

# **What Can Applicants Do to Improve Patent Quality?**

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# Patent Quality: A Shared Responsibility

- USPTO being proactive through 12 EPQI programs
- Other measures: increased time vs. reduced pendency/cost
- Encourage devotion to first action on the merits
  - Reading of specification and fully understanding the invention
  - Providing clear and complete objections and rejections
  - Prior art rejections based on closest prior art available
  - Ability to address all perceived patentability issues in the first response
- Encourage examiner interviews at all stages of prosecution
  - Examiner understanding of applicant's invention
  - Examiner creates clear record of changes in position and basis thereof

# Patent Quality: Applicant Pre-Filing Measures

- Obtain sufficient details of invention from inventors
  - Informs decision to pursue for patenting
  - Improves prior art search direction / application clarity and completeness
- Prior art search as default practice
  - Perceived patentable feature(s) vital to search and independent claims
  - Exceptions to default practice (e.g., bar dates, world-class knowledge)
- Draft clear/understandable/navigable specifications and claims
  - Use tools to alleviate time concerns
  - Draft claims that can be understood without reading the specification
  - Present broadest claim first (don't “hide the ball”)
  - Avoid over-claiming – not best use of examiner time

# Patent Quality: Applicant Prosecution Measures

- Promptly respond to pending USPTO actions
  - Mitigates need to re-learn the case and its current posture
  - Can benefit patent term and reduce cost
- Interview early and interview often
  - Ensures applicant understanding of examiner's point of view
  - Improves the probability of advancing prosecution
  - Cost of extension of time vs. cost of RCE or notice of appeal
- Avoid prior art “flooding” in IDSs
  - More likely when there are several related cases
  - Mitigate citing immaterial/cumulative art – not best use of examiner time