101s



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Results – Q2 What behaviors or actions do you see that speed up the progress of an application as it is being prosecuted?

Votes	Ideas
13	More e-mail communications
13	Reduce or Limit total number of claims to examine (focus in on the invention)
12	Pilot-1 month to correct claims/specification prior to examination
8	Early disclosure of sister/similar application or patents
5	Willingness for examiners to grant interview (i.e. after final)
4	Better translations
4	Put claims in better form prior to examination
4	Interviews: frequently, telephonic, prior to 1 st OA, more detailed agenda with summary of invention, willingness to have
2	Be ready to negotiate
2	If examiner suggest allowable language, at least add it to a dependent claim
2	Identify allowable subject matter early on
2	Brief arguments; bullet points
2	Keeping related case with same examiner
1	Examine only independent claim and a total of 10 claim in 1 st OA
1	Early IDs submissions (priority documents)
1	Focus search on inventive concept
1	Desktop sharing for phone interviews by attorneys
1	Specs with definitions
1	Having definition/list in disclosure



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Results – Q3 : What suggestions do you have for ways to speed up the progress of an application as it is being prosecuted?

Votes	Ideas
28	Expand communication before 1 st OA pre-action interviews
26	Be able to communicate with email (get nl 7 waiver)
25	Limit to 20 claims
25	Joint training-AIPLA/examiners
23	Notification that examiners are going to begin examination within a month or 2 months (to sync dockets for first action)
22	Reward efficiency
20:	Better linking of references/applications; for example, if a case is allowed, but a ref pops up in a related case linking that reference on the patent office side of things instead of an IDS
19	Applicants mapping of the claim set to corresponding aspect of the spec
16	Early indication of allowable subject matter
15	Timely indication of allowance subject matter by both parties
15	Send or permit SPEs to technical training
14	Strong incentives for quicker response time: incentive fees for buying time, working on related cases of the same time, interviews mandatory
14	Incentives for filing responses sooner (ex. Pref in queue; weighted system)



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Results – Q3 : What suggestions do you have for ways to speed up the progress of an application as it is being prosecuted? *(Continued)*

Votes	Ideas
13	More feedback from pre-appeal
11	SPEs assigned to art area that they know
10	Pre-OA-general state of art and clean up formalities
10	More pre-OA interviews
9	More interactive communications (email, phone etc)
9	Quick e-form for email waivers
8	More use of email
8	Back and forth in same week as opposed to every six months
8	Educate applicant on new DM system
7	List of related cases filed early
7	Mandatory interview prior to issuing FA
7	QEM sessions for examiners to discuss cases
7	Continuation to same examiner
6	Publish internal (PTO) deadlines/requirement
6	Bullet/outline arguments
6	Terminal Disclaimer (TD) via e-Petition
5	European style central claiming



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Results – Q3 : What suggestions do you have for ways to speed up the progress of an application as it is being prosecuted? *(Continued)*

Votes	Ideas
4	More Patent and Trademark Offices around the country - closer to clients
4	Syncing Docket Management system with applicants
4	Clear position taken should be stated/complete search
4	Adaptable workflow to work on similar application
3	Clerical/not subject matter related issues be corrected at office
3	More use of AE, PPH, track 1
3	More custom examination plans based on clients' needs (fast track or slow track)
3	Improve the automation/mailling process
3	Streamline mis-docketing process
3	Promote Track 1-3 options
2	Email alert before work on case
2	Complete search
2	File into A class (applicant picks); (can use ADS to select art unit?)
2	Attach memos/new policy info to OAs
2	Better prior Art searches by applicant/examiners
2	More prior and pertinent arts provided upfront
2	Increase extension of time fees
2	Office of initial exam-need contact info to correct/obtain information
1	Applicant group claims (representative examination)
1	Focused claims/ready for examination
1	Documenting-if examiner not working of continuation



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Next Steps



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Questions?

QUESTION 1: What behaviors or actions do you see that slow down the progress of an application as it is being prosecuted?

