

From: Kenneth Fagin
Sent: Monday, March 11, 2013 2:45 PM
To: RCE outreach
Subject: Response to Invitation to Provide Comments on RCE Backlog
Importance: High

Dear Dr. Yucel,

Thank you for the opportunity to provide input on the growing problem of “unexamined” RCEs. My comments are attached.

The courtesy of an email acknowledging receipt would be very much appreciated.

With best regards,

Ken Fagin

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March 11, 2013

Via email only (rceoutreach@uspto.gov)

Dr. Irem Yucel
Director, Central Reexamination Unit
United States Patent and Trademark Office
401 Dulany Street
Alexandria, VA 22314

Dear Dr. Yucel:

Re: RCE Outreach

I am writing in response to the PTO's request for comments regarding RCE practice, including the eleven specific RCE Outreach Focus Questions the Office published. For balance, I will provide a few recommendations for things applicants can do to expedite prosecution. However, because I believe the primary causes for the growing RCE backlog lie with the PTO, I will comment first on the Office's apparent "attitude" toward applicants filing RCEs and improper and/or unfair examination practices I am convinced have caused or exacerbated the problem.

I have been in active, fulltime practice since 1992, with the large majority of my practice consisting of patent prosecution. Over the years, I have drafted hundreds of patent applications, and I have prosecuted well over a thousand applications in many different fields of technology. In the course of my practice, I have worked with many different examiners and I have experienced firsthand many of the problems I address below.

When conducted properly, patent examination is similar to Socratic discussion in that it identifies legitimate weaknesses in an application and ultimately leads to better claims, i.e., claims that are valid and of warranted scope and that adequately apprise the public of the subject matter covered by the eventual patent (within the reasonable limits of language used to describe often-complex concepts). Over the years, I have worked with examiners who understand this principle and who do, in fact, work diligently toward that goal, and I have often called their SPEs to compliment them (the examiners) when that has been the case. Unfortunately, however, such examiners seem to be the exception instead of the norm.

I. PTO-Related Factors

Regarding the RCE Outreach Questions, my immediate reaction was that the PTO doesn't "get it." As concatenated, questions 6 and 7 ask, "When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE? [W]hat factor(s) cause you to favor the filing of an amendment after final?" Question 9 asks, "How does client preference drive your decision to file an RCE or other response after final?" And question 11 asks, "Do you have other reasons for filing an RCE that you would like to share?" **In my view, those Outreach Questions reflect significant misunderstanding of why applicants file RCEs.**

Applicants file RCEs to obtain further consideration of their claims. Applicants do so when (further) amendments are believed necessary to respond to (i.e., distinguish over) late-raised prior art, or when declaration evidence (e.g., under Rule 1.132) becomes necessary to counter an examiner's position, and the application is properly after final. Applicants file RCEs when a rejection is not yet ripe for appeal – i.e., there is still "room to maneuver" in terms of working with the examiner – and because pursuing an appeal is even more costly and delay-causing than filing an RCE is (or at least it used to be).¹ And unfortunately, all too often, applicants are forced to file RCEs in order for count-focused examiners to actually consider the arguments presented after final and respond with something more meaningful than summarily checking box 11 on the Advisory Action form ("The request for reconsideration has been considered but does NOT place the application in condition for allowance because:") and repeating what the examiner baldly asserted previously. To put things very bluntly, there are many examiners who act as if once an application is after final, they do not have to think at all anymore in response to what an applicant presents for the examiner's consideration.

As far as I know, no applicant or practitioner actually favors the filing of an RCE, as the Outreach Questions suggest the Office seems to believe. Doing so has always added expense and at least some delay to prosecution. Now, however, with the revised manner in which RCEs are docketed and the exorbitant fees the Office is about to implement for filing second or subsequent RCEs, the significantly increased delay and substantial extra

¹ Having applicants file appeals in lieu of RCEs would only exacerbate the appeal backlog problem – like robbing Peter to pay Paul – and is therefore not a viable solution to the RCE backlog problem.

cost caused by having to file an RCE due to poor examination and/or procedural errors/games make(s) the Office's current practices, addressed below, no longer tolerable.

