

# Overhauling Examination Practice

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# Summary

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- RCE is an essential part of current compact prosecution practice
- Increasing numbers of RCE are symptom problems causing longer examination times
- PTO should look short term at making examination under current system as efficient as possible without artificially restricting availability of RCE practice
- PTO should start long term study for best practices in an examination system

# Common view among practitioners as to "cause" of RCEs

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- Examiners do not do a good job with the initial search
- Examiners do not understand the invention
- Examiners unwilling not consider evidence of nonobviousness when presented
- Examiners unwilling to admit to poorly reasoned or mistaken rejection in order to avoid rework
- Some cases need longer examination times; not every case is alike

# External factors contributing to increasing examination time

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- Applicants are strongly motivated by legal system to seek broad claims
  - Huge pressures on practitioners to avoid unnecessary limitations; no room for error
  - Narrow interpretations frequently being given even to broadly worded claims
  - Increasing difficulty in predicting commercial implementations because of increasing variety of ways to implement inventions — greater reliance on functional claiming and avoiding structure
  - Increasingly difficult in proving infringement
- Emphasis on building portfolios leads to time and price pressures on drafting specifications; greater reliance on broad claims
- Much more complex and quickly changing technology
- Pressures on PTO to "do something" about claim scope and §112 issues

# Internal factors contributing to longer examinations

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- Insufficient resources and lack of experienced, well trained examiners; poor quality candidates
- Inflexible examination system that micromanages, second-guesses decisions, relies on onerous production quotas, and penalizes the examiner on relatively minor issues
  - Encourages examiners working the system rather than working substantively to position the case for appeal or allowance
  - Instills fear among examiners to allow an application; pervasive mentality to reject
  - Robs examiner's of professional dignity and leads to a more adversarial system
- Poor quality searching, likely due to lack of time allowed for searching
- Unreasonable interpretations given by examiners to claims

# Recommend goals

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- Rather than reducing RCEs, the goal should be a flexible examination process that encourages quality searching and examination and efficient use of resources
  - There are no shortcuts; every case is different
- A top-down review of the entire examination to develop best practices
  - Must find creative ways to allow applicant and examiner time to come position the case for appeal or allowance
  - Consider borrowing best practices from Europe, Japan and other countries
- Build management and examiner culture that emphasizes professionalism
  - This will help attract and retain the best
  - Give the PTO confidence to give examiner's greater discretion, which will allow them to move cases more quickly to allowance or appeal

# Possible short term strategy

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- Stop placing RCE's on special new docket
- Continue with existing pilot programs that encourage interviews and after final consideration
- New short term pilot programs, such as —
  - Allow for abbreviated reasoning for rejection until it ion non-final rejections and encourage interview after first action
  - Splitting search and examination
    - Interview before search takes place to make sure searcher/examiner and applicant are on the same page
    - Allow amendments after search, before examination

# Conclusions

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- The problem is not with RCEs, but with the examination system and many factors outside the control of the PTO
- PTO must accept fact that some applications just take longer to examine due to circumstances beyond its control
- PTO's only option is to make the examination system more efficient; artificial limits that discourage use of RCEs must be avoided
- Take this opportunity to begin plans for a 21st century examination system