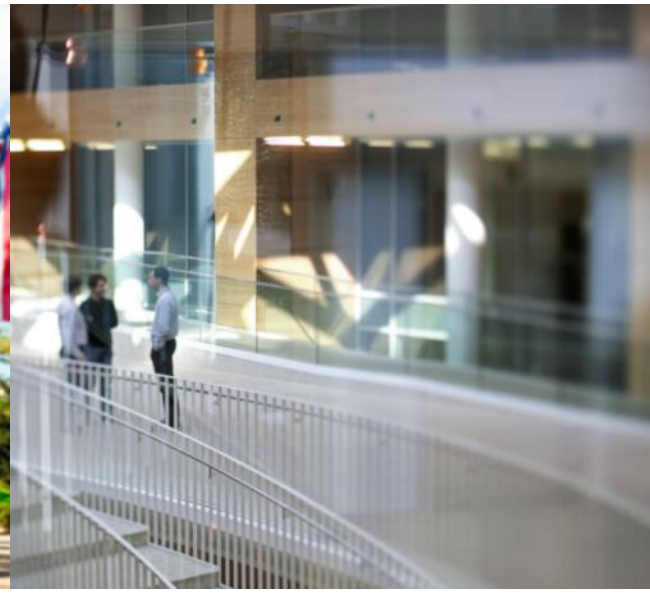
Europäisches Patentamt
European Patent Office
Office européen des brevets

PATENT QUALITY CONFERENCE
International Panel

EPO and user community engagement
Sharing best practices
Quality Assurance and continual improvement





➢ EPO and user community engagement

- ❑What does the EPO do to engage the user community and get them to invest in quality in the applications they submit?

Engaging with users

Regular meetings worldwide:

- user associations, e.g. “Partnership for Quality”
- company visits, more than 300 per year

Meetings used to inform users about:

- legal changes
- new procedural opportunities
- other developments at the EPO

User feedback: core element of the EPO’s ISO 9001 certified QMS

- online complaints form
- User Satisfaction Surveys
- meetings with users
- customer services

EPO procedures encourage quality and efficiency

EPO PCT processing is fully integrated with subsequent EP regional phase

- EPO PCT searches fully recognised during subsequent EP prosecution
- there is no EP phase search for applications searched by ISA=EPO

- PCT Direct: applicants filing an international application claiming priority from an application already searched by the EPO may react to objections raised against the priority application. This simplifies assessment of the international application and adds value to the international search report and written opinion established by the EPO.

- Rule 161 EPC: gives applicants the opportunity to comment on, or amend, an application based on objections raised during the PCT phase.

EPO procedures encourage quality and efficiency

Acceleration**:** PACE and PPH are free (no fee).

Substantiated third party observations can accelerate processing of a competitor’s application.

- **Sharing best practices**

  - What does the EPO do to make sure that best practices within a group are spread?

Disseminating best practices – core activities

Collaboration between examiners is enshrined into the European patent granting process (Art 18 & 19 EPC):

- discussions in examining / opposition divisions – typically 3 technically skilled examiners, if required a 4th legally qualified examiner

- ad hoc consultations (EPeOple portal helps to find the competence required)

- in process quality review and analysis of audit reports

- Single Legal Source and Technical Training portal

- Senior experts

Examiner support network

Disseminating best practices – training and monitoring

Dedicated training:

- classroom training
- on demand eLearning
- dedicated coaches for newcomers

Risk based monitoring and response

- Procedural Data Visualization identifies deviations from norm and allows one to take act

Disseminating best practices – other activities

- Continuous Knowledge Transfer (CKT), flash seminars, intranet daily tips
- Asian Patent Expert Group (APEG) – enhances knowledge related to documentation in Asian and Russian languages on a practical level, providing translation aid when necessary
- Senior experts network
- External visits to companies, conferences
- Internships Extern
- Internships Intern

➢ Quality Assurance and continual improvement

- ❑ How does EPO use data from prosecution to drive consistency in patent examination?

