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Dear Sir,

I appreciate the opportunity to comment on the long delay in applications being taken up after the filing of a RCE. The Office has identified the large number of RCE applications waiting further examination as a significant problem. However, I do not believe the problem is the large number of RCE's being filed, since there would not be a back log if the examiners quickly took up the application after the filing of an RCE. The more correct statement of the problem would be the long delay by some Examiners in taking up the applications after the filing of a RCE. Some Examiners will take up an application only a few weeks after the filing of an RCE, while other examiners are taking up to 2.5 years (and counting) after the filing of an RCE.

However, even the long delay in taking up an application after the filing of an RCE is not the real problem.

The real problem is the failure to receive a thorough, well-reasoned examination of all the presented claims with appropriate and well-supported rejections based on the Patent Laws that are clearly articulated by the examiner with correct page and line citations in the references, and methods outlined by the examiner that could be used to get the rejections withdrawn by the applicant. Unfortunately, a quality examination is very rare and thus the need to file a RCE.

When the applicant receives a low-quality examination of the claims it is very hard to know how to amend the claims (if needed) or how to argue for allowance because the rejections are not based on references that are close to the claimed product or method. Applicants are forced to waste the response to the Non-Final rejection just trying to get the examiner to focus on the actual claims. If the examiner continues to maintain the faulty rejections in a Final Rejection, the applicant is forced many times to file an RCE because the examiner will not enter any amendments to the claims after a Final Rejection. Thus, the need to file RCE's is actually based on the failure to receive a quality examination at the beginning.

When the applicant receives a high-quality examination (and they do exist in some groups) it is easy to amend the claims to get around the cited references and arguments can be focused on the differences between the claims and the references. The applicant can present a claim set that is allowable after the Non-Final rejection, and if further amendments are needed, the Final rejection points out these issues and the applicant can quickly make the appropriate changes. An allowance can usually be obtained after the Response to the Non-Final rejection and, in the rare cases when needed, can be obtained after the Final Rejection.

There is one other facet of a quality examination. The examiner is more interested in getting the application allowed, than getting "points" by forcing the filing of an RCE. The examiner will enter amendments after Final rejections and even enter amendments during the 6<sup>th</sup> month of the response period for a Final rejection. Good examiners want the applicant to get the claims that they are entitled to and not prolong the examination process by forcing an RCE.

I will give further details in the comments to the proposed questions and present possible solutions to these important problems.

**(1) If within your practice you file a higher or lower number of RCEs for certain clients or areas of technology as compared to others, what factor(s) can you identify for the difference in filings?**

I prosecute applications in two general groups – Chemistry and Biology – and the examination I receive for these applications is like black and white.

The Chemistry applications rarely receive a Restriction Requirement even though the claims are very long and include formulas with many different side groups. The Non-Final Office Action is short and concise with cited references on point. Maybe one 102 rejection and one 103 rejection, and the examiner explains what is needed to withdraw the rejections. Most applications are allowed after the response to the Non-Final rejection and the remaining are allowed after the response to the Final rejection. However, in the rare case of needing to file an RCE, the RCE is taken up quickly (< month) by the Examiner.

In contrast, the Biology applications routinely receive Restriction Requirements with the claims broken into multiple groups with multiple species in each group. There are times when there are more groups than there are claims because the examiner has required an election of individual features from a Markush group. The Non-Final Office Action will contain multiple 112 (1<sup>st</sup> and 2<sup>nd</sup>), 102 and 103 rejections based on references that are not even close to the claimed features. The references appear to have been found by using a “term” search without the examiner reading the references. The response to the Non-Final rejection is usually a process of showing how each reference does not disclose the claimed features or quoting the MPEP to show how the reference does not meet the requirements for a 102 prior art. The Final Rejection will just say the “arguments were not persuasive” (although the examiner never says why the arguments were wrong) and maintain the rejections. The response submitted at the two month deadline to the Final Rejection usually includes a 132 declaration from the inventor stating that the examiner has the science wrong and the claims have been amended to make them clearer to a novice in the science. The examiner quickly sends an Advisory Action refusing to include the amendments. Then, an RCE must be filed. Lately, these applications with an RCE have languished and remain un-examined after 2 years or more.

I do not believe that examiners with a Chemistry background are inherently better than examiners with a Biology background. However, I believe when the new examiners begin work, the other examiners in the group teach the new examiners the ethos of the group and how “things are done”. I believe the ethos of the Chemistry Group is to generate a good examination at the beginning and the ethos of the Biology Group is to drag out the examination to generate the maximum points.

I believe a major reason for the high percentage of RCE's in the Biology group is due to the restriction practice. It is counter-intuitive but the smaller scope of the examined claims in the Biology group forces the applicants to fight harder for their patents.

