



**Enhanced
Patent
Quality
Initiative**

**Case Study: Correctness and Clarity of
Rationale Statements in 35 USC 103
Rejections Case Study**

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Objective of 103 Case Study

To study whether Examiners are making clear and correct rationale statements under 35 USC 103.





Data Collection

- 4916 Random OPQA Reviews completed using the Master Review Form (MRF) including the evaluation of at least one 103 rejection made
- Reviews Completed between November 2015 and June 2016





Correctness of Articulated Rationale

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MRF Section: 103 Rejection Made

Questions Considered to Address Rationale Correctness

Question 1:

Proper rationale to combine prior art references provided (e.g., motivation to combine)

Yes

In-Part

No

N/A

Question 2:

OVERALL OK

Needs Attention

Significant
Deficiency

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Question 1: Correctness of Articulated Rationale Statement

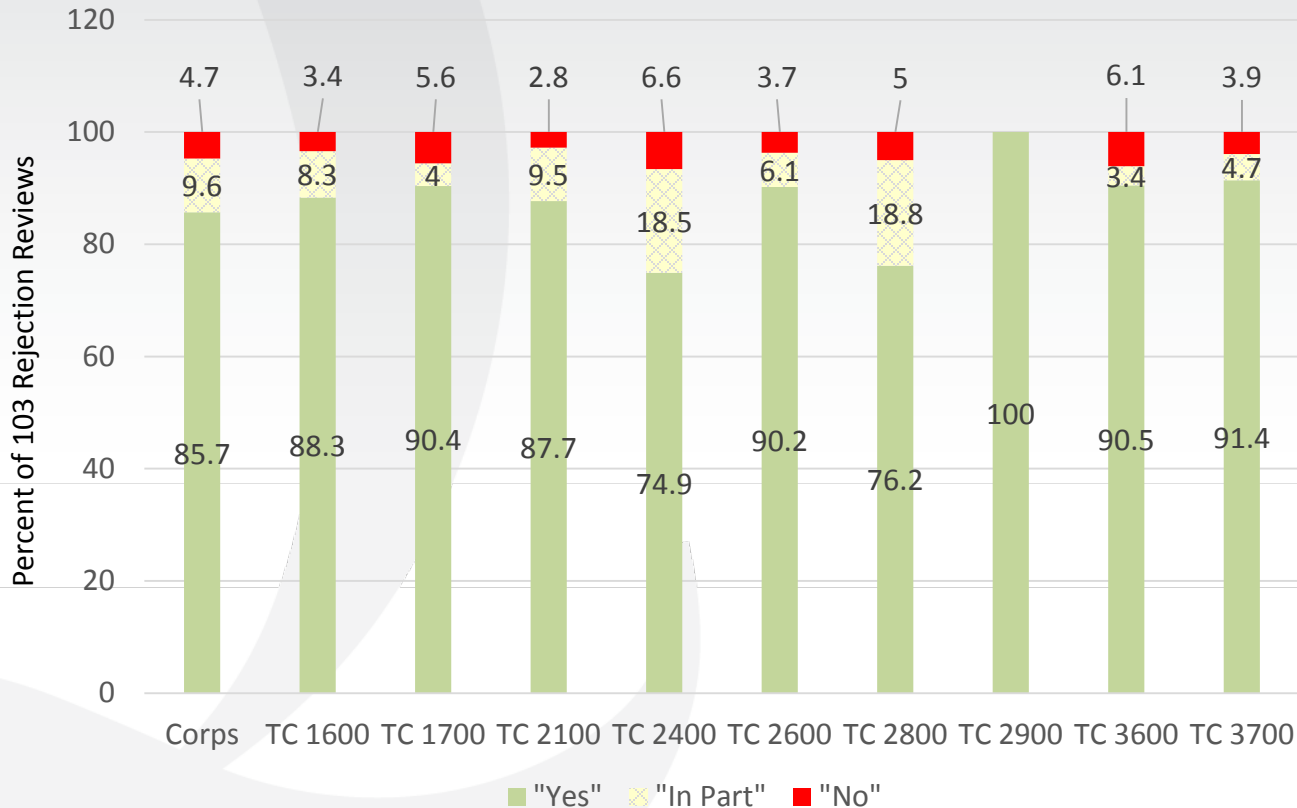
| TC | Yes | | In Part | | No | | N/A * | | Total |
|------|-------|------------|---------|------------|-------|------------|-------|------------|-------|
| | Count | Percentage | Count | Percentage | Count | Percentage | Count | Percentage | |
| 1600 | 308 | 82.6% | 29 | 7.8% | 12 | 3.2% | 24 | 6.4% | 373 |
| 1700 | 571 | 78.0% | 25 | 3.4% | 35 | 4.8% | 101 | 13.8% | 732 |
| 2100 | 527 | 86.5% | 57 | 9.4% | 17 | 2.8% | 8 | 1.3% | 609 |
| 2400 | 490 | 73.8% | 121 | 18.2% | 43 | 6.5% | 10 | 1.5% | 664 |
| 2600 | 535 | 88.9% | 36 | 6.0% | 22 | 3.7% | 9 | 1.5% | 602 |
| 2800 | 554 | 72.8% | 137 | 18.0% | 36 | 4.7% | 34 | 4.5% | 761 |
| 2900 | 11 | 84.6% | 0 | 0.0% | 0 | 0.0% | 2 | 15.4% | 13 |
| 3600 | 431 | 85.3% | 16 | 3.2% | 29 | 5.7% | 29 | 5.7% | 505 |
| 3700 | 564 | 85.8% | 29 | 4.4% | 24 | 3.7% | 40 | 6.1% | 657 |
| | 3991 | 81.2% | 450 | 9.2% | 218 | 4.4% | 257 | 5.2% | 4916 |

