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# Patent Public Advisory Committee Quarterly Meeting

## The Practice of Compact Prosecution when 35 U.S.C. §101 Rejections are Made

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# Topic Submission for Case Studies

- Dec. 2015 Fed. Reg. Notice sought input from public on topics for study
- Over 130 comments received
- Six topics selected for studies
- Purpose of studies:
  - To identify quality issues, as well as examples of examination best practices;
  - To improve patent work products, examination consistency and examination processes; and
  - To reveal areas where further training may be needed

# The Practice of Compact Prosecution When 35 U.S.C § 101 Rejections Are Made

- Case Study #3 of selected case studies
- Feedback from stakeholders:

“where a subject matter eligibility rejection under 35 U.S.C. § 101 was made in the first Office action, prior art rejections under 35 U.S.C. §§ 102 and/or 103 were not being made until the second Office action”

# Purpose and Scope of Study

- Compact prosecution is one in which all appropriate examination issues are raised at the earliest point in prosecution
- Scope of this study is to evaluate one particular aspect of compact prosecution

# Focus of Case Study #3

- Determine how frequently prior art rejections under 35 U.S.C. §§ 102 and/or 103 first introduced in a second non-final Office action could have been introduced in the first Office action in which a subject matter eligibility rejection under 35 U.S.C. § 101 was made

# Data Collection for Study

- Queries developed to obtain data from USPTO Big Data Reservoir (BDR)
- Data collected from publicly available applications in 13 and 14 series
  - February 2011 – November 2016

# Data Collection Results

<b>BDR Data Sets</b>	<b>Total of Series 13 &amp; 14</b>
Public Non-final Office Actions in the BDR Issued 2/15/11 - 11/15/16	1,537,509
Applications with Non-Final Prior Art Rejections	1,080,151
Applications with Non-Final 35 USC 101 SME Rejections	153,959
Total Number of Applications with Non-Final Prior Art and/or SME Rejection	1,096,561
Applications with Only a Non-Final Prior Art Rejection	942,602
Applications with Only a Non-Final SME Rejection	16,410

# Data Collection Results

BDR Data Sets (continued)	Total of Series 13 & 14
Applications with Both Non-Final Prior Art and SME Rejections	137,508
Applications with Both Rejections in First Non-Final Office Action	125,382
Applications with Prior Art Rejection in First Non-Final Office Action	11,405*
Applications with SME Rejection in First Non-Final Office Action	721
Applications Non-Compact after Analysis	361

- A prior art rejection was first introduced in a second Office action that could have been introduced in the first Office action in only 0.26% of the applications having both prior art and SME rejections during prosecution

\*Note that the *Alice* decision may have contributed to many non-final Office actions that later added the SME rejection

# Findings

- The practice of compact prosecution studied is not a problem that would require corps wide examiner training
- This study did not identify any particular Technology Center or time period where the practice of non-compact prosecution was statistically significant

# Top Recommendation

- Corps wide training is not necessary
- The Office should continue to emphasize compact prosecution best practices in any subsequent 35 U.S.C. § 101 examination guidance and training

# Questions and Comments

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## Case Study: Rationale Statements in 35 U.S.C. 103 Rejections

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March 2, 2017

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# 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.

