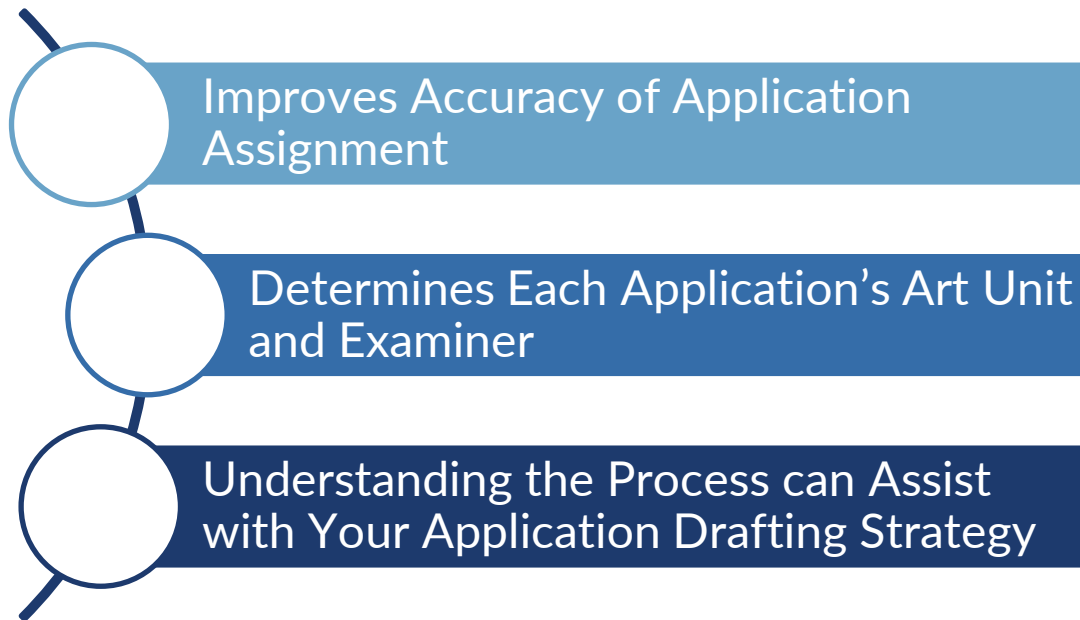


USPTO's New Process for Docketing Patent Applications to Examiners, and Claim Drafting Strategy

