Leveraging USPTO Examiner Count System: Efficiently Prosecuting Patents, Lowering Prosecution Costs

THURSDAY, OCTOBER 13, 2016

1pm Eastern    |    12pm Central   |   11am Mountain    |    10am Pacific

Today’s faculty features:

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Outline

I. Examiner Count System

II. Examiner Docketing/Performance

III. USPTO Programs and Initiatives
Examiner Count System

• Numbers directly impact examiners

• “Production-based” system using “counts”

• Cases vs. “examining time”
  – Minimize examining time, maximize “other time”
  – Interviews, training, vacation/sick leave, meetings

• Factors into bonuses, promotions, warnings

• Each action → different credit
  – Different amount of time allotted
The Count System

• What are “Counts”?

• Counts are points, that correlate to an expected number of hours to examine an application.

• The PTO determines a number of hours per count for each class and subclass of patent applications.
  
  – # of hours correlates to the complexity of the tech, and the difficulty of the required search.

  – Hours per count are fixed for every application classified in the class/subclass.
The Count System (cont’d)

• Who gets counts?

• Examiners and Primary Examiners

• Examining corps hierarchy:
  • Technology Center Director
  • QAS (Quality Assurance Specialist)
  • SPE (Supervisory Examiner)
  • Primary Examiner
  • Junior Examiner
The Count System (cont’d)

Basic Calculation

• Production is measured in 80 hour biweeks
• Number of counts required = 80 hrs / (hours per count)

• Example: 10 hours / count for class/subclass 600/300, Examiners must obtain 8 counts every biweek (80/10)
The Count System (cont’d)

Intermediate

- Examining time can be reduced by “other time” and leave
  - Personal leave, sick leave, training time, interviews, appeal conferences, restrictions, advisory actions

- Number of counts required = (80 hrs - other time) / (hours per count)

- Example: 10 hours / count for class/subclass 600/300,

- Examiner has 20 hours of other time for the biweek

- Examiner must obtain 6 counts that biweek ((80-20)/10)
The Count System (cont’d)

Advanced

• Seniority affects count requirements

• A position factor based on the Examiner’s seniority multiplies the # of counts required
  • Number of counts required = \( \frac{(80 \text{ hrs} - \text{other time})}{(\text{hours per count})} \times \text{position factor} \)

• Example: 10 hours / count for class/subclass 600/300

• GS14 Examiner (Primary Examiner) = 1.2 multiplier

• Examiner has 20 hours of other time for the biweek

• Must obtain 7.2 counts that biweek \( \frac{(80-20)}{10} \times 1.2 \)
How Do Examiners Get Counts?

- By doing work
  - Office Actions
  - Examiner Answers
  - Allowances

- By not doing work
  - RCEs and Abandonments
Each Office Action Is Worth A Different Number Of “Counts”

<table>
<thead>
<tr>
<th>Type</th>
<th>0 RCEs</th>
<th>1 RCE</th>
<th>2+ RCEs</th>
</tr>
</thead>
<tbody>
<tr>
<td>Non-Final OA</td>
<td>1.25</td>
<td>1.00</td>
<td>0.75</td>
</tr>
<tr>
<td>Final OA</td>
<td>0.25</td>
<td>0.25</td>
<td>0.25</td>
</tr>
<tr>
<td>RCE</td>
<td>0.5</td>
<td>0.5</td>
<td>0.5</td>
</tr>
<tr>
<td>Examiner’s Answer</td>
<td>0.5</td>
<td>0.5</td>
<td>0.5</td>
</tr>
<tr>
<td>Abandonment</td>
<td>0.5</td>
<td>0.5</td>
<td>0.5</td>
</tr>
<tr>
<td>Allowance</td>
<td>0.5</td>
<td>0.5</td>
<td>0.5</td>
</tr>
</tbody>
</table>

- NFOA counts are highest.
- Motivation to examine thoroughly, early.
- NFOA counts diminish after RCE.
- Motivation to allow applications earlier.
More about “Other Time”

- Reduces examining hours for the biweek
  - Restriction requirement (mailed): 1 hr
  - AFCP 2.0 Advisory Action: 3 hrs
  - Appeal conference: 1 hr
  - Interview: 1 hr
  - Training and Art Unit meetings: varies
  - Personal and sick leave: varies
  - Holidays: varies
  - Misc: classification, “catastrophic,” govt. closure (except teleworkers)
Some Tasks Yield Zero Counts

