

From: Robert Hayden [mailto:rhayden@petersverny.com]
Sent: Friday, December 18, 2009 12:55 PM
To: patent_quality_comments
Cc: Steven Colby
Subject: my 2 cents on improving examination quality

Sirs,

I greatly appreciate the opportunity to provide feedback on how examination is presently conducted. Thank you in advance for your kind consideration of the following points.

Here's a simple idea – allow cases when objections have been overcome. Roughly 75% of the time that I receive a first non-final office action I overcome all of the rejections only to receive a new non-final office action with new rejections over new art. I recently had a case allowed after three successive non-final office actions, and I never amended a claim. In the last year I've had two different clients each abandon a case after the third successive non-final because, in each instance, the client didn't want to throw any more cash down the hole. If the examiner does a search, makes the best rejections, and those rejections are overcome, why does the examiner then go back to do another search and issue a worse rejection? If you want to reduce the backlog, start applying resources more wisely. Allow the case, collect your issue fee, and move on to the next one.

And another thing, broadest reasonable interpretation consistent with the specification is being routinely read as broadest conceivable interpretation regardless of the specification, and if you disagree with the examiner's interpretation you're pretty much left to explain it to the BPAI. The pre-appeal panel review should have the authority to review matters of term interpretation rather than being constrained to matters of "clear error" which isn't well defined, anyway.

Further, I want to say a word or two about the nature of obviousness rejections. Presently, there does not appear to be any standard for the level of detail with which the "proposed modification" needs to be enunciated. Most obviousness rejections make statements like it would be obvious to "include" the limitation of X into the teaching of Y. Well, what does that mean? Outside of compositions of matter, where you literally "include" a further component simply by stirring it into the pot, most articles of manufacture and processes can't be modified by tossing in something extra. If the proposed modification is the substitution of one component for another, that's simple enough, but far more often it's a matter of the wholesale addition of a feature without further elaboration. I appreciate the time restraints placed upon examiners, but it places an unfair burden upon the applicant to have to puzzle over the myriad ways one could conceivably "include" the limitation of X into the teaching of Y and then address each. And more often than not, when one calls an examiner to ask, one discovers that the examiner never really had a specific modification in mind – they never thought it through. It's more like they went on a fishing expedition for something that could read on the missing limitation, and having found it, they find the benefit the feature provides in the context of the reference in which it was found, and then they assert the same benefit would follow from the inclusion of that feature in the primary reference. It's a mechanical process devoid of reason, but attempts to rebut are typically met with one of two or three form paragraphs about attacking references individually, or bodily incorporation. Well, if you're not proposing the bodily incorporation of the feature of the secondary reference into the primary reference, what then is the proposed modification? How can the applicant properly consider the merits of the supposedly obvious modification when the examiner doesn't actually have a concrete example in mind? For example, if the proposed modification is to add a timing circuit, please at least

explain which nodes of the circuit of the primary reference the additional timing circuit is supposed to connect between.

Lastly, the examination of dependent claims is a joke in many instances. The attitude of many examiners seems to be that if an independent claim is allowable than all dependent claims are allowable and that it somehow follows that if an independent claim is rejected all dependent claims are rejected. But quite frequently the rejections of the dependent claims cannot be squared with the rejections made of the independent claims. Pointing out the further patentability of dependent claims rarely seems effective and is typically met with a regurgitation of the prior rejection. Yet in many instances a client would be delighted to take dependent claims to issue even if they can't obtain the independent claim scope.

Here, in a nut shell, are the reasons why so many applications I prosecute are either pending before the BPAI or on their way.

And don't get me started on species election requirements where every drawing is a species, or every claim is a species...

With all due respect,

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