

Topic Submission for Patent Quality Case Study

Subject: Errors in Representing Patent Claims in Office Action Rejections

When formulating prior art rejections under Section 102/103, the rejections will always be based on the actual claim language that was filed for consideration by the Office.

However, Examiners vary widely in how they state the actual claim language in formulating the rejection. Many Office Actions do not include a clear or accurate representation of the claim language being addressed. The presentation of the actual claim language in a rejection does not appear to be subject to any standards of presentation, formatting, or supervisory quality control by the Office.

Why is it not possible for the USPTO to define and assert minimal standards for presenting the claim language when formulating a prior art rejection? For example, it should be clear when a rejection omits a certain claimed term or modifies the claim language for some purpose, but Examiners do not appear to follow any guidelines in this regard.

It would be very helpful if the USPTO did a case study on how varied actual claim language is presented in Office Actions are, and promulgated minimal standards for formatting, readability, and accuracy of claim language in prior art rejections.

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