

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# USPTO and Supreme Court Update

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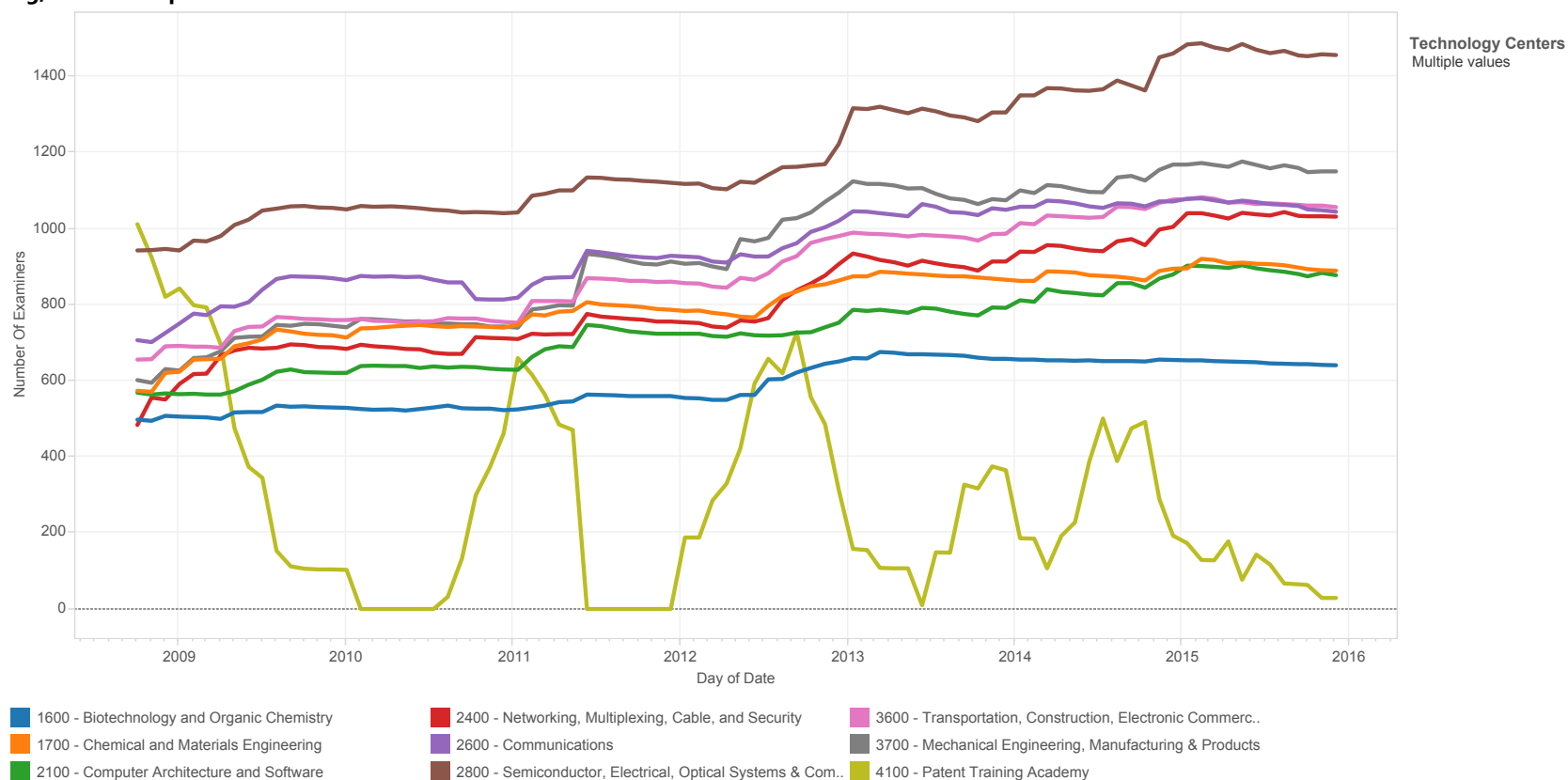
Dallas Bar Association – IP Section  
Belo Mansion – Dallas, TX  
May 27, 2016

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**Utility, Plant, & Reissue by Technology Centers: 1600 - Biotechnology and Organic Chemistry, 1700 - Chemical and Materials Engineering, 2100 - Computer Architecture and Software and 6 more**

Date  
10/1/2008 to 12/2/2015



The above visual displays the number of patent examiners at the USPTO and includes separate counts for each of the USPTO technology centers.