- Restriction Requirements
- 2\textsuperscript{nd}+ Consecutive Non-final or Final OA
- Advisory Actions
Examiner
Docketing/Performance
Docket Management System

- Began in 2011, still evolving
- Actions must be acted on in a particular time period
- One “Regular New” (new case) and one “Special New” (RCE/Continuation/Divisional) every biweek
  - Ordered by oldest priority filing date
  - Permission required to take a case far out of turn.
- Amendments <= 56 days
- After-final Amendments <= 11 calendar days
Docket Management System (cont’d)

• A workflow score is calculated based on # of days taken to complete Regular New, Amendments, Special New, etc.

• Workflow score is used to evaluate examiner performance, and determine bonuses
The Fiscal Year

October 1 - September 30

- New Fiscal Year begins October 1 of each year.
- Goals, bonuses, etc., calculated then.

Timing Considerations:
- Most PTO initiatives have goals for the year-end:
  - 699 program
  - COPA
  - RCE backlog
- Quality review of allowances significantly reduced in September to focus on completing initiatives.
- Final counts are evaluated on October 1, but the counting period can run a few days.
The Fiscal Year (cont’d)

Examiners evaluated yearly, quarterly, biweekly

- Year-end production and workflow are most important
  - Examiners must obtain at least 95% of their expected counts.
  - < 90% results in a warning.
- Quarters end around December 30, March 30, June 30, and September 30
- Production and workflow evaluated quarterly.
  - Q1 and Q3 are less important milestones.
  - Mid-year reviews.
- Biweekly: production
### SECTION II - PERFORMANCE SUMMARY AND RATING

**Name:** KAI RAJAN (83353)  
**Art Unit:** 3769

**ITEM 1: Instructions**

1. List each element in the performance plan; indicate whether it is critical/non-critical and what weight has been assigned to it.
2. Assign a rating level for each element: (5) Outstanding (4) Commendable (3) Fully Successful (2) Marginal/Minimal Satisfactory (SES) (1) Unacceptable/Unsatisfactory (SES)
3. Score each element by multiplying the weight by the rating level.
4. After each element has been scored, compute the total score by summing all individual scores. Total score can range from 100 to 500.

<table>
<thead>
<tr>
<th>Performance Element</th>
<th>Critical or Non-critical (C or NC)</th>
<th>MBO</th>
<th>Individual Weights (sum must total 100)</th>
<th>Element Rating (1-5)</th>
<th>Score</th>
</tr>
</thead>
<tbody>
<tr>
<td>I. Quality</td>
<td>C</td>
<td></td>
<td></td>
<td></td>
<td>35%</td>
</tr>
<tr>
<td>II. Production</td>
<td>C</td>
<td></td>
<td></td>
<td></td>
<td>35%</td>
</tr>
<tr>
<td>III. Docket Management</td>
<td>C</td>
<td></td>
<td></td>
<td></td>
<td>20%</td>
</tr>
<tr>
<td>IV. Stakeholder Interaction</td>
<td>NC</td>
<td></td>
<td></td>
<td></td>
<td>10%</td>
</tr>
<tr>
<td>TOTAL SCORE</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

For SES: Turn to reverse side and continue with Item 3.

### ITEM 2. PERFORMANCE RATING

(Based on total score except that if any critical element is less than fully successful the rating can be no higher than the lowest critical element rating)

- [ ] Outstanding (460 - 500)
- [ ] Commendable (380 - 459)
- [ ] Fully Successful (290 - 379)
- [ ] Marginal (200 - 289)
- [ ] Unacceptable (100 - 199)

<table>
<thead>
<tr>
<th>Rating Official's Signature</th>
<th>Title</th>
<th>Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>Approving Official's Signature</td>
<td>Title</td>
<td>Date</td>
</tr>
<tr>
<td>Employee's Signature (Indicates appraisal meeting held)</td>
<td>Comments Attached</td>
<td>Date</td>
</tr>
</tbody>
</table>

### Section III. - PERFORMANCE RECOGNITION

(General Workforce only)

- [ ] Performance Award:

  
  (_______ %)

  For performance awards: Has employee been promoted during the appraisal cycle? [ ] Yes [ ] No

- [ ] QSI (Outstanding rating required) Appropriation No:

  Rating Official's Signature | Title | Date |
  Approval Official's Signature | Title | Date |
  Final Approving Authority's Signature | Date |
  Payment Authorized by Personnel Office | Date |
Other Considerations

- Sometimes difficult to allow an application
  - Could depend on art unit, recent decisions, outside pressure.
  - Sometimes pressure to reject.
  - The “pencil” rule and “hand” rule.