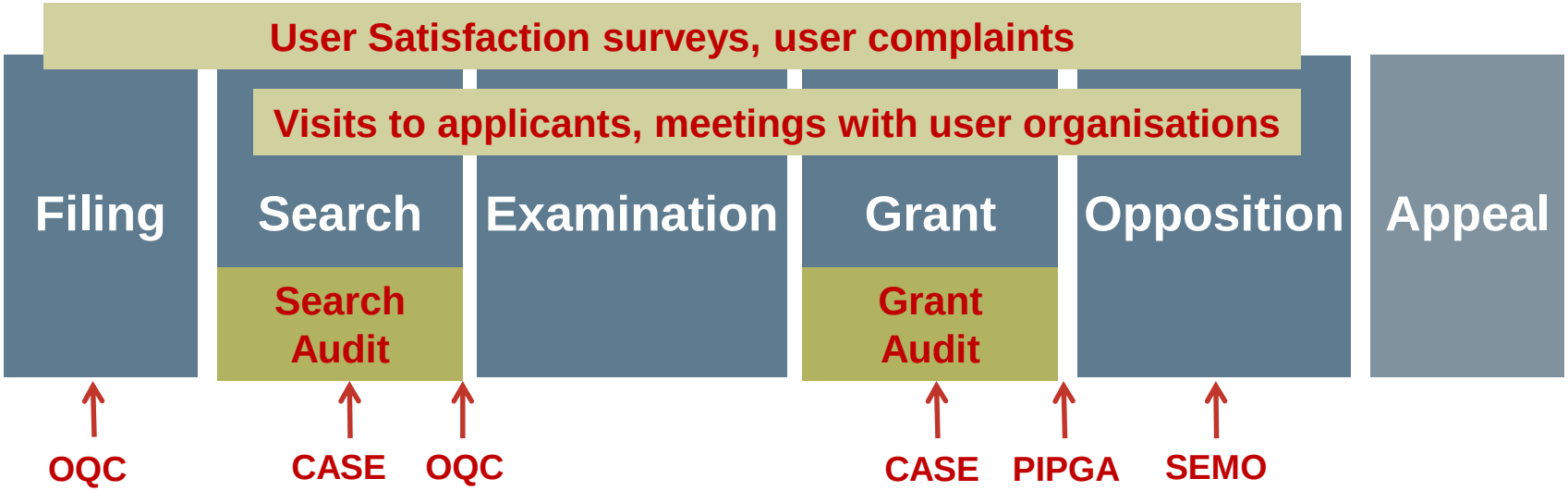
Elements of Quality Assurance

User Satisfaction Surveys & Complaints

- Both are an integral part of the EPO's QMS which help identify users needs and concerns

Meetings with users

- A means of informing applicants of developments and obtaining quality-related feedback



OQC Operational Quality Control: quality control of Patent Administration processes & products

CASE Conformity Assurance in Search and Examination

- in-process control of nonconforming products, quality-relevant data for continual improvement

PIPGA Patent Information & Post-Grant activities:

