From: Sergey Vernyuk
Sent: Friday, December 02, 2016 3:10 PM
To: External Examination Time Study <ExternalExaminationTimeStudy@USPTO.GOV>
Subject: Comments on Examination Time Goals

Dear Sir or Madam,

On October 25, 2016, the USPTO published in the Federal Register (81 Fed. Reg. 73383) a request for comments on examination time goals. My comments correspond to the numbered questions of the Federal Register request. While I am affiliated with Emerson Thomson Bennett, LLC, these comments represent my personal views.

#2 – When estimating the time needed to respond to an Office Action, I consider, *inter alia*:

- the amount of references cited in the Office Action,
- the complexity of those references,
- the length of those references (e.g., a 6-page patent v. a 25-page patent),
- the number of claims in the application,
- the similarity of the claims (e.g., there may be two dependent claims that add the same limitation to two independent claims),
- the complexity of the claimed subject matter.

I have prosecuted some quite-complicated electrical inventions and also some rather-simple mechanical inventions. The complexity of the subject matter does affect the time necessary to respond to an Office action rejection.

#4 – To increase the quality of examination, I strongly believe that more time must be spent in drafting the Office action. When reviewing Office actions, I routinely see grammar and spelling mistakes throughout, copy-pastes that don't make sense (because in the wrong place), cursory/nonspecific (and unhelpful) identification of prior art elements that allegedly correspond to claim limitations, and very general motivations to combine. This frequently makes the Office action unclear, requiring a phone call to the Examiner to properly understand exactly what he/she thought when rejecting the claims. Or, it requires responding to the Office action and pointing out the lack of clarity, only to have the Examiner (hopefully) provide more information in the next Office action (which is positive), which happens to also be Final (which definitely is not positive, requiring an RCE fee to continue prosecution); the Examiner really should have provided a clear explanation of the rejection in the initial Office action.

Whatever the USPTO's decision on giving Examiners more time, I would urge Examiners to use more of that allotted time to draft the actual Office action. Perhaps the USPTO's Examiner workflow system could somehow track how much time Examiners actually spend drafting the Office action (as opposed to searching prior art). Perhaps the USPTO could even mandate that a certain amount of time be spend drafting the Office action, which time could not be used for other activities (such as searching prior art). All of the searching is not useful to applicants if they cannot understand the results of the search because of a poorly drafted and unclear Office action. But clear Office actions (where the applicant readily understands the Examiner's position, even if disagreeing with it) will allow applicants to more readily determine whether to proceed, which will ultimately speed up prosecution and reduce the backlog of pending applications, many of which would perhaps be abandoned if applicants understood clearly the Examiner's position.

#5 – Reciting the statutes underlying the rejections is not necessary where practitioners filed the applications. We know where to look up the statutes (although I recognize it may be helpful for pro se applicants). As far as quality, unclear Office actions do not add value or quality to the examination – see my comment to #4 above.

#7 – Cost and pendency should definitely be considered when looking for an ideal examination time goal. Having enough time to ensure a perfect patent will not be very useful if such a patent is so cost-prohibitive that no one applies for one, or if it takes so long to issue that it's useless the day it's printed because the technology has become outdated.

Thank you for considering my comments.

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