

Via Email

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Office of the Deputy Commissioner for Patent Examination Policy

U.S. Patent and Trademark Office

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Response to “Request for Submission of Topics for USPTO Quality Case Studies,” 80 Fed. Reg. 79277 (Dec. 21, 2015)

Topic Proposal: After-Final Rejection Interview and Amendment Practice

I respectfully submit these comments in my personal capacity and not on behalf of my firm or its clients.

Brief Synopsis of Proposal: The Office should compare both the total pendency and the final disposal type (i.e., allowance, abandonment, examiner’s answer, RCE) of each of the following “groupings” of applications: (1) all finally disposed applications, (2) finally disposed applications in which an after-final amendment was entered and an after-final interview took place, (3) finally disposed applications in which an after-final amendment was entered and no after-final interview took place, (4) finally disposed applications in which an after-final amendment was refused entry and an after-final interview took place, and (5) finally disposed applications in which an after-final amendment was refused entry and no after-final interview took place. Data should be generated for each fiscal year for the past 10 years and broken out by Technology Center. The relative size of the five groupings of applications should be compared over time and across Technology Centers to reveal any differences in examiner attitudes towards permitting after-final amendments and interviews; such differences may indicate a need for training and clearer policy guidelines regarding how examiners should exercise their discretion during the very important “after final” period of prosecution. Moreover, differences in pendency and final disposal type among the five groupings of applications may show a correlation between enhanced examiner/applicant interaction and patent quality, similar to that observed in the First Action Interview Pilot Program.

Background:

The First Action Interview Pilot Program successfully showed that early examiner/applicant interaction generally leads to shorter pendency and higher allowance rates of claims that are both clear and of appropriate scope. But such interaction should not stop with the first Office action. Often, multiple rounds of communication and amendment are needed before an examiner and applicant can agree on claims that are both clear in scope and patentable over the prior art, especially when the technology and the law are complex, as is increasingly the case today. Thus, just as the Office has wisely encouraged liberal use of the First Action Interview Pilot Program, the Office should study what effect, if any, after-final behavior may have on total pendency and disposal outcome. This is particularly important at the final rejection stage, when a breakthrough in understanding, by one or both sides, may eliminate an expensive and time-consuming appeal or RCE.

Historically, examiners have possessed very broad discretion in deciding whether to permit an after-final interview and amendment. *See* MPEP 713.09; MPEP 2272. Unfortunately, this discretion is not applied uniformly. Practitioners often see wide variability in examiner attitudes towards permitting after-final interviews and amendments, even within the After-Final Consideration Pilot. It also may be the case that, in view of the After-Final Consideration Pilot, examiners now tend to refuse after-final amendments and interviews unless done formally through the After-Final Consideration Pilot.

Study Design:

Step 1. Classify all finally disposed applications into a genus and four species of applications, which thus constitute the following five “groupings”: (1) all finally disposed applications, (2) finally disposed applications in which an after-final amendment was entered and an after-final interview took place, (3) finally disposed applications in which an after-final amendment was entered and no after-final interview took place, (4) finally disposed applications in which an after-final amendment was refused entry and an after-final interview took place, and (5) finally disposed applications in which an after-final amendment was refused entry and no after-final interview took place. A finally disposed application is a new serialized application that has resulted in an allowance, abandonment, examiner’s answer, or RCE; but an “application” is not itself an RCE (because it is not newly serialized). Further tag all applications in which the applicant filed a compliant request to participate in the After-Final Consideration Pilot (further tagged by whether it was the AFCP 1.0 and AFCP 2.0 version of the pilot). Further tag all applications that underwent the First Action Interview Pilot Program.

Step 2. Compare relative sizes of the five groupings and note how the relative sizes change over time (during the last 10 years) and vary across Tech Centers, relative the Office as a whole.

Step 3. Determine whether applications that underwent the After-Final Consideration Pilot are significantly more likely to have an after-final amendment entered and an after-final interview allowed. Determine whether these results vary by the version of the pilot (AFCP 1.0 versus AFCP 2.0). Further determine whether applications that did not participate in the After-Final Consideration Pilot are more likely to be refused an after-final amendment and interview (thereby revealing any examiner bias against after-final consideration unless done formally through the pilot). Compare data across years and Tech Centers.

Step 4. Correlate grouping with disposal type (i.e., allowance, abandonment, examiner's answer, and RCE). Of course, the mere filing of a "notice of appeal" does not constitute a disposal, given that after-final consideration and allowance may still take place prior to the examiner's answer. Compare data across years and Tech Centers.

Step 5. Correlate grouping with total pendency (including time during appeal and during RCE examination). Compare data across years and Tech Centers.

Step 6. Determine whether applications that underwent the First Action Interview Pilot Program are more likely to cluster disproportionately within any of the five groupings, as compared with applications that did not undergo the First Action Interview Pilot Program. Further determine whether applications that underwent the First Action Interview Pilot Program, within each of the five groupings of applications, reveal different pendency and disposal outcomes than those that did not undergo the First Action Interview Pilot Program.

Conclusion:

The willingness of examiners and applicants to remain open to interviews and amendments, especially in the critical "after-final" period, is likely to have a significant impact on the total pendency and final outcome of the examination. Data generated from this proposed study may suggest changes to the After-Final Consideration Pilot and a need for training and clearer policy guidelines governing examiners' after-final discretion. The data from this study may also demonstrate second-order relationships: an after-final amendment filed without an interview may lead to more appeals and RCEs than if the after-final amendment was filed as part of an after-final interview discussion. Likewise, second-order effects may be present when both a First

Action Interview and After-Final Consideration occur in the same application, suggesting that these two pilots may serve as appropriate “bookends” during the examination process.

The undersigned thanks the Office for soliciting these comments and welcomes any questions or follow-up directed to his telephone or email addresses listed below.

Sincerely,

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