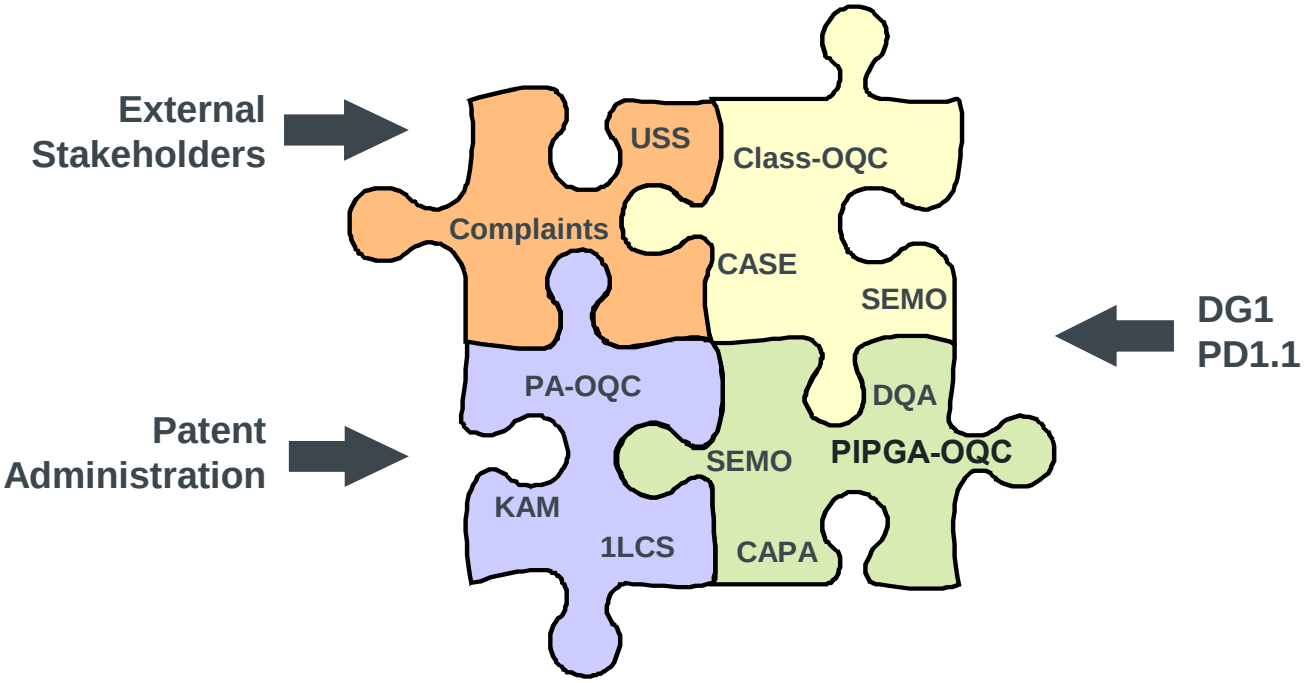
- timeliness of each core process, accuracy and quality data of EP patents

SEMO: Search and Examination Metrics from Opposition

Quality Audits: detailed analysis of approx. 720 search and examinations per year

Integrated Quality Reporting: Preparation

- In Autumn, all quality-related data is collated:
  - a preliminary analysis is performed by PDQM
  - findings are discussed with DG1, Patent Administration and Patent Information




Set quality objectives
(President)
Implement Action Plans
(Operations)
QMS process audits & quality KPI monitoring
(Quality Management Dept.)
Quality Reporting to Operations
(Quality Management Dept.)
Management Review of QMS
(Chaired by President)

www.epo.org/quality

PATENT QUALITY: WHAT WOULD A ZERO-BASED PATENTING PARADIGM LOOK LIKE?

File, Examine and Issue Patents in One Year

Leverage Applicant Disclosures to Optimize Quality/Productivity

Robert A. Armitage – Consultant, IP Strategy & Policy

Zero-Based Patenting: One-Year Examination Paradigm

Provisional filing fees credited against NP appl. fee

Provisional Patent Filing

Foreign Priority Patent Filing

Grace Period: Technical Journal Publication

Option to treat as provisional filing.

New Disclosure Duty Barring Disclosure of Items of Prior Art Not of Potential Relevance.

Maximum pendency is 3 years – no PTA – 17-year patent life guarantee.

At 3-years, pending claims issue if rejected claims remain.

§ 257 SE-type reexam then declared

PTAB Appeal Process ca. 3 months

Encourage use of a one-year *provisional-grace-priority* period in before the definitive patent filing triggering the 20-year term.

Single Filing-Search-Examination-Issue Fee for Each Indepen-dent Claim

NP Filing Must Be Accompanied by an IDS

Patent issues unless application abandoned within 1 month after all claims allowed.

Nonprovisional [NP] Patent Filing

Every NP Application Published Upon Filing

2 months to first action

2 months applicant response

2 months to final action

2 months to final response

3-Year RCE limit; *no Divisional, CIP, or Other Continuing Applications.*

Patent Quality Means Start Over From Scratch With An Entirely New Paradigm For Applicant Disclosures

§ 1.56 Disclosure of Information to the Office.

(a) REQUIREMENTS WITH RESPECT TO DISCLOSURES.—

(1) IN GENERAL.—An individual submitting information in a matter before the Office must not—

(A) falsify, conceal, or cover up by any trick, scheme, or device a material fact;

(B) make any materially false, fictitious, or fraudulent statement or representation; or

(C) make or use any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry.