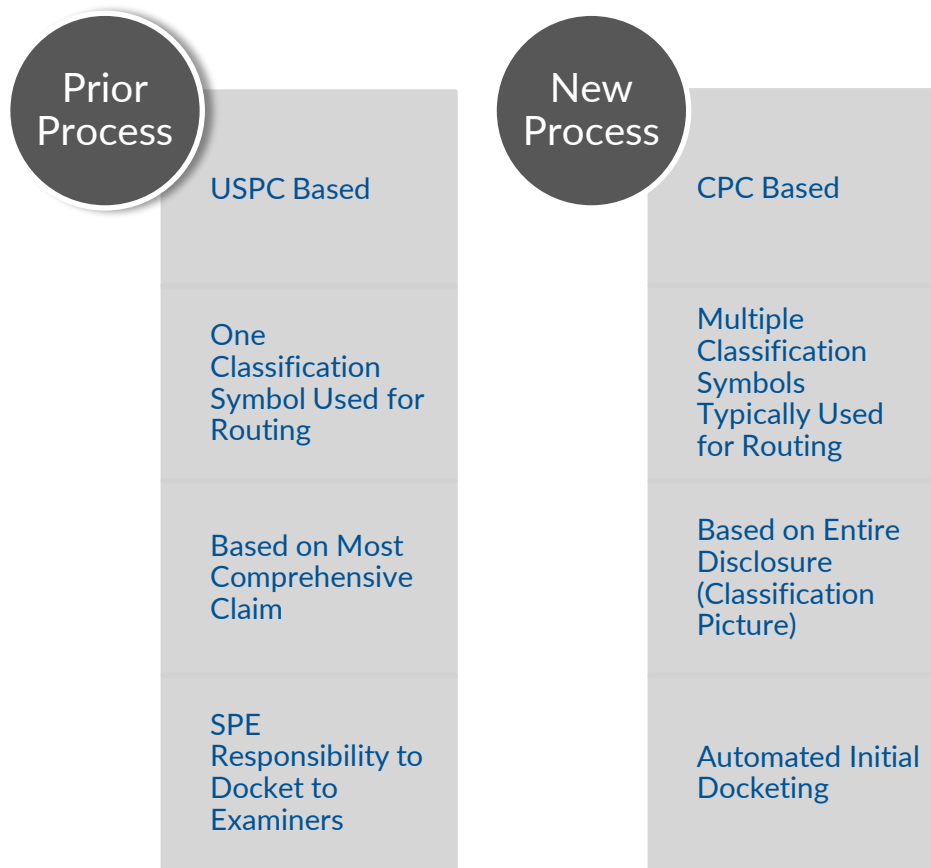
October 20, 2022

Why are we Discussing the New Process for Docketing?



Overview

Prior v. New



New Process

Docketing to the Correct Examiner

Application Classification
Picture

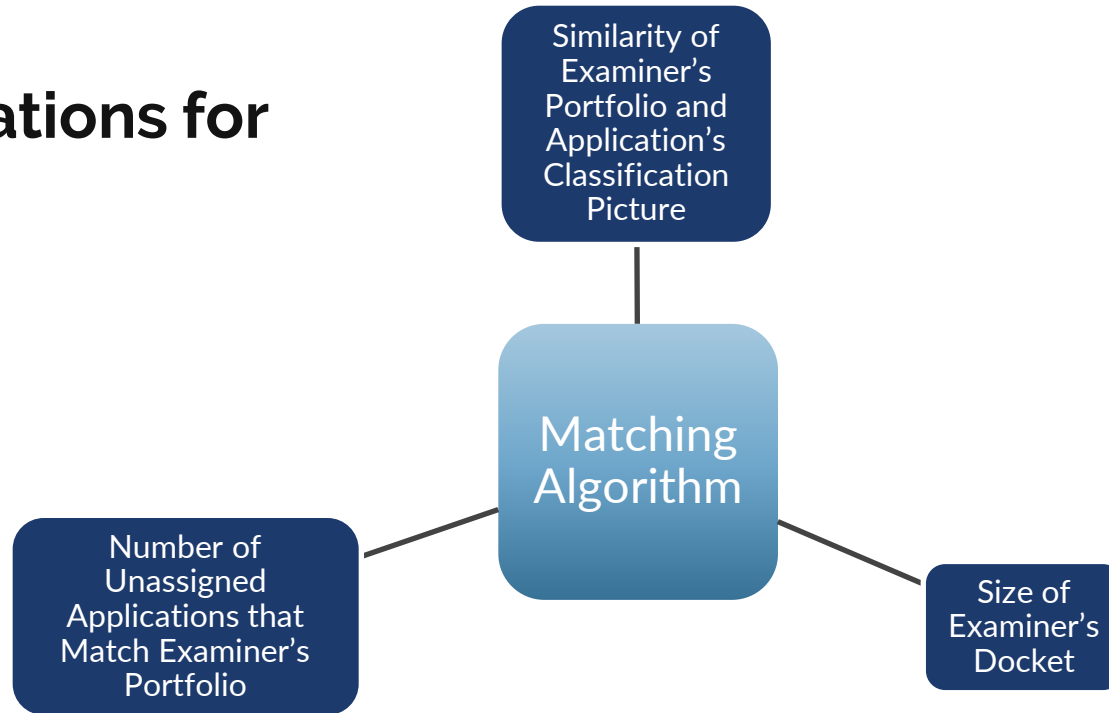


Automated Matching

Examiner Portfolio

- Created for Each Examiner
- Based on Previous Applications Examined
- Will Evolve as Technologies Evolve

Considerations for Matching



Additional Thoughts

Designees, Such as SPEs, can Modify Classification and/or Assignment

- High motivation for accuracy since classification and assignment impacts examination time and examiner portfolios

