



# A Conversation with the Commissioner: A Look Inside Patent Processes at the USPTO



# Today's speakers



**Drew Hirshfeld**  
USPTO



**Robin Evans**  
USPTO



**Robert Bahr**  
USPTO



**Gene Quinn**  
IPWatchdog



**Megan McLoughlin**  
LexisNexis® IP



**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**uspto**

# Patent Examiner Training

- **Entry-level training:** initial in-depth instructor-led classroom training on U.S. statutes, rules, and patent examination practice and procedure.
  - Updated to reflect the new Performance Appraisal Plan (PAP).
- **Experienced examiners training:** ongoing training to ensure examiners maintain the skills required to provide high quality examination throughout their careers.
  - Includes additional search strategy training addressing the search Quality Major Activities 3 and 5 in the new PAP.

# Patent Examiner Training

- **Patent Law and Evidence:** mandatory training for GS-12 patent examiners on authoritative court decisions concerning statutory issues under 35 U.S.C. §§ 101, 102, 103, and 112 and on decisions concerning the handling of evidence during the examination of applications.
- **Patent Training Council:** a new collaborative patent training process designed with the goal of developing and delivering effective training that is legally compliant, consistent in content, and structured to maximize learning for an intended audience.



# Performance appraisal plan (PAP)

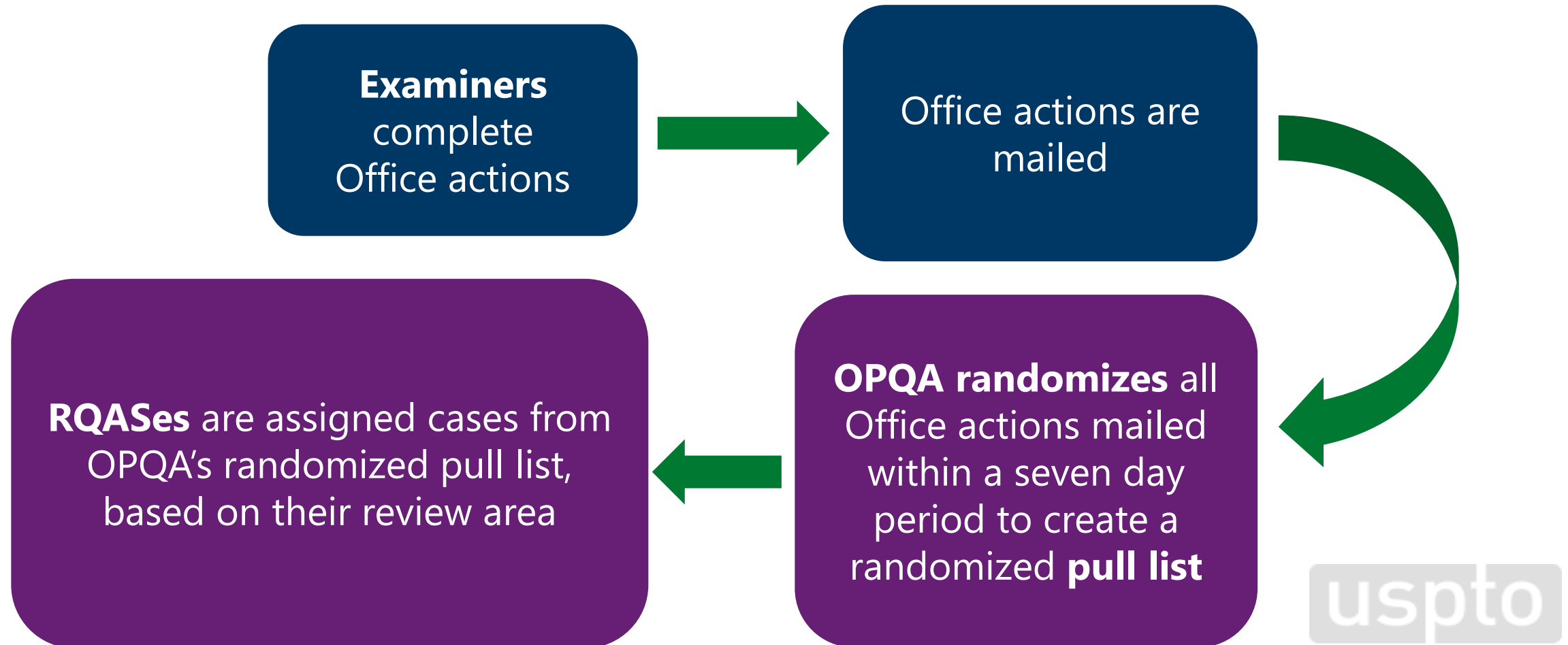
Previous PAP	2021 PAP
Main three (3) pillars of examination weighted differently (timeliness (20%), productivity (35%), and quality (35%))	Main three (3) pillars of examination equally weighted (30% each)
"Error-free" work is presumed to be <b>outstanding</b> unless additional quality-related indicia are not present	"Error-free" work is presumed to be <b>fully successful</b> unless additional quality-related indicia* are present
Different categories for errors that are averaged to determine rating	All errors are considered equal to determine rating