* The wording of the question is “Proper Rationale to combine prior art references” which led to some reviewers to answer “N/A” (not applicable) if it was a single reference 103. Suggestion to change the wording on the MRF to: “Proper rationale for the modification(s)” and/or train RQAS how to interpret.





Question 1: Correctness of Articulated Rationale Statement – Bar Graph Comparison



*Percentages of reviews without N/A

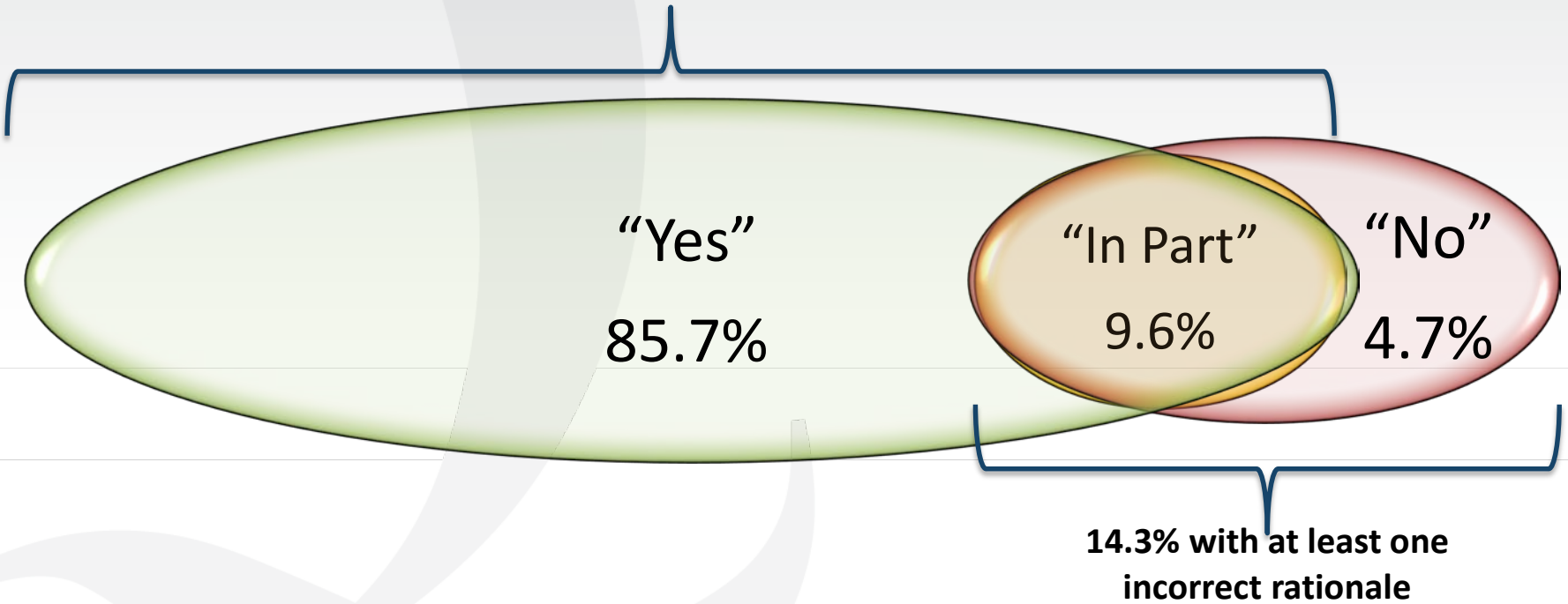
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Correctness of Articulated Rationale (Question 1)

