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To: AB94Comments

Subject: Comments on proposed rule changes 71 Fed. Reg. 48 and 71 Fed. Reg. 61

Attached are my comments on the Proposed Changes to Practice for Continuing Applications, RCE Practice, and Applications Containing Patentably Indistinct Claims, 71 Fed. Reg. 48 (January 3, 2006), and on the Proposed Changes to Practice for the Examination of Claims in Patent, 71 Fed. Reg. 61 (03 January 2006).

These comments are my own opinions and do not represent anyone else's views.

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**Comments on the Proposed Changes to Continuation and RCE Practice  
and on the Proposed Changes to Examination Procedures  
(Published in the Federal Register in January, 2006)**

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**A. Summary of My Comments on the Proposed Changes in Examination  
Procedure, 71 Fed. Reg. 61 (03 January 2006)**

I support the USPTO's proposed changes in examination procedures. The changes will improve the quality of issued patents: by shortening the time necessary for rejection, the changes will reduce examiner bias toward allowance; by abandoning the fiction that an examiner is able to fully search (and write up the detailed rejection for) every claim in time that is only sufficient for about five to twenty claims, the changes will make examiners less likely to allow claims they have not searched thoroughly; and by partially shifting the burden of identifying patentable subject matter from the examiner to the applicant, the changes will encourage applicants to try to file independent claims that are patentable.

I would prefer a hard cap of ten representative claims instead of offering applicants the opportunity to request more with the filing of an examination support document. The examination support document will consume examiner time without helping the examination: because it is likely to explain how claims differ from prior art references that are, if fact, different, the document will not be relevant to rejections based on other references. Even if the document is filed in a response to a first action and explains how claims that have not been considered differ from a reference that was asserted against representative claims, the document will not save time: it would take just as much time for the examiner to check if the attorney is right as it would to compare the claims to the reference. If the requirement of the document deters applicants from requesting more than ten representative claims, the requirement has some value. However, a hard cap would ensure that no application has more than ten representative claims.

Even if past attempts to cap the total number of claims failed, a cap on representative claims is not as harsh. It will take away no substantive rights, as long as the right of applicants to file as many related applications, RCEs, and continuations as they wish is preserved. Furthermore, the applications will issue with all the properly dependent claims that were filed.

The only other purpose the requirement of the document might serve is that it will force applicants to do what they should already be doing: carefully compare their claims to every close prior art reference and add limitations that distinguish the claims. However, once they have followed this procedure, the document becomes irrelevant.

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## **B. My comments on the Proposed Changes in Continuation and RCE Practice, 71 Fed. Reg. 48 (03 January 2006)**

I oppose the USPTO's proposed rule changes for continuation and RCE practice and for related applications. Although some limit on the time for filing a continuation (e.g. five years from a first Office action) might be necessary to give the public notice of the scope of the claim, I think it would be a mistake to place limits on the number of continuations, RCE's, and related applications.

"Rework" is an essential part of PTO function, which is to examine applications until they accurately capture patentable subject matter. Continuation applications do not wear down the examiner. When they have too many claims, they are not much more difficult to examine than original applications with too many claims. The main added difficulty is the need to ensure that the continuation does not introduce new matter, especially when it drops a limitation—while the decision could be difficult, it does not consume much time. The additional checking for double patenting is not critical because the patents now have the same expiration dates.

The filing of many related applications instead of the filing of all the claims in one application helps the examiner: the alternative would be too many claims, divergent subject matter, and sometimes mixed priority. RCE filings after final rejections enable examiners to meet their production quotas without allowing every amended case. If more applicants choose to go to appeal instead of amending their claims in an RCE filing, examiners will have to draft many more examiner answers and attend appeals conferences. If the appeals conference requires them to reopen prosecution, they will not earn a disposal count until much later, after they have done much more work.

Limits on related applications, RCE's and continuations are particularly inappropriate if the changes in examination procedures are implemented. Fairness to applicants requires that when they are limited to ten independent claims in one application (though applications now rarely have so many independent claims), they should get to file as many related applications as they believe are necessary to capture all the different groupings of novel features of their invention.

Fairness also requires that if examiners can reject applications without considering all the claims, the applicant should be able to keep trying to identify claims that are patentable and choose them to be representative in an RCE filing. Many attorneys and agents are not able to identify all relevant prior art references, whether because of lack of time or lack of expertise in the field, because of deliberate ignorance of patents the client might be held to infringe, or because they have not anticipated the examiner's construction of a claim limitation (but are willing to accept the broad construction). Although the proposed changes in examination procedures are likely to encourage them to find all the applicable prior art early, the applicant should not have to overcome more hurdles (beyond the cost of an RCE and attorney fees) to amend the application.