\* Quality-related indicia are directed to characteristics of searching, clarity, and compact prosecution and are evaluated as a whole taking into account the action under review as well as the prosecution history.

# 2021 PAP quality rating – standards and criteria for evaluation

- Quality major activities are assigned activity levels to help ensure proper evaluation standards (i.e. basic, advanced, legal).
  - Levels are based on patent examiner position description (the GS-level of employees who are expected to be able to independently perform those activities).
- Elevates search, restriction, and double patenting errors to be equal to the other statute-related errors.
- Error rate is used to determine above or below fully successful while indicia is used to differentiate between fully successful, commendable and outstanding.

# How are Office actions selected for compliance review?





# Master Review Form (MRF)

- Modular review form designed to capture information about quality of work products:

Statutory compliance	Non-statutory inquiries (e.g. restriction)
Office action characteristics	Accolades

- Provides feedback to Technology Centers and data for USPTO quality metrics
- Includes 20+ sections (statutory rejections made/omitted, search) and 330+ question library

Entire MRF can be found at: <https://www.uspto.gov/sites/default/files/documents/MRF-Current.pdf>

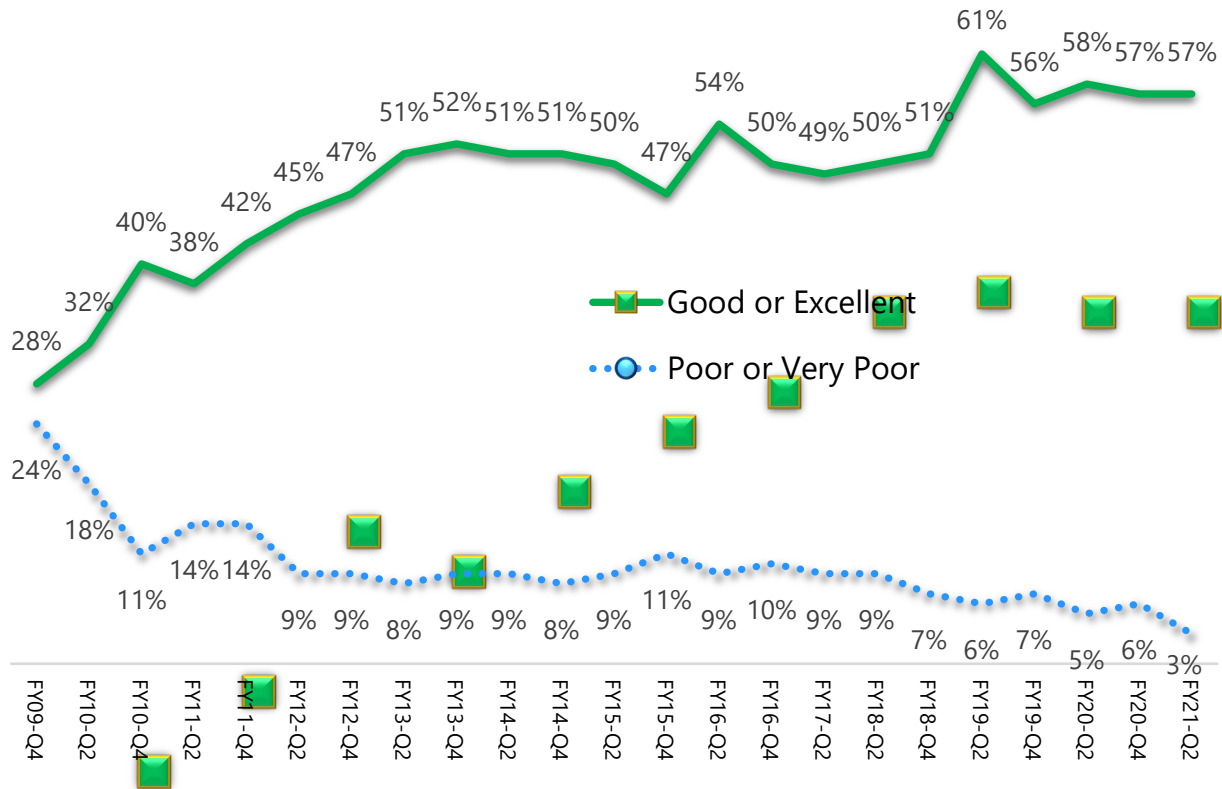


# Feedback in MRF random reviews

- **Noncompliant** – identifies issues of statutory noncompliance
- **Attention Needed** – identifies issues not rising to statutory noncompliance
- **Pass-through** – no issues of noncompliance or needing attention
- **Accolade** – highlights where accolades were provided for use of select best practices
- Comments can be included in any of the above to provide feedback.