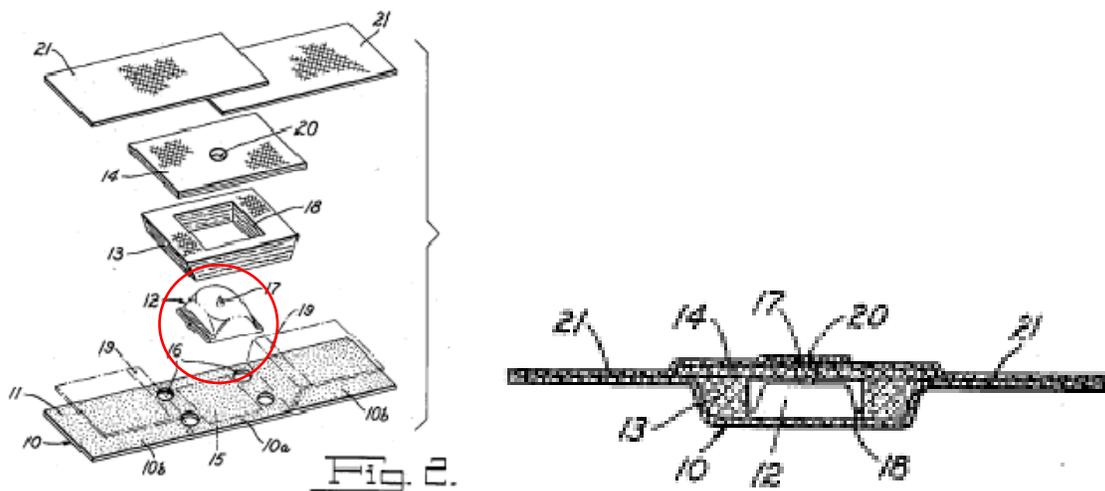
My reaction is also a result of statements the Office recently made in attempting to justify the significant RCE fee increases which are about to be imposed on applicants. In particular, the Office asserted that "[s]ince most applicants resolve their issues with the first RCE, the Office determined that applicants that file more than one RCE are using the patent system more extensively than those who file zero or only one RCE." See Fed. Reg. Vol. 78, No. 13, Page 4245 (January 18, 2013). To the extent that statement (apparently) accuses certain applicants of abusing the system, it incorrectly places blame on those applicants and is therefore unfair.

Based on my experience, there are two primary, PTO-related factors that have led to the current RCE situation: 1) uninformed or otherwise-specious claim interpretation; and 2) improper or otherwise knee-jerk-reaction finality of office actions, with complete closure of prosecution after final.

A. Claim Interpretation Issues

It is a fundamental principle that during prosecution, claims are to be given their broadest reasonable interpretation in light of the specification as it would be interpreted by one of skill in the art. While examiners frequently quote this principle, more often than not they do not follow it and simply ignore the terms "reasonable," "in light of the specification," and "by one of skill in the art." In other words, focusing solely on the word "broadest," they act as if the principle gives them carte blanche to force-fit the claim language onto anything and everything that conceivably could be said to show one or more claim terms when those terms are read in a vacuum, i.e., as divorced from the specification and without regard to the intellect or intelligence one of skill in the art would bring to bear in understanding what claim terms really mean. Sometimes that is the result of not having read the application (to which I have had examiners actually admit); more often, however, it seems to be the result of deliberate efforts to find a way to reject the claims. In this regard, the "reject, reject, reject" mentality still exists throughout the Office, and it appears to be driven by the PTO's count system.

For example, in one of my recent applications, the claim recited a medication-containing capsule located at an end portion of a bandage, and the examiner asserted that the prior-art bandage shown below has a medication-containing capsule (the capsule 12) located at an end portion of the bandage as recited in the claim.



