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Patent Quality Chat

Rationale Statements in 35 U.S.C. 103 Rejections

January 19, 2017

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Enhanced Patent Quality Initiative



High-quality patents enable certainty and clarity of rights, which fuels innovation and reduces needless litigation. To ensure we continue issuing high-quality patents well into the future, we established the **Enhanced Patent Quality Initiative (EPQI)**. We are strengthening work products, processes, services, and how we measure patent quality at all stages of the patent process.

Updates

- The **Stakeholder Training on Examination Practice and Procedure (STEPP)** Program launched July 12th and is one of our current efforts to enhance patent quality through customer service. This program provides perspective on patent examination to our external stakeholders. Visit the [STEPP](#) web page for more information and to take a short survey so you can help us determine future training topics.
- We received over 135 qualified topics for our [Topic Submission for Case Study pilot program](#). To view the six (6) selected topics, please visit the [Selected Topics for Case Studies Pilot](#) web page. Check back periodically for case study results.
- **Tune in to Quality Chats!** We host a series of events collectively entitled Patent Quality Chats, a lunchtime patent quality webinar series held on the second Tuesday of each month. The Patent Quality Chat series is designed to provide information on patent quality topics and gather your input. [Visit our Patent Quality Chat webpage](#) for more information.
- **Michelle K. Lee**, Under Secretary of Commerce for Intellectual Property & Director of the United States Patent and Trademark Office, discussed results from the Enhanced Patent Quality Initiative, how patent quality impacts the U.S. Courts, and next steps the USPTO is taking to advance patent quality. View the December 13, 2016 Patent Quality Conference [Agenda](#), [Presentation Slides](#) and the [Booklet of Supporting Materials](#) for EPQI results and speaker biographies.

EPQI programs

Patent Quality Chat

Rationale Statements in 35 U.S.C. 103 Rejections

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Case Studies - Background

- Case studies used internally on an *ad hoc* basis to study particular issues
- Federal Register Notice initiated a more formal program, **Topic Submission for Case Studies**, on December 21, 2015
 - USPTO invited stakeholders to submit patent quality-related topics for study
 - Submissions were accepted through February 12, 2016



Topic Submissions and Selection

Submissions:

- Received over 135 ideas for case studies from 87 stakeholders
 - Intellectual property organizations, law firms, companies, and individuals
 - <https://www.uspto.gov/patent/laws-and-regulations/comments-public/topics-submitted-quality-case-studies>

Process of review and selection:

1. Assessed whether the topic was appropriate or capable of being timely assessed via a case study
2. Determined whether other programs or mechanisms within the USPTO were more appropriate
3. Grouped the remaining submissions by subject matter



Topics Selected for Case Studies

Patent Quality Topic

1. Compliance of rejections with 35 U.S.C. 101 official guidance
2. Consistency of application of 35 U.S.C. 101 across Art Units/Technology Centers
3. Use of compact prosecution when making 35 U.S.C. 101 rejections
- 4. Correctness and clarity of rationale statements in 35 U.S.C. 103 rejections**
5. Enforcement of 35 U.S.C. 112(a) written description in continuing applications
6. Consistent treatment of claims after May 2014 35 U.S.C. 112(f) training



Objective of 103 Case Study

To study whether Examiners are making clear and correct rationale statements for modification when setting forth rejections under 35 U.S.C. 103.



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Case Study Data Collection

- 4916 random reviews completed in the Office of Patent Quality Assurance (OPQA) using the Master Review Form (MRF) were identified where *at least* one 103 rejection was made
- These reviews were completed between November 2015 and April 2016 (MRF Version 1.0)