1. An electronic card associated with a particular theme, including person, character or object comprising:
   - a flat body having a uniform thickness and being sized and shaped to conform to a standard sports card and including a memory storing imaging data corresponding an image of said theme; and
   - an electronic display disposed on said body and associated with said memory, said display being adapted to receive said imaging data and display said image;
   - wherein said flat body further comprises a text zone formed on said flat body, said text zone comprising textual information;
   - wherein said textual information is printed on said flat body.
Other Considerations (cont’d)

• Quality review.

• Examiners (occasionally) judged on “errors.”
  – Part of Primary Examiner’s performance evaluation, not juniors.
  – Some types of actions are more closely scrutinized than others (example: first action allowances).

• Infrequently assessed, but still a concern.

• 101 (Alice) - no errors assessed currently.

• Quality review STOPS between late August - September 30.
Production

- Emphasis on timeliness and throughput

- Production bonuses - every 5% from 110%-135%+
  - Must be “fully successful” or “commendable”
  - 2%-7% bonus

- Pendency Award
  - Quarterly - workflow
  - 0.25%-0.75% bonus

- SAA - 110% for four quarters
  - 3% bonus
USPTO Programs and Initiatives
Ombudsman Program

• To help in getting the application back on track when there is a breakdown in the normal application process.

• http://www.uspto.gov/patent/ombudsman-program
Post-Prosecution Pilot (P3)

• Developed to enhance patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal
  
• Incorporates the After Final Consideration Pilot (AFCP) 2.0 program and the Pre-Appeal Brief Conference Pilot program into a single program and adds new features, such as providing applicants an opportunity to present arguments to a panel at a conference

• For nonprovisional and international, utility applications

• No fee

• 81 Fed. Reg. 44,845 (July 11, 2016)

• Begins on July 11, 2016, runs for 6 months or 1,600 accepted requests, whichever comes first.
  • Each individual technology center will accept no more than 200 compliant requests.
P3 Requests

Post-Prosecution Pilot (P3)

- **Participation requires:**
  - Request Form filed electronically within two months of the mailing date of the final rejection and prior to filing a notice of appeal.
  - Statement that the applicant is willing and available to participate in a P3 conference with the panel of examiners;
  - Response comprising no more than five (5) pages of arguments under 37 CFR 1.116 to the outstanding final rejection, exclusive of any amendments; and
  - Optionally, a proposed non-broadening amendment to one or more claim(s).
Post-Prosecution Pilot (P3)

Requirements:

- No fee to participate;

- Cannot have previously filed a proper request to participate in Pre-Appeal or the AFCP 2.0 programs in response to the same outstanding final rejection;

- Once accepted, no additional response under 37 C.F.R.§ 1.116 to the outstanding final rejection; and

- Impermissible to request Pre-Appeal program or AFCP 2.0 once a P3 request has been accepted.
Post-Prosecution Pilot (P3)

- P3 process terminated if applicant files any of the following after the filing of the P3 Request but prior to a notice of decision from the panel:
  - A notice of appeal;
  - A Request for Continued Examination (RCE);
  - An express abandonment under 37 CFR 1.138;
  - A request for the declaration of interference; or
  - A petition requesting the institution of a derivation proceeding.
## Comparison between AFCP 2.0, Pre-Appeal Program and P3