Limits are also unwise procedurally. Applicants should be encouraged to file independent claims in different applications. Applicants who currently lump several provisional applications or foreign priority documents into one non-provisional create a messy application that is difficult for the examiner to handle because of the number of claims, the divergent subject matter, and the mixed priority. In contrast, an applicant has

filed many related applications on a very complex apparatus developed by large teams of engineers. If that applicant had attempted to capture all the novel features in one application, the workload and complexity would have overwhelmed the examiner. Even under the proposed changes in examination procedures, an examiner would find it difficult to examine ten independent claims to divergent subject matter.

It might appear that the current proposed changes in examination procedures will increase Office workload because the number of related applications, RCE's, and continuations will rise. However, I do not think the workload will increase significantly. The number of restriction requirements is likely to drop dramatically (as long as few applicants request more than ten representative claims) because examiners usually do not bother to make the requirement when they only have to examine a few claims. The number of divisional applications filed should then drop as well.

Furthermore, applicants have reasons for filing large numbers of claims other than the presence of multiple truly novel features of an invention or concerns about the role of file-wrapper estoppel, limitations on the doctrine of equivalents, and claim construction in litigation. The primary reason for filing many claims is that the applicants or their representatives do not want the effort and responsibility of determining the differences between the invention and the prior art. Instead, they throw everything at the examiner and see what comes out. Another reason, for attorneys who are paid flat fees for applications, is their attempt to induce a restriction requirement. These reasons will lose their force if the proposed changes are implemented: the number of claims might drop in all applications. Furthermore, the applicants who filed many claims for these reasons would have no reason to file other applications, except for RCE's after final rejections.

Another reason the Office workload will not rise significantly is that not all applications are equally difficult. Although the Office projects its workload by looking at its performance on a large number of applications, that performance is hindered by applications with large numbers of claims. Those applications get bounced around from one art unit to another, get complex and multiple restriction requirements, and often have many other problems such as overly broad claims, weird terminology, too many information disclosure references, priority based on multiple provisional applications, and various other omissions and mistakes that require petitions. Limiting the number of claims examined for rejection to ten will limit the impact of such applications on Office performance.

The number of RCE filings is certain to rise, at least temporarily. However, any limits on these filings will result in more appeals—a far more time-consuming and expensive process that is unnecessary and premature if the applicant still has patentable subject matter in non-representative claims. Also, limits will complicate prosecution by making procedures that are now done routinely more cumbersome. An RCE is commonly filed after a notice of allowance is sent. For example, Information Disclosure Statements are often filed in this way. The filing of the RCE enables the examiner to spend the time to consider the references without having to borrow time from other applications and without having to withdraw the allowance if a reference is applicable (with loss of the disposal count). In many cases, applicants notice after allowance that they could have added another independent claim or dropped a limitation, or that they

could have worded the claims more clearly. These changes are best made through the filing of an RCE. They do not prolong prosecution significantly because the changes are usually minor and the examiner usually deals with RCE's within two months of filing.

### **C. More Detailed Comments on the Proposed Changes in Examination Procedures**

Current examination procedures cause examiner bias toward allowance because an allowance takes much less time and effort than a rejection. Although this source of bias may not be as significant as the immediate award of a disposal count for allowance, the end result of both sources together is a higher likelihood of overly broad claims in issued patents.

Few examiners, if any, deliberately allow an overly broad claim, and any attempt to catch the "bad apples" will result in a destructive witch hunt. However, patentability decisions often require the examiner to judge how broadly a claim limitation should be construed or whether a claim is obvious. It is therefore essential that the examiner's judgment not be colored by considerations that have nothing to do with the merits of the case.

An example illustrates why an allowance takes less time than a rejection: In an application that has one independent claim and nine dependent claims, allowance of the independent claim requires only a thorough search to determine that no reference meets that claim. A glance at the dependent claims insures that they are properly dependent on the independent claim. The Office action (in art units that require reasons for allowance; some art units permit allowance with only a form) has a short identification of one or two limitations that are not found in the prior art in combination with the other limitations of the claim.

In contrast, rejection of the independent claim requires subsequent consideration of the dependent claims. If all the limitations of those claims are explicitly disclosed in the first reference that meets the independent claim, the work on those other nine claims is not substantial. However, if some limitations are not explicitly disclosed, the examiner might have to decide if they are inherent. For example, the examiner might have to calculate parameters to check if they meet specified conditions. If the first reference does not meet limitations of some claims, the examiner has to search for references that do meet all the limitations of the independent claim and of the claims that were not yet rejected. The examiner continues in this manner until the examiner has either rejected every claim or has determined that there is no reference that meets the limitations of a claim or that renders it obvious. In the Office action, the examiner identifies where in the references each limitation is disclosed. A separate explanation of where the limitations of the independent claim are disclosed is necessary for each reference on which rejection of dependent claims is based. More complicated explanations are needed for rejections based on obviousness.