MRF Section: 103 Rejection Made

Questions Considered to Address Rationale Correctness

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

Yes

In-Part

No

N/A

OVERALL OK

Needs Attention

Significant
Deficiency



Correctness of Articulated Rationale

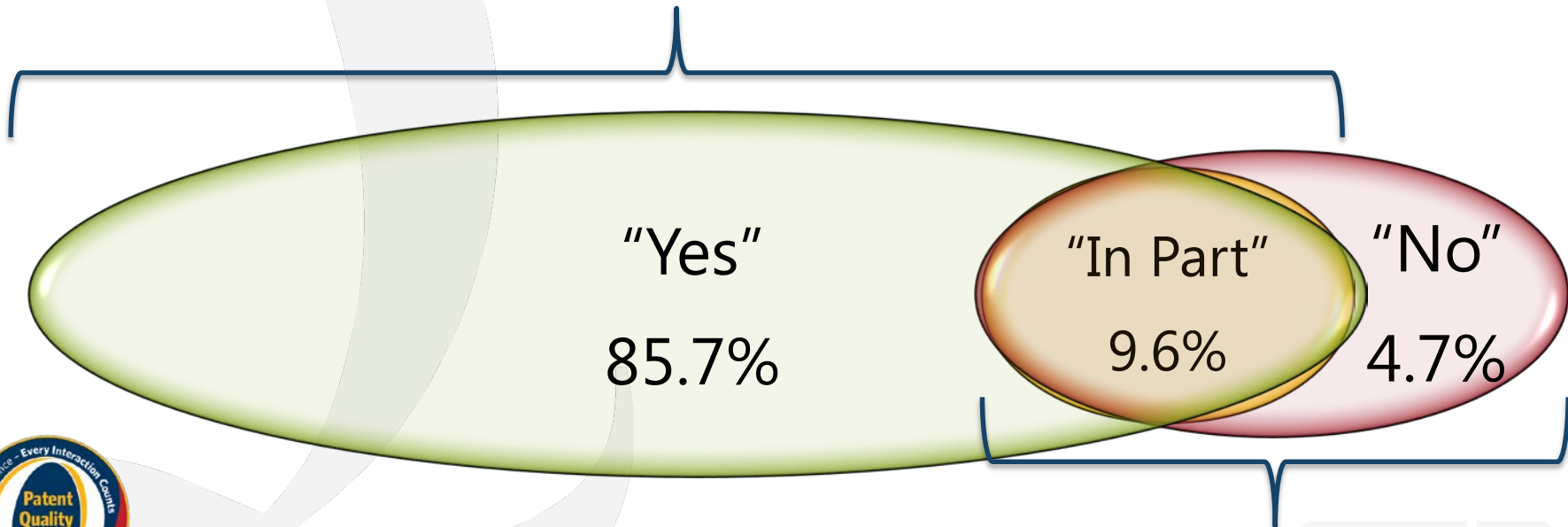
TC	Yes		In Part		No		N/A*		Total
	Count	Percentage	Count	Percentage	Count	Percentage	Count	Percentage	
1600	308	82.6%	29	7.8%	12	3.2%	24	6.4%	373
1700	571	78.0%	25	3.4%	35	4.8%	101	13.8%	732
2100	527	86.5%	57	9.4%	17	2.8%	8	1.3%	609
2400	490	73.8%	121	18.2%	43	6.5%	10	1.5%	664
2600	535	88.9%	36	6.0%	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 MRF question "Proper Rationale to combine prior art references" led some reviewers to answer "N/A" (not applicable) if a single reference was used.

