

From: Guerrini, Christi J [email redacted]  
Sent: Wednesday, May 20, 2015 4:23 PM  
To: WorldClassPatentQuality  
Subject: Comments on Enhancing Patent Quality

Please see attached.

Thank you,  
Christi Guerrini

May 20, 2015

Michael Cygan  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: Request for Comments on Enhancing Patent Quality

Dear Mr. Cygan:

I am submitting the following comments in response to the United States Patent and Trademark Office's Request for Comments on Enhancing Patent Quality, 80 Fed. Reg. 6475 (Feb. 5, 2015). These comments represent my personal views as an attorney and scholar and do not represent the views of any institution with which I am affiliated.

Sincerely,

/Christi J. Guerrini/

## ***Response to the PTO's Request for Comments on Enhancing Patent Quality***

These comments are directed to a question that is central to the Patent and Trademark Office's (PTO) Enhanced Patent Quality Initiative: what is "patent quality"? As some of us have discussed in other forums, this simple question eludes an easy answer.<sup>1</sup> Yet it is critical that the PTO give this question the serious attention it deserves. That is because the choice of definition has major implications for the Initiative's shape and direction.

### **I. THE PTO'S DEFINITION OF "PATENT QUALITY" TO DATE**

Although the PTO is now in its sixth year of programing specifically devoted to patent quality improvement, it is not clear whether the agency has yet engaged in a careful analysis of what it means by "patent quality." That conclusion is based on the PTO's various quality-related pronouncements and activities, which suggest a muddled and at times indiscriminate understanding of patent quality. Specifically, the PTO has consistently equated good patent quality with legal validity,<sup>2</sup> but it has not reconciled its objective of increasing the number of valid patents with the fact that validity is not a static property. At the same time, the PTO has suggested that good-quality patents promote clarity beyond what the validity standards require.<sup>3</sup> For example, the PTO is engaged in a glossary pilot program—the aim of which is to improve patent quality—that arguably promotes a level of clarity exceeding what is required by 35 U.S.C. § 112.<sup>4</sup> The PTO also has associated patent quality with issues related to operational efficiency and user satisfaction.<sup>5</sup> While faster processing and improved responsiveness may enhance users' perception of the PTO however, it is unclear how a better public image translates to better patents.

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<sup>1</sup> See Christi J. Guerrini, *Defining Patent Quality*, 82 *FORDHAM L. REV.* 3091 (2014); Bruce Berman, *Towards a Working Definition of Patent Quality*, *INTELL. ASSET MGMT.*, May/June 2015, at 41; Sara-Jayne Adams, *Quality Is the Key to a Bright Patent Future*, *INTELL. ASSET MGMT.*, Apr./May 2008, at 55.

<sup>2</sup> See, e.g., U.S. Patent & Trademark Office, Request for Comments on Enhancing Patent Quality, 80 Fed. Reg. 6475, 6476 (Feb. 5, 2015) (stating that an effective patent system "requires that issued patents fully comply with all statutory requirements"); U.S. Patent & Trademark Office, Request for Comments on Enhancement in the Quality of Patents, 74 Fed. Reg. 65,093, 65,904 (Dec. 9, 2009) (defining a quality patent as one that gives the public and patentee confidence that the patent is "likely valid").

<sup>3</sup> See 80 Fed. Reg. at 6476 (stating that "[h]igh quality patents permit certainty and clarity of rights," thereby encouraging innovation and reducing needless litigation). *Accord* DEPARTMENT OF COMMERCE, OFFICE OF INSPECTOR GENERAL, USPTO NEEDS TO STRENGTHEN PATENT QUALITY ASSURANCE PRACTICES, Final Report No. OIGe 15e 026e A (2015), available at [http://www.oig.doc.gov/OIGPublications/OIGe\\_15e\\_026e\\_A.pdf](http://www.oig.doc.gov/OIGPublications/OIGe_15e_026e_A.pdf) (defining high quality patents as "those whose claims clearly define and provide clear notice of their boundaries"); U.S. Patent & Trademark Office, Glossary Pilot Program, 79 Fed. Reg. 17,137, 17,138 (Mar. 27, 2014) (describing the quality-enhancement purpose and requirements of the program).

<sup>5</sup> See, e.g., 80 Fed. Reg. at 6476 (identifying "excellence in customer service"—described as the prompt, fair, consistent, and professional treatment of PTO service recipients—as an "aspect" and "pillar" of patent quality); PATENT PUBLIC ADVISORY BOARD, PATENT QUALITY TASKFORCE: PRELIMINARY REPORT, INITIAL PUBLIC COMMENTS & ROUNDTABLE PREPARATION 7 (2010), available at [http://www.uspto.gov/sites/default/files/about/advisory/ppac/patent\\_quality\\_tf\\_report.pdf](http://www.uspto.gov/sites/default/files/about/advisory/ppac/patent_quality_tf_report.pdf) (defining patent quality in part as a function of "timeliness," described as "[a]ctions which increase process efficiency and reduce overall application pendency").

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### **II. THE IMPORTANCE OF ENGAGING IN A THOUGHTFUL DEFINITIONAL ANALYSIS**

Why does it matter what the PTO understands patent quality to mean or how it arrived at that understanding? Because the agency's definition of patent quality is the foundation for all of its quality improvement efforts. The definition dictates the universe of programs that might enhance patent quality, and it dictates the universe of metrics that might assess progress and decline in patent quality. If patent quality is defined exclusively in terms of validity, for example, the universe of appropriate programs and metrics has a different profile than if patent quality is defined more expansively. If clearly stated, the PTO's choice of definition also provides notice to the public regarding what the agency can be expected to do to improve patent quality, and perhaps more importantly, what it cannot.