<table>
<thead>
<tr>
<th>Program</th>
<th>How Many Requests Will Be Accepted and Until When</th>
<th>Time for Filing</th>
<th>Procedural Requirements</th>
<th>Argument</th>
<th>Are Amendments Allowed?</th>
<th>Who Reviews?</th>
<th>Result</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>After-final Consideration Pilot (AFCP 2.0)</strong></td>
<td>Unlimited, program extended to September 30, 2016</td>
<td>Filed in response to Final Office Action</td>
<td>Certification and Request for Consideration Under the After Final Consideration Pilot Program 2.0 (Form PTO/SB/434)</td>
<td>Response under 37 CFR § 1.116</td>
<td>Yes, non-broadening amendment to at least one independent claim</td>
<td>Examiner of Record</td>
<td>AFCP Response Form, may include interview summary</td>
</tr>
<tr>
<td><strong>Pre-Appeal Brief Conference Pilot Program</strong></td>
<td>Unlimited, no end date for program</td>
<td>Filed with Notice of Appeal</td>
<td>Pre-Appeal Brief Request for Review (Form PTO/AIA/33) and Notice of Appeal under 37 CFR § 41.31</td>
<td>Pre-Appeal Brief, with no more than five pages of argument</td>
<td>No</td>
<td>Panel of Examiners</td>
<td>Panel Decision, without reasoning</td>
</tr>
<tr>
<td><strong>Post-Prosecution Pilot Program (P3)</strong></td>
<td>Up to 1,600 total and up to 200 per technology center, program ends January 12, 2017 (if not extended)</td>
<td>Filed within 2 months from mail date of a Final Office Action and before filing Notice of Appeal</td>
<td>Post-Prosecution Pilot Program (P3) Request Form (Form PTO/SB/444)</td>
<td>Response under 37 CFR § 1.116, with no more than five pages of argument</td>
<td>Yes, optional proposed non-broadening amendment (Notice indicates best use is amendment that focuses the issues with respect to a single independent claim)</td>
<td>Panel of Examiners, with 20 minutes of applicant presentation before panel discussion</td>
<td>Notice of Decision from Post-Prosecution Pilot Conference, with brief written summary</td>
</tr>
</tbody>
</table>
Full First Action Interview Pilot Program

- Examiner Interview prior to first Office Action on the merits
- Limited by technology area and filing date
- Open to all utility application in all technology areas and filing dates
- Request form: http://www.uspto.gov/sites/default/files/forms/sb0413c.pdf

**Requirements:**
- Non-reissue, non-provisional/international utility application;
- \( \leq 3 \) independent claims and \( \leq 20 \) total claims;
- No multiple dependent claims;
- Only a single invention; and
- No first Office action on the merits as of the date Applicant requests participation in program.
Flowchart of EFAI Procedure

Enhanced First Action Interview
Combined Process

- Notice of Improper Request
- Request to join FAI pilot
  - Restriction
  - Search by Examiner
  - Notice of Allowability & Notice of Allowance
  - Pre-Interview Communication
    - 30 days to respond, 30 days extension by request
    - Applicant Initiated Interview Request Form (must be accompanied by a proposed amendment of arguments)
      - Interview must be scheduled and conducted within 60 days from filing request form (non-extendable)
    - Interview
      - Notice of Allowability, Notice of Allowance & Interview Summary
        - Current Office policy, practice and procedure for post allowance now govern examination
      - First Action Interview Office Action & Interview Summary (FAOM)
        - Waiver of First Action Interview Office Action & Request to Enter the Proposed Amendment
      - Amendment/Response
      - Second Office Action (which may be made final)

- Reply under 37 CFR 1.111 & Request to NOT have a First Action interview

Source: USPTO slides; http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program#heading-1
Full First Action Interview Pilot Program

First Action Allowance Rate - First Action Interview Pilot cases vs. all new cases

FAIP First Action allowance rate = 29.5%

First Action allowance rate in new, non-continuing applications = 11.9%

August 2016

Patent applications that have received a first office action allowance are applications that have been examined by USPTO patent examiners and determined to be eligible for a patent upon first review. The FAIP first action allowance rate, or percent allowed, is calculated by dividing the number of FAIP applications that received a first office action allowance by the total number of first actions completed on all FAIP applications since inception of the pilot. The first action allowance rate for new, non-continuing applications is calculated by dividing the number of new, non-continuing applications that have received a first action allowance by the total number of first actions completed since the beginning of the fiscal year.

For more information on the First Action Interview Pilot, please click here.

Quick Path Information Disclosure Statement (QPIDS)

• Eliminates the requirement for processing of a request for continued examination (RCE) with an information disclosure statement (IDS) filed after payment of the issue fee in order for the IDS to be considered by the examiner

• Extended to run through **September 30, 2017**

• Form:
After Final Consideration
Pilot Program 2.0

• Extended through *September 30, 2017*

• Enhance communication between the Office and applicant

• Form designed to more clearly indicate how the AFCP submission was treated by the examiner.