Rationale Correctness Overall

95.3% with at least one correct rationale



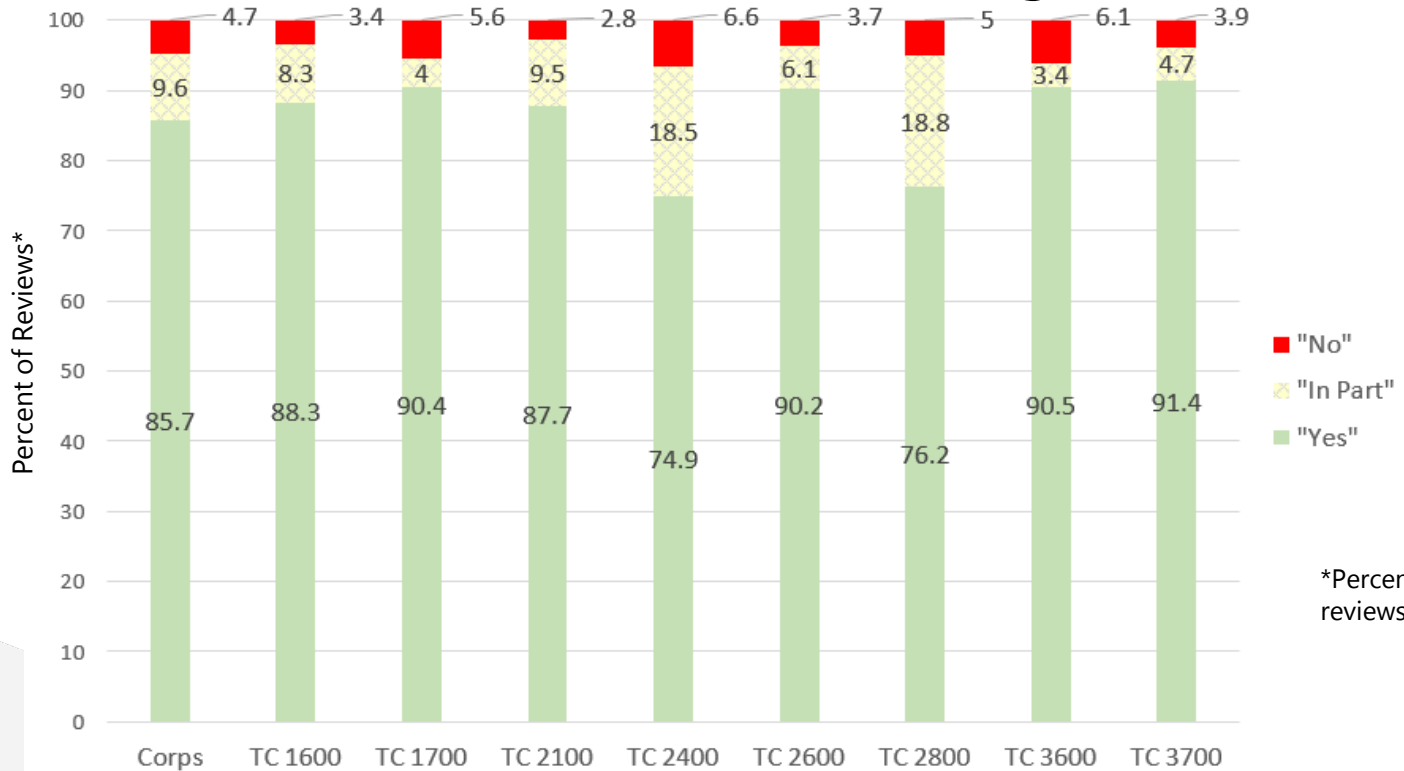
14.3% with at least one incorrect rationale



*Percentages of reviews without N/A (4659 applications)

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Rationale Correctness by TC



*Percentages of reviews without N/A



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Does Rationale Correctness Drive Overall 103 Correctness?

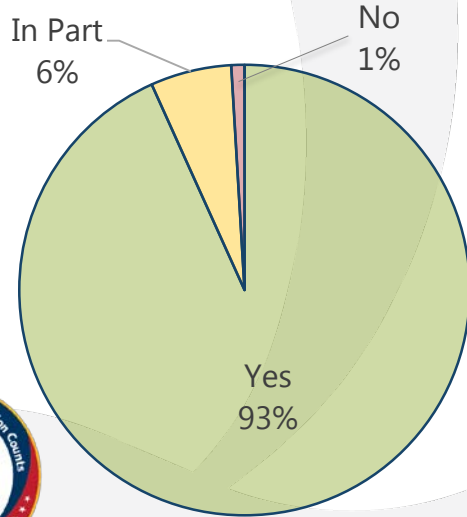
	Overall Correctness				
Rationale Correctness		OK	Needs Attention	Significant Deficiency	Total
	Yes	3568	311	112	3991
	In Part	222	168	60	450
	No	36	94	88	218