Votes	Ideas
14	Better foreign translation
12	Failure to explain claim interpretations
11	Not having detailed agenda for interview
7	More discussion (compromise) in interviews
4	More claim interpretation in OA
4	General arguments of claim items not taught without specifics
4	Lack of quality in IDS refs
3	Broad claims
3	Piecemeal rejection; not all rej in first OA
3	Too large citations of where things are taught
3	More guidance on restriction practice
3	Tailor patent tract to customer's need; maybe also need a "slower" track, ex quick time for first action long time to dispose begging and end points
3	Sync examiner/att dockets
2	Increase ext of time fecs after 3 months
2	Quick response incentive
2	IDS after allowance
2	Repeating arguments
2	Need earlier indication of allowable subject matter (both ways)
1	More telephonic interviews
1	New arguments late in prosecution
1	Clearly non-statutory claims (20 years)
1	Phone calls are good
1	Person making decision not present at interview, i.e. TQAS, SPE, such as 101s
1	Misdocketed case
	Quick responses; not wailing until six months
	Filing more applications in accordance with US IP Practice
	No art rejection when foreign application not in compliance
	Rule changes for extension of time
	More detailed interview agenda
	Unclear arguments
	No interviews
	Lots of copy and paste; few specific arguments
	Lots of boiler plate comments
	Flipping positions by office
	Scope of invention changes after last action
	Reduce initial pendency
	Move RCE to different docket incentive to push RCEs
	Know next steps after interview
	Reduce piecemeal references

	Amending claims beyond scope of original presentation
	Explain how claim read on ref
	Restriction after first action
	Examiner behavior to meet deadline
	New examiner restriction that not common to art
	Voluminous claims
	Hard to reach, phone number, weeks, months
	Double patenting and TD (time) e-petition
	Inconsistent review 4 junior examiner
	Internal doc flow
	Complete diff (word search) interpretation of art and junior not in art (ex: 100 page)
	Significant amendment att final new claims (scope) could go to RCE problem (1 st action final)
	Multiple request for final/find proper home
	Only citations listed, no explanation
	Treat all claims equally
	Translations not provided-references from 371
	Final practice limiting new references
	Consistently between art units (tech dependent) and core wide
	Filing of incomplete application
	Poor translations
	High number of actions per BD
	Minor items—include it on subsequent OA
	New limitations-RCE
	Multiple embodiments
	Refusal to elect over the phone
	Fail/and/or/willful non-understanding of Art
	Early filing of TD if possible to avoid DP
	Piecemeal amendment; filing amendments/RCEs
	Unclear classification of application
	More exchange of specific information
	Claims-too broad
	Need more detailed disclosure that would lend support for claim amendments to lead to allowance
	Foreign applicants (communication time)
	Pro-se application

QUESTION 2: What behaviors or actions do you see that speed up the progress of an application as it is being prosecuted?

Votes	Ideas
13	More e-mail communications
12	Pilot-1 month to correct claims/spec prior to examination
9	Reduce number of claims to examine
8	Early disclosure of sister/similar application or patents
5	Willingness for examiners to grant interview-i.e. after final
4	Better translations
4	Put claims in better form prior to examination
4	Limiting total number of claims (focus in on the invention)
3	Interviews: frequently, telephonic, prior to 1 st OA, more detailed agenda with summary of invention
2	Be ready to negotiate
2	If examiner suggest allowable language at least add it to a dependent clm
2	Identify allowable subject matter early on
2	Brief arguments; bullet points
2	Keeping related case with same examiner
1	Examine only independent cl and a total of 10 cl in 1 st OA
1	Early IDs submissions (priority docs)
1	Interviews: examiner has art ready (if examiner gets time to first art), agenda-organization
1	Focus search on inventive concept- V. BRI of claim
1	Desktop sharing for phone interviews by attorneys
1	Specs with definitions
1	Interviews (willingness to have)
1	Having definition/list in disclosure
	Patent prose hwy: more useful
	Address more issues in PCT
	Clearly states more open to allowable subject matter
	Better prepared examiner interview
	Interviews (in person)
	Directions on how to amend are helpful
	General summary of arguments helpful before details
	Cancel non-elected claims by calling applicant before allowing
	Provide all "good" art early on
	Good interview: reach agreement, provide/propose amendments, show "why" inventive concept is novel
	Narrow claims during interviews
	Address more than independent claim in applicant's argument
	Meaningful interviews
	Citing relevant art and sections
	Amendments comp. sooner
	Clear/better response to applicant's arguments (position)

