

**EXAMINATION PROBLEMS
ENCOUNTERED
BY APPLICANTS

USPTO USERS**

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Lack of Experienced Examiners

- USPTO has about 5000 examiners and since 2006 is hiring an additional 1200 examiners per year – about 20% new examiners each year
- Large attrition rate with many examiners leaving
- USPTO Rules are very complex and keep changing and new examiners are not well versed in the rules
- Many new Examiners lack practical experience in the particular technology
- The result is poor quality first office actions. They include errors in law and lack of understanding of the technology

- Younger examiners often act as “messengers” between the applicant and his/her supervisor, where the Examiner does not have the authority – and sometimes full understanding of a rejection – to deal with applicant’s arguments or proposed amendments.
- Supervisory examiners are often only checking that the office actions are procedurally accurate and do not review the actual rejections of the examiner

Excessive Pressure on Applicants to Narrow Claim Scope

- Examiners are concerned of being overturned and corrected by supervisors and are therefore resistant to allow reasonable scope of claims. They lack confidence in granting broad claims.
- Examiners insist on applicant's adding limitations (often unnecessarily) before any decision of grant.
- Once an examiner's supervisor indicates a claim should be rejected, the examiner will rarely allow the claim unless substantial limitations introduced.

- Examiners in Business Method Patents pride themselves in “rejecting more than 95% of applications.”
- In biotech and pharmaceutical areas, they are strictly interpreting the written description and enablement requirements, forcing unnecessary limitations and specifics into claims.

Examiners Encourage Prolonged Examination

- Overuse of Restriction and Species Election requirements; and Examiners will rarely, if ever, change their mind even if good arguments are presented;
- Examiners encourage the use of an RCE more than necessary, e.g. refusal to allow any claim changes after final rejection; excessive use of 35 USC 112 rejections;
- Examiners rush to give final rejections explaining that applicant can just file another RCE

Expanding use of Lack of Utility Rejections

- 35 USC 101 requires utility. Federal Circuit requires, “useful, tangible and concrete”. USPTO Interim Guidelines have indicated what tests should not be used, but no guidance on what should be used.
- Examiners now reject almost every application for software, signaling, biotech, computer method, telecommunications, etc. as lacking any “useful, tangible and concrete” subject matter.
- Without suitable guidelines, there is lack of uniformity in what limitations should be acceptable.

Other Examination Problems

- Many Examiners have poor English language capabilities, making interviews difficult, and often impossible
- Insufficient Prior Art available to Examiners in Business Method Patents areas, e.g. taxation, financial systems, insurance methods, etc.
- Certain areas of Business Methods are more advanced than the technical skills of the Examiners, especially financial systems
- Examiners are not familiar with PCT Practice

Third Party Review of Prosecution History

- Third parties are also USPTO users
- In many cases Examiners permit claim language not found nor supported in the application
- Examiner interviews are poorly documented. After interview, claims allowed and no reasons provided
- Examiners often focuses on only some claims and once they are allowed, allow other claims failing to focus on the different language in the other claims
- File record is often not clear why claims were allowed

Problems with PCT Applications

- All PCT searches are being outsourced by ISA/US
 - Unsure of quality of searches
 - Unsure of extent of quality of review by Examiners
 - Unsure of whether Examiners in US National Phase will make use of these PCT Searches
- Lack of timeliness of ISA Search
 - US has worst record on timeliness of ISA Searches
 - Almost 25% of searches provided after 30 months
 - Applicants are denied a major use of PCT to get search information before deciding on National Phase.

Timeliness of International Search Reports

ISA	ISRs Completed	% Done within 18 Months	% Done After 30 Months
EPO	64,831	75%	1%
Japan	24,74	99.6%	0%
Korea	4,700	99.7%	0%
USPTO	23,724	20%	23.6%

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