

**Strategic Plan**

**For the**

**Office of General Counsel**

**Of the**

**United States Patent and Trademark Office**

**2003**

# **Strategic Plan for the USPTO Office of General Counsel**

## **VISION**

*The USPTO will lead the way in creating a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system for the 21st Century.*

The Office of General Counsel (OGC) embraces this vision by fostering the highest degree of expertise, professionalism, and promptness in handling legal issues facing the USPTO. OGC is committed not only to enhancing its operations' quality, productivity and responsiveness to the needs of the public, but also to expanding the effectiveness of its operations in supporting the efforts of other organizations of USPTO. The ethic of quality-driven performance will permeate the actions of employees of the OGC and their efforts will be supported by specific initiatives in such areas as timeliness, e-Government, and expanded support of the USPTO's quality initiatives. Through these activities, the OGC supports the USPTO's overall strategy to become a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system for the 21st Century.

## **MISSION**

*The USPTO mission is to ensure that the intellectual property system contributes to a strong global economy, encourages investment in innovation, fosters entrepreneurial spirit, and enhances the quality of life for everyone.*

Standing mainly outside the trademark and patent examination processes, the organizations composing OGC – the Board of Patent Appeals and Interferences (BPAI), the Trademark Trial and Appeal Board (TTAB), the Office of Enrollment and Discipline (OED), the Office of the Solicitor (SO), and the Office of General Law (OGL) -- play a vital role in the USPTO's mission to assure that the intellectual property system serves its purposes in the public interest. Through OED's role in qualifying attorneys and agents to represent patent applicants, and OED's, SO's, and OGL's roles in discipline proceedings, OGC helps assure the integrity of the patent prosecution in the interest of the public. The two Boards, in hearing appeals by dissatisfied patent and trademark applicants, help assure that the benefits of intellectual property rights are not denied to those with legal rights to obtain them. The TTAB, by hearing cancellation and opposition proceedings, also serves the purposes of trademark protection by assuring that the public has an effective means of preventing or terminating improper registrations. The 21<sup>st</sup> Century Strategic Plan contemplates legislative action to give the BPAI a similar role in guaranteeing the integrity of the patent system. It currently by statute has a more limited role in considering interferences during the examination process. In defending actions of the Boards and of the Director, helping represent the government in other intellectual property cases of public importance, and advising USPTO operating units on substantive developments, the SO contributes to the sound development of the law. OGL, through its advice to management and defense of administrative actions taken by the USPTO, contributes to the USPTO's overall capacity continually to improve its ability to serve the public consistent with law and within the appropriated resources.

## STRATEGIC THEMES

OGC's strategic plan is a step in our continual effort to improve the ways we perform our mission and contribute to the USPTO as a whole. Our planned initiatives and goals are in keeping with the strategic themes articulated for the agency as a whole in the 21st Century Strategic Plan (June 3, 2002) – the themes of agility, capability, and productivity.

### **1. Agility: Address the 21st Century Economy by Becoming a More Agile Organization –**

An agile organization facilitates its processes to meet the changing demands of its business environment. To maximize that agility, the OGC must streamline its key processes to meet internal and external customer demands. This includes the strategic theme's goals of using e-government innovations to increase OGC's ability to handle the increasing and growing complexity, be more responsive to the demands of its internal and external customers, and reduce costs by radically reducing labor-intensive paper processing. The OGC seeks to expand its services and ensure responsive, timely delivery of services notwithstanding budgetary constraints.

### **2. Capability: Enhance Quality through Workforce and Process Improvements –**

A capable organization meets the quality demands of its customers. To be a capable organization, the OGC must have in place effective quality management processes that ensure high quality work and promote continuous performance improvement. In their functions of reviewing and defending actions of the examining corps and in enrolling and disciplining practitioners before the USPTO, the OGC organizations stand to play a strategic role in the USPTO's evaluation of its own processes and work product. Only by modeling attention to quality in all aspects of its own work can OGC also optimize its capability to help the USPTO as a whole constantly improve its quality.

### **3. Productivity: Accelerate Processing Times Through Focused Examination –**

A productive organization meets the timeliness demands of its customers and its business environment. To be a productive organization, the OGC must maximize its output of work performed with limited resources. This is particularly true in those OGC organizations -- BPAI, TTAB and OED – that have a responsibility to promptly decide large numbers of matters brought to them by applicants and the public. It also means, in the OGC's legal advice and litigation functions, meeting the time constraints imposed on the OGC by judicial and other legal regimes and being responsive to the public and USPTO management.