General fiscal year workload statistics relating to patent examiner staffing can be viewed in the U.S. Patent and Trademark Office Annual Reports / Performance and Accountability Reports (workload table 29 of the fiscal year 2014 report). Those reports and workload tables may be accessed from the following web page: [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/ann\\_rpt\\_intermed.htm](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/ann_rpt_intermed.htm).

Additional fiscal year workload statistics relating to patent examiner staffing may be viewed at the "USPTO Data Visualization Center -- Patents Dashboard".

**How to Use the Visual:**

**Date Range:**

This interactive visual allows you to adjust the time period to show any given time range within the bounds of the data. To adjust the date range, use the cursor to select either the beginning or ending date and slide along the time scale.

**Technology Center:**

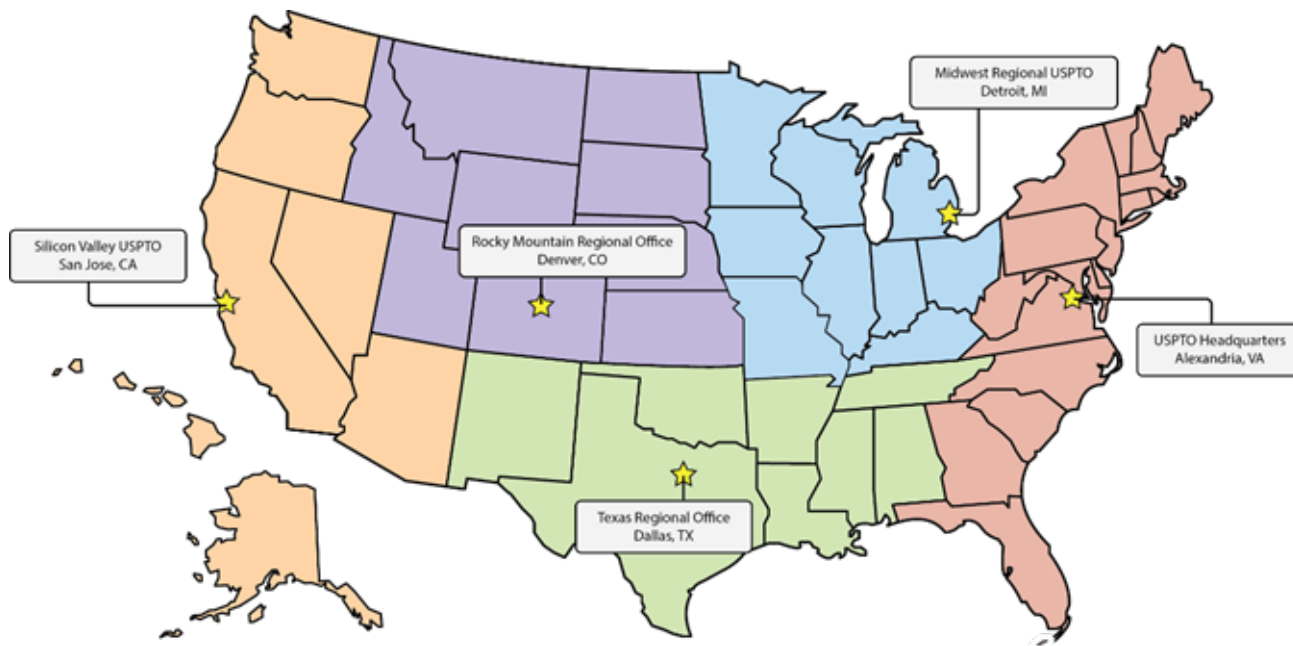
Use the cursor to select from the Technology Center drop down to compare and contrast relationships between the various centers.

**Highlighting Data:**

Hovering Over Data: Use the cursor to hover over any data set to highlight that period in time and learn more details about the data.

