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December 29, 2010

Hon. David Kappos
Under Secretary for Commerce and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313

Dear Director Kappos:

On behalf of the Industry Trilateral, I am sending you our letter of December 28, 2010, making recommendations on patent quality. The letter is also being sent to President Battistelli and Commissioner Iwai.

Our recommendations have been under development for some time. They were mentioned at the meeting with the Trilateral Patent Offices in November 2010. The letter and appendix contain:

- Recommendations to applicants for preparing a quality patent application;
- Recommendations to patent offices and courts for improving patent quality; and
- Recommendations for actions by the public to improve patent quality.

We will welcome an opportunity to discuss the recommendations with the Trilateral Patent Offices.

Sincerely,

Douglas K. Norman
President

Cc: Cherie Kazenske



Hon. Benoit Battistelli
President
European Patent Office

Hon. Yoshiyuki Iwai
Commissioner
Japan Patent Office

Hon. David J. Kappos
Director
United States Patent and Trademark Office

28 December 2010

Dear President Battistelli, Commissioner Iwai, and Director Kappos:

RE: Industry Trilateral Recommendations on Patent Quality

The Industry Trilateral includes the American Intellectual Property Law Association (AIPLA), BUSINESSEUROPE, Intellectual Property Owners Association (IPO), and the Japan Intellectual Property Association (JIPA). Since its founding in 2004, the Industry Trilateral has held a great interest in and has supported the implementation of policies and procedures that can produce high quality patents at reasonable costs and with reasonable pendency.

The Industry Trilateral recognizes that applicants have an important role to play in improving the efficiency and cost-effectiveness of the overall patenting process, including timeliness and legal certainty. As the incoming patent application is the starting point of the process within a patent office, it is important that the application is presented in such a way as to facilitate searching and examination by the office.

Patent offices, courts and third parties also have important roles in improving efficiency and cost effectiveness, of course. We should consider the issue of improvement of patent quality from a broad perspective.

With this aim in mind, the Industry Trilateral has drafted the appended set of recommendations. We would welcome any comments the Office Trilateral or the individual offices may have on these recommendations.

We strongly believe that improvements to the patenting process in all jurisdictions will result not only from separate efforts by offices and by applicants, but even more from cooperation as close as possible between offices and applicants. Efforts on each side must be seen over time to make a difference on the other side, which requires a regular exchange of experience and feedback.

For its part, the Industry Trilateral is determined to continue its efforts in this direction and will welcome the opportunity to discuss them with the Office Trilateral.

Yours sincerely,



Philippe de Buck
BUSINESSEUROPE Director General



Fumihiko Moriya
President of JIPA



Douglas K. Norman
President of IPO



David W. Hill
President of AIPLA

Appendix attached

28 December 2010

APPENDIX:

INDUSTRY TRILATERAL RECOMMENDATIONS ON PATENT QUALITY

INTRODUCTION

Definition of Quality

A “quality patent” or “quality patent right,” for purposes of this paper, is a patent that satisfies all of the legal patentability requirements. Patentability requirements include, for example, novelty, inventive step (non-obviousness), and description requirements. Claims of a quality patent will be found valid if subsequently reviewed by a patent office or a court. Patent quality or validity often is determined separately for each claim of a patent.

When a patent is granted with one or more claims that fail to satisfy one or more of the patentability requirements, such claims may be found to be invalid, and the patent can be said to have low quality. Where this paper recommends ways to “improve” quality, it is recommending ways to increase the likelihood that a patent’s claims will be valid, and to increase the number of patents wherein all of the claims will be valid.

We should consider the issue of improving patent quality from a broad substantive perspective. The number of low quality patents will be reduced if applicants improve the quality of their patent applications and file patent applications that fully satisfy the applicable patentability requirements. The number of low quality patents also will be reduced if patent office examiners find all of the prior art relevant to the claimed inventions within a reasonable time and expense, and if patent offices and courts keep judgments at a uniform level with regard to issues such as inventive step (non-obviousness), clarity of claiming and adequacy of description.

Patent applicants invest substantial amounts of money during the process from filing a patent application through obtaining a patent and enforcing it. From the applicants’ standpoint, their investment will be wasted if their patent applications are rejected by patent offices because the applicants prepared their applications relying on non-uniform levels of examination. Their investment also will be wasted if their patent rights, after grant, are invalidated for reasons relating to novelty or inventive step because of prior art found only after patent grant. In this respect, it is important for patent rights to have high legal stability.

With all of these points in mind, the Industry Trilateral views the concept of “patent quality” or “quality patent right” as including the quality of the patent application, the quality of the search and the quality of the examination. The quality of a patent right also

includes the concepts of predictability and legal stability of the patent right. Patent quality must be distinguished from the monetary value of a patent.

