

**From:** Mphpatlaw  
**Sent:** Monday, November 14, 2016 5:15 PM  
**To:** External Examination Time Study <ExternalExaminationTimeStudy@USPTO.GOV>  
**Subject:** Comments on Examination Time Goals

Attached are my comments regarding to the Federal Registration Notice on October 25, 2016.

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Re: October 25 Federal Register Notice

Dear USPTO:

My response to the Federal Register Notice of October 25, 2016 is not specifically directed to how much time an Examiner should devote to the prosecution of a particular patent application, but rather concentrates more upon those basic pitfalls which have adversely affected effective patent application prosecution and utilization of United States Patent and Trademark Office resources. The issue of how much time should be devoted to an application fails to recognize the basic underlying factors which have created the problem in the first instance.

After more than 50 years of experience working with Fortune 500 companies, private practice and as a U.S Patent and Trademark Office Patent Examiner, I have witnessed many transitional policy changes within the United States Patent and Trademark Office purportedly to enhance the patent application examination efficiency. Unfortunately, often these policy changes create hasty, ill-conceived and costly United States Patent and Trademark Office prosecution dogmas which fail to foster the constitutional mandate or the examination process.

The problem appears to partly emanate from a lack of patent law knowledge and training even at the GS-14 patent examining level. It is also appears that many Patent Examiners have little or no knowledge as to what is actually claimed or disclosed in a patent application. This frequently becomes apparent in restriction requirements in USPTO Office Actions which are often strictly based upon the applicant's drawings without bearing any relationship or perception as to what is being actually claimed by an applicant. This necessitates a needless response to a meaningless restriction requirement. Obviously such Examiners have failed to fully read and comprehend the applicant's claims by relying only upon the pictorial depiction in applicant's drawings for the restriction requirement. As a result, matters that will not even be claimed by an applicant now necessitate needless attorney time and effort responding to what is essentially a meaningless issue which *de facto* lowers efficiency and raises prosecution costs for the applicant.

Similar needless duplicate patent application prosecution situations also arise when a restriction requirement is made between a method necessitating the use of an identically claimed patentable device claimed by applicant's device claims. Irrespective of an applicant's election of either the method requiring the use of the claimed patentable device or the identical claimed device, the patent statutes, the rules and the MPEP require a complete and thorough examination of the claimed device. Under these circumstances there should exist no grounds for not rejoining the method claims and the device claims after an allowance of either of the non-restricted claims. To maintain the restriction under these circumstances and then to not rejoin the claims simply duplicates the patent application examination proceedings, the base issue fees, the filing fees, and the maintenance fees, and further places a significant additional financial burden upon the applicant to pay the duplicate attorney prosecution expenses all of which does little to promote

the constitutional mandate. Moreover the Patent Office goal should be to expeditiously prosecute and grant patents upon meritorious inventions. The current policy of rewarding Patent Examiners for simply disposing a patent application fails to effectively reduce the patent application back-log because it forces an applicant to file a duplicate patent application and needlessly reopen the patent prosecution on a matter which should not have required another application to be filed. It should also be noted that I have encountered Examiners attempting to justify restriction requirements and not permit a rejoinder on grounds directly contradictory to what is being actually claimed by an applicant.

There also appears to exist a premium or a reward for prematurely advancing the prosecution of an application without giving an applicant a fair opportunity to challenge the impropriety of the initial rejection. This problem appears to be compounded by a basic misunderstanding among Examiners as to what grounds constitute a valid 35 USC §102 or 35 USC §103 rejection. There also appears to exist a rush to establish a final rejection and thereby forestall an applicant's ability to effectively traverse a first Office Action rejection upon the merits of an invention.

It seems the existing USPTO software makes it easy for an Examiner to piece together a lengthy, but flawed 35 USC §102 or 35 USC §103 rejection. The long-established standards (*e.g. (i) that:* the cited references must fairly teach and suggest the reference combination by themselves without needing an applicant's contribution to explain the rationale for the reference combination; *(ii) the salient cited reference teachings explicitly teach a contrary conclusion from what is stated in the Patent Office rejection;* *(iii) an Office Action 35 USC §103 rejection may be premised upon the notion that a primary reference may be indiscriminately modified by a secondary reference even in a manner which destroys or renders by the device or the method disclosed by the cited primary reference inoperative or unfit for its intended purpose or use;* *(iv) the claimed invention as a whole including its operative components yields an unexpected results, etc. are exemplary crucial patentability indicia which often fall upon deaf ears of USPTO Patent Examiners.*

Notwithstanding repeated requests for an early interview by an applicant's attorney in an initial Office Action response upon the merits of a claimed invention which interview, if granted, may have likely resulted in an early allowance, many Office Actions too frequently rely upon software based rejections to hastily facilitate a premature final rejection. This often leaves the prosecuting attorney with little choice but to file a Notice of Appeal, Request for Reexamination or to refile a continuing application in order to obtain a proper examining forum, all of which could have been avoided if the requested interview had been granted so as to provide an avenue to an early allowance during the initial application prosecution stages. It is rather disgusting for an experienced Patent Office Practitioner to spend costly time, effort and fees as well as the costly attorney's expense just to obtain an allowance upon claims which should and could have been expeditiously allowed during the initial patent application proceedings. This obviously causes a needless drain upon the resources of the USPTO as well as the applicant.