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# USPTO Offices



## Detroit

- Operational since July 2012

## Denver

- Byron G. Rogers Federal Building
- Operational since July 2014

## Silicon Valley

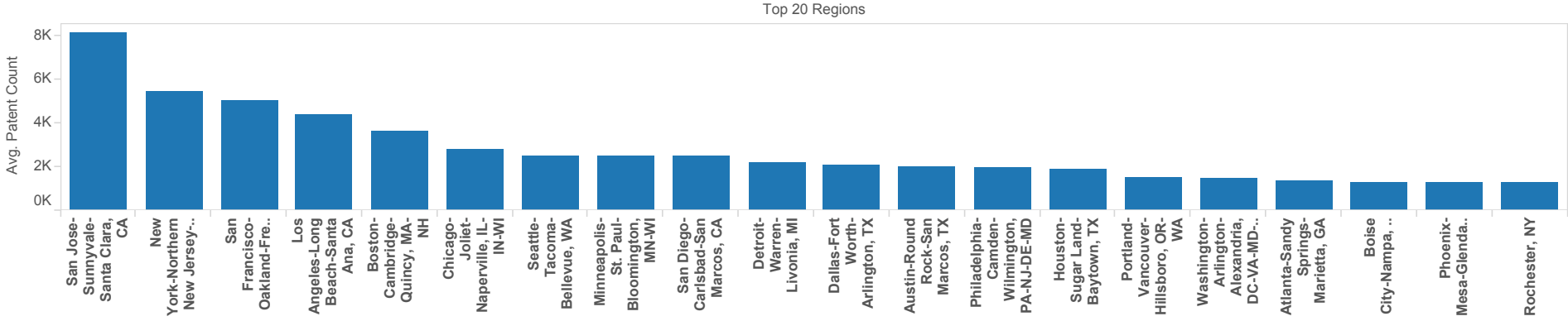
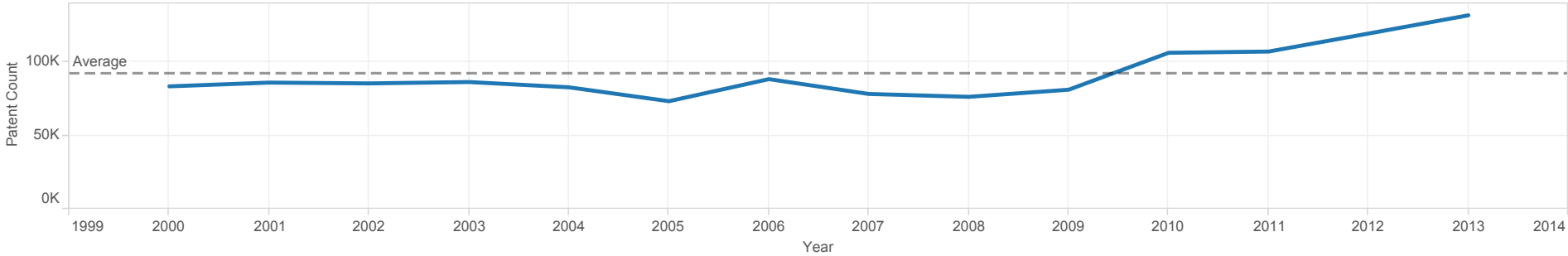
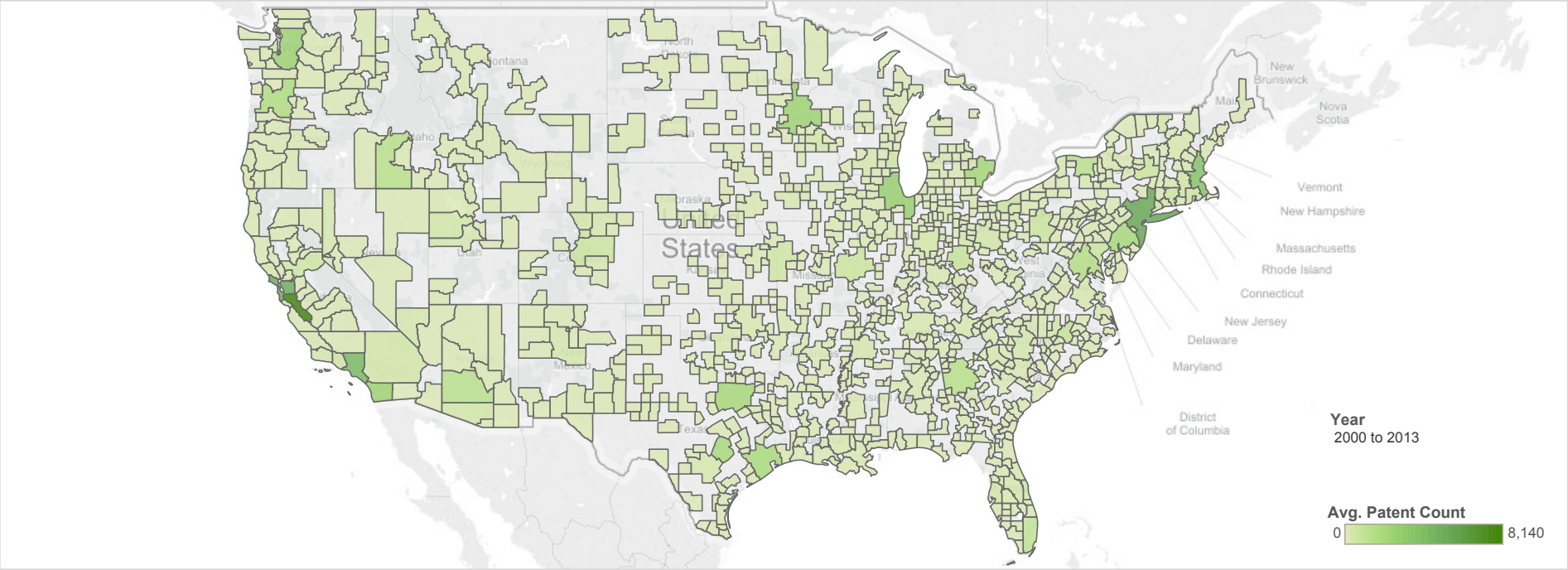
- San Jose City Hall Building
- Operational since October 2015