Just compare the differences between the Chemistry and Biology applications. The Chemistry applications do not receive restrictions, even though the claims may cover 100's or even 1,000's of individual compounds when the various side groups are taken into account. The examiner examines all the claimed compounds and finds the compounds that have been disclosed in prior art references. The applicant is told if those specific side groups are deleted, then the claims will

be allowed. The applicant may lose 10 or 20 compounds of the claimed 100's, but they will get the vast majority of the claimed compounds. The applicants are very happy to get their patent in a short time.

The Biology applications, although with formulas similar to the Chemistry applications, will receive a restriction reducing the examined compounds to just one or two compounds. The Office Actions cite references that are combined into a poorly supported rejection. The applicant knows his claimed compounds are novel over the cited references and fights for their allowance. Due to the restriction, it is an "all or none" situation for the application, so the applicant does not want to give up after spending so much time and money.

There is a saying in academia "the disputes are severe because there is so little to fight over".

If the applicant has only the choice between abandoning the application and fighting for an allowance, they will fight. However, if the applicant is able to lose a few claimed compounds in order to get the majority of the claimed compounds, they will happily lose the "few" to get the "many".

**(2) What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs?**

I have a suggestion for a "grand" change in procedures that would eliminate RCE's and enhance the examination process.

I feel there should be only one metric for judging an examiner's performance – number of applications allowed and number of application abandoned. I call this the "up or out" metric.

I know this has implications for "points" and other current measurements for an examiner's performance. However, the current system allows too much manipulation of the examination process to increase the number of points.

The goal of the Patent Office is to quickly identify those applications that have "allowable" claims, and at the same time quickly identify those applications that do not contain any allowable claims. This should be the goal of both the examiner and the patent practitioner. They should be working to get the broadest claims that are allowable by the disclosure of the specification, and if there are no allowable claims, quickly realizing this fact to abandon the application.

To obtain this goal requires a new mind set by the examiners and the patent practitioners.

The new examination process would eliminate restrictions and the idea of "non-final" and "final" rejections. All presented claims would be examined on their merits and there only would be successive rounds of examination with amendments and arguments after each Office Action. The examiner would have to enter the amendments presented by the applicants and examine the newly amended claims.

The examination process would continue until one of four outcomes:

1. The application is allowed
2. The application is abandoned
3. The examiner tells the applicant that he/she cannot see any allowable claims or presents the broadest claim for which they would give an allowance. At that point the applicant can either abandon the application or make one final amendment to the claims and Appeal.
4. The applicant tells the examiner that they have amended the claims as much as they are willing to do. At that point the examiner can either allow the application or make their rejection and send the application to Appeal.

The examiner would be limited to only having "open" a certain number of applications under examination. This would stop any examiner from "gaming" the process by quickly forcing appeals to increase the number of potential allowances/abandonments. If the examiner has too many outstanding appeals, then this is a sign that they are not actively trying to find allowable claims or giving concise rejections to convince applicants to abandon the inferior applications.

The Examiner would only get credit for applications allowed or abandoned (truly abandoned – not an RCE). Applications that are being appealed do not give the examiner any credit. This will give an incentive to the examiner to either guide the applicant to allowable claims or convince the applicant that nothing is allowable. Neither the examiner nor the applicant wants the delay associated with an Appeal, so both will be working towards ending the examination process.

This proposed examination process has the benefit of encouraging both parties to come to a quick resolution and, if one of them is being unreasonable (either not allowing "allowable" claims or dragging out the examination of applications without allowable claims); the other party can stop the examination process and force an Appeal or Abandonment. Additionally, neither party wants an Appeal because the examiner would not get any credit for the work already completed and the applicant would have a long delay and added costs.

This will force both parties to sit down and have a real discussion on finding allowable claims.

I believe this proposed procedure would greatly increase the speed of examination and reduce the back log.

**(3) What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE?**

The interview practice has no effect in the decision to file an RCE.

The interview practice, as currently conducted in some groups, has no useful purpose. The examiners are not prepared to discuss proposed amendments or knowledgeable on the "full" disclosure of the cited references. The typical answer will be "I will think about it" or "I have to talk to the supervisor". You can never get a definite answer from the examiner whether the proposed amendments will withdraw the rejection.

Including the Supervisor during the interview does not help either in resolving the issues. Instead of the Supervisor using his experience in understanding the requirements of 112, 102 and 103 rejections to resolve the issues between the applicant and examiner, they are more concerned in backing up the examiner, even though they know the examiner has made a faulty rejection. I have had Supervisors lie to me just to back up the examiner. I had a Supervisor state that the claimed product was "obvious" because a simple "GOOGLE" search found numerous returns, so the claims were properly rejected. However, when I conducted the "GOOGLE" search, all the returns were for the publication of the US application that was being examined.

I conduct an interview with an examiner in the Biology group only to have an opportunity to point out how "wrong" they are in their understanding of the science. I also use the interview process to gain information about the examiner so I can better argue for allowance.

At the beginning of my patent practice, I would wonder to myself how an examiner could make such basic errors in biology. They would make errors for which a Bio 1A student would know the proper answer. I thought that the examiners were just playing "dumb" and pretending not to understand the science to force me to make statements on the record to narrow the scope of my client's claims.