95.3% with at least one correct rationale



*Percentages of reviews without N/A

"Yes" = All Rationale Statements Correct

"In Part" = Some Rationale Statements Correct and Some Rationale Statement Incorrect

"No" = All Rationale Statements Incorrect

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Correctness of Articulated Rationale to Overall 103 Correctness

| | | Overall 103 Correctness (Question 2) | | | |
|---|---------|--------------------------------------|-----------------|------------------------|-------|
| Correctness of articulated rationale (Question 1) | | OK | Needs Attention | Significant Deficiency | Total |
| | Yes | 3568 | 311 | 112 | 3991 |
| | In Part | 222 | 168 | 60 | 450 |
| | No | 36 | 94 | 88 | 218 |

“OK” = No error that rises to the level of a significant deficiency as defined by the IPED standard

“Needs Attention” = Issues present that require attention generally formal in nature and are not found to have a significant impact on prosecution

“Significant Deficiency” = Issues present that have significant impact of prosecution

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Clarity of Rationale

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MRF Section: 103 Rejection Made

Questions Considered to Address Rationale Clarity

Question 3:

Was the rationale to combine/reasons for obviousness clearly explained? Yes In-Part No

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Question 3: Clarity of Articulated Rationale Statement

| TC | Yes | | In Part | | No | | Total |
|------|------|--------|---------|--------|-----|-------|-------|
| 1600 | 342 | 91.69% | 23 | 6.17% | 8 | 2.14% | 373 |
| 1700 | 658 | 89.89% | 34 | 4.64% | 40 | 5.46% | 732 |
| 2100 | 559 | 91.79% | 43 | 7.06% | 7 | 1.15% | 609 |
| 2400 | 548 | 82.53% | 88 | 13.25% | 28 | 4.22% | 664 |
| 2600 | 552 | 91.69% | 33 | 5.48% | 17 | 2.82% | 602 |
| 2800 | 620 | 81.47% | 120 | 15.77% | 21 | 2.76% | 761 |
| 2900 | 12 | 92.31% | 1 | 7.69% | 0 | 0.00% | 13 |
| 3600 | 466 | 92.28% | 13 | 2.57% | 26 | 5.15% | 505 |
| 3700 | 623 | 94.82% | 13 | 1.98% | 21 | 3.20% | 657 |
| | 4380 | 89.10% | 368 | 7.49% | 168 | 3.42% | 4916 |

“Yes” = All Rationale Statements Correct

“In Part” = Some Rationale Statements Correct and Some Rationale Statement Incorrect