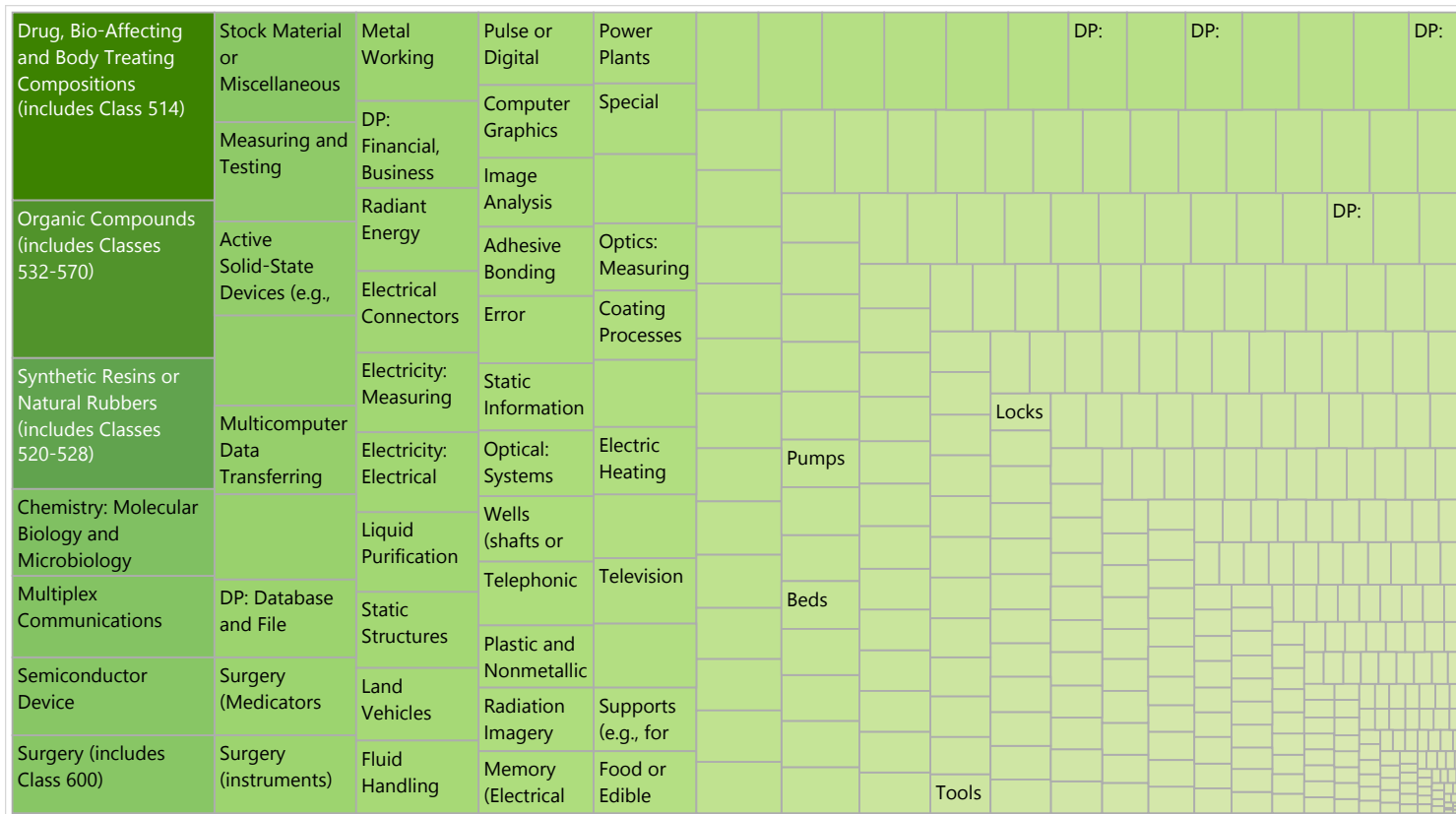
## Dallas

- Terminal Annex Federal Building
- Operational since November 2015

# 2014 State by State Patent & Trademark Data

State	Patent Applications	Patents Granted	Trademark Applications	Trademark Registrations
Alabama	1,089	532	2,069	1,178
Arkansas	601	286	1,312	699
Louisiana	951	707	2,442	1,374
Mississippi	337	179	844	368
New Mexico	984	436	957	540
Oklahoma	1,173	593	1,780	1,226
Tennessee	2,396	1,118	5,714	3,187
Texas	20,088	10,553	24,636	13,908
<b>TOTAL</b>	<b>27,619</b>	<b>14,404</b>	<b>39,754</b>	<b>22,480</b>