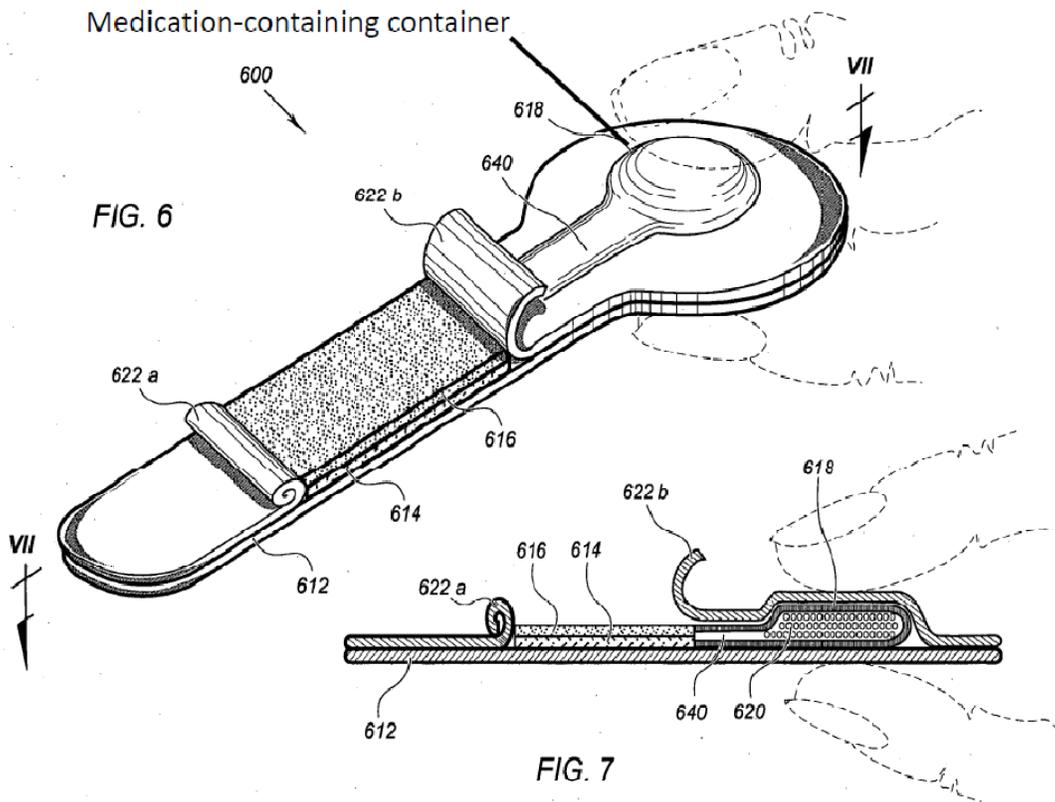
That's right; according to the examiner, a capsule located in the center of the bandage is actually located at an end portion of the bandage.

As the examiner explains this apparent paradox in the office action, "end portions are interpreted to be defined [by the examiner] as starting at each respective end of the main body [] and extending to a nonoverlapping position on [the] body[.]" Therefore, according to the office action, "an end portion can be interpreted to extend to [what is really a central] portion of the adhesive layer including the capsule[.]" In other words, as the examiner explained in a subsequent interview,² because an end portion can include anything at all right up to the bandage centerline (i.e., so long as it is "nonoverlapping" with respect to other "end" portions), and because the capsule 12 in the reference extends

² The interview was necessary because even with a Mensa-level IQ (at least when I was 14 it was tested to be at that level); an engineering degree from M.I.T.; a J.D.; and twenty years of patent experience, I could not figure out from the office action how the examiner could be making such a facially illogical statement.

past the bandage centerline and toward the ends of the bandage, the capsule 12 is actually located at an end portion of the bandage!

Notably, however, there was nothing at all in the specification to suggest that the term “end portion” meant anything other than something remote from the central portion of the bandage, i.e., a distal portion of the bandage as shown in the single relevant embodiment, reproduced below:



Thus, the Examiner actually was giving the term “end portion” a meaning contrary to what was reasonably suggested by the specification and that clearly was contrived to force-fit the term onto the reference. In my view – and more importantly in the applicant’s view (to my chagrin) – such rejection-driven claim interpretation is unforeseeable nonsense, and it is not at all reasonable in light of the specification.