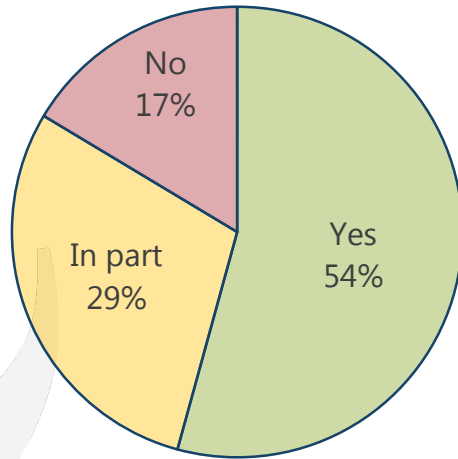
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Rationale Correctness Alone Does Not Drive Overall 103 Correctness

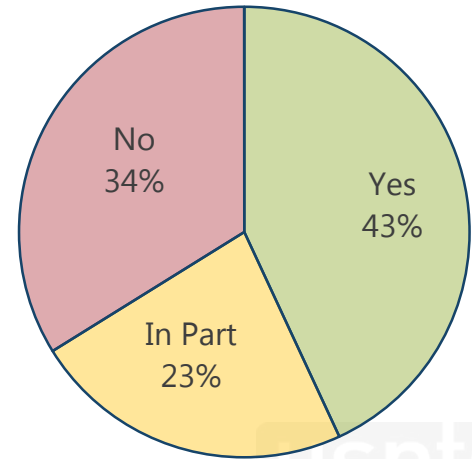
Ok Overall



Needs Attention



Significant Deficiency



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MRF Section: 103 Rejection Made

Question Considered to Address Rationale Clarity

Was the rationale to combine/reasons for obviousness clearly explained?

Yes

In-Part

No



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Clarity of Articulated Rationale

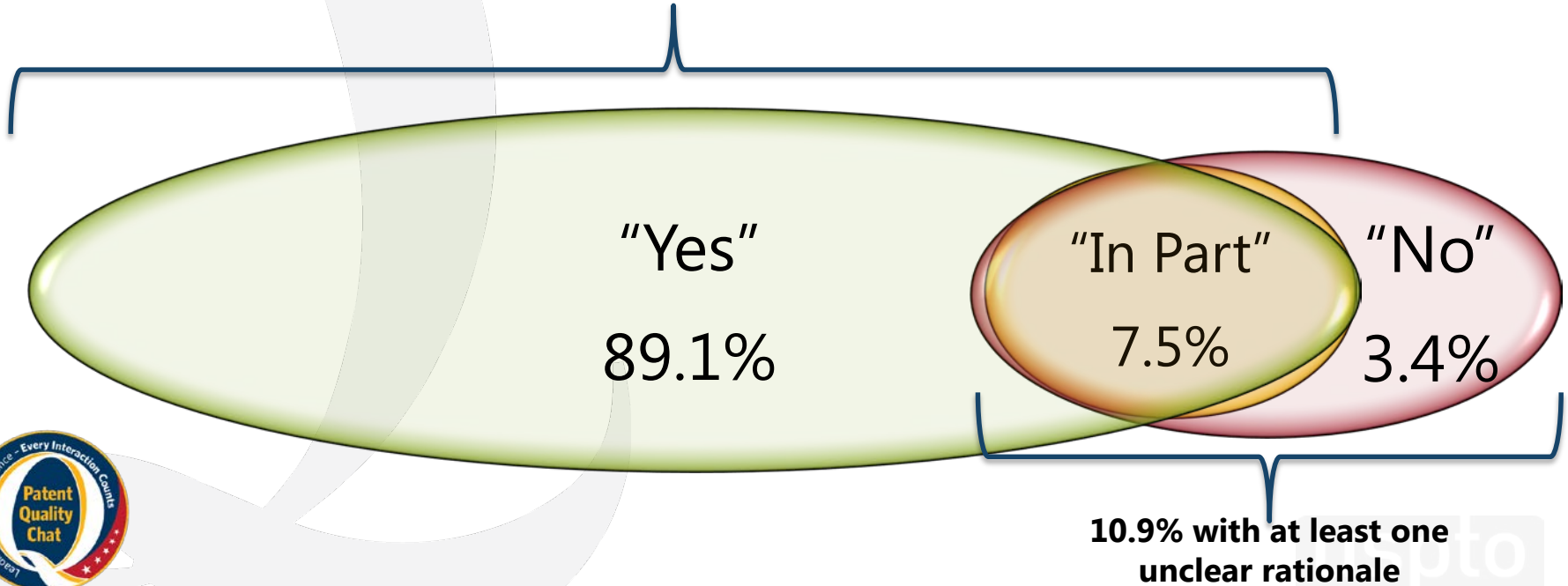
TC	Yes		In Part		No		Total
1600	342	91.69%	23	6.17%	8	2.14%	373
1700	658	89.89%	34	4.64%	40	5.46%	732
2100	559	91.79%	43	7.06%	7	1.15%	609
2400	548	82.53%	88	13.25%	28	4.22%	664
2600	552	91.69%	33	5.48%	17	2.82%	602
2800	620	81.47%	120	15.77%	21	2.76%	761
2900	12	92.31%	1	7.69%	0	0.00%	13
3600	466	92.28%	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



