

From: Michael Brown
Sent: Tuesday, March 10, 2015 12:53 PM
To: WorldClassPatentQuality
Subject: Comments on your Proposal 5

I would like to offer the following comments, based on your brainstorming questions for Proposal 5:

How effective is the current compact prosecution model (achieving final disposition in the fewest number of Office actions) in resolving patentability issues in a quality manner and with efficiency?

Not very effective. All too often, the first office action is not as effective as it could be, and the first response largely serves to resolve examiner's issues with the claims rather than to actually change the situation. The second office action is invariably final and requires an RCE, even if the claims are narrowed and avoid the prior art cited.

Would the ability to receive an additional Office action for a fee before a final Office action is issued be beneficial? How would it allow for more fine-tuning of claims? Would the ability to also interview after the additional non-final Office action be beneficial?

The ability to receive an additional office action before final would be beneficial, but I don't think it should be at a fee. The first office action usually results in clarification or narrowing of claims, as the applicant is made aware of the prior art the examiner has found and refines the claims to address any problems or misunderstandings. While the examiner is supposed to do a comprehensive search before the first office action, more often than not the response to the first office action results in citation of new references in the second office action. In the majority of cases in my experience, responding to this office action results in an allowance - but the rejection is usually final, so the client has to pay an RCE fee. The applicant should be allowed to respond to these new references before the final rejection.

Would the ability to also interview after the additional non-final Office action be beneficial?

Yes. Interviews are often beneficial, and I think limiting interviews in any way is not a good policy.

Would applicants be able to identify the applications that would benefit from an additional Office action before close of prosecution when they respond to the first Office action on the merits?

No. When I reply to the first office action, I do so in a way I believe responds to all of the examiner's issues and the cited art, and I hope for an allowance. I have no way of knowing if the examiner is going to raise additional new references in the next office action.

Some have suggested that the practice of issuing final Office actions be abolished to allow for more give and take between the applicant and examiner.

That might go too far. I do not object to the concept of final office actions. What I do think needs to be fixed is the practice of calling office actions “final” when they raise new issues for the applicant to respond to. I think it is inherently unfair to tell the applicant that he has had his last bite at the apple (but for paying an RCE fee) because the examiner has found something new that the applicant has never seen before.

My proposal would be to base the finality of an office action on whether or not the examiner found any new references relative to the last office action. As long as the examiner raises new art, the applicant should be able to amend the existing claims to address that art.

Abolition of final office actions would not be required if actions are only considered final when they are really final - that is, when all of the issues the examiner will bring up have been brought up, and the applicant has had the opportunity to amend the existing claims in response to those issues. Once the examiner has done all the searching he plans to do, and I have had a chance to respond to anything he found, then if he does not agree that the claims are allowable (preferably, after an interview to make sure we’re understanding each other), I am comfortable with having to appeal at that point.

Would fees per reply be sufficient to incentivize applicants to close prosecution to avoid endless prosecution scenarios? What are other incentives, beyond fees, that would encourage applicants to close prosecution quickly in the absence of final Office actions?

I object to the basic premise of the question - that it is the applicants who are responsible for the “endless prosecution” and they need to be incentivised to conclude prosecution without final rejections. It is more common in my experience that the examiners keep finding new art, to which I respond, and they find more new art in response to my response, to which I respond, and so on. At least as far as my clients are concerned, they’d much rather get things over as quickly as possible, and they hate “endless prosecution”. It’s not within my client’s control if the examiner finds something new and declares the rejection final before my client has had an opportunity to respond to it, and no incentives for the applicant can control that.

If “compact prosecution” is taken seriously, all of the art relevant to the application would be cited in the first office action, and then the applicant and the examiner can focus on claiming something which isn’t shown in the art instead of having to constantly chase a moving target.

Would more interactions between the Office and applicant make prosecution more efficient and/or enhance quality?

Yes. Examiners should be encouraged to have interviews with applicants at any stage. I recommend that applicants should be entitled to a telephone interview after each office action, final or not. I have had all too many cases where examiners just flatly refuse to have an interview when I thought it would be helpful.

Sincerely,

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