Unfortunately, this is hardly the worst instance of rejection-driven claim interpretation I have encountered. For example, the examiner’s position in 12/054,690 (appeal pending),

set forth in the October 12, 2012 Advisory Action, is hopelessly contorted. In fact, when I called the SPE more than a month after filing the last after-final Response to ask when we would hear back from the Office, the SPE told me, before that after-final Response had even been considered, that he would tell the examiner to send an Advisory Action. In other words, the SPE's "marching orders" to the examiner were going to be to reject the claims regardless of the merits of the after-final Response, and it was up to the examiner to come up with a way to do so. The examiner's contrived, rejection-driven claim interpretation (not reproduced here due to its length), which bears no relation at all to the embodiments disclosed in the specification, speaks for itself.³

Given this sort of situation, I will try in the remarks section of a Response to elucidate what a claim term means, or I will try to obviate facially unreasonable interpretations like those described above, by explanatory reference to what is disclosed in the specification. Unfortunately, however, examiners typically respond that I am improperly reading limitations into the claims from the specification or that I am arguing limitations that are not in the claims, and examiners quoting those principles usually misunderstand and misapply them. Therefore, in order to obviate misinterpretations caused by an examiner's failure to comprehend the claimed invention, or in order to counter examiners' contrived, rejection-driven claim interpretations that are not perceptibly related to any reasonable interpretation of the claim language, it becomes necessary to amend the claims to recite explicitly that which already should have understood to be implicit in the claims.

Unfortunately, however, examiners refuse to admit after such clarifying amendments that they were wrong in the first instance, i.e., that they originally misunderstood the claimed invention and/or that their original claim interpretations were otherwise flawed. Rather, examiners invariably seem to respond with another office action, applying new art that should have been applied in the first instance and making the second office action final – i.e., blaming the applicant for the examiner's own failure to understand the invention well

³ Another untenable claim interpretation with which I had to deal was when an examiner asserted that the term "chemical polishing" (of a metal plate) would be confused with rubbing one's hand across a sheet of paper because there are chemicals in the oils in one's skin and rubbing one's hand across a sheet of paper removes fibers from (i.e., polishes) the surface of the sheet of paper. It is inexcusable that applicants spending large sums of money on patent applications have to contend with such nonsensical assertions from examiners who seem determined to reject the claims before them.

enough to focus the search – on the basis that it was the applicant’s amendment that necessitated the new grounds of rejection, even when the amendment was clarifying or elucidating in nature only. Then, unfortunately, if one needs to introduce additional concepts – i.e., concepts not reflected by or implicit in the original claims – in order to differentiate over the newly applied prior art, **the only way to do so is to file an RCE.**

In my view, that situation is unfair because it was the examiner’s uninformed or, worse, contrived interpretation that necessitated the first amendment, not the prior art. As a result, an applicant essentially wastes his or her single opportunity to amend the claims without significant limitation 1) in order to help the examiner understand that which should have been understood previously or 2) to get the examiner to drop a far-fetched position, **and that is before meaningful examination based on truly germane prior art can begin.**

Thus, as one solution to the RCE backlog problem, I submit that **the Office needs to take steps to ensure that examiners fully comprehend the inventive subject matter they are considering.** Toward that end, examiners should be required to actually read the application **fully** before they conduct their searches and consider the claims; that way, they will understand, *a priori*, the claims they will be evaluating.

I acknowledge that many examiners do, in fact, read the application carefully (as evidenced, for example, by an examiner calling spelling or figure-labeling errors to my attention). Unfortunately, however, it is also frequently clear from an office action that the examiner did not understand the claimed invention; skipped over key claim language; or blithely matched words in the claims to words or features shown in a reference regardless of whether the match-up even made sense. In this regard, there have been many times when I read claims before reading the specification and did not have a clue as to what the claims meant, only to see with perfect clarity what they meant after I read the specification. Similarly, if all examiners would do the same for applicants, then the need for wasteful amendments 1) to clarify for the examiner what meaningful review of the specification already should have made clear, or 2) to disabuse an examiner of a contrived, unreasonably broad interpretation position, would be significantly reduced.

Toward this goal, I suggest that an examiner should be required to summarize, in his or her own words, his or her understanding of the disclosed subject matter before issuing any first action on the merits, to demonstrate that the examiner understands the disclosed and claimed subject matter. (Any subsequent examiner to handle a given application

would be required to do the same.) Furthermore, I strongly urge the Office to require an examiner to explicitly state any interpretation that, it is foreseeable, would be “surprising” to the applicant (e.g., counterintuitive as in the bandage example above) before he or she proceeds further with examination.

