
A New Approach to Finality: Preliminaries

In this series of articles, I will propose an entirely new test for Finality. This new test would, I think, avoid the inconsistent results of the current test¹ and be more consistent with the rule. But before I can outline the test itself, there are some preliminaries to discuss.

Substantive vs. Non-Substantive Amendments

Under the current Finality analysis, Examiners are generally free to argue that any amendment can necessitate a new ground of rejection, justifying Finality. I do not think that this is correct: there are some amendments that clearly should not justify an Examiner jumping to Finality. To address this problem, I suggest distinguishing between substantive and non-substantive amendments: non-substantive amendments would not justify an Examiner making an Office Action Final.

So how would I define substantive and non-substantive amendments? I would define a substantive amendment is an amendment that affects the Examiner's search strategy and analysis of the claims. A non-substantive amendment, in contrast, does not affect an Examiner's search strategy or analysis of the claims.

Rather than trying to define substantive amendments more specifically, I think it is easier to give examples of amendments that should not be considered substantive. Any amendment that is not non-substantive would therefore be a substantive amendment. But the examples below are not intended to be all-inclusive: there might be other ways in which non-substantive amendments can arise.

Amendments That Address Issues That Are Not Claim Rejections

If the Examiner indicates that there is a problem with the claim, but does not reject the claim, by definition the issue is not substantive. Therefore, amending the claim to address such a problem is not a substantive amendment.

There are various ways in which the Examiner can indicate there is a problem with a claim without rejecting the claim. These include, for example, claim objections and *Ex Parte Quayle* actions. In addition, Amendments After Allowance, if entered into the record by the Examiner, are presumed to not be substantive, unless the Examiner is forced to re-open

¹ See the section entitled [The Fly in the Ointment](#) in The Problem with Finality: Inconsistent Analysis.

examination of the application after the Amendment After Allowance². (Of course, *Ex Parte Quayle* actions and Notices of Allowance both end examination, meaning that there is no concern about a Final Office Action.)

Amendments Suggested By the Examiner

If the Examiner suggests an amendment, either directly or indirectly, the Examiner is presumed to have considered the consequences of the Applicant making such an amendment, and therefore should know what would happen if the Applicant made that amendment. By encouraging the Applicant to make a particular amendment, the Applicant can presume that the proposed amendment will only resolve issues, and not raise new issues in the application³. If the Examiner can foresee that the proposed amendment would raise new issues, the Examiner should not suggest the amendment in the first place.

As noted above, the Examiner can suggest an amendment both directly and indirectly. A direct suggestion is where the Examiner says exactly what language the Examiner wants to see in the claim. An indirect suggestion is where the Examiner indicates the need for an amendment and points out how the Applicant might make such an amendment, but without specifying the exact language the Applicant should use. The Examiner also has suggested an indirect amendment where the Applicant introduces an amendment that narrows the claim more specifically than the Examiner suggests.

Some examples might help to illustrate my intent.

Example 1: Claim 1 recites, among other features, a widget. The Examiner rejects the claim, arguing that reference A teaches a widget. The Examiner notes that the prior art only teaches widgets with a circular cross-section, and does not teach widgets with a polygonal cross-section. The Examiner suggests that the Applicant amend the claim to recite a “widget with a

² Amendments After Allowance are at the discretion of the Examiner (*see* Manual of Patent Examining Procedure (M.P.E.P.) § 714.14), and it is likely that an Examiner would refuse to enter an Amendment After Allowance that would require a new search. The Applicant can always force entry of the amendment by filing a Request for Continued Examination (RCE), but filing an RCE also re-opens examination.

³ This is not to say that the proposed amendment cannot raise a new issue that the Examiner did not should have foreseen but missed. For example, the suggested amendment might introduce an indefiniteness problem under 35 U.S.C. § 112(b), for which the Examiner would need to issue a new rejection. But the Examiner’s suggestion that the Applicant make the amendment should mean that any rejection of that claim consequent to the Applicant’s following the Examiner’s suggestion should not justify Finality.

polygonal cross-section”. This is a direct suggestion, and if the Applicant follows the Examiner’s suggestion, the amendment is not considered substantive.

Example 2: Claim 1 recites, among other features, a widget. The Examiner rejects the claim, arguing that reference A teaches a widget. The Examiner notes that the prior art does not teach widgets with pentagonal or hexagonal cross-sections. The Examiner suggests that the Applicant amend the claim to recite the claim accordingly. This is an indirect suggestion, and if the Applicant amends the claim to recite a “widget, wherein the widget has a cross-section that is either pentagonal or hexagonal”, the amendment is not considered substantive.