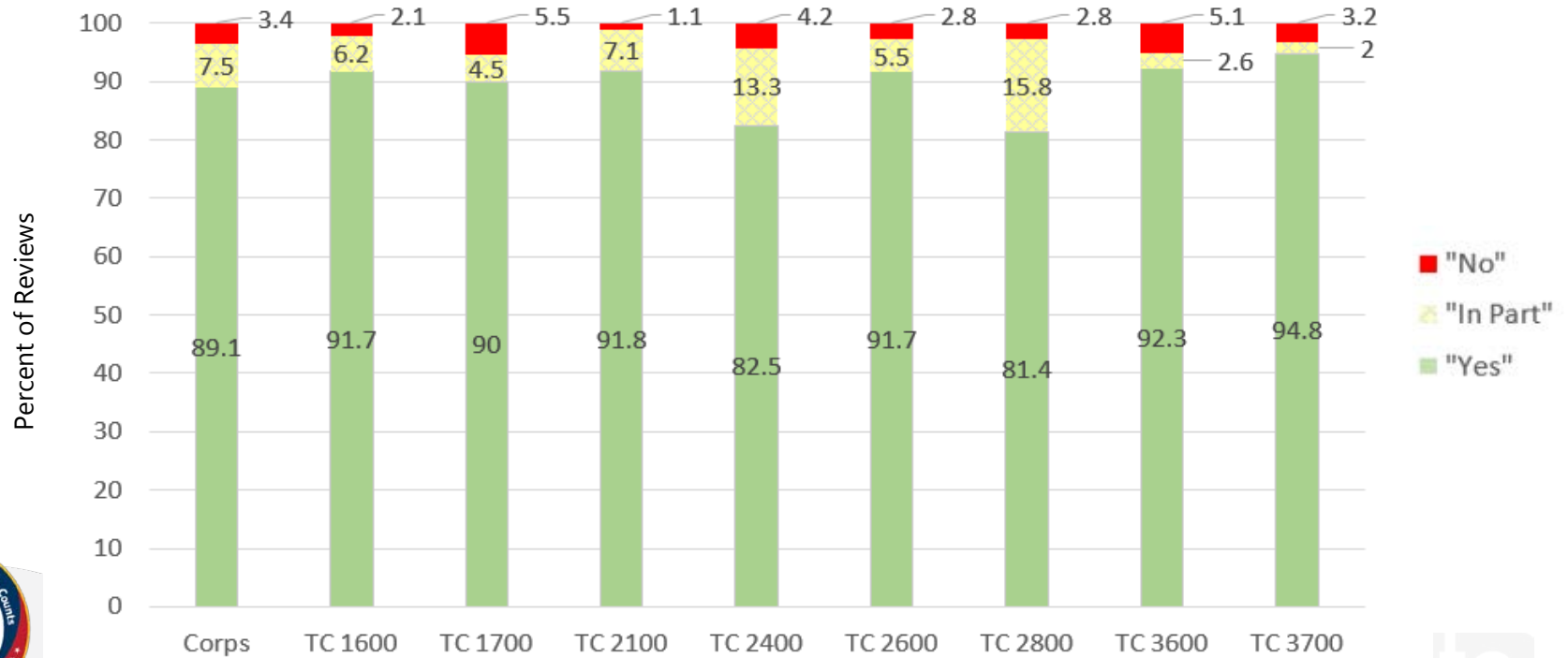
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Rationale Clarity Overall