An applicant then would have a brief opportunity – e.g., one month – to challenge/correct the examiner’s understanding of the invention and/or the examiner’s claim interpretation. If the examiner then relies on some non-apparent claim interpretation in rejecting claims and that interpretation was not explained beforehand, an applicant would not be penalized (e.g., by making a subsequent action final) for clarifying through claim amendments what one of skill in the art – not an examiner deliberately trying to reject claims – would have understood the claims to mean in light of the specification. Otherwise, if a rejection relies on the examiner’s previously explained understanding of the disclosed subject matter and/or claim interpretation but the applicant did not correct or contest it, the applicant would be “charged” with making amendments necessitating any new grounds of rejection (art-based as well as formalities-based) that might be lodged against the revised claim language.

In addition to reducing the number of initial rejections that are “misguided” (for whatever reason), this approach would have the salutary effect of improving overall patent quality. In proposing this solution, I am mindful of the fact that examiners have a limited amount of total time allocated to examine each application, and it may take significantly more time to review, summarize, and provide explicit claim interpretation “up front” in connection with some applications than it may take in connection with other applications. To address that concern, the amount of time allowed for an examiner to so preliminarily process an application could be based on the size of the application (i.e., pages of written description) and/or the number of claims, with more time being allocated for independent claims than for dependent claims. Other procedural solutions are possible, and I would leave it within the purview of the Office to develop such further procedural approaches.

B. Finality Issues

The second area where I see the Office as being primarily at fault for the RCE backlog problem is in the issuance of improperly final or knee-jerk-final final rejections, with consequent closure of prosecution after final.

1. One way this situation arises is addressed above: to help an examiner understand the claims or to obviate an examiner's unreasonable claim interpretation, an applicant makes a clarifying amendment that does not change the scope of the claim at all, but that merely explicitly (and redundantly) recites that which already should have been understood in light of the specification and/or that is already implicit in the claims; the examiner then applies new art, which should have been applied in the first instance, and makes the rejection final on the asserted basis that the amendment necessitated the new ground of rejection. In my view, making the subsequent rejection final in that situation unfairly closes prosecution and restricts an applicant's ability to shape the claims to avoid prior art because it was the examiner's misunderstanding and/or unreasonable claim interpretation in the first place that necessitated the clarifying amendment. This scenario exacerbates the RCE backlog situation because it unnecessarily and unfairly forces an applicant to file an RCE if the applicant wishes to introduce any further substantive claim amendments in pursuit of meaningful examination. Implementing procedures like those I have suggested above should help eliminate this frustrating situation.

2. What has become a far more significant problem within the last few years, however, is what I refer to as "mulligan final" final office actions. Erroneously instructed to do so by their SPEs and group directors, many examiners are now issuing mulligan final office actions in total disregard for what the M.P.E.P. (and other sources, e.g., the Office's recent statements in the Federal Register) makes clear is improper. **It is procedurally incorrect, and it is something to which the Office must put an end if the Office truly wishes to reduce the RCE backlog.**

More specifically, I am referring to the situation where an applicant amends the claims in response to a legitimate, well founded rejection, and the examiner raises a new ground of rejection and properly makes the next office action final. The applicant then traverses the new ground of rejection by argument alone, i.e., without amending the claims, and the examiner withdraws the new ground of rejection in favor of yet another new ground of rejection (typically based on new art, but sometimes relying on the previous art applied in a different manner). However, the examiner makes that subsequent, "replacement" rejection final on the basis that if he or she had "gotten it right" and rejected the amended claims using the "replacement" ground of rejection in the previous, properly final action, there would have been no basis for applicant to object to the finality. See, for example,

page 8 of the February 6, 2013 office action in application number 12/527,983
(bold/italics added; bold/all-caps in original):

Applicant's amendments, filed after the office action dated 19 March 2012, necessitated the new ground(s) of rejection *in the office action dated 26 October, 2012*. Applicant's amendments substantiated the formulation of a new ground(s) of rejection *in the previous office action*, accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

But that is contrary to the clear import of M.P.E.P. § 706.07(a).