Example 3: Claim 1 recites, among other features, a widget. The Examiner rejects the claim, arguing that reference A teaches a widget. The Examiner notes that the prior art only teaches widgets with a circular cross-section, and does not teach widgets with a polygonal cross-section. The Examiner suggests that the Applicant amend the claim to recite a “widget with a polygonal cross-section”. The Applicant, in reviewing the application, determines that the widget can only have a hexagonal cross-section: no other cross-section will be operative. The Applicant then amends the claim to recite a “widget with a hexagonal cross-section”. This amendment is strictly narrower than the amendment suggested by the Examiner. The Examiner’s suggested amendment is an indirect suggestion, and the Applicant’s amendment is not considered substantive.⁴

Rewriting a Claim in Independent Form

Rewriting a claim in independent is not a substantive amendment. It does not matter if the Applicant amends the dependent claim to include the features of the parent claim(s), amends a parent independent claim to have the same scope as the dependent claim (and cancels the dependent claim), or adds a new independent claim with the same scope as the dependent claim (and cancels the dependent claim): in all three situations, the amended claim has the same literal

⁴ Note that this Examiner has made an indirect suggestion of an amendment only with respect to the claim language at issue. If the Applicant were to also amend the claim to add “a doohickey connected to the widget”, while such an amendment would be strictly narrower than what the Examiner suggested, that portion of the amendment was not suggested by the Examiner at all.

On the other hand, presumably the Examiner had suggested an amendment that would overcome at least some of the claim rejections. If the Examiner issues a new claim rejection based on the amendment the Examiner had suggested, that new claim rejection should not justify Finality.

scope as the unamended dependent claim, and therefore should not affect how the Examiner analyzes the claim.⁵

Allowable Claims

If the Examiner indicates that dependent claims are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claim(s) (*see* Form Paragraph ¶ 7.43⁶), if the Applicant follows such an amendment, the amendment should not be considered substantive for all three reasons outlined above: the Examiner is only objecting to the dependent claims (and not rejecting them), the Examiner is suggesting an amendment to the Applicant, and the Applicant would be rewriting claims in independent form.

Amendments to Claims That Have Dependent Claims (Indirect Amendment)

The Applicant can amend a claim either directly or indirectly. A direct amendment is when the Applicant amends the language of the claim itself. An indirect amendment is when the Applicant amends a claim that is a parent to the claim in question.

A substantive amendment to a claim is also a substantive amendment to any claim that depends from that claim. That is, any claim that depends from a (directly) substantive amended claim is itself (indirectly) substantively amended. I have not decided whether the same rule should apply to non-substantive amendments. I cannot imagine a situation in which a non-substantive amendment to a parent claim would create substantive issues in a dependent claim. But at the same time, I cannot say that a non-substantive amendment to a parent claim cannot create a substantive issue in a dependent claim. Therefore, while I lean toward a non-substantive

⁵ Curiously, even though each of these possible amendments can be expected to produce an independent claim with the same language, this fact does not mean that the Applicant can carelessly choose the form of amendment. Under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabishiki Co.*, 535 U.S. 722 (2002), an Applicant is not entitled to apply the doctrine of equivalents to amended portions of a claim. (The doctrine of equivalents is a policy that permits a patent holder to argue that a claim is infringed by “equivalents” of the recited claim elements, even where the literal language of the claim is not infringed. The doctrine of equivalents thus avoids the need for an Applicant to literally cover every possible claim variant, which could unduly multiply the number of claims in a patent.) Applying the reasoning in *Festo Corp.*, if the Applicant adds the dependent claim features to the independent claim, the Applicant would not be entitled to the equivalents of those features. On the other hand, if the Applicant amends the dependent claim to include the features of the parent claims, the Applicant would not be entitled to the equivalents of *those* features. (And adding a new independent claim of identical scope to the original dependent claim would result in a claim that is not entitled to *any* equivalents.) Different amendments can therefore produce different claim scopes, even though the amendments could result in identical claim language.

⁶ Form paragraph ¶ 7.43 can be found in [M.P.E.P. § 707.07\(j\)](#).

amendment to a parent claim not being considered a substantive amendment to a dependent claim, I leave this question open.

Proper Office Actions

The second concept I would introduce is the concept of the “proper” Office Action. In short, a “proper” Office Action is an Office Action in which all claim rejections must be addressed substantively. That is, a proper Office Action includes no claim rejections that can be overcome merely by addressing procedural problems with any of the rejections. I personally think of the improper Office Action as the analog to the Non-Compliant Amendment⁷.