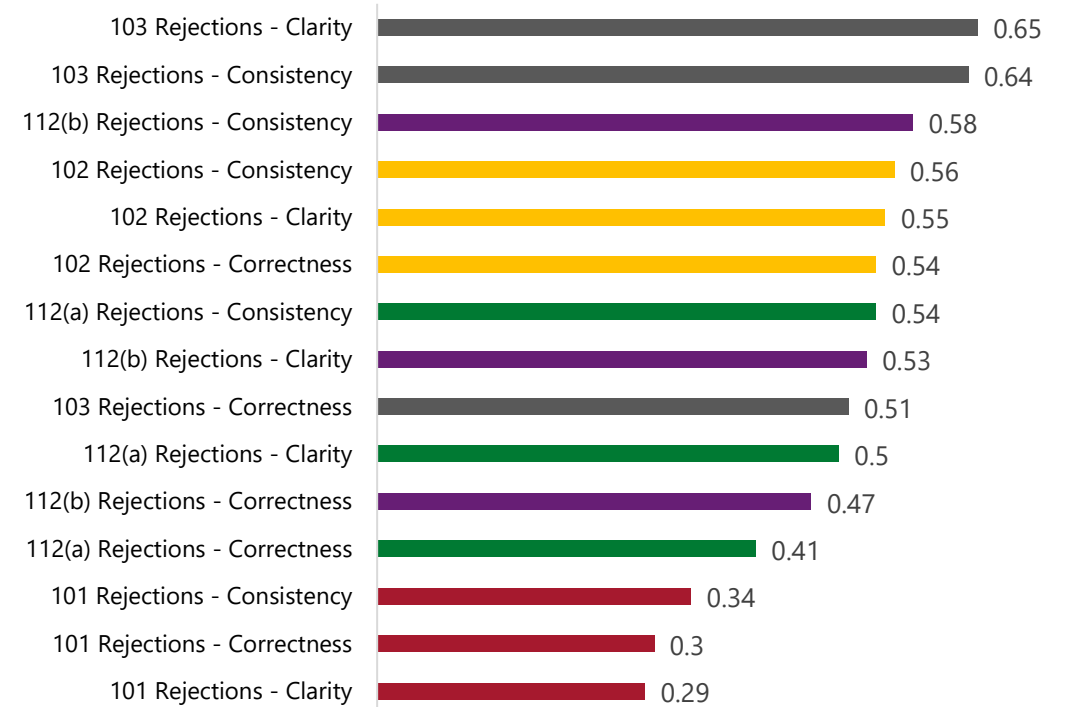


# In the past 3 months, how would you rate overall examination quality?



Source: USPTO Semi-annual External Quality Survey

## Correlations with Overall Quality Ratings

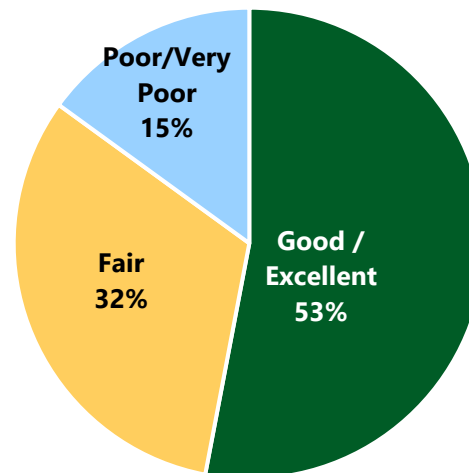


# Patent Examiner Perception Survey

Applicants facilitate high quality examination through....	% of examiners reporting applicants do so to a:		
	Small Extent	Moderate Extent	Large Extent
Clarity & completeness of specification	27%	50%	23%
Clarity of claims	34%	51%	15%
Manageable # of claims	25%	46%	29%
Claims drafted to capture concept of invention	<b>42%</b>	42%	16%
Claims vary reasonably from broad to narrow	35%	46%	19%
Art cited in IDS is material to patentability	<b>54%</b>	35%	11%
Clarity of translations for foreign apps	<b>54%</b>	34%	12%
Clarity & completeness of drawings	19%	55%	26%
Clarity of response to office actions	16%	50%	<b>34%</b>
Thoroughness of response to address specific issue(s) set forth in office action	18%	50%	<b>32%</b>
Citation to spec that provide support for newly added claim limitations	<b>42%</b>	41%	17%
Preparedness to efficiently and effectively conduct interviews	12%	42%	<b>46%</b>
Professional demeanor displayed in interview to advance prosecution	8%	33%	<b>59%</b>