The specific initiatives that OGC plans to undertake are discussed in more detail under each of the major themes.

## SPECIFIC ACTIONS

### ***AGILITY: ADDRESS THE 21<sup>ST</sup> CENTURY ECONOMY BY BECOMING A MORE AGILE ORGANIZATION***

USPTO as a whole is committed to leveraging e-government strategies to make it a more agile organization. The organizations of OGC too will use these tools to help it serve its customers more effectively through such initiatives as e-filing, e-processing, and videoconferencing of hearings, and to prepare to expand its functions as may be required by the Madrid Protocol and such 21<sup>st</sup> Century Plan initiatives as post-grant review of patent claims and examiner and practitioner recertification.

#### **Use Information Technology to Improve the Internal Efficiency and Public Responsiveness of OGC Processes**

##### OGC-wide

- Recognizing the national scope of OGC's litigation and adjudicative functions, reduce costs for USPTO and the public by creating an electronic hearing room at the Carlyle location to permit videoconferencing of hearings by the Boards and depositions by OGL and SO

##### OGL

- Enhance workflow docketing procedures in OGL through the use of work tracking software to report on the monthly status of employee activities
- Utilize electronic database to store and retrieve legal opinions and briefs

##### SO

- Coordinate with the Judicial Conference of the U.S. Courts to achieve electronic reporting of patent and trademark litigation in the federal courts
- Enhance public access to the role of the Solicitor's Office in advancing intellectual property law by posting briefs of major policy concern on the USPTO web site

##### BPAI

- Improve workflow tracking at BPAI to ensure that appeals and other proceedings are timely processed throughout the time they are at the BPAI
- Improve workflow at BPAI in the handling of inter partes communications by scanning all outside communications for interferences declared on and after June 1, 2002
- Prepare for expansion of BPAI jurisdiction by developing e-filing and e-processing systems for inter partes proceedings at BPAI
- Integrate the electronic handling of appeal communications at BPAI with the Patents electronic filing system

## TTAB

- Fully implement the TTAB information system (TTABIS), thus creating a completely electronic workflow system by December 2002
- Automate tracking, reporting and communication of events at the TTAB that must be reported to the International Bureau under the Madrid Protocol by November 2003, including implementing TTABIS and web-based IT changes and linking TTAB to the Trademarks Examination Operation information system
- Initiate e-filing at TTAB by December 2002, with full implementation with capacity to handle all filings by January 2004
- Improve customer responsiveness by making image records of files that are kept on TTABIS available to the public at the USPTO's Public Search Room by December 2002 and by making such information available of the USPTO's web site by Fiscal Year 2004

## OED

- Improve service to those seeking to become patent practitioners and improve OED efficiency by developing nationwide delivery of the patent registration examination to test centers through secure dial-up access, thus making it available not only twice a year but on every business day
- Provide for electronic filing of the form portions of all practitioner enrollment applications
- Improve value to public of patent practitioner bar membership by developing continuing education program encompassing Web-site delivery of training content to practitioners and verification of their participation
  - Automate the process for tracking currency of enrollment of practitioners and integrate that information with the database supporting the patent application process to assure that the registration roles are continually current
- Improve reciprocal discipline process by efficiently parsing an American Bar Association service

## **Enhance Knowledge Management**

### OGC-wide

- Inventory all law library collections in OGC and create a searchable catalogue that makes the availability of the unique volumes of each library known to OGC employees and allows for cross-unit borrowing of volumes no later than December 2003
- Enhance quality and productivity of multiple units by creating searchable databases of OGC work products
- Schedule monthly training meetings for SO and OGL to discuss current developments

## **Increase flexibility through greater reliance on the private sector or other intellectual property offices**

### OGI

- Assist Procurement in developing guidelines to streamline the procurement process
- Assist the Office of Corporate Planning in defending objections to FAIR inventory

### OED

- Outsource the delivery of the patent registration examination to permit frequent administration of the exam and more efficient processing of fees, thus making OED more effective in its other functions by evening across the year the workload due to administration of the practitioner examination

## **Organizing workforce to be more responsive to customers and clients**

### OGI

- Develop team concept to be more responsive to external and internal customers by increasing OGI's participation with Agency management outside of specific requests for advice or litigation which will contribute to managements' understanding of applicable laws and increase OGI's attorneys understanding of the agency's goals and strategies
- Create specialties of practice to enable employees to establish subject matter expertise allowing OGI to provide more timely advice