Because the example above has only ten claims, the examination under the proposed procedures of such an application would not change. However, as the example shows, the workload often grows non-linearly with the number of claims: the more claims there are, the greater the likelihood that one reference will not disclose the

limitations of all the claims. Repeated searching and writing for all the claims in the dependency chain will be necessary.

Under current procedures, even when an application is rejected, time constraints sometimes make examiners indicate that overly broad claims are allowed in cases that have large numbers of claims. Current rules require Office actions to be complete—to reject every claim that can be rejected or else to indicate that a claim has allowable subject matter. Although some examiners are able to make this determination correctly for every claim in every application, others resort to one or more of the following procedures in applications that have a large number of claims (and in which no broad claim could be allowed that would eliminate the many claims that depend on it from consideration):

1) They make a restriction requirement. This course is not always available because of narrow MPEP rules that were developed primarily to prevent patent-term extensions at a time when the term was measured from the issue date. It also may no longer be available if rules are implemented that allow applicants to pay more instead of making an election.

2) They reject some claims on the basis of references that do not meet all the limitations, with or without a detailed explanation. This procedure is similar to the proposed examination procedures. However, because it is not sanctioned by the rules, the improper rejection of any claim could be challenged on appeal. The appeals conference (much more strict now than it used to be) might force the examiner to reopen prosecution instead of proceeding to appeal. The result is a great deal of work and delay for the examiner before he or she could earn the disposal count. Pendency of the application could grow as a result as well. The same problem occurs if the examiner rejects on other bases that could be found to be improper in an appeals conference, such as Official notice, case law, or indefiniteness of claims.

In its attempt to improve quality, the Office has dedicated a substantial portion of its review resources to in-process review: reviewers identify erroneous rejections, and the errors are held against examiners. As a result, it is now more difficult for examiners to reject many claims on the basis of one reference, absent a rule change.

3) They indicate that claims are allowed (or would be allowable if rewritten as independent). This procedure is proper, and required, when the examiner has determined that no reference meets all the limitations. However, when an application has multiple tens, or even hundreds of claims, an examiner working under time constraints may, at best, be able to determine that no reference of record meets those claims. A reviewer might be able to find a reference, but reviewers are only able to consider a fraction of cases. Further, without the expertise of the examiner in the field of the application, the reviewer is not likely to find a reference that has inherently disclosed limitations. Still further, it is not reasonable to require examiners to perform an exhaustive search on every claim in every application, regardless of how unlikely it is to be found and how many other claims the examiner has already rejected. If such a requirement is enforced through more quality review (without the proposed changes in examination procedures), it will bring undesirable results such as substandard quality on subsequent cases, increased conflicts between and within art units over allocation of applications (everyone wants the cherries, applications with few claims, and no one wants

the dogs, applications with many claims), reluctance on the part of primary examiners to help with training, classification, and other essential functions, as well as high attrition. The proposed changes are therefore essential for improving the quality of issued patents without relying on overly strict quality reviews.

The proposed changes in examination procedures will reduce the time to a first Office action by reducing the time necessary to reject applications with more than ten claims (most applications). The average pendency from filing to disposal might rise temporarily because the rejection rate will be higher than the current rate—an allowance ends pendency much sooner than a rejection. In the long term, however, applicants will improve the quality of initial filings, and the time saved at the examiner level could bring down the overall pendency. If the Office is contemplating an increase in production quotas, it should wait for at least five years after the changes in examination procedures are fully implemented, and only if most examiners are achieving outstanding production rates. Ideally, the Office will achieve its efficiency goals by reducing examiner workload alone, without putting examiners under the threat of losing their jobs if they do not meet higher production quotas.

It might appear that the only rule that is fair to applicants is a rule that requires the examiner to reject a claim only on the basis of a reference that meets that claim's limitations. However, it should not be the job of the examiner to identify the allowable subject matter among myriad claims. Attorneys, agents, and even pro se applicants (especially if they have filed a previous application) should be able to identify the relevant prior art and draft only claims that are patentable. In the event that the examiner interprets a limitation more broadly than they expected (or otherwise asserts a reference that is missing limitations of representative claims), they have opportunities to explain to the examiner how the limitation should be interpreted or which limitations are missing in the reference, to amend the representative claims before a final rejection (e.g. by adding a limitation from a non-representative claim), appeal the rejection of the representative claims, or file an RCE (no limit should be placed on the number of RCE's that can be filed as of right). The examiner's role is properly limited to identifying a claim that can be rejected, rather than to identifying claims that can be patented.

The proposed procedure is more generous toward the applicant than the procedure I suggested in an e-mail I sent in January, 2005, to Director Dudas. I suggested that the examiner should be able to reject an application if s/he finds just one claim that is not patentable because of prior art and explains only the rejection of that claim, without discussing other claims. This suggestion would have caused too many procedural difficulties, but I do not think it would be unfair. Nonetheless, the changes the USPTO is currently proposing are abundantly fair, workable, and essential.

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