

# U.S. Patent Prosecution: Examiner's Perspective

Presented by:  
Stephen S. Wentsler  
swentsler@pearne.com

---

2010 FICPI ABC Meeting  
Ottawa, Ontario  
June 18, 2010

1



# What Are Examiners Thinking?

- Productivity
- Flow of Applications
- Quality

# Productivity

- Productivity –

- Quantity not quality
- Based on “Counts”

- Examiner’s goal – as high as possible

- Monetary awards if exceed expected production (up to 10% of salary)
- Unsatisfactory if Examiner does not maintain 90% of expected production

# Current Count System

Original Case			1st RCE			2nd, 3rd ... RCEs			Total Counts	
FAOM	Final	Dispose	FAOM	Final	Dispose	FAOM	Final	Dispose		
1.00		1.00							2.00	Original
1.00		1.00	1.00		1.00				2.00	1st RCE
1.00		1.00	1.00		1.00	1.00		1.00	2.00	2nd ... RCEs

*Overview of Count System Initiatives and Changes, USPTO  
Joint Labor and Management Count System Task Force,  
pg. 7, March 8, 2010*

# New Count System (Feb. 2010)

Original Case			1st RCE			2nd, 3rd ... RCEs			Total Counts	
FAOM	Final	Dispose	FAOM	Final	Dispose	FAOM	Final	Dispose		
1.25	0.25	0.50							2.00	Original
1.25	0.25	0.50	1.00	0.25	0.50				1.75	1st RCE
1.25	0.25	0.50	1.00	0.25	0.50	0.75	0.25	0.50	1.50	2nd ... RCEs

*Overview of Count System Initiatives and Changes, USPTO  
 Joint Labor and Management Count System Task Force,  
 pg. 7, March 8, 2010*

# New Count System – Examiner's Perspective

- Focus efforts on first Office actions for original cases
- Encourage continuation application filings
  - Find allowable subject matter in depending claims

# New Count System – Examiner's Perspective

- Encourage divisional application filings
  - Issue more election/restriction requirements
- Issue (improper) final Office actions

# New Count System – Examiner’s Perspective

- Declare the first Office action after RCE (continuation) “final”
- Avoid writing an Examiner’s Answer



# Flow of Applications

- USPTO objective – Maintain the flow of activities that do not “count”
- Examiner’s view –
  - Count obstacle
  - Relatively insignificant reward or penalty

# Flow of New Applications

- Special New Applications  
(RCE, Continuation, Divisional, Special Status)
- Regular New Applications
- Complete oldest every month

# Flow of Amendments

- **Special Amendments**

(Amendments after final, Special Status)

→ Complete within the earlier of 10 days from examiner receiving or 30 days from applicant mailing

- **Regular Amendments and Appeal Briefs**

→ Complete within two months

# Quality

- Quality = proper allowance
- No penalty for:
  - low quality before allowance
  - being reversed by the Board of Appeals

# Understanding the Examiner

- Picking the next application to examine
- Considering an election/restriction
  - Reduce the number of claims?
  - Potential divisional applications?
  - Need to move for flow reasons?
  - Avoid if likely allowable generic claim

# Understanding the Examiner

- The first Office action
  - Search strategy
  - Rejection – possibly final?
  - Allowable dependent claims?

# Understanding the Examiner

## ■ Interview considerations

→ Attorney prepared?

→ Interview approach?

→ Who's making the decision?

# Understanding the Examiner

- Response to common arguments
  - Teaching away, lacking claim elements
    - Possibly the most persuasive
  - Hindsight, motivation to combine
  - Secondary considerations



# Understanding the Examiner

## ■ Amendment after final

→ RCE likely?

→ Need the “count” now?

→ Time considerations

- Supervisor involved?
- Examiner’s amendment necessary?