Expect Future Iterations

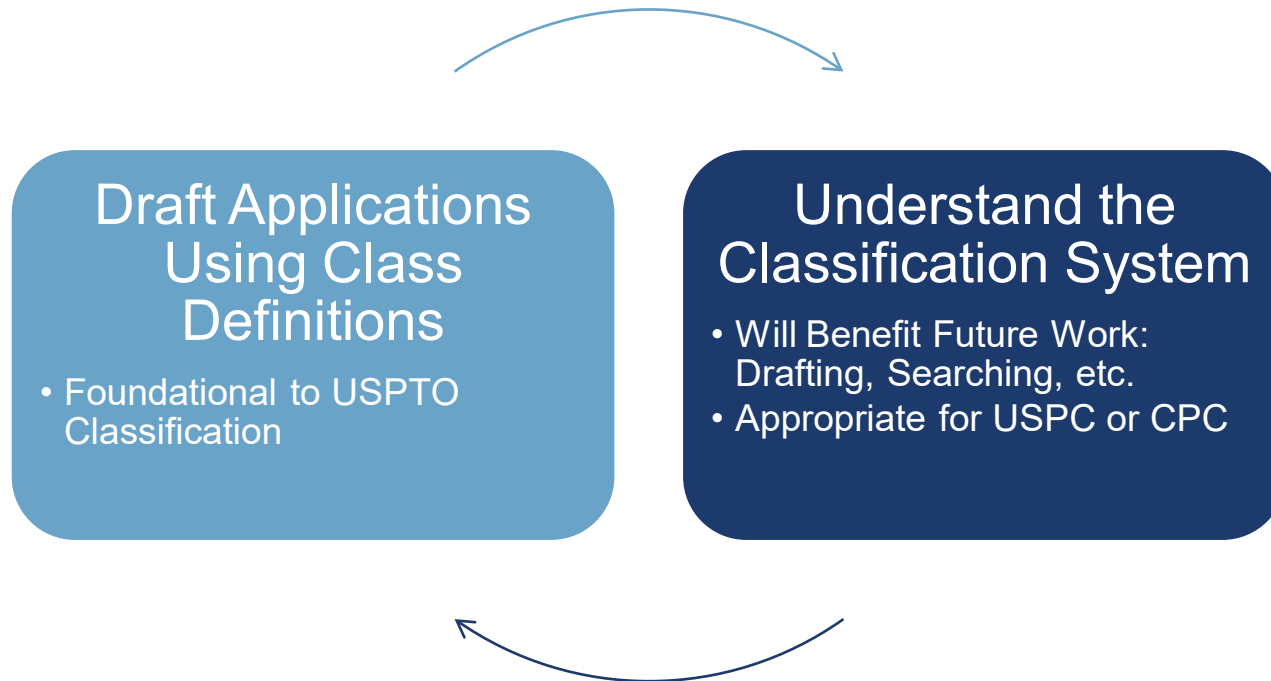
- Matching algorithm can be modified as needed, such as by weighing impact of claimed subject matter higher than non-claimed subject matter

Artificial Intelligence is being used to suggest CPC symbols and indicate claimed subject matter

Application and Claim Drafting Strategy

- Using the USPTO Classification system to drive accurate classification

Drafting Strategy - Goals



Patent Drafting Strategies

USPTO Website: <https://www.uspto.gov/web/patents/classification/>

Classification Symbol Lookup

Select Classification System: CPC USPC

Enter Classification symbol:

Select Content:

- Scheme**
- Definitions
- CPC to IPC Concordance

Select output format: HTML PDF

Classification Text Search

Enter one or more keywords in the field to search the Classification Scheme (Schedule) and Definitions.