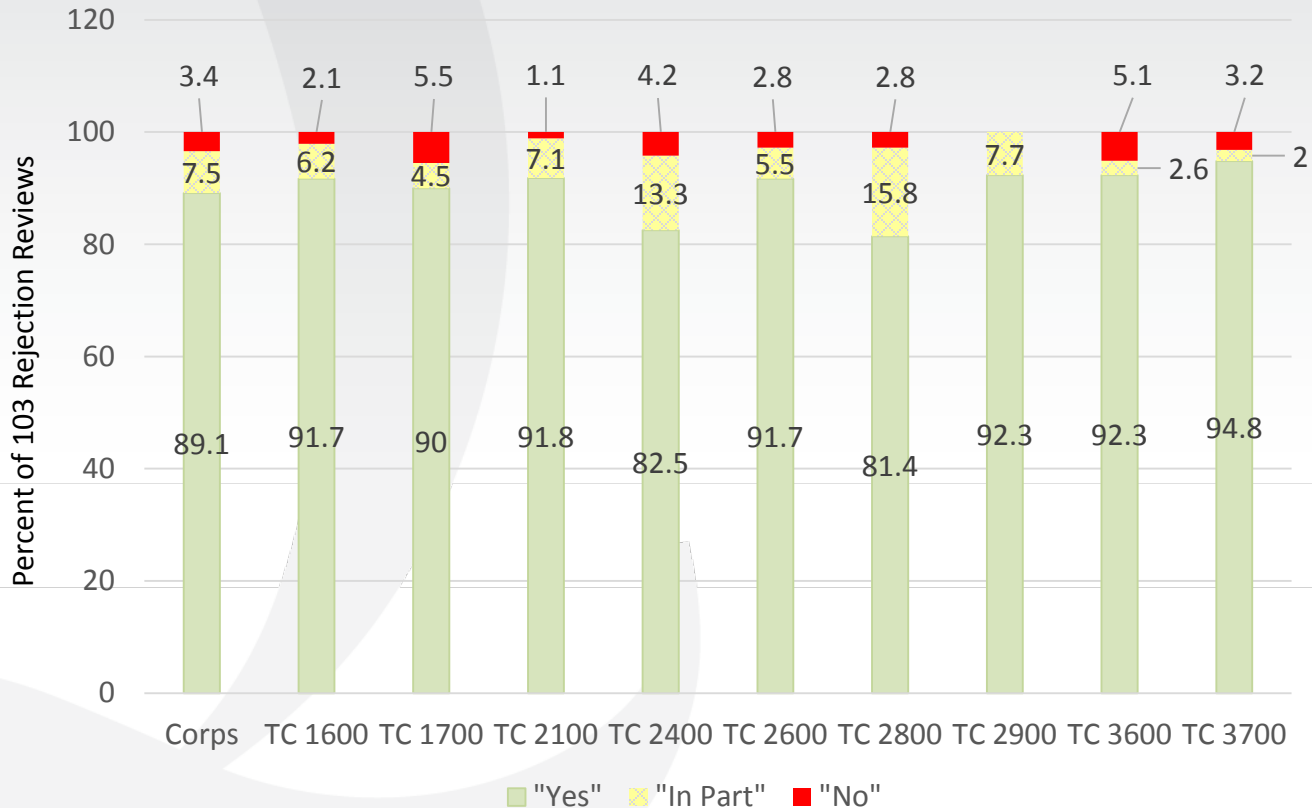
“No” = All Rationale Statements Incorrect

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Question 3: Clarity of Articulated Rationale Statement – Bar Graph Comparison