According to M.P.E.P. § 706.07(a) (emphases added),

Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims**, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a **second or any subsequent action on the merits** in any application or patent undergoing reexamination proceedings **will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art**. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

While I understand the logic behind the examiners' tactic in issuing such mulligan final actions, the tactic is contrary to the clear language of the M.P.E.P.⁴ The language does

⁴ I recently spoke by phone with the examiner responsible for application number 12/527,983 to contest the finality of the rejection. According to the examiner, both of her SPEs have told her to do it this way, and she therefore stands by the finality of the rejection. As noted above, this

not refer to an examiner being able to base finality of a new ground of rejection on amendments that necessitated a **previous**, properly final ground of rejection, which previous ground of rejection has been shown to be incorrect; the language refers to a **new** ground of rejection not necessitated by an applicant's amendment . . . period.

In this regard, it is illuminating that that provision further instructs (emphasis added) that a successive action "will not be made final if it includes a rejection, on newly cited art . . . of any claim not amended by applicant or patent owner **in spite of the fact that other claims may have been amended to require newly cited art.**" In other words, even if the applicant does something that ordinarily would prejudice the applicant (by bringing about finality and thus closing prosecution), if the examiner also introduces a new ground of rejection not necessitated by what the applicant has done, the Office will have to "take it on the chin" and permit further prosecution of all claims, even where the applicant's actions otherwise would have precluded such further prosecution. Thus, the intent of the provision to be fair to an applicant is clear, and the count-driven nature of examiners' blatant disregard for this provision is equally clear.

Furthermore, it is troubling that the Office has been aware of this practice for some time now, and yet it continues unabated. For example, an internal email from TC 2600 Directors dated November 17, 2008 was posted on an Internet forum at some time prior to November 2010 and made clear that the practice is improper:

procedure is being practiced on an art unit-wide basis (if not on a technology center-wide basis), and it is disturbing to see SPEs – people who are supposed to understand and properly apply the PTO rules – instructing their reports with such disregard for what the M.P.E.P. mandates.

Furthermore, there is an illuminating current "thread" on LinkedIn that notes the problem in this area. See, in particular, David Boundy's troubling comment (emphasis add) at http://www.linkedin.com/groupAnswers?viewQuestionAndAnswers=&discussionID=216514186&gid=64574&commentID=121956215&goback=%2Eamf_64574_482230&trk=NUS_DISC_Q-subject#commentID_121956215 ("Honesty, integrity, and getting the job done within the rules remains the norm in some parts of the PTO, but was managed out of others. I had a phone call with one T.C. [Director] only two months ago, **he squarely told me that written MPEP "The examiner must" rules would not be enforced under him.**"). I have discussed the subject telephone conversation with Mr. Boundy, and at his request I will not identify the subject T.C. Director in these remarks; however, I would be happy to relay to appropriate Office officials what Mr. Boundy expressed to me in separate, "offline" correspondence.

Second Consecutive Final Rejection, Premature?

Page 1 of 2

From: TC 2600 Directors
Sent: Monday, November 17, 2008 8:02 AM
Cc: Campbell, Dianne; Christensen, Andrew; Groody, James; Hunter, Daniel; Knode, Marian; Powell, Mark; Walker, Wanda
Subject: Instruction Regarding Making an Office Action FINAL

Recently a question has come up about whether a consecutive FINAL Office action with a new ground of rejection can be made after the finality of a previous Office action has been withdrawn. The answer to that question is set forth as follows.

When the second Final OA stated that the finality of the last OA (the first Final OA) is withdrawn, the first Final OA is back to a non-final status, and the AF amendment (hereinafter "entered amendment") filed is entered into the case. See MPEP 706.07(e).

At this point, we need to take a close look at the entered amendment to determine whether a consecutive Final OA would be proper. Same requirement is applied here, i.e. Final is proper when it is 1) necessitated by amendment, 2) necessitated by IDS with Fee, or 3) necessitated by invoking the Joint Research Agreement Prior Art Exclusion under 35 USC 103(c), see MPEP 706.07(a).

In the case where the entered amendment simply provided arguments without amending any claim, none of 3 reasons to make proper Final discussed above is applicable. Thus, a second Final OA would be improper with a new ground of rejection.

