

From: Chris Maiorana
Sent: Tuesday, April 26, 2016 11:49 AM
To: QualityMetrics2017
Subject: Comments from Maiorana PC

Sirs,

Here are 4 cases that we have concerns about. They all seem to be related to rushing the process.

1. An Examiner sends an action based on a docket due date and tells us that he “doesn’t have time” for an interview.

There seems to be no scenario when an Examiner should fail to have an interview by being “rushed” by the docket system. It is in nobody’s advantage to rush the process. In some cases, an Examiner calls late in the day, or after hours, so we return the call the next day. Then we hear an action has already been mailed.

2. Next action after we file an amendment that changes the scope of the claims.

The Examiner sends a second action, often a final, without any new references. The Examiner makes arguments that the claims still read on the references despite the claim amendment. While possible, it seems more likely the Examiner rushed the action. We have spoken to Examiners in this situation that say they “know” that there is more art out there, but they just “don’t have time” to find it. This is an unproductive scenario. We are either forced to appeal, or forced to file an additional amendment with an RCE. If we get past the references, the Examiners tend to then go out and find another reference. If they are telling us in an interview ahead of time that they know there are additional references, they should find them and put them on the record early in the file history.

3. Timing of Mailing Advisory Actions.

It seems that the Patent Office puts a strict due date on mailing an advisory action within 30 days of the filing of an after final amendment, but only when applicants file within 2 months of the mailing date of the final. If applicants miss the 2 month date, the advisory actions often take much longer to process. This is the exact opposite of the intention of the 2 month rule. The 2 month rule gives the applicants protection if the Examiner needs more time for the advisory.

Almost every amendment filed within the 2 month time frame by our office results in an advisory within the 1 month period. The times the Examiners take longer only seem to happen if we file after the 2 month date. This gives us essentially no benefit at all to the 2 month rule.

4. The Examiners add a third or even more reference to a previous 103 rejection.

Under this scenario, the Examiners often tend to say that the previous remarks are “moot” in view of the new ground of rejection. However, if the Examiner is moving from a 2 part 103 rejection to a 3 part 103 rejection, and applicant has already put arguments on record (e.g., how it is improper to combine the particular references, or the references do not teach all of the elements of the claims, etc.), the previous remarks are not moot, but should be directly addressed. This strategy by the Examiners drags out the process.

Chris Maiorana