	Suggested amendment/allowable subject matter
	Early intention of allow. Subject matter
	Interview before 1 st action
	Applicant amendment when PCT (preliminary)
	Foreign apps-file application ready for examination
	New workflow calc of days vs biweek
	Make public PTO internal deadlines
	Full disclosure of RDS upfront
	Advance training on legal concepts
	Applicant can get SPE/third party involved without penalty to examiner
	Interviews, explanation of the background of invention prior to FAOM, phone calls
	Offering suggestions
	Citing relevant prior art in addition to that used in rejections
	After final and RCE include amendments
	Accelerated examination, PPH
	IDS considered after NOA, before issue
	Provide atty as many pertinent prior as possible upfront
	Early interviews
	AF Amendment: 1 month incentive, 2 months none, 3 months penalty
	Full utilization of docket management
	Amendment with mapping to detail support in spec particulars for non-common terminology
	Suggestions for allowable factors to applicants
	Jepsom format claims preferred
	In spec, less boiler plate and less number of claims
	Phone call with info pertaining to why independent claims are not allowable
	Cite all relevant not just applied art
	Providing citation information in the specifications
	Good claim drafting
	Claim element to ref element matching in office action
	Providing statement of relevance with IDS ref's cited
	International search reports
	When ADS provides suggested classification
	Willingness to work together (reducing issues)

QUESTION 3: What suggestions do you have for ways to speed up the progress of an application as it is being prosecuted?

Votes	Ideas
28	Expand communication before 1 st OA pre-action interviews
26	Be able to communicate with email (get nI 7 waiver)
25	Limit to 20 claims
25	Joint training-AIPLA/examiners
23	Notification that examiners are going to begin examination within a month or 2 months (to sync dockets for first action)
22	Reward efficiency
20:	Better linking of references/applications; for example, if a case is allowed, but a ref pops up in a related case linking that reference on the patent office side of things instead of an IDS
19	Applicants mapping of the claim set to corresponding aspect of the spec
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14	Strong incentives for quicker response time: incentive fees for buying time, working on related cases of the same time, interviews mandatory
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8	More use of email
8	Back and forth in same week as opposed to every six months
8	Educate applicant on new DM system
7	List of related cases filed early
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7	QEM sessions for examiners to discuss cases
7	Continuation to same examiner
6	Publish internal (PTO) deadlines/requirement
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5	European style central claiming
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4	Clear position taken should be stated/complete search
4	Adaptable workflow to work on similar application
3	Clerical/not subject matter related issues be corrected at office
3	More use of AE, PPH, track 1

3	More custom examination plans based on clients' needs (fast track or slow track)
3	Improve the automation/mailing process
3	Streamline misdocketing process
3	Promote track 1-3 options
2	Email alert before work on case
2	Complete search
2	File into A class (applicant picks); (can use ADS to select art unit?)
2	Attach memos/new policy info to OAs
2:	Better prior Art searches by applicant/examiners
2	More prior and pertinent arts provided upfront
2	Increase extension of time fees
2	Office of initial exam-need contact info to correct/obtain information
1	Applicant group claims (representative examination)
1	Focused claims/ready for examination
1	Documenting-if examiner not working of continuation
	Multiple related cases have group interviews
	Clean word copy of claims
	Use of powerpoint in interviews
	More detailed in propose amendment
	Interview agenda/bring art
	Align pre-appeal conferences with appeal conferences
	Chart claims 1-1 mapping and explanation
	Offer common interpretations earlier in prosecution
	Consider utility type model applications
	E-form SBOIA-make it editable (ex add more than 2 inventors)

- Quicker Responses Q1
↳ not waiting till 6 mths.

