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To: patent_quality_comments
Subject: Request for Comments on Enhancement in the Quality of Patents

Re: PTO-P-2009-0054
Request for Comments on Enhancement in the Quality of Patents

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Respondent: Matthew Boxer. No affiliation.
The comments are the respondent's personal views.

Comments

Section V of the USPTO's request for comments identifies five specific areas where such comments are sought but then goes on to state that remarks may concern matters outside these five areas. My comments do, in fact, relate to matters outside the five specified areas; namely, they relate to Statements of Reasons for Allowance (MPEP 1302.14). These statements are generated during the examination process and they affect the quality of a patent by (a) making clear in the record that the application has received a thorough and complete examination by addressing important issues on the record; (b) by helping identify that the protection granted is of proper scope; and (c) by helping provide sufficiently clear notice to the public as to what is protected by the claims.

From fiscal years 2005 through 2009, the USPTO's review of Statements of Reasons for Allowance was presumably done in the "Allowance Compliance Rate" because such statements would arise, if at all, upon the examiner's decision to allow the application and such statements would further relate to completeness and clarity of the record. In fiscal year 2010, the USPTO's review of such statements can be accomplished in the new metric "Final Action/Allowance Compliance Rate" where final rejections and allowances will be reviewed.

An examiner may prepare a Statement of Reasons for Allowance if he or she "...believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims..." See MPEP 1302.14, Section I. In most cases, the record will make evident the reasons for allowance; however, the rules still give the examiner the discretion to add such a statement to the record. 37 CFR 1.104(e). "The examiner's statement should not create an *estoppel*." MPEP 1302.14, Section V. However, the examiner's Statement of Reasons for Allowance is an important source of prosecution file history. See Zenith Labs., Inc. v. Bristol-Myers Squibb Co., 19 F3d 1418 (Fed. Cir. 1994). Therefore, an examiner's statement can influence the way in which the scope of a patent's claims is viewed in litigation. In Zenith, which involved a claim to a composition for an antibiotic, the examiner's statement indicated that the sole basis on which allowance of the claim was challenged was whether the claim was inherently

anticipated by a particular reference. Because this sole inherency argument was overcome during prosecution, the Court rejected Zenith's contention that the patentee's prosecution statements about the superior manufacturing characteristics of the composition, lent patentability to the claim, thereby causing that claim to cover only preingested forms of the composition. Therefore, the Statement of Reasons for Allowance in Zenith had an important effect on the course of the ensuing litigation.

Unfortunately, in my experience, examiner's Statements of Reasons for Allowance sometimes do, in fact, place unwarranted and narrowing limitations on the scope of the claims. Hypothetically speaking, this would have been the case in Zenith, had the examiner stated that the claim in question was being allowed because of the manufacturing characteristics of the claimed compositions, thereby implying that only preingested forms of the composition were being covered.

Such inaccurate statements pose difficulties for the applicant for a number of reasons. First, if the applicant is dissatisfied with such a statement, he cannot appeal it, because none of his claims have been rejected. 37 CFR 134 (a). Second, while the applicant can file a comment on a Statement of Reasons for Allowance, the failure of an examiner to respond to said comment does not give rise to any implication. 37 CFR 1.104(e). (Indeed, the examiner has no obligation to respond to applicant's comment on a Statement of Reasons for Allowance. (MPEP 1302.14, Section I)). Third, if the applicant comments on the statement, his comments risk creating estoppels. Fourth, if the applicant files a continuing application in the hope of "correcting" the misleading impression left by the examiner's original statement, such a course of action is problematic for the reason that it delays the issuance of the patent and further because the application may well come before the same examiner who issued the original Statement of Reasons for Allowance.

Even Salazar v. Procter & Gamble Co., 414 F3d 1342 (Fed. Cir. 2005), which held that an applicant's silence in the face of a Statement of Reasons for Allowance should not be treated as acquiescence to the examiner's statement does not assure the issuance of a quality patent. In Salazar, the examiner issued a "unilateral" Statement of Reasons for Allowance, asserting that the claims to a certain toothbrush were allowable for the reason that nylon for the bristles was not covered by the claims which referred to "elastic" bristles. The majority in Salazar held that the applicant's silence in the face of this statement did not alter claim scope and did not bar applicant from asserting infringement by nylon bristle tooth brushes under the doctrine of equivalents, because such silence was not a clear disavowal of claim scope by the applicant. However, the dissent in Salazar pointed to the specification which called the nylon bristles "conventional" and a feature of prior art tooth brushes. The dissent asserted that the applicant's silence in the face of a distinction that was central to patentability indicated that the applicant was estopped from asserting that the nylon bristles were within the scope of the claims under the doctrine of equivalents.

Perhaps, the best description of the effect of a Statement of Reasons for Allowance on claim scope is that "Any inferences or presumption [created by such a statement and the comments thereon] are to be determined on a case-by-case basis by the court reviewing

the patent..." MPEP 1302.14, Section V. Therefore, it is all the more important, that the examiner's statement does not initially "...place unwarranted interpretations, whether broad or narrow, upon the claims." MPEP 1302.14, Section I.

For this reason, it is respectfully submitted that a careful review of examiners' Statements of Reasons for Allowance be made by the USPTO in the new metric "Final Action/Allowance Compliance Rate". This review should take special care to ensure that such statements do not lend support to interpretations of claim scope that are unduly narrow or broad as compared to the remainder of the prosecution record.