For example

- (1) The examiner made a first action non-final under 102.
- (2) Applicant filed a reply amending the claims.
- (3) The examiner made a second action final. The claims were rejected under 103 using new prior art. The examiner stated that applicant's amendment necessitated the new ground of rejection and therefore, the second action was made final.
- (4) Applicant filed a reply. The reply only included arguments and the claims were NOT amended.

Second Consecutive Final Rejection, Premature?

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(5) The examiner made a third action final. The examiner stated in the third office action that the "finality of the last office action has been withdrawn in view of the new ground of rejection." The claims were rejected under 103 based on different prior art. The examiner stated that applicant's amendment necessitated the new ground of rejection and therefore, the third action was made final.

THIS IS NOT CORRECT.

When the finality of an office action is withdrawn, all the rejections/objections/requirements set forth in that office action are still there. All this means is that that particular office action is now a non-final office action and therefore, any reply submitted by the applicant in response to that office action is treated under 37 CFR 1.111 rather than 1.116.

Once the examiner withdraws the finality of the second action, the reply filed by applicant (item 4) is treated under 37 CFR 1.111 rather than 37 CFR 1.116. To determine whether the next office action can be made final or not, the examiner must look at the reply filed in item 4 and not the reply filed in item 2. Since the reply filed in item 4 did not include any amendments to the claims, the third action (item 5) with the new ground of rejection CANNOT be made final. The examiner's statement in the third office action that applicant's amendment necessitated the new ground of rejection is WRONG since the reply filed in item 4 only included arguments.

(The forum currently appears to be being "re-tooled" and the link, which is identified on the copy I made of the posted email, does not connect one to the subject posting.)

Further still, when I first started to encounter this practice on a regular basis a few years ago, I called OPLA seeking to have them "weigh in" on an application where the examiner had issued such a mulligan final action. The person with whom I spoke acknowledged that mulligan final actions are not proper, and she disclosed that the issue of whether they are proper had been "floating around the Office" for some time by then. As she further revealed, however, for some undisclosed reason, the Office would not formally rule on the matter and provide official guidance to the examining corps.

In my view as one who represents applicants paying substantial sums of money to the Office, it is untenable that the Office would fail to address a recognized problem and act

to curb an examination practice that, by the admission of at least that one person in OPLA, is contrary to the PTO's established rules. That the Office now seeks to clean up the RCE-backlog mess – which is largely of the Office's own creation – by apparently trying to dissuade applicants from continuing to pursue rights to which they are entitled (though imposition of higher fees) makes the Office's failure to act previously that much more galling. **When the Office puts an end to this practice, it will go a long way toward reducing the RCE backlog.**

3. Another examiner tactic that prematurely advances an application toward a final rejection is two-step examination. In this scenario, the examiner rejects only for formalities or nonsubstantive errors (e.g., lack of antecedent basis, spelling errors, etc.) in a first action. Then, after the applicant has amended the claims to address those issues, the examiner follows with art-based rejections in a second action and makes it final on the alleged basis that it was the amendments that necessitated the new ground(s) of rejection.⁵

That practice violates numerous principles that are supposed to guide examination.

See, for example, **37 C.F.R. §§ 1.104(a),(b)** (emphases added): “The examination [conducted “on taking up an application for examination”] **shall be complete** with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated[;]” “The examiner's action **will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made[;]” **M.P.E.P. § 706.07(a)** (emphasis added): “Before final rejection is in order a clear issue should be developed between the examiner and applicant[;]” and **M.P.E.P. § 2106** (emphases added): “Under the principles of compact prosecution, each claim should be **reviewed**

⁵ In one extreme example of this practice with which I had to deal, the examiner asserted that 1) changing “the” to “a” in the first instance of a claim term (to supply proper antecedent basis for subsequent instances of the claim term), and 2) changing “affect” to “effect” when the intended word (as well as the mistake, which is common) was obvious in light of the specification (see above), necessitated the new grounds of rejection because he could not properly understand the claimed subject matter beforehand. Such positions are absurd, and applicants suffer – both financially and in terms of timeliness of patents being issued – as a result of them.

for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to the patent-eligibility requirement of 35 U.S.C. 101. **Thus, Office personnel should state all non-cumulative reasons and bases for rejecting claims in the first Office action.**”