(2) MATERIALITY; RELEVANT PRIOR ART.—

(A) RELEVANCE TO AN EXAMINED CLAIM REQUIRED FOR MATERIALITY.—Information or its misrepresentation is not material to the examination of an application for patent unless the information or its misrepresentation is relevant to the patentability of a claim being examined in the application.

(B) RELEVANT PRIOR ART.—An item of prior art that has not previously been considered by the Office during examination of an application is relevant to the patentability of a claim in the application if, taking account any prior art that may already be under consideration by the Office, consideration of the item not previously disclosed would allow the Office to reject the claim as unpatentable on a new ground that could not have been raised without a citation to such item.

(C) MATERIALITY LIMITATION.—Notwithstanding subparagraph (B), information or its misrepresentation is not material to the patentability of a claim in an application if, were such claim to be patented on the application, the claim would not be invalid.

(b) ITEMS OF PRIOR ART NOT TO BE DISCLOSED.—

(1) IN GENERAL.—An individual who submits one or more items of prior art to the Office in connection with the examination of a patent application must limit such a submission of prior art to items for which such individual has a good faith belief that each submitted item is possibly relevant to the patentability of at least one claim being examined in the application.

(2) POSSIBLE RELEVANCE.—An individual item of prior art is of possible relevance to the patentability of a claim under paragraph (1) if a reasonable possibility exists that such item could qualify as relevant to patentability, as set out under subparagraph (a)(2)(B).

(3) SAFE HARBORS.—

(A) NO VIOLATION OF PROHIBITION.—A submitter's disclosure of an item of prior art shall be deemed not to violate the prohibition on disclosures under paragraph (1) if the submitter's disclosure of such item is accompanied by a concise statement setting forth the submitter's belief as to the item's content that is of possible relevance to the examination of the application in which it is disclosed.

(B) REPRESENTATIONS AS TO CONTENT AND POSSIBLE RELEVANCE.—No representation by a submitter that is made in the manner described under subparagraph (A) may be cited in support of a contention that a disclosure requirement under subsection (a) has been violated.

(C) NO ADMISSION OF RELEVANCE.—No statement made under subparagraph (A) may be cited by the Office or the courts as an admission that an item is material in fact to patentability or otherwise of any relevance in fact to patentability, including as an admission that such item could be relied upon by the Office in support of a rejection of any claim in an application.

(c) REQUIRED STATEMENT IN LIEU OF PRIOR ART DISCLOSURE.—Unless a submission in an application has been made at the time the application was filed identifying one or more items of possibly relevant prior art, a statement must be submitted in connection with the filing of the application that the applicant for patent has no knowledge of any relevant prior art.

(d) EFFECTS OF INFORMATION DISCLOSURE.—

(1) CONSIDERATION BY THE OFFICE.—For the purposes of this section, no item of prior art shall be deemed to have been considered by the Office in determining the patentability of the claims in an application unless such item was—

(A) relied upon by the Office in support of a rejection of at least one claim in the application;

(B) submitted in the application, by or on behalf of the applicant, together with a concise statement accurately identifying the content of the item that is possibly relevant to patentability; or

(C) submitted to the Office by a third party in connection with the application in a preissuance submission meeting the requirements under 35 U.S.C. § 122(e).

(2) OTHER PROCEEDINGS.—In determining the validity of a patent in a proceeding in which the patent is presumed to be valid, only prior art deemed under paragraph (1) to have been considered by the Office in the application on which the patent issued shall be regarded has having been before the Office in the examination of the patent.

§ 1.56 Disclosure of Information to the Office.

(a) REQUIREMENTS WITH RESPECT TO DISCLOSURES.—

Rule 56(a) bars *material* omissions and misrepresentations using the same framework as 18 U.S.C. § 1001(a).

Rule 56(c) – Affirmative statement required as to existence of relevant prior art.

3-Part Materiality Standard: (1) Must be *relevant* to an examined claim, (2) *relevance of prior art to a claim requires ability to cite in support of a new ground of rejection*, and (3) no materiality to a claim unless the claim, if patented, would be invalid.

Rule 56(b) bars the disclosure of item of prior art absent good faith believe of *possible relevance* to an examined claim.

Possible relevance requires that *reasonable likelihood that item of prior art could qualify as relevant*.