The meaning of “addressed substantively” vs. “addressed procedurally” is intentionally not defined further, because it is possible for new situations to arise beyond those outlined below. But I have several examples of rejections that are addressed only procedurally (and not substantively).

Rejections of Dependent Claims That Are In Part Broader Than Their Parent Claim

If a rejection of a dependent claim is broader (in whole or in part) than the rejection of its parent claim, the rejection of the dependent claim is not proper.

Example 1: Claim 1 is independent; claim 2 depends from claim 1. Claim 1 is rejected under 35 U.S.C. § 103 as being obvious over reference A in view of reference B; claim 2 is rejected under 35 U.S.C. § 102 as anticipated by reference A.

My reasoning would be as follows: The Examiner bears the initial burden of proof⁸. Therefore, if the Examiner fails to make a particular rejection, the implication is that the Examiner *cannot* make that rejection. In this example, the Examiner failed to reject claim 1 under 35 U.S.C. § 102 as anticipated by reference A. Therefore, there is at least one feature of claim 1 that is impliedly not taught by reference A. But that feature is part of claim 2 by virtue of claim 2’s dependency from claim 1. Therefore, claim 2 cannot be anticipated by reference A.⁹

⁷ See [M.P.E.P. § 714.II.F.](#)

⁸ See [35 U.S.C. § 102](#): “A person shall be entitled to a patent unless...”

⁹ Alternatively, I could argue that since the rejection of claim 1 required reference B, any rejection of a claim that depended from claim 1 would also require reference B, and therefore the rejection of claim 2, which did not rely on reference B, was improper.

Example 2: Claim 1 is independent; claim 2 depends from claim 1. Claim 1 is rejected under 35 U.S.C. § 102 as being anticipated by reference A; claim 2 is rejected under 35 U.S.C § 102 as anticipated by reference B.

Because claim 1 is not rejected as anticipated by reference B, the Examiner has implicitly acknowledged that there is at least one feature recited in claim 1 that is not taught by reference B. Since any claim that depends from claim 1 includes that feature by virtue of the dependency, no claim that depends from claim 1 can be rejected as anticipated by reference B. Rejecting claim 2 as anticipated by reference B is therefore improper.

Example 3: Claim 1 is independent; claim 2 depends from claim 1. Claim 1 is rejected under 35 U.S.C. § 103 as being obvious over reference A in view of reference B; claim 2 is rejected under 35 U.S.C .§ 103 as obvious over reference A in view of reference C.

Because the Examiner used reference B in rejecting claim 1, any claim that depends from claim 1 requires reference B as part of the rejection. Omitting reference B from the rejection of claim 2 is improper.

Note that the inclusion of reference C makes the rejection of claim 2 narrower in part than the rejection of claim 1; but omitting reference B makes the rejection of claim 2 also in part broader than the rejection of claim 1.

Example 4: Claim 1 is independent; claim 2 depends from claim 1. Claim 2 is rejected under the judicially-created ground of non-statutory obviousness-type double patenting over reference A; claim 1 is not rejected as double-patented over reference A.

Because claim 1 is not rejected as double-patented, the Examiner has implicitly acknowledged that there is at least one feature of claim 1 that is not taught by the claims of reference A and would not be obvious over reference A. Therefore, no claim that depends from claim 1 can be rejected as double-patented over reference A. Rejecting claim 2 as double-patented over reference A is improper.

Double-Patenting Rejections of Claims Subject to a Restriction Requirement

If a claim is rejected under the judicially-created doctrine of obviousness-type double patenting over a claim in a patent from which the current claim was restricted out, the claim rejection is not proper.

One of the consequences of a restriction requirement is that the Examiner has acknowledged the original claims included claim groups directed to two (or more) distinct inventions. If the claims are divided along the invention lines described by the Examiner, the distinct claim groups cannot be subject to double patenting rejections.

Rejections of Claims That Ignore the Language of the Claim

If a claim rejection does not address the actual language of the claim, the claim rejection is not proper.

Example: Claim 1 is independent; claim 2 depends from claim 1 and further recites feature F; claim 3 depends from claim 1 and further recites feature G (but not feature F). Claim 1 is rejected under 35 U.S.C. § 102 as anticipated by reference A. Claims 2 and 3 are also rejected under 35 U.S.C. § 102 as anticipated by reference A on the theory that reference A teaches feature F.