We also should consider the issue of improved patent quality from a broad procedural perspective. Practices, procedures and policies that result in inefficiencies, inaccuracy and piecemeal prosecution should be avoided. Further, efforts should consistently be made to enhance the efficiency and accuracy of the prosecution process, through cooperative efforts among offices and with the input of users and other stakeholders.

Quality, both substantive and procedural, can be judged at various stages during the prosecution of a patent application and after the patent is granted. The measures of quality will vary over time, and those measures should be uniform, clearly defined and, to the greatest extent possible, accepted by offices and users worldwide.

Appropriate Metrics

The metrics for measurement of appropriate indicia of patent quality, as well as their collection, reporting, review and analysis, are fundamental to evaluating the success of patent systems in issuing quality patents. Well-defined metrics can provide an essential resource for gauging quality at several stages in the patenting process. Moreover, through appropriate feedback mechanisms, they can provide a basis for implementing changes to processes, procedures, regulations and practices, and even for redefining the relevant metrics as experience is gained. Preferably, the results reported by an office would be verifiable from the outside so that conclusions can be more readily understood.

Shared Responsibility

The Industry Trilateral accepts the concept of “shared responsibility” as part of the discussion of patent quality. From the time an invention is created and it moves into the patent granting process until it reaches the enforcement process, it passes through several stages. The inventor/applicant and their patent attorney and many other parties are involved, including patent offices, courts, and third parties.

The Industry Trilateral has studied the actions that each party should take at each stage in the course from the creation of an invention through the patent grant process and through the exploitation process. The Industry Trilateral believes that all parties must do what they need to do to improve patent quality.

I. RECOMMENDATIONS TO APPLICANTS FOR PREPARING A QUALITY PATENT APPLICATION

- Before drafting a patent application, the applicant and the applicant's patent attorney should analyze the prior art that it has at its disposal, either from its own knowledge or through a search the applicant has conducted or requested. The applicant should use this analysis to decide whether the applicant has a patentable invention, thus minimizing the chances of wasting time and money on patenting.
- Applicants should draft patent applications as far as possible in a standard format, preferably that approved by the PCT and additional common format requirements agreed on by patent offices, such as the common application format (CAF) that has been adopted by the Trilateral Offices. This will make it easier for the examiner to process the application.
- Applicants should avoid being prolix, repetitive or inconsistent in the language used to draft a patent specification. Not only will this avoid unnecessary cost, but it will also avoid adversely affecting the scope or usefulness of the protection that may be granted. Applicants should draft the specification and claims in light of the known prior art. This will help frame the scope of the invention, and allow a faster examination at the patent office.
- An application should state clearly what the invention is and what makes it a patentable invention over the prior art cited in the application. For prior art only available on the Internet, the details of source and date should be clearly given. The application should use consistent language throughout the specification to identify particular items. "Inventing" new words should be avoided as this will only serve to confuse the examiner and anyone reading the claim. Each numbered feature in each drawing should be clearly explained and, if necessary, defined. Reference numbers can be used in claims to point out where elements are explained in the specification and drawings. Specificity and clarity avoid unnecessary cost; in contrast, poor drafting may adversely affect the scope or usefulness of the protection that will be granted.
- The specification should set out clearly the features of the invention with enough specificity to provide an explicit basis for any claims that are drafted. In addition, the ordinary practitioner in the technical field to which the application relates needs to be able to understand and reproduce, without undue effort, the full scope of the invention claimed, so in general more explanation is needed for broader claims. The applicant should work on the assumption that the applicant will not be able to supplement the information after filing. The addition of subject matter will lead to revocation or invalidation of the patent in some jurisdictions.
- Wherever possible, the applicant should provide data in the specification showing how the invention works. If it is available, data should be provided across the whole scope of the invention (especially with respect to preferred features).

However, extra exemplification should not be provided simply for effect. Disclosure of the best features of the invention should not be avoided by supplying sub-optimal exemplification. In some jurisdictions this can prove fatal to the patent.