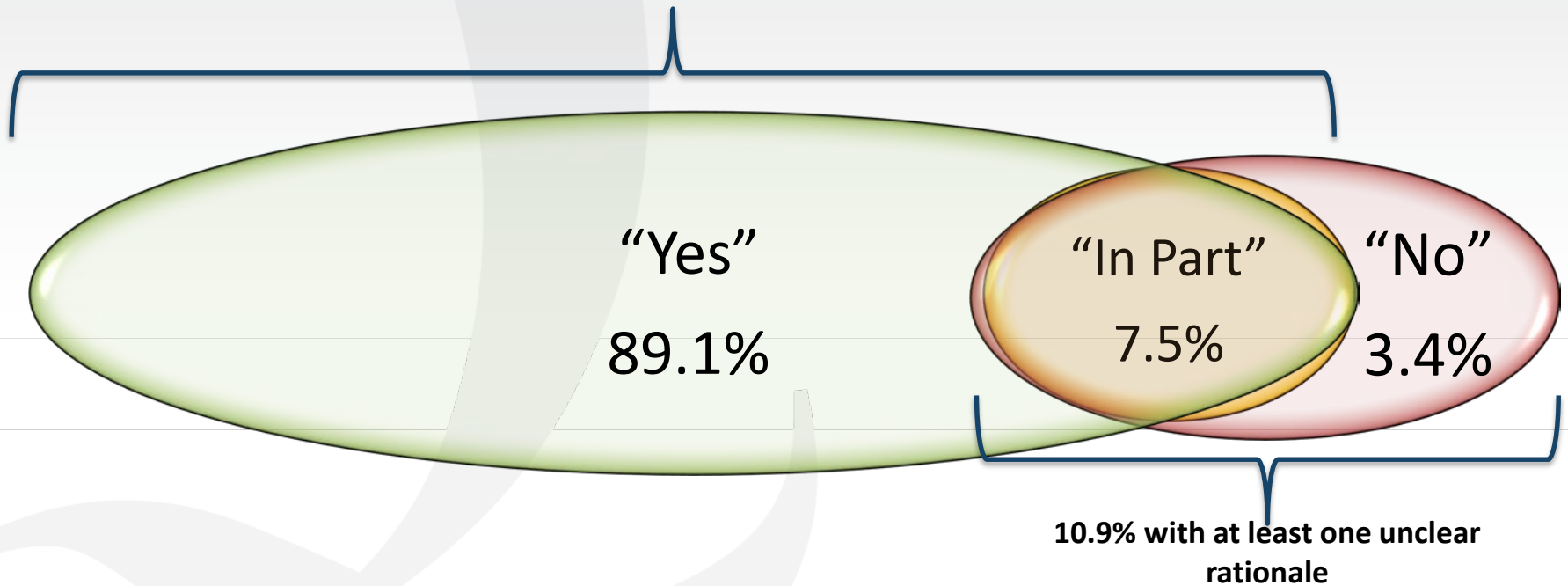
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Clarity of Articulated Rationale (Question 3)

96.6% with at least one clear rationale



"Yes" = All Rationale Statements Correct

"In Part" = Some Rationale Statements Correct and Some Rationale Statement Incorrect

"No" = All Rationale Statements Incorrect

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Clarity of Articulated Rationale to Overall 103 Correctness

| | | Overall 103 Correctness (Question 2) | | | |
|---|---------|--------------------------------------|-----------------|------------------------|-------|
| Clarity of Articulated Rationale (Question 3) | | OK | Needs Attention | Significant Deficiency | Total |
| | Yes | 3761 | 427 | 192 | 4380 |
| | In Part | 205 | 120 | 43 | 368 |
| | No | 42 | 75 | 51 | 168 |

“OK” = No error that rises to the level of a significant deficiency as defined by the IPED standard

“Needs Attention” = Issues present that require attention generally formal in nature and are not found to have a significant impact on prosecution

“Significant Deficiency” = Issues present that have significant impact of prosecution

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By Action Type

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Correct Articulated Rationale: By Action Type

