Sterne Kessler Goldstein Fox
ATTORNEYS AT LAW

February 12, 2016

Commissioner for Patents of the United States Patent and Trademark Office
Attn: Michael Cygan
Senior Legal Advisor, Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy
Mail Stop Comments Patents
P.O. Box 1450
Alexandria, VA 22313-1450
via email: TopicSubmissionForCaseStudies@uspto.gov

Re: Submission of Topic in response to USPTO's Request for Submission of Topics for USPTO Quality Case Studies, Fed. Reg. Vol. 80, No. 244 (December 21 2015)

Dear Commissioner:

We are attorneys with Sterne Kessler Goldstein & Fox, an intellectual property law firm with more than 170 IP professionals in Washington, DC. In 2015 alone, our firm filed over 3200 design applications worldwide, nearly 500 of which were filed at the USPTO. Together we have nearly 30 years' experience filing and prosecuting design patent applications before the USPTO on behalf of over 100 companies and individuals, including 2 companies that are regularly among the top 50 annual US design patent grantees.

As a firm and as individual practitioners we regularly contribute to efforts to shape and improve design prosecution practice. We work with the USPTO and foreign patent offices, and with nongovernmental intellectual property groups around the world.

We write today to suggest that the Office study the issuance of obvious-type double patenting rejections based on a primary reference that is applicable as a pre-AIA §102(b) or AIA §102(a)(1) reference against the application being examined.

We believe investigation of this topic will result in identification of areas in which the Office can improve the quality and efficiency of its examination.

PROPOSED CASE STUDY

Title: Obvious-type double patenting rejections citing a primary reference that may be a statutory bar (i.e., a pre-AIA § 102(b) or AIA § 102(a)(1) reference published more than one year before the effective filing date of an application being examined) against an application.

Proposal for study: The Office should study the issuance of obviousness-type double patenting rejections instead of § 103 obviousness rejections based on a primary reference that may be applicable as a statutory bar against an application because it published more than one year before the effective filing date of the application.

Explanation: In our experience, particularly with design applications, Examiners often issue obviousness-type double-patenting rejections based on a primary reference that may be a statutory bar reference published more than one year before the examined application's effective filing date. Usually when this happens, there is no parallel § 103 obviousness rejection.

Prior-issued patents that published more than one year before the filing of an application being examined should be excluded from being applied in an obvious-type double patenting rejection. An obvious-type double patenting rejection based on such a reference serves no legitimate purpose that a rejection under § 103 would not properly address. Further, the signing of a terminal disclaimer (a common way to overcome an obvious-type double patenting rejection) may not effectively overcome a reference that is a statutory bar, were it properly applied in a § 103 rejection. These obviousness-type double patenting rejections only slow down prosecution and create the possibility for errors or incomplete examination.

The MPEP recognizes that statutory-bar references are not applicable in obvious-type double patenting rejections. For example, MPEP § 1504.06(II) states that:

> A nonstatutory double patenting rejection … may only be necessary if the patent issued less than a year before the filing date of the application. If the patent is more than a year older than the application, the patent is considered to be "prior art" under 35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102(b) which may be applied in an anticipation or obviousness rejection as applicable.

Further, the charts in MPEP § 804 direct examiners to apply only §102(e) or §102(a)(2) references in obvious-type double patenting rejections. These charts are silent with respect to statutory-bar references.

Since obviousness rejections based on a primary reference that is a statutory bar should be resolved under §103, the Office should refrain from rejecting an application under the doctrine of obvious-type double patenting in view of such a reference. The Office should study the issuance of such obvious-type double patenting rejections and deter examiners from making these rejections. Preventing the issuance of these rejections would speed up examination by removing unnecessary and unproductive rejections. Also, it would prevent the improper allowance of an application after the filing of a terminal disclaimer over reference that is actually a statutory bar against an application.

Respectfully submitted,

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The views expressed herein are our own and are not to be attributed to any other person or entity including Sterne, Kessler, Goldstein & Fox P.L.L.C., or any client of the firm.
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