

The following is in response to a request for submission of topics for case studies.

During prosecution, an Applicant may encounter examination, though not “piece-meal,” as that term is generally understood (i.e. where new rejections are made for reasons that previously existed, such as described at MPEP 707.07(G)), but includes repeated, simple tactical rearrangement over an extended period of previously relied-upon references on the purported basis of minor claim amendments. Such examination can occur over many years – 5, 6, 7 years – without resolution, while an Examiner timely moves the case on his/her docket, requiring Applicant to file RCEs, etc., but does little to advance examination. It also appears that supervisors are unable or unwilling to override an Examiner, including a Primary Examiner, in such situations or are not properly overseeing applications that fall into this category, are simply signing off, not reviewing or not supervising.

The role of interviewing, in particular in-person interviewing, is extremely important in the application process, particularly in the circumstances described above, yet some Examiners, due to hoteling distance, are not required to interview in-person, which hinders the quality and progress of examination, particularly in the circumstances described above. Video conferencing is a poor substitute for in-person interviews, and long distance hoteling avoids having to grant in-person interviews. In addition, it is virtually impossible to adequately demonstrate an invention or differentiate Applicant’s invention from prior art cited by the Examiner, for example, by showing the Examiner a prototype of the invention, such a medical device, battery or mechanical device via a video conference or telephone call. Although an Applicant can request a supervisor to be present at an in-person interview at the USPTO while the Examiner participates on webcast, the supervisor generally have little familiarity with the case or does little to override or otherwise “supervise” long distance hoteling Examiners, particularly if the hoteling Examiner is a Primary Examiner.

Although an Applicant, under the circumstances described above or other similar circumstances, can opt for an After Final 2.0, this requires a claim amendment; a pre-appeal conference, this requires exclusion of the Applicant; an appeal to the Board, this takes years to get a decision, and is expensive; or an ombudsman who will be new to the case, but grant only a one-half hour interview, which is often not sufficient if prosecution has gotten far enough along that an ombudsman needs to be called in – none of these options are adequate after years of examination, particularly with long distance hoteling Examiners.

Possible solutions and suggestions:

- Require ALL Examiners to make themselves available at the USPTO at least 2-3 times a year to conduct in-person interviews for those Applicants who request them;
- Require supervisors to audit cases that have a prolonged examination of repeated rejections and permit supervisors to interview cases, including in-person interviews, with Applicants and overrule Examiners, including Primary Examiners;
- Enable Applicants to participate in a Pre-Appeal Conference, including in-person, if requested by the Applicant; and
- Lengthen period of interview with Examiners and, if requested, an Ombudsman to at least 45 minutes.

Thank you for your consideration.

Regards
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