

**From:** Michael Brown  
**Sent:** Tuesday, March 10, 2015 11:40 AM  
**To:** WorldClassPatentQuality  
**Subject:** Comments on your Proposal 1

I strongly support your Proposal 1, to provide a route for an applicant to request review of an office action. I have the following specific comments, based on your brainstorming questions:

What types of issues would prompt you to use such a program and what attributes would the program need in order to make it useful?

- Office actions which are essentially cut-and-paste boilerplate, copying pages of generic rejections and “for example” lists, without actually identifying the particular problems the examiner sees in the particular claims under review. This has become especially troublesome lately with section 101 rejections, where the examiner simply says that the claim recites unpatentable subject matter because it “claims an abstract idea and/or a naturally occurring substance or correlation and/or a law of nature”, without ever saying which of the judicial exceptions the claims might cover (I just reviewed such a rejection, exactly as quoted).
- Office actions which reject claims based on generic conditions without identifying the specific problem the examiner is addressing. For example, the rejection says that the claim recites an “abstract idea” but never says what the “abstract idea” is. Then it says that in order to be patentable the claim must include “substantially more” - how can one point out that the claim adds “substantially more” without knowing what it has to “significantly more” than?
- Office actions which reject claims over examples, without reference to the actual words of the claims themselves. I have had a number of examiners who rejected method claims with the explanation, “methods of doing (x) are not patentable because they claim things like (y)” - when the claim wasn’t a method of doing (x), or it never claimed (y).
- Office actions which require the applicant to guess what the examiner is thinking. This applies primarily to 112 rejections - some examiners like to issue office actions which point out one problem, then say “there are lots more like this, the applicant must find all of them and fix them, or the response will be rejected as nonresponsive”. If the examiner thinks some problem is sufficiently important to mention, the examiner should do the work to point out where it is.
- Restriction requirements or elections of species which list far more inventions or species than can be justified by the application. For example, I once had a restriction requirement which identified more “inventions” (one per figure of drawing) than there were claims (of which there were relatively few, and only one independent). In another case, I had an examiner identify a side view and a front view of the same object as separate “species”.
- Office actions which are simply inexplicable. I have, from time to time, received office actions having rejections which were so garbled as to be unreadable. I would probably try first to call the examiner and ask for an explanation, but my experience is that the sort of examiner who issues such rejections is reluctant to grant telephone interviews.
- Office actions which just make nit-picking technical objections without real significance to the question of patentability - a number of rejections a few years ago, where office actions were issued solely to object to the form of s-signatures comes to mind. If the

examiner has a problem with a caption or a signature or other similar procedural issues without substance, there's no reason why they can't be included in a reasonable response on the merits.

- Consistency of processing problems - office actions where similar and related cases are being allowed by other examiners in the same art group, but one examiner consistently refuses to allow claims without clearly explaining the problems.

Are there any reservations/concerns that might limit your use of the program?

- Whatever method of review is adopted needs to result in a meaningful review, rather than a routine rubber stamping of all office actions. If the program does not lead to a reconsideration of some reasonable percentage of final office actions without the need to file useless RCE's, then the perception would quickly become that the program is just one more useless hoop to jump through without corresponding benefit for the client.
- The program needs to provide some indication that even if the request did not result in a reversal of the rejection, at least a reasonable review was done. If all we ever get back is a form with a box checked saying "your request is rejected", we probably wouldn't use the program for long.
- Too many USPTO programs sound good and are well-intentioned, but when you try to use them the examiner ignores the program in order to push for an RCE. For example, our experience with the the AFCP 2.0 pilot is that more than half the time the examiner rejects the request out of hand and refuses to give an interview on the grounds that it would require more work than the pilot program allows. That has led us to use AFCP 2.0 less than we might otherwise do.

What parameters, if any, should be imposed on requests (e.g. who should be able to submit an application into the program- practitioner with standing in the case only, third party. etc., limit number of applications per requestor within a given timeframe, limit timeframes for submission relative to date of action containing issue for which review is sought, types of issues submitted for review, must have had interview with examiner and reached impasse, etc.)?

- I'd limit participation to practitioners with standing in the case.
- I probably would also limit participation by *pro se* filers - I'd hope the program would be used for review of the most egregious of problem office actions, not for explaining office actions to those who don't understand how they are supposed to work.
- I would not want to see a limitation on the number of requests per practitioner per time, absent a showing that someone was trying to subvert the system. It's not unusual for one client's applications to all be assigned to the same examiner, and for a number of similar rejections to be received in a short period of time. If that examiner is not doing a good job, the client's counsel should be able to get review of all problem office actions, whether or not they exceed an arbitrary number within an arbitrary period of time.
- There should be a relatively short deadline for filing a request for review - certainly before the three-month reply deadline. If the office action is truly problematic enough to justify a request for review, one should be able to tell that relatively quickly.

- I have no objection to requiring a contact with the examiner to attempt to resolve the problem before filing a request for review, but not requiring “an interview which reaches impasse”. I have had too many cases where the examiner simply refuses to see that there is a problem, or won’t grant a telephone interview at all, to want to see review conditioned on some definition of “impasse”. Also, if there are a number of related cases with the same examiner which have the same issue, it should be possible to submit them all without having to have an interview on each of them separately.

What level of detail should be provided to OPQA in describing the issue for which review is sought?

- It would be only fair to expect that someone requesting review of an office action should be as clear and specific in describing what the problem is, as the office action itself needs to be to describe the problem the examiner has with the application.
- Each problem should be specifically pointed out, and listed separately.
- Any attempt to resolve the issue before filing the request should be described as well.

What type of result/outcome would practitioners expect if they were to use this program (e.g. what type of acknowledgement/feedback, if any, should be provided to the requestor concerning selection of submitted application for review, review findings, etc. and how would any feedback be used?

- If the application is selected for review, the requestor should be informed that it was selected, and any pending deadline should be stayed (or, if it is not, that should be clearly explained to the requestor).
- If the application is not selected for review, the requestor should be told that, too - preferably with some indication of why.
- In any case, the selection/non-selection feedback should happen sufficiently before any pending deadline that the applicant has time to act (or the filing of the request should stay the deadline).
- The outcome should be, effectively, an office action on the office action or on the request to review the office action.
- That is, if one requests review of an office action because of an inability to understand a specific rejection, the result should be either (a) the review upholds the examiner *by explaining what the words mean*; or (b) the review upholds the requestor by requiring the examiner to re-issue the office action (with a new deadline) with a better explanation of the rejection.
- Similarly, if the review request is because the examiner issued a generic boilerplate rejection without tying it to the claims, the result should be either (a) pointing out where in the office action the examiner had, in fact, identified the elements in the claims which constituted the points in the boilerplate; or (b) requiring the examiner to do the work to provide a reasoned application of the rules to the specific claims.

Sincerely,  
Mike Brown

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