

POPA Comments on the Draft USPTO 2018-2020 Strategic Plan

September 20, 2018

POPA's main concern is "Goal 1-Optimize Patent Quality and Timeliness, Objective 1: Optimize Patent Application Pendency" on page 8 of the Draft Plan. The Plan states that through this goal it will both improve patent quality and improve pendency. But these two goals are at odds with each other. The shorter examiners' dockets become, the more likely it becomes that examination is not performed by the examiner or examiners who are best versed in the art. This is counter-productive to improvements to quality and reliability of issued patents.

The Corps is currently experiencing short dockets in approximately 5-10% of art areas. While this is a relatively small percentage, it equates to about 400-800 examiners who are experiencing short dockets. These examiners are being or shortly will need to be assigned cases that they have not regularly examined. Either their SPE or case assigner is keeping cases from related art areas that would previously have been transferred to someone with better knowledge of the art or they are getting an influx of art from an area that has more work. The result is examiners working on applications from technology areas for which they have less expertise.

Agency management has told POPA for years while it was reducing pendency that it was also being careful to prevent dockets in any area from becoming too short, i.e. planning for a "soft landing", so that there would not be a loss of expertise and the Patent Corps would not be harmed. Even with all of the planning, this has not been successfully accomplished. The Agency has a difficult time predicting incoming workload and aligning production capacity by art area with the workload.

This will be exacerbated when the Agency implements a CPC routing system. Routing by CPC is very different than routing by USPC. The CPC combines different statutory classes of invention in the same subgroup and this method of routing is likely to require examiners to broaden the technologies they work in. Examiners will be generalists with much less of an opportunity to develop specialized knowledge of the art they examine because the applications they are assigned will be from a larger area of technology and in constant flux. The Agency plans to use a routing algorithm that will match applications with production capacity as well as examiner experience in the art. Using this type of algorithm is likely to prioritize pendency over examination expertise and quality.

In addition to the uncertainty caused by short dockets and an automated routing system based on CPC, Goal 1, indicator 4, talks about providing "prosecution options" to applicants. At the bottom of page 8, these suggested options are "deferred examination" and "compact prosecution." The Agency has already been unsuccessful with predicting the fire power needed in examination dockets without additional variables. Deferred examination and compact prosecution will exacerbate the docket imbalances that already exist.

Applicants working in areas that have short dockets are more likely to want deferred examination. If examination is deferred, the examiners won't have adequate dockets and they will have to be reassigned to other art. Applicants from technology areas with large backlogs are more likely to want compact prosecution. If examination in these areas is to be expedited, since these examiners already have full dockets, it will require the assignment of additional examiners less familiar with the art.

All of these scenarios have one thing in common. Less knowledge of the technology on the part of the examiner and therefore, a diminution of examination quality. The Agency should be very cautious with moving forward with any efforts in these areas to make sure anything that they consider adopting is given an extended test as a pilot prior to considering adoption of any prosecution options.

Under “Objective 2: Issue Highly Reliable Patents”, we support the adjustment of outdated examination time goals through completion of the Examination Time Analysis. These adjustments should be made so that there is no net loss of examination time for any examiner. The complications of moving to the CPC mentioned with respect to Objective 1 and the expansion of the searchable collection of prior art makes it unconscionable that any examiner should lose time through this process.

Under “Objective 3: Foster Innovation through Business Effectiveness”, POPA favors improved search tools resulting in the ability to provide a thorough search and examination. However, we are concerned with the development and implementation of these tools. Search differs widely across the Examining Corps. We want to ensure that the needs of all examiners are considered in tool development and implementation. The best way for this to be accomplished is for the Agency to continue to work with POPA and user groups like the UCDC to collect feedback on new tools. Recently, we are concerned that POPA is receiving information on tools development later in the process. This gives us less opportunity to provide examiner concerns at a time when it is the least costly and time consuming to consider our input. We would like to continue to work closely with the Agency through the development process so that the tools development is efficient and results in tools that are most effective for the Examining Corps.