

I would like to propose the following topic for a quality case study:

**Consequences of Examiner Unwillingness to State a BRI on the Record**

It has been my experience that a major impediment to high quality patent examination in a reasonable time frame is that sometimes Examiners adopt a broad "broadest reasonable interpretation" of a claim term, but don't necessarily point this out to the applicant. The applicant is left to guess at the real basis for the rejection, often trying various amendments and arguments which, in the Examiner's view, miss the point. This results in several exchanges back-and-forth in which neither party understands what the other party is saying.

Interviews clearly are one way to ferret out these "broadest reasonable interpretation" issues, and I applaud the Office's initiative to encourage them. Another way, which might seem obvious, is to require Examiners to state their definition for a term that they know they might be interpreting more broadly than the Applicant intended. My sense is that Examiners often know when they are adopting such a broad claim interpretation, but are, for one reason or another, reluctant to state their interpretation in writing. My experience has been that in the few cases in which the Examiner has stated an explicit interpretation for a claim term, prosecution becomes much more focused and expeditious, and results in high quality claims that have the correct scope given the prior art – neither too broad nor too narrow.

It is currently not PTO policy to require Examiners to state a BRI on the record. Therefore I would suggest that a study could be made comparing the cases in which the Examiner did state a BRI, to those in which the Examiner declined to state a BRI, to determine the extent to which stating a BRI on the record improves patent quality.

Thank you  
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Reg. No. 31,454