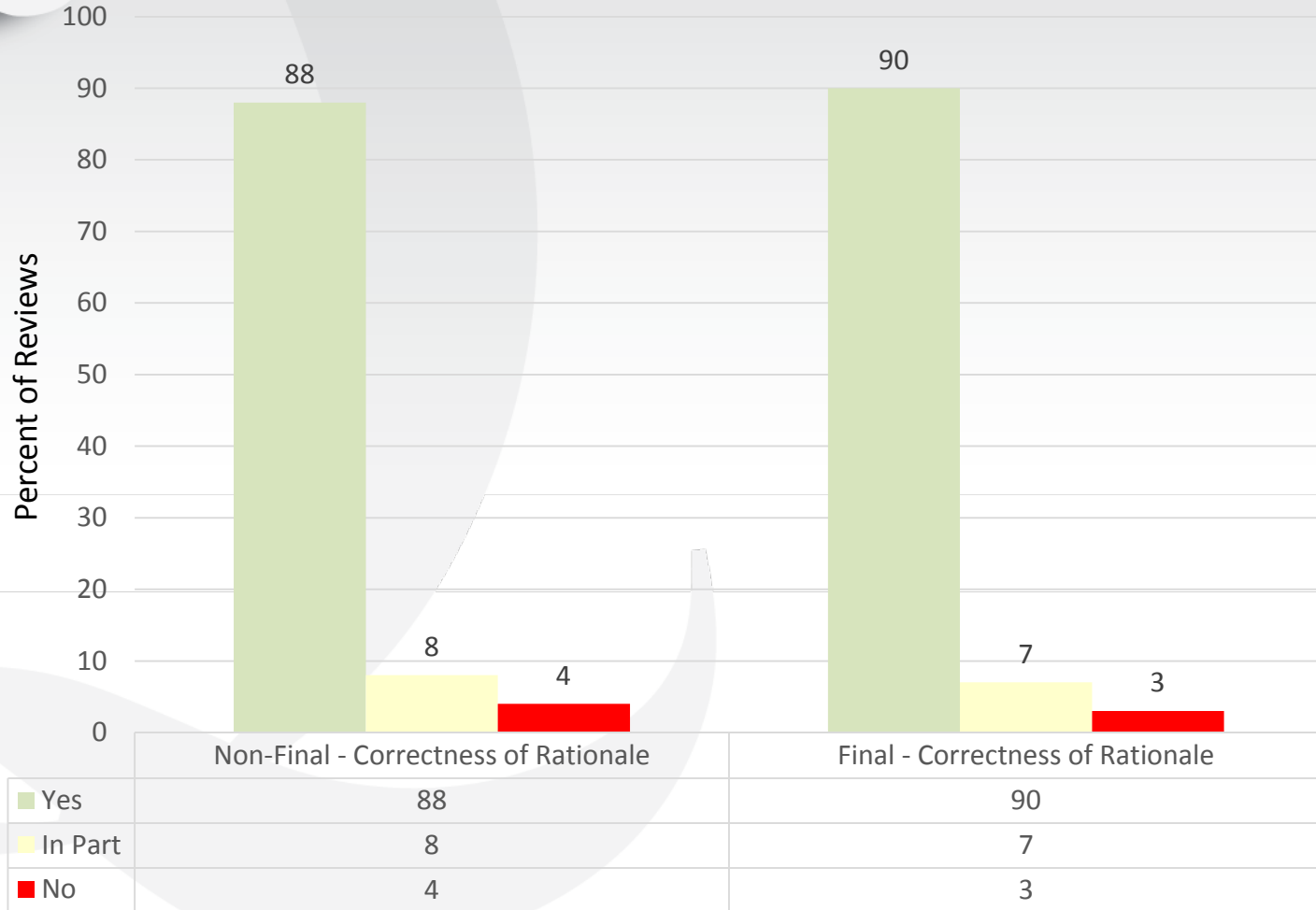


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Clear Rationale: By Action Type