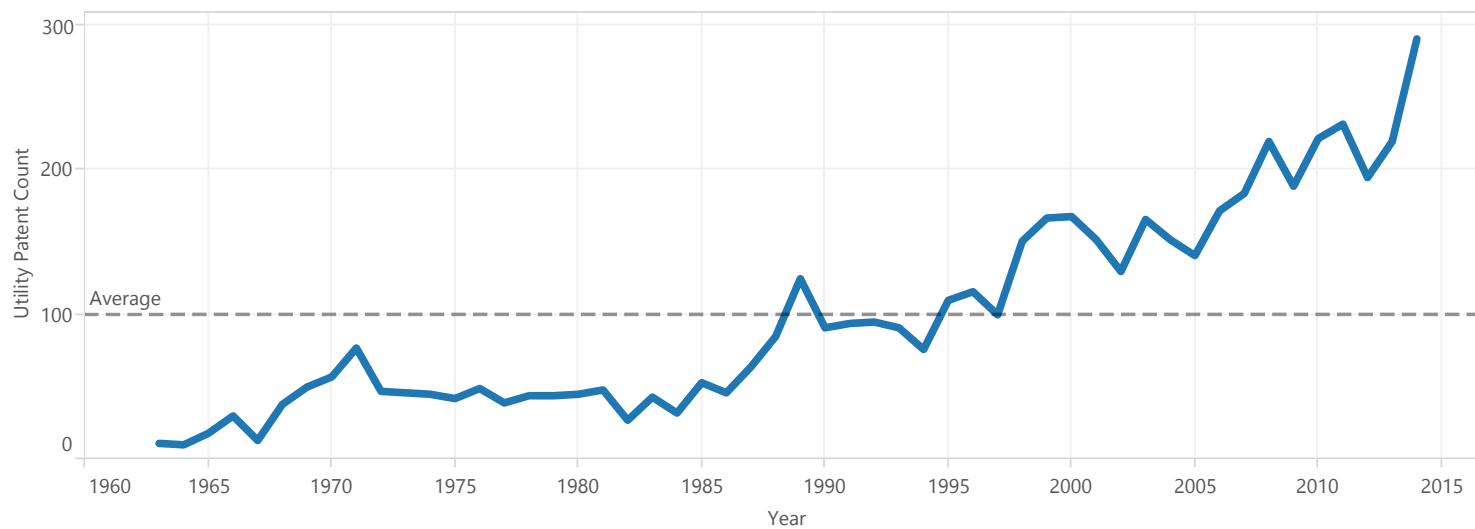


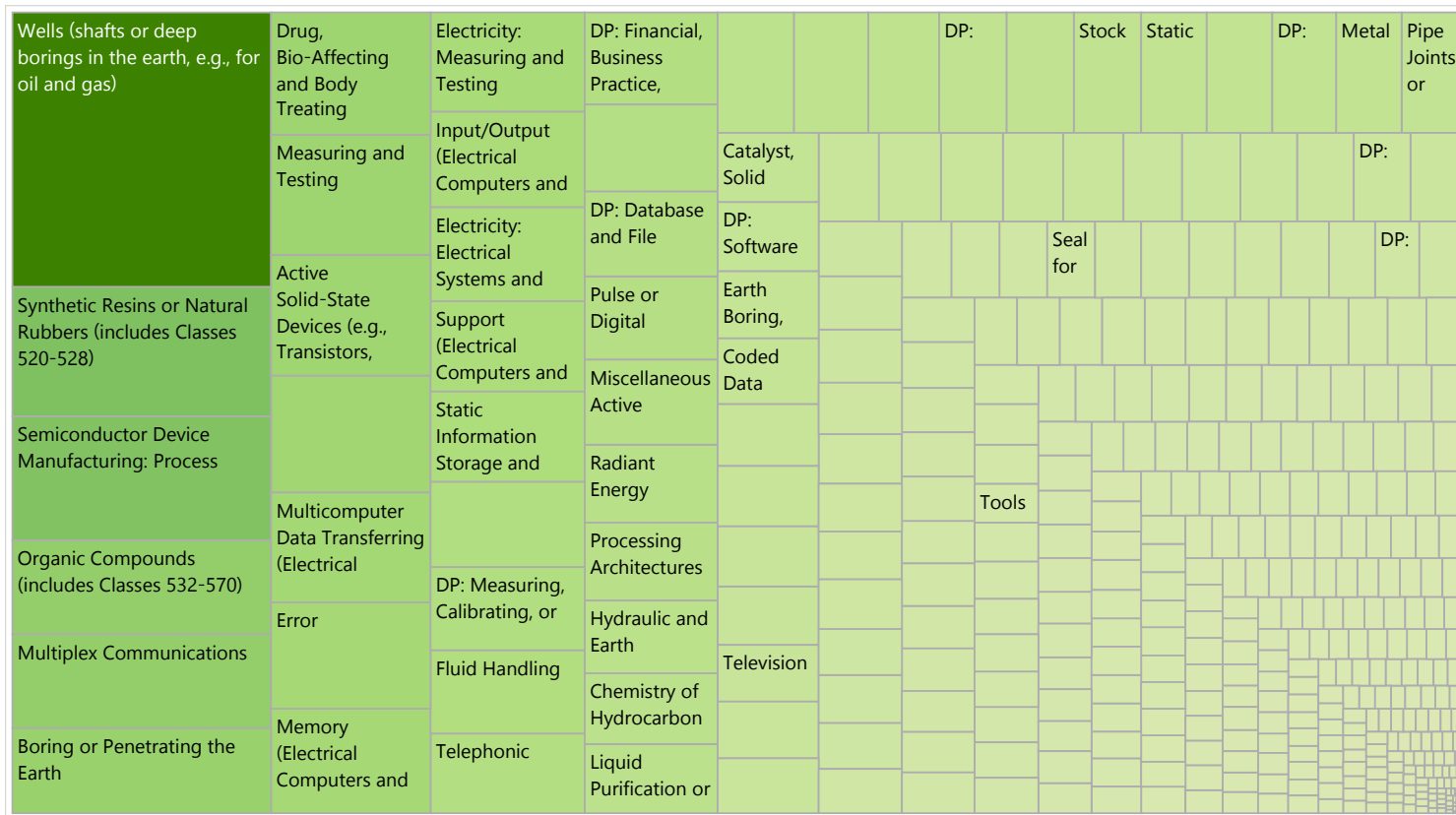
Utility Patent Count  
3 105,663

State  
All

Year  
All values

TOTAL: 3235054



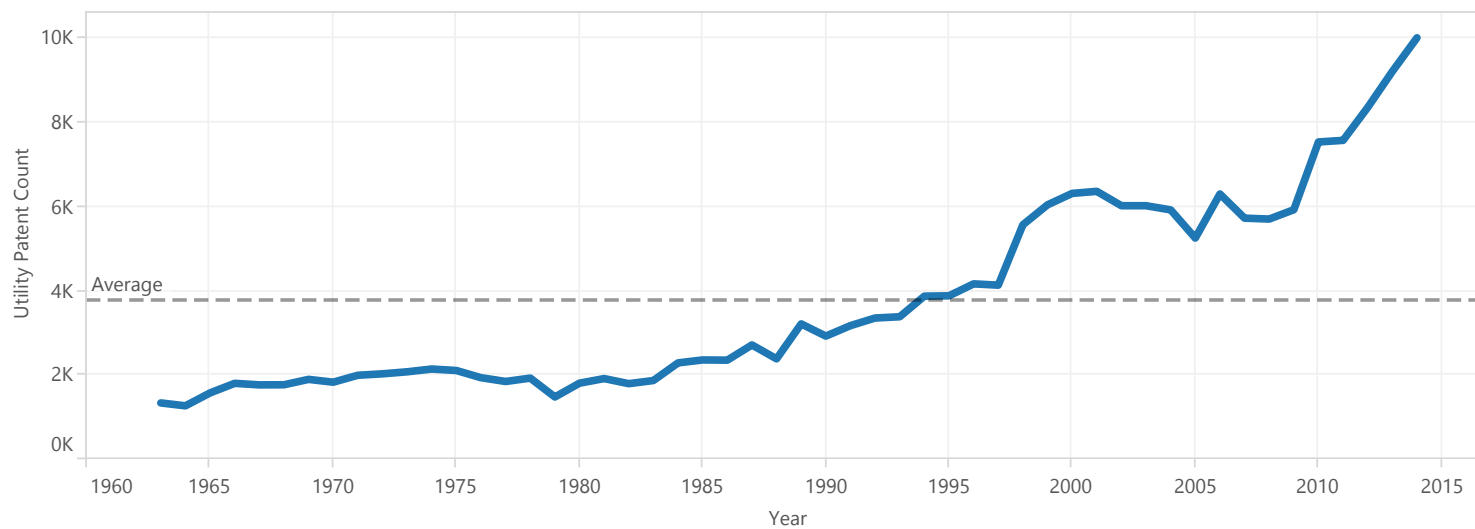


**Utility Patent Count**  
1 12,020

**State**  
Texas

**Year**  
All values

**TOTAL: 196499**





# Enhanced Patent Quality Initiatives



## I. Excellence in work products

- a) Topic Submission for Case Studies
- b) Automated pre-examination search pilot
- c) STIC Awareness Campaign
- d) Clarity of the Record Training
- e) Clarity of the Record Pilot
- f) Post Grant Outcomes

## II. Excellence in measuring patent quality

- a) Clarity and Correctness Data Capture (Master Review Form or MRF)
- b) Quality Metrics

## III. Excellence in customer service

- a) Review of AFCP, Pre-Appeal and QPIDS
- b) Interview Specialist
- c) Design Patent Publication Quality

