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**To:** [AEcomments2016](#)  
**Subject:** RE: Comments on Accelerated examination Regulations and proposed termination  
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I have been using the AE program for over 10 years. In the last five years, I've filed over 25 applications including petitions for accelerated examination. I think the program should be continued. It offers Applicants the chance to bring the references they consider most important to the Examiner's attention (instead of filing the usual enormous list of references). This may be useful in protecting patents that issue from post-grant attacks or invalidation in Court. But changes to the AE program are needed.

I'm sure anyone who tries the program for the first time will have the petition either dismissed (usually because something in the support document needs to be altered) or denied. Dismissal can usually be remedied with a revised support document. But many such novice-filed petitions will be denied— meaning the defect cannot be fixed. Remedying dismissal requires considerable added effort to prepare and file revised documents. Denial means the expense of the search and document preparation was entirely wasted. Many of the reviewing SPEs seem to view it as their duty to dismiss or deny.

Between the search fees and writing the required reports, it costs about as much for the client to try for accelerated exam as for Track 1 – assuming it's not dismissed or denied. The dismissals and denials are arbitrary and depend on the notions of the particular examiner reading the rules. I have worked out a format for the summary of the claim elements against the prior art, and the statements of why the claims are distinguishable (required in the support document), which is nearly always effective for the Examiner (Marianne Seidel) in group 1600 who reviews it. But the same format fails with other examiners when applications go to their groups. Notwithstanding my long experience, I have even received an outright denial recently.

The AE program (unlike Track 1) can assist the examiner assigned to the case, by identifying relevant art. But the rules are loose enough, so that even I, with extensive experience in writing the required statements, am often dismissed or denied. Based on the most recent denial I received, I have decided to stop using this program where subject matter is outside Group 1600, and instead, advise clients to use Track 1. I hope changes are made so that the program again becomes viable.

The dismissals are most often because of the alleged inadequacy of statements in the support document. Here is an example of a denial, which followed a dismissal (and my response to the dismissal, and an attempt to rectify the alleged defects in the support document):

With regards to the support document, the listing of all the limitations (or portions thereof) in each of the claims that are disclosed in each of the cited references, specifying where each of the limitations (or portions thereof) are disclosed in each of the reference was insufficient. Additionally, the support document did not contain a satisfactory detailed explanation of claim patentability over each of the references ....

there still is not an adequate listing of all the limitations (or portions thereof) in each of the claims that are disclosed in each of the cited references, specifying where each of the limitations (or portions thereof) are disclosed in each of the references. An explanation of the structures the references teach is provided and portions of the references are identified, ***but it is not totally clear what portions of the claims are admitted to be taught by each of the references.***

Notwithstanding having successfully submitting similar statements of where in the references claim limitations are disclosed over 25 times, here, for this SPE, it was not “totally clear” what was admitted to be in the references. The format I use is to quote claim language and then write quoted relevant portions from the reference below the quoted claim language.

The denial in the case above goes on:

Furthermore, **each reference must be analyzed to indicate whether or not each limitation of each claim is taught by the reference.** For example, claims 1-4 are only analyzed to indicate whether each limitation is taught by US Publication 2002/0178924. Likewise, claim 5 is only analyzed to indicate whether each limitation is taught by US Patent 7,377,336.

In every other support document I have filed, it was clear to the examiner (as intended) that where a reference is not quoted below claim language, it had no relevance. There is no requirement in the rules to break a claim into elements, and where one relies on several patents, list each one below each element with “NONE, NO relevance” beside the ones that are inapposite to the claim element in question. Clearly, one should just discuss the relevant patents below the claim language they are relevant to.

The denial in this case goes on to note alleged defects in distinguishing the claim from the prior art, including:

Petitioner indicates that “[i]ndependent claim 1 has the following elements not in any prior art reference ...” [then cites verbatim the language of claim 1.]

The Examiner alleged that some of the listed elements in claim 1, which I had asserted were not in the prior art, were in fact in the prior art. So an effective examination was conducted – without me having the ability to respond in the context of examination. Based on the Examiner’s conclusions from this faux examination, accelerated status was denied (I had already tried to respond as best I could to a dismissal).

In another recent case, although the OPAP noted and then withdrew a request to file corrected application papers, and although the defect did not affect the filing date (which is the standard in the new rules for determining if an error is significant enough to cause denial of a petition for accelerated examination) the Examiner denied the petition for accelerated examination based on the alleged defect (which was not considered a defect by the OPAP).

I hope the Office finds a way to re-write rules so that arbitrary denial by the SPEs is impossible, or at

least more difficult. I believe some of the reviewing SPEs are viewing it as their duty to deny/dismiss, so the examiners in their group don't have to work on an expedited basis. As I said, although I have been a user of the program for over 10 years, I will not be using it again (except in Group 1600 where Marianne Seidel conducts timely and fair reviews, and Bennet Celsa of QA oversees and is extremely helpful in many instances if things slow) unless changes are made. More specifically, the new rules promulgated in August 2016 which indicate that AE status should not be denied because of defects which don't affect filing date, must be enforced. And the SPEs need to be stopped from trying to defeat AE status. The rules should require them to grant the petitions unless there is a blatant violation or a blatant noncompliance with the rules. Without that kind of enforcement, I fear in most groups, the effort to deny AE status in order to save wear and tear on Examiners (who already have a Track I load to deal with) will continue.

/EPM/

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