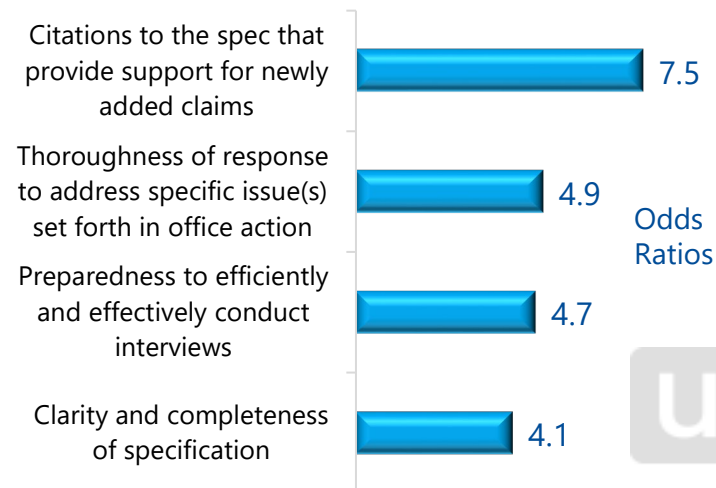
Source: FY21Q2 USPTO Internal Quality Survey

## Overall Satisfaction and Key Drivers



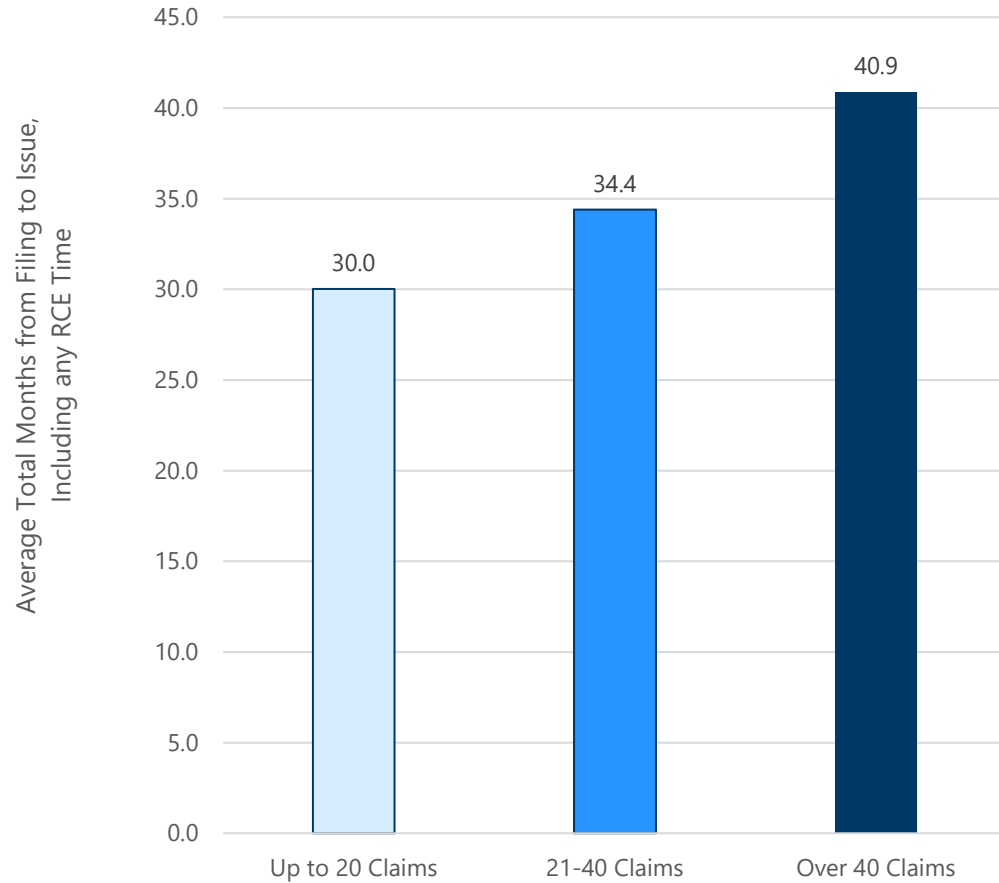
During the past quarter, overall, how would you rate the various external factors (patent applicants/agents/attorneys and their interactions) that impact your ability to provide high-quality patent examination?