# Stakeholder Training on Examination Practice and Procedure (STEPP)



**Stakeholder Training on Examination Practice and Procedure (STEPP) is a program designed to further the USPTO's mission of delivering intellectual property information and education to external stakeholders.**

The program falls under the third pillar (*Pillar 3, "Excellence in Customer Service"*), of the Enhanced Patent Quality Initiative (EPQI), which places focus on improving the customer experience throughout the patent process. STEPP was developed to increase transparency with respect to how an application is examined at the USPTO.

## Program Description

The STEPP program provides unique, day-in-the-life, experiences to those attending training. Material used within the program is derived from training delivered to patent examiners and other USPTO employees. In addition, training is delivered by USPTO trainers.

## What does STEPP Cover?

Training delivered through STEPP focuses on the life of an application after the application is placed on an examiner's docket until the application is allowed.

## Why Participate?

STEPP is designed to provide perspective by detailing what an examiner considers in preparing an office action. Training focuses on how an examiner is taught to use the MPEP to make patentability determinations and write an office action. Gaining perspective of an examiner's point of view will increase your situational awareness which can aid in compact prosecution.

**Payment and Credit** Currently, there is no cost to attend a course in the STEPP program.

The USPTO is currently in the process of determining whether CLE credits will be provided for attending a course within STEPP.