- The applicant should ensure that any data provided are sufficiently complete to be intelligible to and repeatable by an ordinary practitioner in the technical field to which the invention relates. The emphasis should be on drafting the specification to comply with the PCT requirement (*see* Article 5) that the invention can be carried out by a person skilled in the art. The amount and kinds of data to be included will depend on the technology involved.
- The application should be drafted with clear and unambiguous independent claims. Vague and ambiguous language in the claims should be avoided. Words should not be used in a claim if they are not found in the specification, as this could create uncertainty in the basis for the examination and ultimately adversely affect the scope of protection. To reduce excess claim fees, confining sub-claims to those features that are inventive over the subject matter of the independent claims should be considered, while using multiple dependencies only with the greatest care. Multiple dependent claims should be used judiciously, to give flexibility "within" the same invention to claim more embodiments, but claiming (and consequently, asking the patent office to search) more than one "invention" should be avoided. If the application includes more than one independent claim, it should be recognized that the patent application may have to be divided up later unless the patent office can be convinced that the independent claims relate to a single inventive concept. Divisional applications can be a major source of unplanned extra cost, but may be necessary in some instances.
- Applications should be checked thoroughly before filing for typographical errors, missing text and incorrectly labeled drawings. These may be difficult to correct later unless what the applicant intended was completely clear.
- During prosecution, the applicant should endeavor to address all objections and rejections raised by the examiner.
- Patent applications are complex legal documents. The services of a qualified and experienced patent attorney are essential. In the long term, use of the best-qualified personnel will reduce costs for the applicant and make the job of patent offices easier.

II. RECOMMENDATIONS TO PATENT OFFICES AND COURTS FOR IMPROVING PATENT QUALITY

- Patent offices should insure an independent search and examination. They should not depend solely on the applicant's search or analysis.
- Patent offices should share results with other patent offices in real time and to the extent possible make use of the work done by other patent offices to avoid duplication of effort.
- Patent offices must provide incentives for quality work by examiners. Examiner incentives should be shifted toward quality so that goals are not based purely on productivity targets. However, the parallel goal of compact, rather than piecemeal, prosecution also should be emphasized. Productivity incentives should not encourage examiners to force applicants to file successive applications on the same invention.
- New examiners should be highly qualified individuals who can reasonably be expected to stay as examiners for a significant period of time. Patent offices should recruit more examiners with prior experience in industry as attorneys or agents and as scientists or engineers, especially those with some IP training.
- Examiners must have training in new technologies and in developments in court decisions. The amount of training and guidance given to new examiners should be increased over current levels.
- Patent offices should adopt examining procedures and tools that make it easier to improve the end result:
 - Assign related applications to the same examiner.
 - Permit face-to-face interviews with examiners including interviews before the first action.
 - Search for equivalent patent families of the application under examination, and review search reports in such patent family members.
 - Implement a checklist to ensure that examiners have thoroughly reviewed the specification.
 - Provide examiners with tools available to assist in examination, such as the Lexis Patent Optimizer, which allows the examiner to identify terms in claims not referenced in the specification, terms used inconsistently from one claim to the next, and terms in the specification not identified in the drawings.

- Consider new search engines and more patent subject matter reclassification projects.
- Patent offices should provide rejections or allowances that are well reasoned, thorough and clear. The written record of granted patents should make clear what took place during the course of the prosecution, including during interviews.
- Patent offices should strive for inclusion of the Patent Law Treaty requirements in their internal practices to harmonize and streamline formal procedures, pending a formal ratification of that Treaty in their country/region.
- Patent offices should develop and rely on meaningful measures of the quality of work of individual examiners that can improve the end result. Offices should share such measures with other offices and the public. They can review examination of rejected patent claims that are later ruled patentable on appeal within the office, and review examination of patent claims that are later invalidated by the courts. The percentage of patent applications allowed as patents ordinarily is not a good indicator of quality. Rejecting patentable claims should be viewed as an indication of poor examiner performance. The Industry Trilateral is interested in helping patent offices develop meaningful measures of quality and examiner performance.
- Patent offices should view applicants as part of the solution, not the problem. They should maintain and improve relationships with the user community.
- Courts should render clear and explicit decisions in patent cases. Decisions on validity should be precise and provide guidance to applicants and the offices that is clear and consistent. Litigation should be controlled, particularly in terms of the time to trial and the cost of the proceedings.
- Courts should seek to stabilize doctrines of patent invalidity and reviews of patent office decisions.

III. RECOMMENDATIONS FOR ACTIONS BY THE PUBLIC TO IMPROVE PATENT QUALITY

- Companies should cooperate with the patent offices on training programs for examiners in new or complex technologies, such as technology explanations, demonstrations of new products. Training courses should be taught by industry scientists and engineers.
- Members of the public should submit prior art to patent offices during time periods when such submissions are permitted, before or after patent grant.

- Companies should consider donating databases of non-patent prior art publications, such as scientific and technical journal articles, in fields in which companies have built collections of prior art publications.
- Patent offices should adopt programs to improve the examination procedure to widely collect prior art information from the public, such as “peer-to-patent” programs offered by certain patent offices, which permit industry and members of the public to have input on the patentability of claims in pending applications when the applicant has volunteered to publish its application for peer review.

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