

Naples Experts Conference: Phoenix Panel IV- Improving USPTO Practice and Procedure
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- I. What should the USPTO do to reduce duty of disclosure and information disclosure statement burdens applicants and patent owners?
 - a. Finalize changes to 37 C.F.R. § 1.56 based on public comments on the proposed rule change to harmonize the duty of disclosure requirements to be consistent with the standards set forth in *Therasense v. Becton-Dickinson*.
 - b. Mandate that patent examiners review the file histories of foreign counterpart applications contained in the Global Dossier system and record on Notices of References cited or Search Notes identification of the documents that were reviewed, including search reports, Office actions, prior art that may be material to patentability.
- II. What should the USPTO do to improve its final rejection and after-final rejection practices?
 - a. Conduct a quality study on the impacts of interviews, amendments and IDS after final rejection on RCE, allowances, appeals and patent pendency and quality.
 - b. Revise final rejection and after-final rejection practice based on the quality study results and recommendations, including requests for public comments on an advanced notice of proposed rulemaking.
 - c. Permit appellants to participate in patent examiner appeals' conferences reduce the number of appeals or to clarify the issues for appeal.
- III. What should the USPTO do to make better use of PCT search reports and written opinions?
 - a. Have patent examiners concurrently handle PCT applications in the international stage where the USPTO is selected as the ISA with U.S. patent applications filed under 35 U.S.C. § 111(a).
 - b. Reduce the number of PCT search reports and written opinions prepared by independent contractors that are routinely ignored by patent examiners.
 - c. Where the EPO is selected as the ISA for PCT applications filed with the US/RO have the examiners handling the U.S. patent applications filed under 35 U.S.C. § 111(a) rely on the EPO's search and examination results when examining the U.S. patent application even where PPH treatment has not been requested.
- IV. What should the USPTO do to make further improvements in its handling of patent subject matter eligibility issues?
 - a. Keep the examination guidelines and training examples current based on continuing developments in the case law.
 - b. Monitor patent examiner Office actions through in-process and post-issuance to ensure compliance with the guidelines and take corrective actions such as providing more targeted training in problem areas.
 - c. Work with the patent bar groups, Congress and the Administration to seek a legislative fix.
- V. What should the USPTO do to more rapidly achieve patent harmonization?
 - a. Revise restriction practice for U.S. patent applications filed under 35 U.S.C. § 111(a) to conform to the unity of invention standards set forth in PCT Rule 13.
 - b. Redefine the meaning of independent and distinct inventions to be congruent with lack of unity of invention.