One might interpret the PTO's quality efforts to date as consistent with a top-down approach. A top-down approach develops solutions to a problem before the problem has been concretely defined. Going forward, I urge the PTO to embrace a bottom-up approach to its quality improvement efforts. A bottom-up approach begins with describing, publicly and precisely, the meaning of patent quality as that term is understood and used by the agency. According to the bottom-up approach, it is only after the PTO concludes this definitional work that it may proceed with developing programs to improve patent quality. Following a bottom-up approach will ensure that the PTO's patent quality mission objectives, programs, and metrics are consistent with the chosen definition and tightly aligned with each other. Following a bottom-up approach also will decrease the likelihood that the agency commits Type III errors of fixing the wrong problems.

### **III. RECOMMENDATIONS FOR THE DEFINITIONAL ANALYSIS**

Because the meaning of patent quality ultimately chosen by the PTO is of critical importance to its quality agenda, I propose here a starting point for the definitional work that is intended to reflect both my understanding of what patent and innovation communities generally mean when they talk about patent quality and what the PTO realistically can be expected to do about it. Specifically, I propose that the definition *include* at least the following elements:

- A patent's likely validity based on the law in existence, and information known or that reasonably could have been known by the PTO, at the time of the patent's prosecution; and
- The likelihood that a patent's scope and terms will be understood by persons who need to understand them.

Together, these elements point to a "validity-plus" definition of patent quality similar to one that has been advanced by the PTO—but with important limits. The narrower formulation recognizes that a patent is valid or invalid depending on the law in effect and the prior art known at the time of that determination. It also recognizes that a patent's validity can never be predicted with certainty as a result of the myriad rules that inject subjectivity into the validity analysis. Indeed, even if the PTO achieved operational

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perfection, it would still issue patent claims that later are held invalid. An aim of the narrower formulation is to define patent quality such that improvement actually can be achieved.

The “plus” component of the proposed formulation relates to clarity of patent scope and terms. Although some ambiguity in patents is unavoidable, a patent can do a better or worse job of describing its underlying invention, and *avoidable* ambiguity makes it difficult for readers of a patent to understand it and reliably predict how others will interpret it. Because unambiguous patents promote innovation and investment, I agree that clarity exceeding the modest level of disclosure required by § 112 should be captured in the agency's quality definition.

I further propose that the PTO's quality definition *exclude* at least the following elements:

- A patent's value as a commercial asset and to society;
- A patented invention's value as a commercial asset and to society;
- The PTO's operational efficiency, including speed of prosecution; and
- User satisfaction with the PTO's services.

Although it is not uncommon to hear patent quality defined in terms of patent or invention value,<sup>6</sup> assessments of value are outside the scope of the PTO's expertise and so should be excluded from the agency's quality definition. The exclusion would also send the message that problems caused by worthless patents and patented inventions are not the agency's responsibility.

Operational efficiency and service satisfaction should be excluded for other reasons. Efficiency is a patent system input. A good-quality patent is a patent system output. Prosecution speed may influence patent quality, as where rushed prosecution contributes to mistakes and thus decreases patent quality, but efficiency is not a feature or attribute of patent quality.<sup>7</sup> Similarly, while it may be desirable to survey users to identify ways to improve agency operations, attorneys' and innovators' pleasure or displeasure with the PTO is not a feature or attribute of patent quality. The danger in equating efficiency and satisfaction with patent quality is that it can lead to Type III errors wherein evidence of improved efficiency and satisfaction is erroneously presented as evidence of improved patent quality. Improving operational efficiency and user satisfaction are laudable

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<sup>6</sup> See, e.g., Sivaramjani Thambisetty, *Patents As Credence Goods*, 27 OXFORD J. LEGAL STUD. 707, 709–10 (2007) (defining patent quality in terms of a patent's technological significance and commercial importance); John R. Allison & Emerson H. Tiller, *The Business Method Patent Myth*, 18 BERKELEY TECH. L.J. 987, 997 (2003) (explaining that “patent quality and value are interwoven in inextricable ways” such that “value can probably be characterized as quality plus other factors”).

<sup>7</sup> In addition, poor-quality applications (some of which eventually become poor-quality patents) can reduce operational efficiency, but in those circumstances, efficiency is a casualty of application quality, not a feature or attribute of patent quality.

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institutional goals that may solve some problems for the agency, but they will not solve the problem of bad patents.

### **IV. SOME IMPLICATIONS OF ADOPTING THESE RECOMMENDATIONS**

If the PTO adopts a definition of patent quality that includes and excludes the above elements, some implications for its Enhanced Patent Quality Initiative are as follows. First, the Initiative's quality "pillar" of improving the customer experience should be pursued under a separate mandate because its achievement is not the equivalent of improved patent quality. Second, the Initiative's proposal of increasing examiners' availability for in-person interviews also should be pursued under a separate mandate absent evidence establishing its relevance to patent quality. Although some applicants will surely welcome more opportunities to engage in person with examiners, it is unclear whether in-person interviews result in patents that are better than those discussed during videoconference or telephone interviews. Third, the quality metrics currently used by the PTO should be expanded to include assessment of an attribute that is not yet captured by them: clarity of claim scope and terms beyond what is required by the patentability standards.

There is a maxim in business that one cannot manage what one cannot measure.<sup>8</sup> Yet to be valid and consistent, a measurement must be based on a precise and justifiable definition of the thing being measured. So it is with patent quality. The PTO cannot reliably count good and bad patents until it knows *what* counts as good and bad patent quality. I urge the agency to put first things first and engage in a thoughtful definitional analysis as a predicate to the rest of its quality improvement activities.

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<sup>8</sup> David A. Garvin, *Building a Learning Organization*, HARV. BUS. REV., July/Aug. 1993, at 78.