### BPAI

- Streamline processes for declaring Board decisions precedential, thus increasing the Board's ability to be responsive to the need of the examining corps for guidance in areas where judicial decisions do not provide definitive resolutions of substantive or procedural issues

### TTAB

- Identify those interlocutory actions at TTAB whose delays cause the public to need to seek information from TTAB staff and concentrate resources on reducing the pendency of such matters

## **Expand work-at-home opportunities**

### BPAI/TTAB

- Both Boards will continue current support of their work-at-home programs, expanding those programs as budget constraints allow
- Availability of videoconferencing through the electronic hearing room will expand circumstances in which work at remote locations will be feasible

## ***CAPABILITY: ENHANCE QUALITY THROUGH WORKFORCE AND PROCESS IMPROVEMENTS***

OGC employs a distinctive collaborative process for assuring quality products in its operations. Led by the BPAI and TTAB, which make substantive rulings in panels of administrative judges, OGC organizations have adopted peer review as a key strategy to enhance their performance. Attorneys of the Solicitor's Office work in teams on cases. OGL reorganized at the end of FY 2002 to create a team leader system to assure the application of the highest level of expertise and institutional knowledge to each administrative issue. SO and OED have increased and will continue to expand their cooperation in the development of disciplinary cases. This section concentrates on new initiatives that OGC organizations will undertake to improve their own quality of performance and contribution to the quality of the USPTO overall.

### **Focus on Quality in all aspects of the USPTO mission**

#### **BPAI**

- Expand knowledge of the BPAI's Interference Trial Section by training additional current APJs in the new trial procedures
- Expand experience of APJs to handle full trial type proceedings, including disciplinary proceedings
- Position BPAI to conduct post grant reviews of patent claims to assure the integrity of the patent system through trial training and development of electronic filing and processing systems
- Institute a mentoring program at BPAI to expose new APJs to the variety of methods that experienced APJs have developed to effectively decide issues

#### **SO/BPAI**

- SO will increase its feedback to BPAI judges concerning lessons learned in defending BPAI decisions in court
- SO and BPAI will seek to identify opportunities for providing substantive training to the examining corps, including by briefings of SPEs and assisting in developing a cohort of appeals conference specialists with expertise to select and properly present cases for resolution by appeal

#### **SO/OED**

- OED will identify for SO disciplinary cases that are particularly complex before the cases are presented to the Committee on Discipline to allow increased collaboration between prosecutors and investigators before cases are developed for prosecution

### OGI

- Working with the business units and the CFO/CAO organization, identify opportunities to provide enhanced training to managers on areas of administrative law.
- Enhance review of Employee Relations proposed adverse action memoranda
- Coordinate with Labor Relations the review of proposals for negotiability determinations
- Implement new checklist for all rulemakings
- Working with CFO/CAO and business units, revise administrative orders to create improved administrative processes for agency

### TTAB

- TTAB will continue to assist the Trademarks Examining Organization in identifying recurrent problems in examination that appear on appeal and suggest process changes

### **Enhance workforce capabilities by certifying competencies and make improvements in patent and trademark quality assurance techniques covering all stages of examination**

### OED

- Develop a recertification examination and process in conjunction with Patents and other organizations in OGC to recertify the knowledge, skills and abilities of supervisory patent examiners, primary examiners and examiners in line for a GS-13 promotion to ensure currency in patent law, practice and procedures
- Through this collaboration, OED will develop, with assistance from Patents and other OGC organizations, and publish a databank of questions, from which the questions for particular patent examinations will be selected, thus assisting new practitioners in learning the knowledge deemed necessary for competent practice before the USPTO

### SO/BPAI

- Support the recertification project by developing questions for such examinations that reflect appellate experience with recurrent problems in examination and practice as well as new legal developments

### BPAI

- Work with the Patent Corps to establish precedents from BPAI on important issues in which the Patent Corps needs guidance and where processes need reinforcement
- Enhance review of BPAI decisions to identify precedents for Patents' guidance by establishing a database of decisions in Amicus to facilitate the review of previous decisions and briefs
- Enhance assistance in training Patents on appeal conference procedures through BPAI and SO to ensure that Office policy is uniformly applied

### SO/BPAI

- Expand current OGC training initiatives by having BPAI and SO identify new matters to be brought to Patents' attention to update the examination practice
- Enhance interaction between BPAI and SO to address issues specific to the handling of procedural matters on key ex parte and inter partes cases