# 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

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

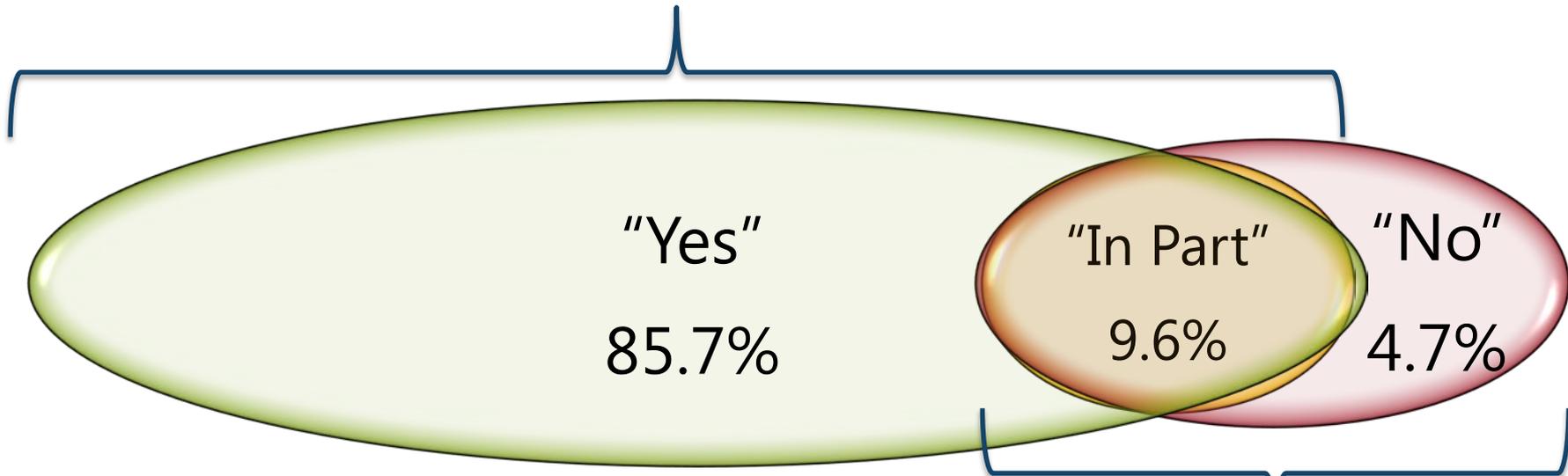
Needs Attention

Significant  
Deficiency

spto

# Correctness of Articulated Rationale (Question 1)

95.3% with at least one  
correct rationale



14.3% with at least one  
incorrect rationale

"Yes" = All Rationale Statements Correct

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

"No" = All Rationale Statements Incorrect

# 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 the 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

# MRF Section: 103 Rejection Made

## Question Considered to Address Rationale Clarity

Question 3:

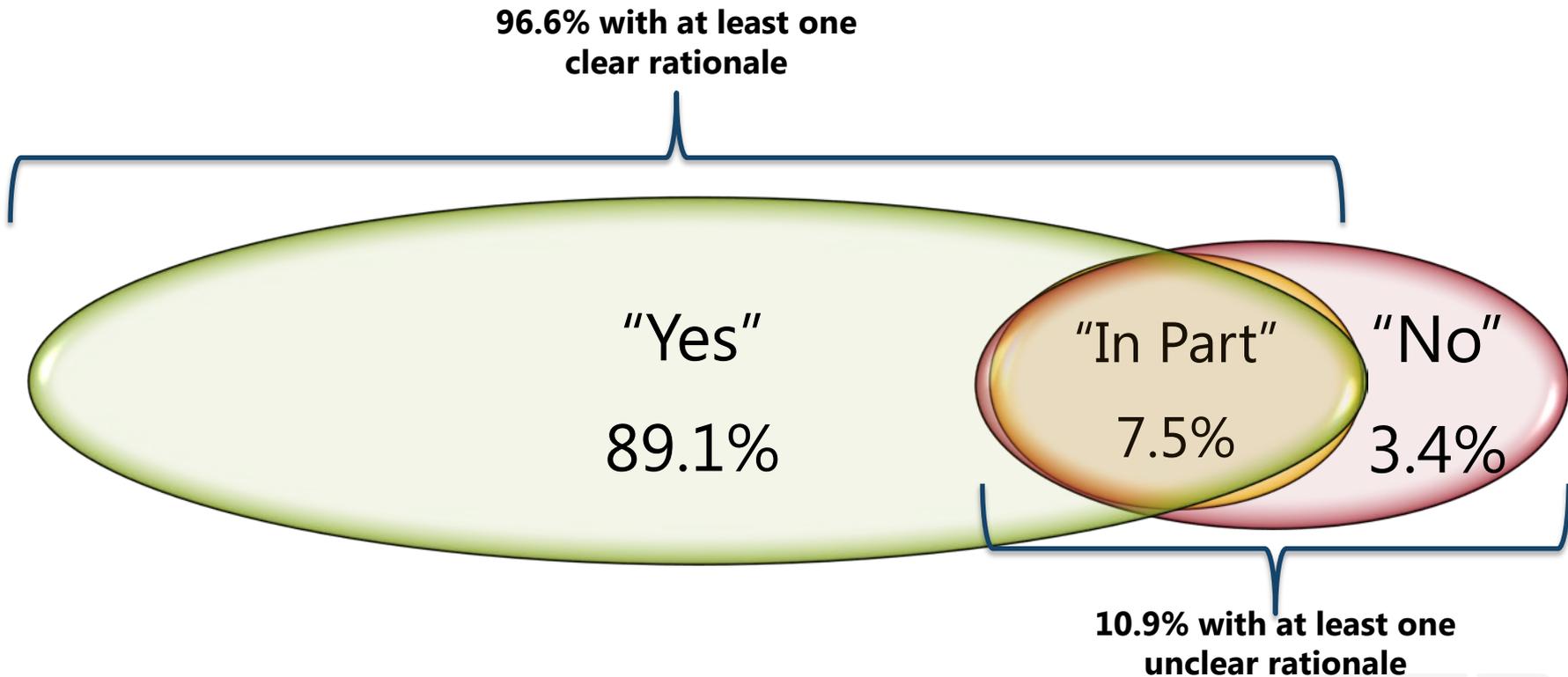
Was the rationale to combine/reasons for obviousness clearly explained?

Yes

In-Part

No

# Clarity of Articulated Rationale (Question 3)



"Yes" = All Rationale Statements Correct

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

"No" = All Rationale Statements Incorrect

# 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 the 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

# 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 Recommendation

- Provide refresher workshops
  - Identification of rationale statements
  - Handling of multiple modifications and/bases in support of the finding of obviousness
  - Effective articulation of rationale statements

# Questions and Comments

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