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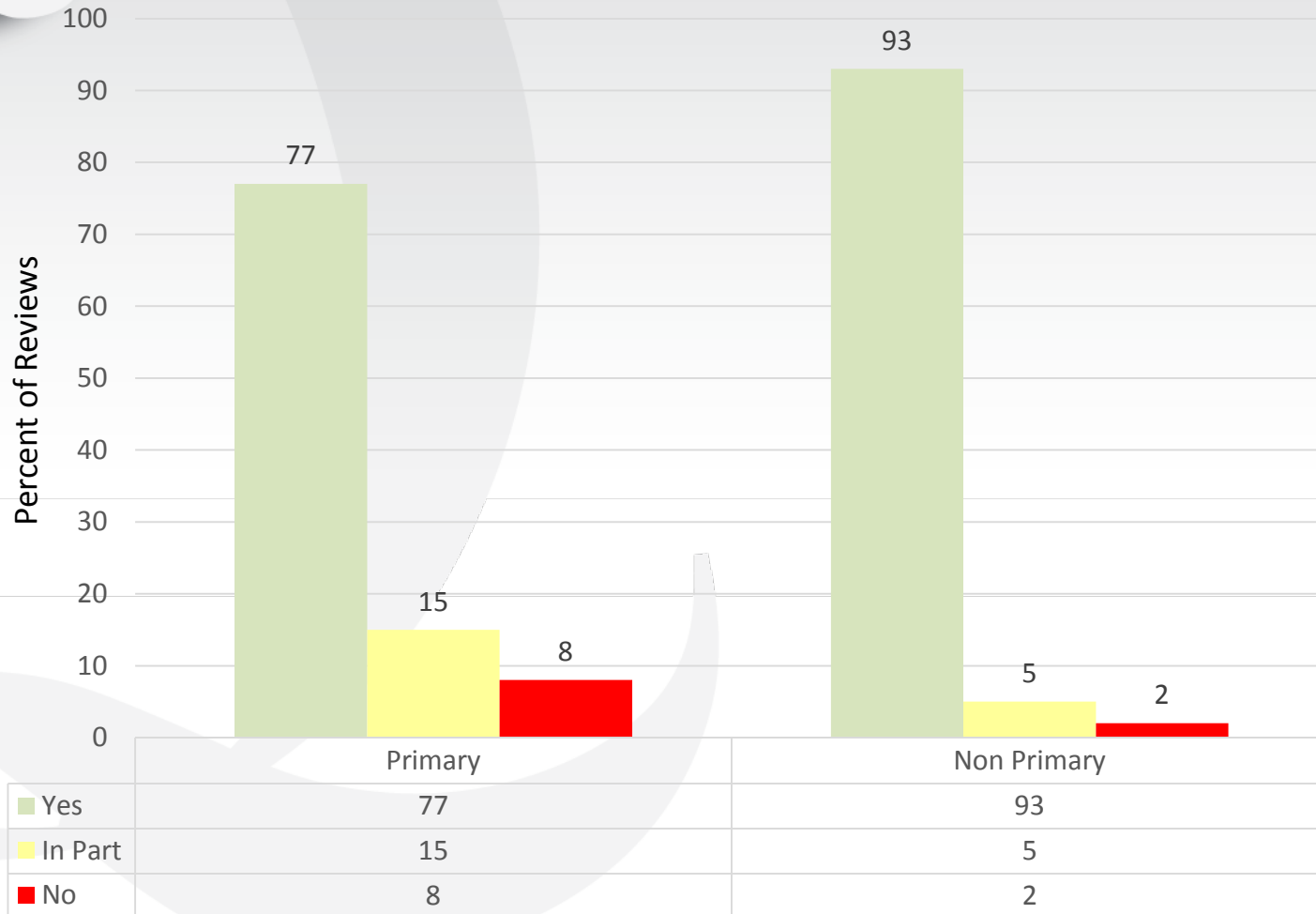
By Signatory Authority

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Correct Articulated Rationale: By Signatory Authority