I was a USPTO Patent Examiner during the infancy of database technology to assist Patent Examiners in prior art searches. This started in what was then Group 140 on a project referred to as a Mech A. Although the database searches are a great tool for assisting Patent Examiners in examining patent applications, it is important for the USPTO to recognize that it is only a useful tool which cannot ultimately be solely relied upon in the final analysis for patentability. Unfortunately, it appears that too many Examiners use the database results as the determinative patentability factor to expeditiously reach the self-serving and rewarding goal of

disposing a patent application. It has thus become evident that throughout the examination process countless Examiners have relied almost exclusively upon database findings without entertaining the mental thought needed to resolve the substantive issues of patentability as required to achieve a quality examination.

From a Patent Office Practitioner viewpoint, it is difficult to comprehend these unneeded and costly expenses in obtaining patent rights on a patent application which could and should have been expeditiously granted before a final rejection was ever made in addition to those needless costly expenses and efforts incurred thereafter by both the USPTO and the applicant. To continue patent application prosecution before the Patent Office to the disfavor of an applicant on matters which should and could have been earlier concluded in a manner favorable to an applicant does not promote the science and useful arts but instead floods the patent system with repetitive patent applications and prosecution issues. Again it needlessly drains both the USPTO and the applicant's resources.

I believe that one critical area needing improvement to resolve the issue portrayed above along with many others, is training. It is important to train the USPTO Examining Corp as to the limits of database prosecution aids. It is also important to train Patent Examiners to provide an earlier and higher quality substantive examination and to create red flags indicating at which juncture it becomes necessary to interject human wisdom into the patent application examination procedure. It is also essential that the USPTO provide the necessary legal training so that this wisdom is judicially applied during the examination of each patent application. Unneeded time and effort devoted by an applicant's attorney to the patent application prosecution process has a direct bearing upon unneeded responsive time and effort incurred by the United States Patent and Trademark Office and often results in cost prohibitions to those inventors having limited resources, all of which will ultimately have a negative impact on the basic goal of promoting technology and the sciences in the United States.

I also believe that another critical area needing improvement is the Examiner rating system. A simple disposal count should not dictate a Patent Examiner's effectiveness. A hastily reached disposition without fairly entertaining the true merits of an applicant's patent position results in low quality and wasted resources. The repetitive nature of such occurrences should be judiciously assessed in any USPTO quality control system. Perhaps the system could be modified in such a manner that when a Patent Examiner fails to fairly take into account the patentable merits of an applicant's claims in order to achieve a quick disposal, the erring Patent Examiner could then receive multiple disposal demerits for failing to thoroughly examine a patent application and fairly appraise an applicant as to the patentable merits of the invention. This review process could also include a flagging system requiring the flagged Patent Examiner to successfully complete a remedial course designed to correct those flagged examination faults. Should the problem still persist, the flagged Patent Examiner should be subject to the appropriate corrective reprisals.

If the database system can search the prior art for potentially relevant 35 USC §102 and §103 teachings, it should also certainly possess the capability of selectively isolating those patentability indicia based on well-established patent law principles which must ultimately require an astute mental judicial consideration in any complete thorough and high-quality examination of the patentable merits of any patent application. Neither the time spent on any given patent application nor the number of USPTO Patent Examiners can solve the current problems confronting the USPTO. Rather the substantive solution rests upon a more effective and judicial use of USPTO time to isolate and entertain those crucial patentability issues

including enhanced training for Patent Examiners and modifications to the Patent Examiner rating system that currently drives their behaviors. The time and effort which I, as a patent attorney must devote to ill-advised Office Actions wanting due consideration to the crucial patentability issues will correspondingly reflect on the repetitive and unneeded effort exerted by the USPTO to continue the patent prosecution upon matters which could and should have been concluded immediately following the responsive communication to the first Office Action upon the merits of the invention. It should be recognized that the USPTO's primary task is to grant high-quality patents for meritorious inventions and it is not to create an obstacle course inhibiting the expeditious prosecution and the granting of meritorious patents. The USPTO Examining Corps and the patent application practitioners should not be viewed as adversaries in the patent application examination procedure but rather should serve as cooperative partners in the promotion of our constitutional mandate.

Respectfully submitted,



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