



UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

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To: Technology Center Directors
Patent Examining Corps

From: *Stephen G. Kunin*
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Reminder of Office Policy Regarding Examiner's Statement of Reasons for Allowance

It has been brought to the attention of the Commissioner of Patents at the spring AIPLA meeting that there has been a substantial increase in the number of examiners' statement of reasons for allowance. In particular, examiners' statements of reasons for allowance are being made even where the prosecution as a whole already makes clear the reasons for allowing the claims. Furthermore, anecdotal evidence shows that the number of improper examiner's statements of reasons for allowance (not suitable as to content) has also increased.

This is a reminder regarding Office policy on the examiner's statement of reasons for allowance. Principally, the use of an examiner's statement of reasons for allowance should be solely for the purpose of clarifying the record where such clarification is necessary. As noted in 37 CFR § 1.104(e) and MPEP § 1302.14, an examiner's statement of reasons for allowance should only be made if "the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims." Any departure from this general principle requires special approval of the Commissioner for Patents, e.g., providing a statement of reasons for allowance for all Class 705 applications.

Applicants have the responsibility to provide a clear and concise written description and to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Where the examiner has issued an Office action, pursuant to 37 CFR § 1.111, applicants have the responsibility to distinctly and specifically point out the supposed errors in the examiner's action, reply to every ground of objection and rejection, and clearly point out the reasons for patentability which he or she thinks the claims present in view of the evidence disclosed in the references cited. The examiner should take appropriate action if applicants fail to comply with 37 CFR § 1.111 (e.g., if 37 CFR § 1.135(c) is appropriate then give applicants a one-month time period to supply the omission). Only in those situations where the prosecution as a whole does not make clear the examiner's reasons for allowing a claim or claims, the examiner should set forth the reasons in a statement of reasons for allowance. For example, an examiner's statement of reasons for allowance would be appropriate where there is a first action allowance, where the examiner is withdrawing a rejection based on reasons not suggested by the applicant, or where there are multiple rebuttals of the rejection presented by applicant and the

examiner seeks to clarify the written record by indicating which rebuttals were persuasive in leading to the allowance of the claims. See MPEP § 1302.14 for additional examples as to when a statement should be added to the record.

If the examiner determines that a statement of reasons for allowance is appropriate, the statement should be of suitable content as noted in MPEP § 1302.14. Examples of statements of suitable content are:

(A) The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant's second affidavit in example 5 shows unexpected results from this restricted range.

(B) The instant application is deemed to be directed to a nonobvious improvement over the invention patented in Pat. No. 3,953,224. The improvement comprises baffle means 12 whose effective length in the extraction tower may be varied so as to optimize and to control the extraction process.

(C) The specific limitation as to the pressure used during compression was agreed to during the telephone interview with applicants' attorney. During said interview, it was noted that applicants contended in their amendment that a process of the combined applied teachings could not result in a successful article within a particular pressure range (see page 3, bottom, of applicant's amendment). The examiner agreed and allowed the application after incorporating the pressure range into the claim.

(D) In the examiner's opinion, it would not have been obvious to a person of ordinary skill in the art first to eliminate one of top members 4, second to eliminate plate 3, third to attach remaining member 4 directly to tube 2 and finally to substitute this modified handle for the handle 20 of Nania (see Fig. 1) especially in view of applicant's use of term "consisting."

Merely reciting the limitations of claim 1, for example, is not a proper statement of reasons for allowance. Note that it is improper to use a statement of reasons for allowance to attempt to narrow a claim and create an *estoppel* by providing a special definition to a claim limitation which is argued by applicant, but not supported by a special definition in the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Cf. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705, 1714 (2002). Examiners should follow the procedures set forth in the memorandum dated June 25, 2003 regarding claim interpretation and procedures on how to handle applicant's reply in this situation.