96.6% with at least one
clear rationale



Rationale Clarity by TC



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*Percentages of reviews without N/A

Does Rationale Clarity Drive Overall 103 Correctness?

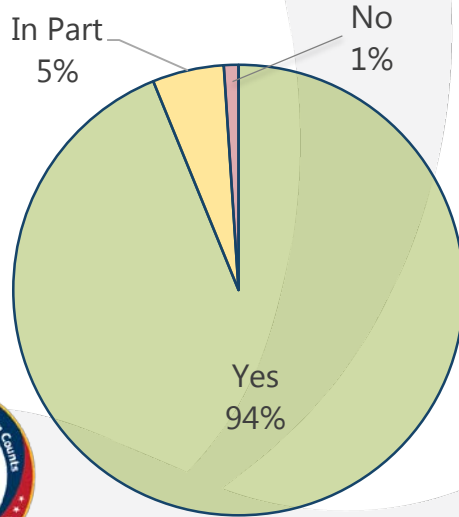
data	Overall Correctness				
Rationale Clarity		OK	Needs Attention	Significant Deficiency	Total
	Yes	3761	427	192	4380
	In Part	205	120	43	368
	No	42	75	51	168



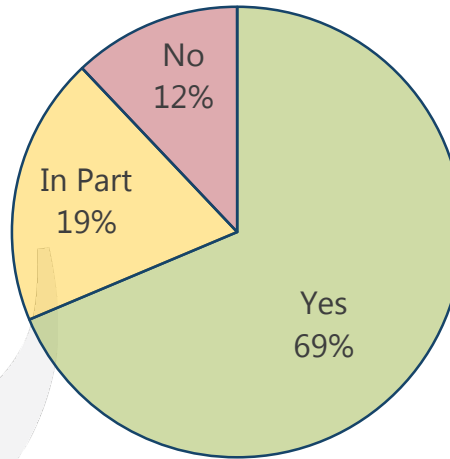
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Rationale Clarity Alone Does Not Drive Overall 103 Correctness

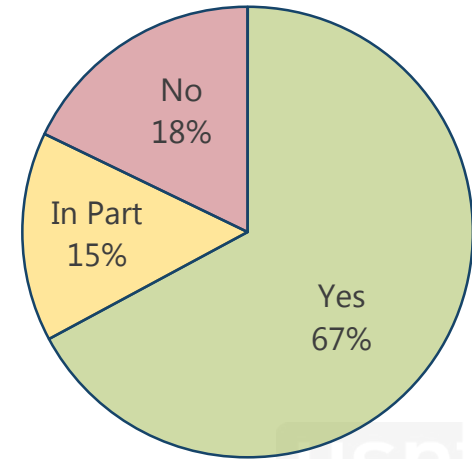
Ok Overall



Needs Attention



Significant Deficiency



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Top Findings

- 95% 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.



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Let's Chat about Rationale Statements in 35 U.S.C. 103 Rejections

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Next Patent Quality Chat
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