- Broad Claims

- Piece meal Rej
↳ not all rej. in 1st OA.

- More Discussion (compromise)
in interviews

- More Telephonic Interviews.

- Filing more App'l in accordance
w/ US IP Practice.

- No Art Rejection when filing App'l
not in compliance

- More Claim Interpretation in
OA.

Q1

- Rule changes for extension
of time

- More detailed Interview Agents

- 1) Reduce piecemeal references
- 2) Amending claims beyond scope of original presentation
- 3) Explain how claim read on ref.
- 4) Better Foreign Translation
- 5) Quick Response Incentive
- 6) Sync. Examiner/Att Dockets

What behavior ... slow prosecuted?

1. restriction after 1st Action Q1
2. Examiner behavior to meet dead line
3. New Examiner restriction that not common to art
4. IDS after allowance
5. New arguments later in prosecution
6. voluminous claims
7. Hard to reach, phone #, weeks, months
8. clearly non-statutory claims (20 years)
9. Double Patenting + TD (time) e-Relation
10. inconsistent Review & Junior Ex.
11. Internal Doc flow

- Rule changes for extension of time
- More detailed Interview Agem

#1 Unclear arguments Q1

No interviews

Lots of copy & paste few specific arguments

Lots of Boiler plate comments

••• Too large citations of where things are taught

••• Failure to explain claim Interpretations

••• General arguments of claim items not taught without specifics

Elaborate positions by office

Lots of Boilerplate comments

• Too large citations of where things are taught

• Failure to explain claim Interpretations

• General arguments of claim items not taught without specifics

Elaborate positions by office

- Scope of invention changes after 1st action
- More guidance on restriction practice
- Increase ext. of time fees after 3 mos.
- Reduce initial pendency
- Move RCE to different docket
- Incentive to push RCEs
- Tailor patent track to customer's need
- Maybe also need a "slower" track
- Quick fee for 1st action long time to dispose beginning & end points
- Know next steps after interview

What behavior ... slow prosecuted?

1. restriction after 1st Action AI
2. Examiner behavior to meet dead line
3. New Examiner restriction that not common to art

- 4. IDS after allowance
- 5. New arguments later in prosecution
- 6. voluminous claims
- 7. Hard to reach, phone #, weeks, months
- 8. clearly non-statutory claims (20 years)
- 9. Double Patenting + TD (time).
e-Rejection
- 10. Inconsistent Review & Junior Ex.
- 11. Internal Doc flow
- 12. Complete Diff. Interpretation of
art + Junior not in art ← (word search)
ex. (101 page) 5
- 13. Significant amendment after final
new claims (scope) could go to RCS
Problem (1st action final)
- 14. Multiple request for final / final paper home

- ① Repeating arguments ●●
- ②, only citations listed no explanation.
- ③ treat all claims equally.
- ④ Translations not provided. (references from 371 ~~...~~)
- ⑤ Final practice limiting new references.
- ⑥ Phone calls are good.
- ⑦ Person making decision not present @ interview.
ie TQAS, etc, such as 101's
- ⑧ Consistency between Art units (tech dependent)
→ Case wide

Talking of
An Incomplete Application

Q1

- Poor Translations

●●●● Lack of quality in IDS refs

→ High # of Actions per BD

- minor issues → add include it on subsequent Opinions

- review limitations → RCE

- Multiple Embodiments

- Refusal to elect over the prior

Q1 behavior - Slow down

Unclear Classification of Application

^{not having}
Detailed agenda for
interview

- need earlier indication of Allowable subject matter (both ways)
- More exchange of specific info

Q1 Claims - Too Broad

- Need more detailed disclosure that would lend support for

- of Allowable subject matter (both ways)
- More exchange of specific info

Q1 Claims - Too Broad

- Need more detailed disclosure that would lend support for claim amendments to lead to allowance

- Foreign Applicants (communication time)