• Authorizes additional time for examiners to search and/or consider responses after final rejection.
  • Schedule and conduct an interview to discuss the results of their search and/or consideration with you, if applicant response does not place the application in condition for allowance.
• Request for Prioritized Examination, Track One
  • 37 CFR 1.102(e)
  • MPEP § 708.02(b)
  • Form: http://www.uspto.gov/sites/default/files/forms/aia0424.pdf

• Fees (Basic Fee, Search Fee, Examination Fee, Application Size Fee, Excess Independent Claim Fee, and Excess Claim Fee)

• Average monthly Track One applications over last 12 months: 820.*

Petition filing to grant: 1.4 months

Petition grant to First Office Action 2.1 months

Petition grant to Allowance 5.2 months

Petition grant to Final Disposition 6.5 months

Filing to Final Disposition 7.9 months

Track One Outcomes*

The Track One final disposition numbers displayed are broken out by final rejections, abandonments, allowances and notice of appeals. The totals are cumulative since inception of the program.

Cumulative Through
August 2016

Patent Prosecution Highway (PPH)

- Accelerating examination of a patent application if examination work has already been conducted at another intellectual property office.

- If claims of an application have been found allowable by intellectual property office handling one member of a patent family, a request for accelerated examination of a corresponding application at a second intellectual property office may be submitted.

- No fee.
Patent Prosecution Highway (PPH)

Patent Prosecution Highway (PPH)

Global and IP5 PPH Participants with the USPTO

Australia (IPAU)  
Austria (APO)  
Canada (CIPO)  
China (SIPO)  
Denmark (DKPTO)  
Estonia (EPA)  
EPO  
Finland (NBPR)  
Germany (DPMA)  
Hungary (HPO)  
Iceland (IPO)  
Israel (ILPO)  
Japan (JPO)  
Korea (KIPO)  
Norway (NIPO)  
Nordic (NPI)  
Portugal (INPI)  
Russia (ROSPATENT)  
Singapore (IPOS)  
Spain (SPTO)  
Sweden (PRV)  
United Kingdom (UKIPO)

Other Patent Prosecution Highway Programs

• Brazil
• Columbia
• Czech Republic
• Mexico
• Nicaragua
• Philippines
• Poland
• Romania
• Taiwan
Examiner Interviews

• **USPTO Automated Interview Request (AIR) Tool**

• **Technology Center Interview Specialists**

• **Video Conferencing for Interviews and Public Interview Room Availability**

• **First Action Interview Pilot Program**
Enhanced Patent Quality Initiative pillars

Our Enhanced Patent Quality Initiative is focused in three areas, termed the “patent quality pillars.” These pillars were selected to enable us to target its efforts in enhancing patent quality in specific ways.

Our Enhanced Patent Quality Initiative is focused in three areas, termed the “patent quality pillars.”

**Pillar 1**
Excellence in Work Products
Provide the best work products and services at every stage of the patent process

**Pillar 2**
Excellence in Measuring Patent Quality
Provide excellence in measuring patent quality, ensuring appropriate quality metrics target examination issues requiring attention

**Pillar 3**
Excellence in Customer Service
Improve customer experience with an emphasis on customer service
Enhanced Patent Quality Initiative

**Patent Quality Chats**

Second Tuesday of Each Month  
Noon to 1:00 PM Eastern  

- 20 minute presentation by a USPTO employee on a topic that affects patent quality
  - Remainder of the time is reserved for Q&A
- Video recordings and any presentation materials are posted
2016 Patent Quality Chats

January: Topic Submission for Case Studies/Post Grant Outcomes
February: First Inventor to File (FITF) Patent Prosecution
March: Cooperative Patent Classification (CPC) System Update
April: Excellence in Customer Service: Meet the Regional Offices
May: Enhancing Examination Evaluation Using the Master Review Form (MRF)
June: eCommerce Modernization (eMod): Improving the Electronic Patent Application Process

SPECIAL ENGAGEMENT: Evaluating Subject Matter Eligibility

July: Opportunities for Examiner Interviews: First Action Interview Pilot and General Practice
August: The Post-Prosecution Pilot: A New After Final Collaboration Program
September: Future Information Disclosure Practice in a Global Dossier Environment
October: Assistance in Patenting: Patents Ombudsman and Pro Se Assistance Programs
Thank You!

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