“Citations to the specification that provide support for newly added claims” was found to have the most impact on overall ratings. That is, if an examiner was satisfied with the citations to the specification, the examiner is roughly 7 times more likely to rate the overall external factors as good/excellent.

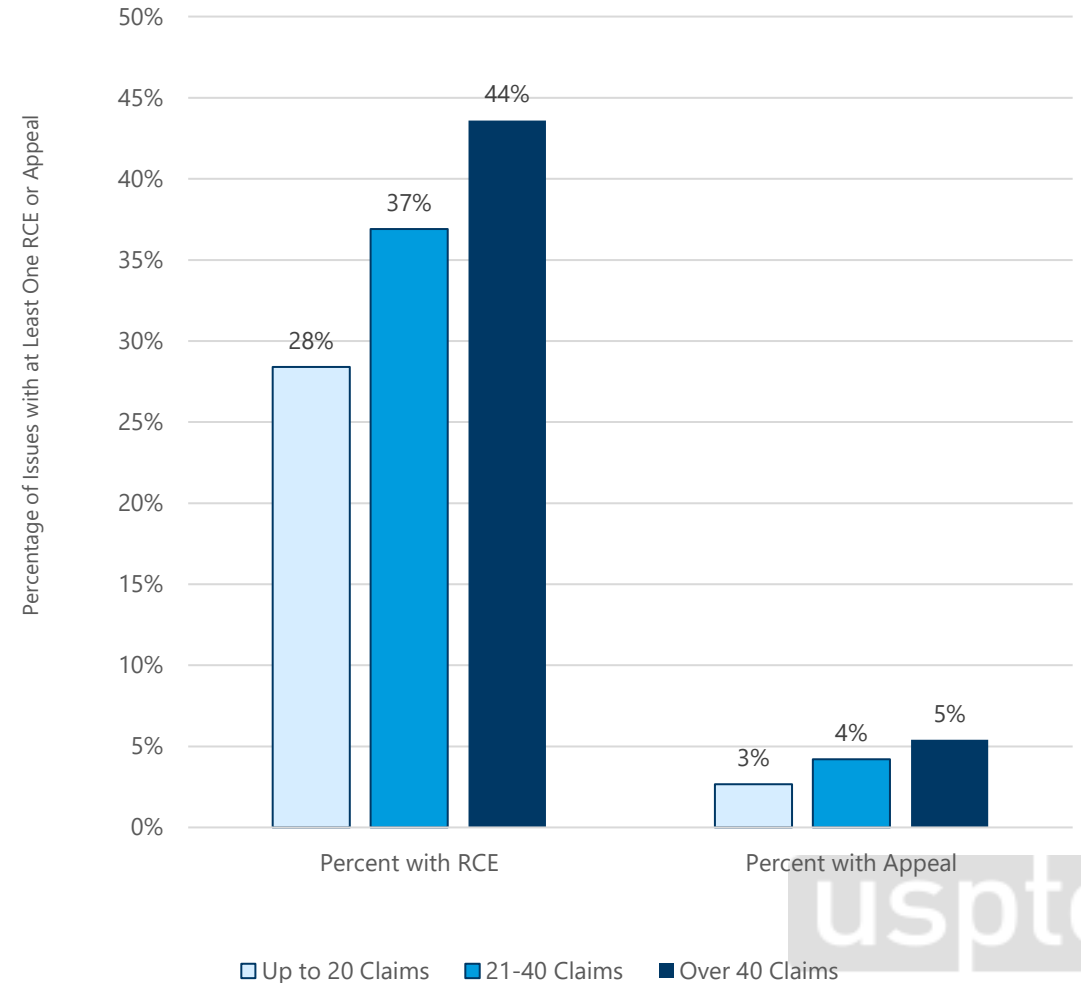


# Prosecution impacts of larger claim sets

## Pendency Impact



## Prosecution Path Impact







# QUESTIONS?

For more information, contact:

**Shelli Sombrio**

Senior Business Development Manager

[MSombrio@lexisnexisip.com](mailto:MSombrio@lexisnexisip.com)

+1 760-619-9689

[www.LexisNexisIP.com](http://www.LexisNexisIP.com)