- Pro-Se Application

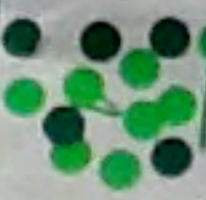
Q2

- 1) Meaningful Interviews
- 2) Willingness for Examiners to Grant Interview - i.e. After Final
- 3) Citing Relevant Art & sections
- 4) Put claims in better form prior to Examination
- 5) Pilot - 1 month to correct claims/spec prior to Examination
- 6) ~~Fee~~ Amendments comp sooner
- 7) Clear / Better Response to Applicant's arguments (Position) ~~7~~

8) Suggested Amendment / Allowable subject matter

Q2

- Interviews
 - ↳ Frequently ●
 - ↳ Telephonic
 - ↳ Prior to 1st OA. ●●●
 - ↳ More detailed Agenda w/ summary of invention
- Patent Procec. Hwy.
 - ↳ More Useful.
- Address more issues in PCT.



More e-mail comm.

- Clearly states more open to allowable subject matter
- Better prepared Examiner. Interview ①

- Examine only Independent
- Cl. # and a total of 10 Cl. in 1st OA

#2 Interviews (In person)

- Be ready to negotiate

- If examiner suggest allowable language at least add it to dependent claim

Directions on ^{how} ~~where~~ to amend are helpful

General summary of ~~arguments~~ ^{arguments} before details helpful

early IDs submissions •
priority Docs

Better translations •••

Q2:
• Cancel non-elected claims by calling applicant before allowing

- Provide all good art early on

- Good interview - reach agreement
 - provide/propose amends

early IDs submissions ●
priority Docs

Better translations ●●●●

- Cancel non-elected claims by calling applicant before allowing
- Provide all good art early on
- Good interview - reach agreement
 - provide/propose amdt
 - show "why" inventive concept is novel
- narrow claims during interviews
- address more than independent claim in Applicant's argument
- reduce # claims to examine ●●●●●
- identify allowable subject matter early on. ●●

1) Interviews

- A) Examiner has art READY
(if exam ~~can~~ gets time to find art)
- B) Agenda → Organization

2) EARLY indication of allow. ^{Sub matter}

3) Interview before 1st Action

- 4) Focus SEARCH on inventive concept
V. BRI of claims

5) Applicant ^{emol.} when RET (preliminary)

6) Foreign Apps → File App/claim READY FOR examination

Q2 | P2

- 7) Desktop sharing for phone interviews by city.

8) new workflow rule of days v Biweek ??

Examiner
Atty

explanation of the background of invention
(prior to FAOM)

Question 2

①, Interviews, Phone Calls. ●

②, Offering Suggestions.

③, Limiting total number of claims
●●●● (four in on the invention)

④, Citing relevant prior art in addition
to that used in rejections

⑤ ~~Final~~ + RCE include Amendments.

⑥, Accelerated examination, P.P.H.

⑦ IDS considered after NOA, before Issue

⑧ Keeping related case w/ same
●● Examiner.

⑥

- * Provide ~~ed~~ as many ~~positive~~ ~~prior~~ as possible upfront
- * Early Interviews

Q2

AF	1 mos	incentive
Amdt	2 mos	NO "
	3 mos	penalty

- * Full Utilization of Docket Mgmt
- * Amendment w/ mapping to detail support in spec ~~for~~ particulars for non-common terminology
- * Suggestions for allowable features to Applicants
- * Ipcsm format claims preferred
- * In Spec, less boiler plate & less # of claims
- * Phone call w/ into pertaining to why indep claims ~~are~~ are not allowable
- * all relevant ~~not~~

Q2-Cont

• Early disclosure of
• Sister/similar
Application or Patent

• Providing statement
of relevance with
IDS ref's cited

• International Search
Reports

when ADS provide
requested classification
progress to work

G2: Behavior - Speed up

- Interviews
- (Willingness to have)
- having definition list in disclose
- Providing citation ~~more~~ information in the specification
- Good Claim drafting
- Element to Ref
- element matching in Action

- Cont. page
• SPE's ~~are~~ Assigned to
art area that they know

• Send SPE's to training
Permit Technical

23- cont.