(2) POSSIBLE RELEVANCE.—An individual item of prior art is of possible relevance to the patentability of a claim under paragraph (1) if a reasonable possibility exists that such item

1st Safe Harbor – No Rule 56(b) violation for a prior art item accompanied by concise description of submitter's good faith belief as to content of possible relevance.

2nd Safe Harbor – No Rule 56(a) violation a representation made under the 1st Safe Harbor.

(B) REPRESENTATION AS TO CONTENT AND POSSIBLE RELEVANCE.—No representation by a submitter that is made in the manner described under subparagraph (A) may be cited in

Rule 56(b)(3) – Three Safe Harbors

3rd Safe Harbor – Representation under 1st Safe Harbor cannot be cited by the USPTO or courts as material to patentability or otherwise relevant to patentability—or could be relied upon to support a claim rejection.

(d) EFFECTS OF INFORMATION DISCLOSURE.—

(1) CONSIDERATION BY THE OFFICE.—For the purposes of this section, no item of prior art shall be deemed to have been considered by the Office in determining the patentability of the

Rule 56(d) (1) – Prior art not deemed *considered* by the USPTO unless (1) submitted by applicant under 1st Safe Harbor, (2) cited in support of a rejection, or (3) filed under 35 U.S.C. § 122(e).

Rule 56(d)(2) – Only Rule 56(d)(1) prior art to be regarded as before the USPTO in assessing presumptively valid patents.

(2) OTHER PROCEEDINGS.—In determining the validity of a patent in a proceeding in which the patent is presumed to be valid, only prior art deemed under paragraph (1) to have been considered by the Office in the application on which the patent issued shall be regarded has having been before the Office in the examination of the patent.

A Zero-Based Patenting Paradigm Would:

Enact greater incentives to utilize provisional filings—nonprovisional fee credit, immediate publication of nonprovisional filings upon filing, and immediate IDS obligation upon nonprovisional filing; permit certain "grace period" publications to provide the priority (and require NP filing at the end of the 1-year "grace period").

Create a one-year pendency goal, start-to-finish—one filing, one comprehensive fee due at NP filing (per independent claim), one examination, one patent issuance—and no divisional, CIP, or other continuing applications permitted.

Provide a 3-year maximum pendency—if necessary, issue patents with rejected claims into a § 257 SE-type reexaminations. Allow early post-grant review initiation.

Rationalize applicant disclosure obligations—incentives to limit what information is disclosed and to vastly improve the content of information that is disclosed.

What Can Applicants Do to Improve Patent Quality?

Mark Vallone
December 13, 2016

Patent Quality: A Shared Responsibility

- USPTO being proactive through 12 EPQI programs
- Other measures: increased time vs. reduced pendency/cost
- Encourage devotion to first action on the merits
  - Reading of specification and fully understanding the invention
  - Providing clear and complete objections and rejections
  - Prior art rejections based on closest prior art available
  - Ability to address all perceived patentability issues in the first response
- Encourage examiner interviews at all stages of prosecution
  - Examiner understanding of applicant's invention
  - Examiner creates clear record of changes in position and basis thereof

Patent Quality: Applicant Pre-Filing Measures

- Obtain sufficient details of invention from inventors
  - Informs decision to pursue for patenting
  - Improves prior art search direction / application clarity and completeness
- Prior art search as default practice
  - Perceived patentable feature(s) vital to search and independent claims
  - Exceptions to default practice (e.g., bar dates, world-class knowledge)
- Draft clear/understandable/navigable specifications and claims
  - Use tools to alleviate time concerns
  - Draft claims that can be understood without reading the specification
  - Present broadest claim first (don't "hide the ball")
  - Avoid over-claiming – not best use of examiner time

Patent Quality: Applicant Prosecution Measures

- Promptly respond to pending USPTO actions
  - Mitigates need to re-learn the case and its current posture
  - Can benefit patent term and reduce cost
- Interview early and interview often
  - Ensures applicant understanding of examiner's point of view
  - Improves the probability of advancing prosecution
  - Cost of extension of time vs. cost of RCE or notice of appeal
- Avoid prior art "flooding" in IDSs
  - More likely when there are several related cases
  - Mitigate citing immaterial/cumulative art – not best use of examiner time