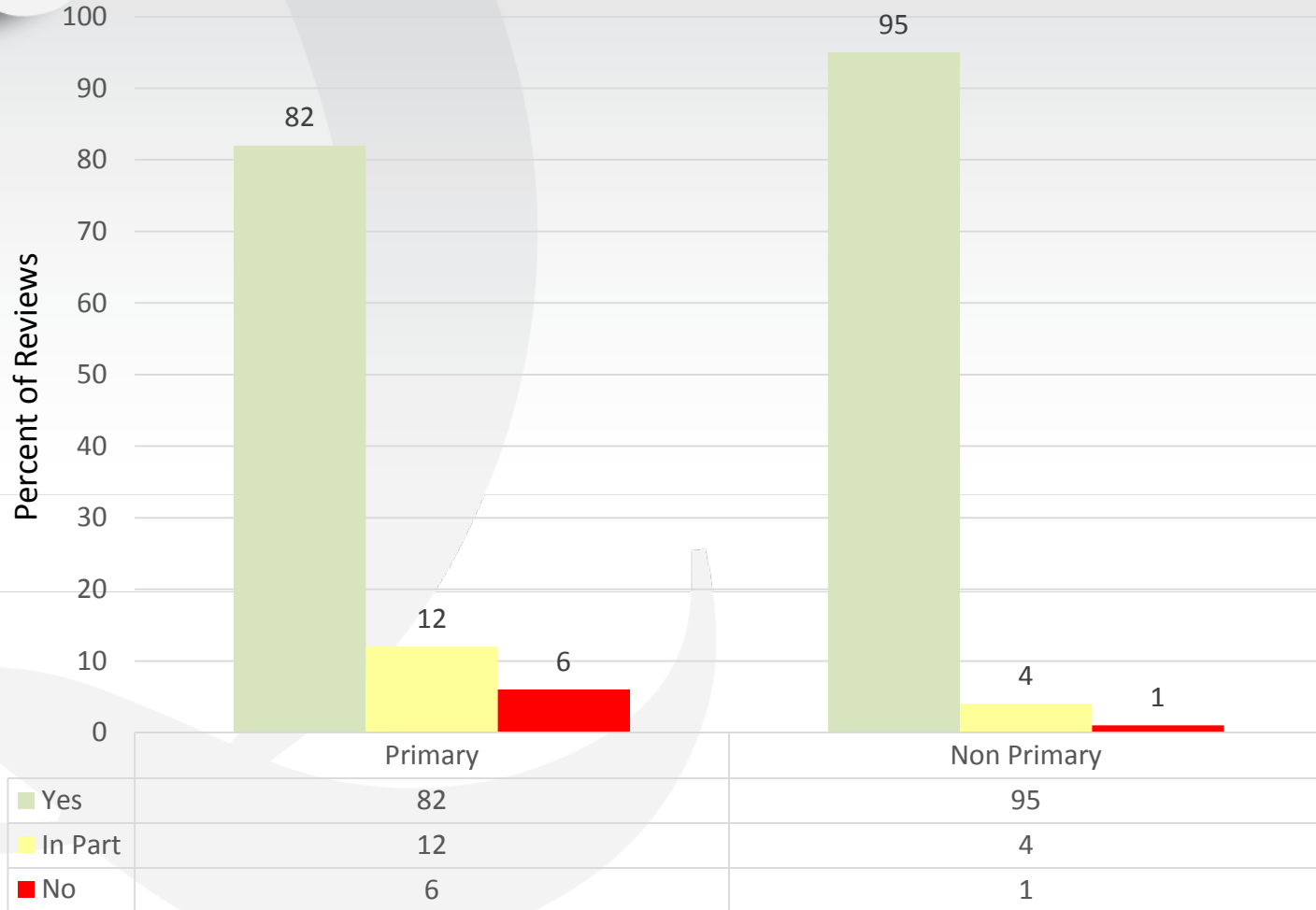


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Clear Rationale: By Signatory Authority



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Top Findings

- 95.3% of 103 rejections reviewed included at least one articulated rationale statement that was found to be correct; whereas, only 85.7% found all articulated rationale statements correct.
- 96.6% of 103 rejections reviewed included at least one articulated rationale statement that was found to be clear; whereas, only 89.1% found all articulated rationale statements clear.
- Even when the articulated rationale statement was found to be incorrect or unclear, prosecution was not impacted in a majority of instances.





Top Recommendations

- Provide refresher workshops with emphasis on identification of rationale statements and the handling of multiple modifications and/bases in support of the finding of obviousness.
- Reassess TC 2400 and TC 2800 data after implementation of formalized definitions for “In-Part”. If data remains outlying, implement a root cause analysis to develop a targeted action plan for improvement.





Questions?