## **Make process improvements that contribute to enhance quality through legislative/rule changes**

### BPAI

- During FY 2003, propose new rules to govern appeals and interferences, thus institutionalizing such recent developments as prompt file review of appeals cases to assure that cases are not referred to Board panels if they are not ready for decision, and trial section techniques that have expedited interferences

### SO/BPAI

- Take lead in developing legislative, regulatory proposals to implement the USPTO's proposal for post-grant review in the BPAI

### TTAB

- Publish its revised Trademark Board Manual of Procedure on the USPTO website in the second quarter of FY 2003, thus providing increased guidance to examining attorneys and trademark practitioners in effectively presenting cases to the Board and permitting that guidance to be updated more frequently
- Participate in the developing rules implementing the Madrid Protocol by the end of 2003
- Develop rules to further streamline discovery and other processes in inter partes cases

### OED

- Publish in FY 2003 revised rules governing practitioners to clarify their obligations and expand the role of OED in ensuring integrity and quality of practice before the USPTO

### OGL

- In collaboration with CFO/CAO, finalize the USPTO procurement policy, implementing the increased contracting flexibilities authorized by the USPTO Efficiency Act
- In collaboration with CFO/CFO, identify internal procedures for which USPTO-specific procedures would be beneficial and develop agency administrative orders

## ***PRODUCTIVITY: ACCELERATE PROCESSING TIMES THROUGH FOCUSED EXAMINATION***

In the late 1990s, many of the organizations within OGC were regarded as in crisis. Those organizations – OED, BPAI, and TTAB – embarked on long-term strategic plans to improve their performance. The production goals that those organizations have set below represent the culmination of a concerted, multi-year effort to improve productivity. Without those improvements, the expanded service to the public and to the rest of USPTO that OGC plans under the themes of agility and capacity would not be possible. OGL is a new organization, designed to effectuate the increased autonomy of the agency under 1999 legislation. Reflecting the performance-based philosophy of that legislation, it has set specific performance goals. Its true productivity contribution to the agency lies, however, more in its effectiveness in providing legal advice and litigation support, as needed, to the goals of the business units of USPTO. SO, too, has established performance measures for many aspects of its work. Its functions of defending the agency in intellectual property matters and promoting the sound development of intellectual property law in conjunction with other agencies of the federal government are less amenable of quantification.

### OGL

- Review of 90% of proposed personnel actions within five business days
- Review procurement decisions within 5 business days 95% of the time
- Final stage review of rules packages within 10 days 98% of the time
- Take initial action on FOIA requests and decide FOIA administrative appeals within 20 days 100% of the time
- Review draft Agency Administrative Orders within 10 working days of receipt
- Cut backlog of pending grievances through settlement or arbitration

### SO

- Review of TMPEP, MPEP, Federal Register Notices, and Official Gazette Notices within 20 business days 80% of the time
- Provide expedited clearance review where matters are urgent and brought to SO attention in advance
- Effectively represent OED in enrollment and disciplinary matters
- Review all speeches and presentations by USPTO employees within 10 days 80% of the time
- Reach a settlement agreement, file a complaint, or otherwise resolve all of the OED cases within 6 months after probable cause determination

### BPAI

- Reduce the backlog of appeals at BPAI to a six-month inventory by the end of FY 2003
- Terminate virtually all inter partes proceedings at BPAI pending for 2 or more years by the end of FY2003

### TTAB

- Enhance the expedition of discovery by expanding the program of interlocutory attorney resolution of discovery disputes via telephone
- Reduce pendency of decision on the merits in TTAB cases following full submission from 12 weeks to 10 weeks
- Disseminate information and provide file access to TTAB records by responding promptly and completely to all requests for information relating to the TTAB, maintaining customer satisfaction ratings of over 70% satisfied, and by providing on-line access to all TTAB records.

### OED

- Reduce enrollment cycle time for applicants for registration by developing means to deliver the patent practitioner examination on a continual and national basis
- Six-month target from initiation for completion of enrollment investigations except in particularly complex cases
- Complete discipline investigations within two years from initiation
- Decrease OED's response time to customer requests.

## **FINAL COMMENTS**

This strategic plan is a living document that the OGC is committed to refine and update periodically to adjust to changing conditions. In pursuing this commitment, the OGC will seek guidance from USPTO management, OGC employees and, where applicable, the intellectual property community in general.