**Please visit the STEPP website for more information:**

<http://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp>

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# Upcoming Events

- June 1: Trademark Lunch and Learn
- June 2: Patent Examiner Webinar
- June 8: PPH/International Patent (11:30-1:30 AM) (tentative)  
Global Dossier Road Show (2-4 PM)
- June 28: Texas Regional Patent & Trademark Seminar - San Antonio
- June 29: CPC BYO Lunch (tentative)
- July 6: Trademark Lunch and Learn
- July 26: Texas Regional Patent & Trademark Seminar - El Paso
- July 29: Design and Plant Patent Day
- July 30: Girl Scout IP Patch Day

# Patent Trial and Appeal Board

## State of the Board

AIA Rulemaking

Miriam L. Quinn  
Lead Administrative Patent Judge

UNITED STATES  
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# **AIA Rulemaking**

# AIA Rulemaking

In response to stakeholder requests, the Office moved forward with two rule packages:

1. A first final rule package that encompassed less difficult “quick-fixes” based upon both stakeholder comments and internal PTAB suggestions, including more pages for briefing for motions to amend and for petitioner’s reply brief; and
2. A second proposed rule package published August 20, 2015, and the final rules published April 1, 2016 (<https://www.federalregister.gov/articles/2016/04/01/2016-07381/rules-of-practice-for-trials-before-the-patent-trial-and-appeal-board>).
  - A correction published April 27, 2016, to clarify word count limitation – removes “grounds for standing under §§ 42.104, 42.204, or 42.304” (<https://www.federalregister.gov/articles/2016/04/27/2016-09814/amendments-to-the-rules-of-practice-for-trials-before-the-patent-trial-and-appeal-board-correction>).

# New Rules - Summary

- Claim Construction for Expiring Patents
- Patent Owner Preliminary Response
- Oral Hearings
- Word Count
- Rule 11-Type Certification

# New Rules – Claim Construction

- A party may request district court-type (Phillips) construction
- Must certify patent will expire within 18 mos. from entry of Notice of Filing Date
- Motion and certification must be filed within 30 days from filing of Petition



# New Rules – Preliminary Response

- Eliminates prohibition of new testimonial evidence
- Petitioner may seek leave to file a reply
  - Requires showing of “good cause”

# New Rules – Preliminary Response

“The Board’s decision will take into account a patent owner preliminary response where such a response is filed, *including any testimonial evidence*, but a genuine issue of material fact created by such testimonial evidence *will be viewed in the light most favorable to the petitioner* solely for purposes of deciding whether to institute an inter partes [post-grant] review.”

# New Rules – Oral Hearing

Demonstrative exhibits must be served at least seven business days before the oral argument and filed no later than the time of the oral argument.

# New Rules – Word Count

- Petitions for IPRs: 14,000 words.
- Petitions for PGR/CBM: 18,700 words.
- Petitions requesting DER: 14,000 words.
- Preliminary Response and Response: same as Petition.
- Reply to Patent Owner Responses: 5,600 words

# New Rules – Word Count

- New Exclusions in Petitions:
  - Grounds for standing
  - Mandatory notices
  - Certificate of word count
- Other Exclusions:
  - Table of contents
  - Table of authorities
  - Certificate of service
  - Appendix of exhibits or claim listings

# New Rules – Rule 11-Type Certification

- Signature Requirements
  - Incorporate 37 C.F.R. 11.18(a)
  - Board may expunge unsigned submissions
- Representations
  - Incorporate 37 C.F.R. 11.18(b)(2)
- Sanctions
  - 21-day cure provision

# **New Rules – Signature Requirement**

“Every petition, response, written motion, and other paper filed in a proceeding must comply with the signature requirements set forth in § 11.18(a) of this chapter.”

# New Rules – Signature Requirement

“For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office *must bear a signature*, personally signed or inserted by such practitioner . . . .”

37 C.F.R. 11.18(a)



# New Rules - Representations

“By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under § 11.18(b)(2) of this chapter.”

# New Rules – Representations

“(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any *improper purpose*, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other *legal contentions therein are warranted* by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The *allegations and other factual contentions have evidentiary support* or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The *denials of factual contentions are warranted* on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief. ”

37 C.F.R. 11.18(b)(2)(emphasis added)



# New Rules – Sanctions Motions

- Requires a separate motion
- Motion must describe specific conduct
- Board must authorize filing
- Moving party must serve motion 21 days before seeking authorization
- No motion if opposing party “cures”

# New Rules – Sanctions

- Board *sua sponte* may order attorney or party to show cause
- Sanctions must be consistent with § 42.12
- Sanctions order must describe conduct and explain basis