However, by chance, I came across the true reason for the examiner making basic mistakes in Biology. It turned out that they did not have a background in Biology.

During an interview, I was discussing the reasons why the cited prior art reference did not disclose the claimed method and the examiner said something that I could not understand. I asked him if his specialty was Biology and he said "no". Immediately, I understood why I was not making progress with my arguments for allowance, the examiner did not understand the science. I was able to change my arguments to a simpler level of biology to teach the examiner why the reference was wrong. Eventually, the examiner understood and I got the allowance.

I now routinely ask the examiner during the interview for their science background so I can formulate my arguments. Some examiners get very upset when asked this question but it helps progress the examination. If they do not understand the science, even though they may think so, it helps me explain at a more basic level rather than assuming the examiner has a Ph.D. in a biology specialty.

Unfortunately, I have yet to have an examiner in the Biology group who had a degree (even a B.S. degree) in Biology. I know there are some examiners with a biology background since I have read their office actions concerning stem cells, however, there must not be too many of them.

My suggestion is to have the background of each examiner listed somewhere on the USPTO web site. This information would be invaluable to an applicant when preparing a response. The arguments could be adjusted to match the background and level of education of the examiner.

**(4) If, on average, interviews with examiners lead you to file fewer RCEs, at what point during prosecution do interviews most regularly produce this effect?**

N/A

**(5) What actions could be taken by either the USPTO or applicants to reduce the need to file evidence (not including an IDS) after a final rejection?**

The need to file evidence could be reduced if the examiner would state on the record what he/she will accept to get the rejection withdrawn. Many times, I have to guess on what basis a 103 reference qualifies under 102. I had one examiner change their mind from 102(e) [after I disqualified it under 102(e)] to 102(a) [after I disqualified it as the applicant's own work] to 102(b) [after I disqualified it as being published less than 1 year from the priority date] to refusing to accept the evidence for the date of publication.

This would not occur if the examiner understood why a particular reference qualified as prior art and what could be shown to disqualify it as prior art.

**(6) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE?**

There are no factors that favor the filing of an RCE. I know once I file the RCE, the application will not see the light of day for several years.

**(7) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an amendment after final (37 CFR 1.116)?**

I always file a response after a Final Rejection. I file a response at the 2 month deadline to get an Advisory Action. I then file a Response with the RCE.

I never abandon an application due to an Office Action. I have yet to receive a rejection that truly shows that a prior art reference discloses the claimed composition or method. I will continue to fight for allowance until the client runs out of money or gets tired of the dealing with an incompetent examiner.

**(8) Was your after final practice impacted by the Office's change to the order of examination of RCEs in November 2009? If so, how?**

I believe the change in the number of points an examiner receives for handling an RCE and following RCE's was a great opportunity to prevent examiners from prolonging the examination to receive more points. However, this opportunity was lost when the order of examination of RCE's was changed. Human nature will always find a way to maximize their perceived "return".

The reduction in the value of examining a RCE was based on the understanding that a RCE would take less time since the examiner would already be familiar with the application and prior art. However, the examiner's memory of the disclosure of the application and prior art diminishing over time, so even a short time – a month – increasing the amount of work needed by the examiner to refresh their memory.

Now that the Examiner can delay taking up the application after a RCE, the examination of the RCE becomes the same as a New application, although it is worth less points. Therefore, there is no incentive for the examiner to take up a RCE.

I believe some examiners have decided to never examine an application after the filing of a RCE. Imagine this scenario, the examiner knows he/she only wants to work at the PTO for 2 to 3 years before going on to work for a law firm. The examiner also knows they can delay taking up an RCE for 2 to 3 years. Therefore, why take up a RCE rather than new application, since he will get more points working on a new application. If they quickly push the applicant to file a RCE (bad first examination and not entering amendments after final), they will get their maximum points.

The question that remains is what happens to the examiner's back-log of RCE's when they resign from the PTO? Do these applications suddenly become "new applications" when the new examiner begins examination?

My after final practice was not immediately impacted because some examiners were quickly taking up the applications after filing an RCE. It was only after realizing that some examiners were not taking up the applications that I have changed by procedures.

**(9) How does client preference drive your decision to file an RCE or other response after final?**

The decision by the client is only based on how "pissed" off they are with the examiner. I had one client who refused to file an RCE because he did not want the examiner to get any more points. He insisted on filing an Appeal.

I have had clients just give up and abandon the application because they figured the examiner was never going to allow the claims and it was impossible to get another examiner.

**(10) What strategy/strategies do you employ to avoid RCEs?**

My strategy is to "hope" for a good examiner. Nothing else works.

**(11) Do you have other reasons for filing an RCE that you would like to share?**

N/A

I hope my comments and suggestions will help the USPTO develop methods to avoid the filing of RCE's. As currently practiced, RCE's have failed to fulfill their stated purpose – to quickly receive another round of examination.

I wish I could sign this document, but sometimes honesty requires anonymity.

Sincerely  
Patent Practitioner