It is extremely frustrating and disconcerting that examiners who play such games seem to have no understanding of the real-world consequences of their actions, and too many supervisory staff seem unconcerned with either the letter of the rules or the practical consequences of examiners violating those rules. Prosecution is expensive in terms of both PTO fees and practitioner fees, and the ability *vel non* to secure meaningful patent protection in a timely manner can have significant financial/business-related consequences. More to the point of the Office’s present Outreach, such games needlessly necessitate RCEs by prematurely closing prosecution, thereby exacerbating the RCE backlog. Accordingly, **the Office needs to impress upon the examining corps that such count-driven games are unacceptable.**

4. Finally on this point, the related problem of complete closure of prosecution after final further exacerbates the situation. Although some examiners have, in fact, “taken to heart” the intent of the After Final Consideration Pilot and “gone the extra mile” to help put an application in condition for allowance even after a final rejection,⁶ too many other examiners – particularly those prone to issuing mulligan final actions as addressed above – still refuse to give an applicant even the slightest bit of further consideration (including simple telephone interviews) after final, which forces an applicant to file an RCE to make even the slightest changes to the application. **If the PTO would take steps to eliminate such a close-minded after-final attitude among examiners, it would help reduce significantly the need for, and hence the backlog of, RCEs.**

⁶ See, for example, the closing prosecution in application number 12/608,464. My “hat is off” to Examiner McAvoy.

II. Applicant-related Factors

To be fair, I acknowledge that there are things an applicant should do which would reduce the need to file an RCE for further, more-meaningful examination. Besides reducing prosecution costs, these practices should lead to stronger, higher-quality, and therefore more valuable patents.

A. First, applicants should work to ensure their claims are in good shape before an examiner considers them. In reviewing hundreds of file histories reflecting other practitioners' work, I have seen claims ranging from beautifully written to downright ugly. From poor punctuation (e.g., incorrect use of commas and failure to hyphenate when clearly needed) to lack of paragraphing or other means to better organize claim elements and express the inventive concept, some claims are in very bad condition when the examiner first reviews them. By devoting more time (and thus cost) up front to making sure the claims are as intelligible as possible and that they actually describe what the application is about, an applicant can – examiner games as described above aside – significantly improve the quality of the initial examination he or she receives and thus reduce the need for RCEs. After all, as is often said in the computer science field, “Garbage In, Garbage Out.”

B. Second, applicants (*viz.*, the practitioners who represent them) should stop being so afraid to actually advocate on the record. Handled skillfully, patent prosecution requires just as much advocacy as patent litigation. If an examiner refers to a specific component or passage in a reference as constituting/disclosing a claim-recited element, simply asserting that the component/passage in the reference does not constitute/disclose the claim-recited element will rarely cause the examiner to withdraw a rejection. Rather, it is far more effective to explain by way of example shown in the specification what the claim term is referring to; what the component in the reference actually is or does, or what the referenced passage really teaches; or both. In other words, applicants need to do more than just assert a conclusion; they need to explain (i.e., advocate) their position so that an examiner can understand **why** the reference disclosure and the claim element are not, in fact, the same thing. In order to do that, however, it is necessary to make statements on the record that will be used later on to construe the claim elements. But if an applicant is unwilling to put on the record anything reflecting any sort of position, prosecution is unlikely to advance at all, and the application is unlikely to be allowed no

matter how many RCEs are filed. As the well known expression puts it, insanity is doing the same thing over and over and expecting different results.

C. Finally, the most honest statement I can make is that sometimes the examiner “gets it right” and the claimed invention really is anticipated by or would have been obvious from the applied reference or references. In those cases, continuing to assert that the sky is orange (metaphorically speaking), and filing one RCE after another in order to keep asserting that, does, in fact, needlessly contribute to the RCE backlog. Instead, a practitioner does the applicant a greater service by telling the applicant the examiner is right and persuading the applicant to abandon the application when that is merited, and in so doing the practitioner avoids contributing to the RCE backlog him- or herself.

Conclusion

Thank you in advance for considering these comments. Should you wish to discuss any of them with me, please feel free to contact me at your convenience. I would be happy to speak with you by phone, or I would be happy to meet with you at the Office (I am local). Otherwise, I look forward to participating in the Alexandria RCE Round Table once it has been rescheduled.

Respectfully submitted,



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