• Quick e-form for
e-mail waivers

• Adaptable Workflow
to work on Similar

Application

Continuation to same

03 cont.

• Quick e-form for e-mail waivers

• Adaptable workflow to work on similar

Application

Continuation to same

Examiner

Documenting - if examiner not
continuation

Form SP01A - make it
able (to add more than 2
others)



Q3: Suggestion - Speed up.

- Increase extension of time fees

- Early Indication of Allowable Subject matter

- QEM sessions for examiners to discuss cases

- TD via e-petition

- Office of initial Exam - need

- Contact info to correct/obtain information

- Joint training - AIPLA/Examiners

More Pre-OA interviews

Streamline Mic Marketing Process

Provide back 1-3 options

Better prior Art Searches
by Applicant / Examiners

More interactive
(communicating email, phone
etc.)

Timely indications
of Pendency subject matter
by both parties

more joint work
#

Attay

① Chart claims \rightarrow 1-1 mapping and explanation.

② Offer ^{Common} interpretations earlier in prosecution.

③ European Style central claiming.

④ Reward Efficiency

⑤ Better linking of references/applications

for example if a case is Allowed,
but a ref pops up in a related case
linking that reference on the Patent
Office side of things, instead of an IDS.

⑥ Consider utility type model
Applications

Q3	P1
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1) Applicant Group claims
(Representative Examination)

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2) File into A class (Applicant picks)
(can use ADS to select Art Unit?)

3) Interview Agents / Bring Act

4) Focused Claims / Review for Examination

5) Publish Internal (PTO) deadlines / Requirements

6) Bullet / outlined Arguments

7) Attach Memos / New Policy info to OAs

8) Align Pre-Appeal Conferences
w/ Appeal conferences

9) More feedback from pre-Appeal

10) Limit to 20 claims

5

6) Improve the automation/
mailing process

Q3:

1) Notification that Examiners are
going to begin Examination within
1 month (To Sync Dockets)
or
2 months for first Action

2) Clear Position Taken should
be stated/Complete Search

3) Applicants mapping of the
claim set to corresponding
aspect of the spec

4) Complete Search

Issuing

FA

Q3:

incentives for ^{filing} responses sooner
(pe.s. ~~prof.~~ pref. in queue) - weighted system

more detailed in propose and t

pre-OA - ^{general state of art} ~~full search~~ + clean up formalities

Expo communication before 1st OA
(pre-action interview)

e-mail alert before work on case

educate applicant on new DM system

more custom examination plans

based on clients needs
(Fast track or slow track)

Syncing DM system w/
applicant's

- Be able to communicate w/email. (Get rid of waiver)

- Multiple related cases have group interviews

• Clerical/not subject matter rel. issues be corrected @ office.

• Strong incentives for quicker response time

↳ Increase Fees for buying time

↳ Working on related cases at the same time

↳ Interviews Mandatory.

• More PTO offices around country closer to clients (1)

• More use of email

Clean ^{word} copy of clms

• Back & forth in same week
as opposed to every 6 months

• List of related cases filed early

Use of powerpoint in interviews

• More use of AE, PPH, track 1

- ① Repeating arguments ● ●
- ②, only citations listed no explanation.
- ③ treat all claims equally.
- ④ Translations not provided. (references from 371 ~~and~~)
- ⑤ Final practice limiting new references.
- ⑥ Phone calls are good.
- ⑦ Person making decision not present @ interview.
i.e. TQAS, Spe, such as 101's
- ⑧ Consistency between Art units (tech dependent)
→ Core wide.

Tilting of Incomplete Application

- Poor Translations

* Lack of quality in IDS refs
* → High # of Actions per BD

- minor items → add include it on subsequent OA is too many, too hard
- New limitations → RCE

- Multiple Embodiments

- Refusal to elect over the phone

- Fail/and/or/willful

non-understanding of Art

* Misdocketed case

- delay per OA interview

- Early filing of TD + or initial disc
if possible to avoid DP double pat

- Piecemeal Amendments

Many Amendments/RCEs