# Understanding the Examiner

- Appeal Brief or Request for a Pre-Appeal Brief Conference Review
  - Now only receive 1/2 count for writing the Examiner's Answer
  - The dreaded panel review
  - Consider reopening prosecution

# Update on U.S. Patent Law Reform

Presented by:  
Stephen S. Wentsler  
swentsler@pearne.com

---

2010 FICPI ABC Meeting  
Ottawa, Ontario  
June 18, 2010

19



# Recent U.S. Patent Reform Activity

## ■ Patent Reform Act of 2009

(introduced March 3, 2009 in both the House and Senate)

### → House of Representatives – H.R. 1260

- House Judiciary Committee conducts hearing on April 30, 2009

### → Senate – S. 515

- Reported by Committee on April 2, 2009

# Recent U.S. Patent Reform Activity

- Patent Reform Act of 2010

- Introduced March 4, 2010 in the form of a Manager's Amendment to S. 515
- Compromise on previous reform provisions by Democratic and Republican Senators

# Patent Reform Act of 2010

## Key Provisions

- **First-Inventor-to-File**  
(S. 515 Sec. 2)

- Not “First to File” – must be an inventor
- “Effective filing date” includes the actual filing date of the application or the filing date of the earliest domestic or foreign priority application

# Patent Reform Act of 2010

## Key Provisions

### ■ Novelty

(S. 515 Sec. 2)

- Claimed invention lacks novelty if the invention was available to the public before the effective filing date
- Exception – Inventor still receives one-year grace period to file a U.S. patent application after public disclosure

# Patent Reform Act of 2010

## Key Provisions

- False Marking  
(S. 515 Sec. 2)

- Person must have suffered a competitive injury

- Damages  
(S. 515 Sec. 4)

- Court identifies methodologies and factors relevant to determination of damages



# Patent Reform Act of 2010

## Key Provisions

### ■ Willful Infringement

(S. 515 Sec. 4)

- Requires “objectively reckless” conduct
- No increased damages for a “close case” as to infringement, validity, or enforceability
- Failure to obtain advice of counsel (or failure to present advice of counsel) may not be used to prove willful infringement

# Patent Reform Act of 2010

## Key Provisions

- **Best Mode**  
(S. 515 Sec. 15)
  - Still required for applications; but
  - No longer forms a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable

# Patent Reform Act of 2010

## Key Provisions

### ■ Venue

(S. 515 Sec. 8)

- Only transfer venue upon a showing that the transferee venue is “clearly more convenient” than the venue where the civil action is pending
- Avoid forum shopping

# Patent Reform Act of 2010

## Key Provisions

### ■ Supplemental Examination

(S. 515 Sec. 10)

- Patent owner may request supplemental examination of patent
- Consider, reconsider, or correct information believed to be relevant to the patent
- Can cure “inequitable conduct” allegations

# Patent Reform Act of 2010

## Key Provisions

- Post-Grant Review Proceedings  
(S. 515 Sec. 5)
  - Requested by a person who is not a patent owner
  - Must be filed no later than 9 months from grant of a patent or issuance of a reissue patent
  - Will be granted if Director determines that it is “more likely than not” that at least one of the claims is unpatentable
  - All grounds of invalidity considered

# Patent Reform Act of 2010

## Key Provisions

- **Inter Partes Reexamination Proceedings**  
(S. 515 Sec. 5)
  - Requested by a person who is not a patent owner
  - Cannot be filed until after 9 months from grant of a patent or issuance of a reissue patent
  - Will be granted if there is a “reasonable likelihood” that a petitioner would prevail on one claim
  - Only patents or printed publications under section 102 or 103 considered

# Patent Reform Act of 2010

## Key Provisions

- U.S. Patent & Trademark Office Rule Making Authority  
(S. 515 Sec. 9)
  - May set or adjust, by rule, any fee established or charged by the Office
  - Does not address fee diversion
  - Does not address substantive rule-making authority

# Questions?

---

2010 FICPI ABC Meeting  
Ottawa, Ontario  
June 18, 2010

32





# Thank you!

Stephen S. Wentsler