Tip: Use quotes to search for exact phrases (e.g. "fuel cells")

Select Classification System: All CPC All USPC

Patent Drafting Strategies

USPTO Website: <https://www.uspto.gov/web/patents/classification/>

Classification Text Search

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Select Classification System: All CPC All USPC

Search

Patent Drafting Strategies

USPTO Website: <https://www.uspto.gov/web/patents/classification/>

artificial intelligence data processing



Class Definition for Class 706 - **DATA PROCESSING - ARTIFICIAL INTELLIGENCE**

<https://www.uspto.gov/web/patents/classification/uspc706/defs706.htm>

Resources CLASS 706, **DATA PROCESSING - ARTIFICIAL INTELLIGENCE** Click here for a...for **artificial intelligence** type computers and digital **data processi** ...

Class Definition for Class 707 - **DATA PROCESSING: DATABASE, DATA MINING, AND FILE MANAGEMENT OR DATA STRUCTURES**

<https://www.uspto.gov/web/patents/classification/uspc707/defs707.htm>

...707, **DATA PROCESSING: DATABASE, DATA MINING, AND FILE MANAGEMENT OR DATA STRUCTURES**...This class is for computerized **data processing** systems and ...

Class Schedule for Class 701 **DATA PROCESSING: VEHICLES, NAVIGATION, AND RELATIVE LOCATION**

<https://www.uspto.gov/web/patents/classification/uspc701/sched701.htm>

Classification Resources Class 701 **DATA PROCESSING: VEHICLES, NAVIGATION, AND RELATIVE**...file Turn Outline Expand/Contract **Processing** Please Wait ...

Patent Drafting Strategies

USPTO Website: <https://www.uspto.gov/web/patents/classification/>

Classification Symbol Lookup

Select Classification System: CPC USPC

Enter Classification symbol: /

Select Content:

- Schedule
- Definitions**
- USPC to LOCARNO (for Designs)

Select output format: HTML PDF

Patent Drafting Strategies

Use Class Definitions When Drafting Claims

- ❑ Business Methods (Class 705)
 - “...uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.”

- ❑ Data Processing – Artificial Intelligence (Class 706)
 - “...emulation of intelligence...” and
 - “...including systems for reasoning with uncertainty (e.g., fuzzy logic systems), adaptive systems, machine learning systems, and artificial neural networks.”

Final Thoughts

Accurate Classification is Best for Everyone

- Facilitates Best Examination

Don't Try to Game the System

- Classification is Complex, with Checks and Balances for Accuracy

Watch for Over-Breadth

- Don't Inadvertently Claim a Business Method When Invention is Not One

Drew Hirshfeld

Principal



Drew Hirshfeld was a long-tenured employee of the United States Patent and Trademark Office (USPTO). He began his career at the USPTO as a patent examiner in 1994 and held positions at virtually all levels of the agency during his tenure. He was named Commissioner for Patents in 2015, and performed the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO from January 2021 to April 2022.

Mr. Hirshfeld brings a wealth of patent prosecution and litigation experience to Schwegman Lundberg & Woessner. His achievements included leading the USPTO's response to the Supreme Court's 2021 *Arthrex* decision by implementing a new process for Director review of final written decisions from the USPTO's Patent Trial and Appeal Board; serving on the USPTO's Precedential Opinion Panel to decide issues of exceptional importance to the Patent Trial and Appeal Board; and overseeing extensive patent prosecution training for patent examiners and members of the public.

Christopher Palmisano

Principal



Christopher Palmisano is a registered patent attorney, admitted to practice in Minnesota and before the U.S. Patent and Trademark Office. His practice includes patent procurement, technical analyses including freedom-to-operate opinions and validity opinions, trademark prosecution, and counseling. Christopher especially enjoys working with startups and small organizations to develop and implement IP strategies through utility patents, design patents, trademarks, and trade secrets. Christopher has extensive prior experience in design, test, and manufacturing engineering roles, and as an officer of a startup manufacturing company. Prior to joining Schwegman, he was a design engineer at Electro-Voice, a division of Bosch Security Systems of North America, where he designed electro-mechanical transducers and other electronic and acoustic products. Christopher received his bachelor's degree (magna cum laude) in Electrical Engineering from Illinois Institute of Technology in Chicago, and his law degree from William Mitchell College of Law in St. Paul.



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