The rejection of claim 3 is not based on the language of the claim, since the Examiner has argued that reference A teaches feature F even though that feature is not recited in claim 3, and the Examiner has not argued that reference A teaches feature G. The rejection of claim 3 is therefore not proper.¹⁰

Note that the form of the rejection does not matter. This rejection is improper where the Office Action rejects claims 2 and 3 at the same time, or where the Office Action rejects claim 2 as anticipated by reference A, and then rejects claim 3 for the same reasons as claim 2, or where the Office Action rejects claim 3 with the same argument as the rejection of claim 2.

Rejections of Claims Based On A Reference That Is Not Proper Prior Art

If a claim rejection depends on a reference that is not proper prior art under the statute, then the claim rejection is not proper.

Example 1: The Applicant files an application including one claim on January 1, 2013. In the first Office Action, the Examiner rejects claim 1 as anticipated under [pre-AIA 35 U.S.C. § 102\(b\)](#) as anticipated by reference A. Reference A is a patent that was filed on January 2, 2012 and has no claim of priority to an earlier-filed patent application.

¹⁰ Note, however, that the rejection of claim 2 is proper.

Reference A is a patent that was filed less than one year before the filing date of the instant application. Reference A is not proper prior art under pre-AIA 35 U.S.C. § 102(b). The rejection of claim 1 is not proper.

Reference A might be proper prior art under pre-AIA 35 U.S.C. § 102(a) or (e). But because the claim was rejected under pre-AIA 35 U.S.C. § 102(b), the applicability of reference A under these other subsections of pre-AIA 35 U.S.C. § 102 does not matter.

Example 2: The Applicant files an application including one claim on January 1, 2013. In the first Office Action, the Examiner rejects claim 1 as anticipated under pre-AIA 35 U.S.C. § 102(e) as anticipated by reference A. Reference A is a U.S. patent that was filed on January 2, 2013, but claims priority from an international application under 35 U.S.C. § 119(a)-(d) filed on January 2, 2012.

For purposes of pre-AIA 35 U.S.C. § 102(e), the foreign application filing date does not count: the 35 U.S.C. § 102(e) date for reference A is January 2, 2013. Reference A is not proper prior art under pre-AIA 35 U.S.C. § 102(e). Therefore, the rejection of claim 1 is not proper.

Note that there is a difference in the pre-AIA 35 U.S.C. § 102(e) date when a U.S. application is claims priority from an international application under 35 U.S.C. § 119(a)-(d) versus when a U.S. application is a National Stage application of an International Application filed under 35 U.S.C. § 371. The priority claim does not count in the former case, but it does count in the latter case.

Example 3: The Applicant files an application including one claim on January 1, 2013. In the first Office Action, the Examiner rejects claim 1 as anticipated under pre-AIA 35 U.S.C. § 102(b) as anticipated by reference A, which is a paper published on the Internet. Reference A does not, on its face, include a date of publication. The earliest date of publication that can be attributed to reference A is January 2, 2016.

Electronic publications, which include publications on the Internet¹¹, are considered prior art as of the date the publications are publicly posted¹². Since reference A was publicly posted no earlier than January 2, 2016, reference A was not available more than one year prior to the filing date of the application. Therefore, the rejection of claim 1 is not proper.¹³

¹¹ See [M.P.E.P. § 2128](#).

¹² See [M.P.E.P. § 2128](#).

¹³ Note that the content of the electronic publication is irrelevant to the analysis: only the publication date matters. Even if the Examiner believes the content of the electronic publication was known before the date the

Rejections of Claims Using A Reference That Has Not Been Identified As Prior Art

If a claim rejection is made relying on a reference that has not been identified as prior art, the claim rejection is not proper.

Note that the reference does not need to be listed as prior art on a form (such as form PTO-892) attached to the Office Action that includes the claim rejection in question. Provided the reference has been identified as prior art no later than the mailing date of the Office Action, the reference is of record as prior art in the application. So if the reference was identified as prior art on a form by the Examiner, or the reference was identified by the Applicant on an Information Disclosure Statement (IDS) and was acknowledged by the Examiner as prior art (in either case, before the mailing date of the Office Action), the reference is presumably prior art. But if neither the Examiner nor the Applicant has identified the reference as prior art, then the Examiner's failure to cite the reference as prior art on a form like form PTO-892 would result in the claim rejection being an improper claim rejection.

Rejections of Claims That Do Not Follow U.S. Patent & Trademark Office Procedure

If a claim rejection is made without regard for proper U.S. Patent & Trademark Office procedure, the claim rejection is not proper.

Example: The Examiner rejects claim 1 of an application under the judicially-created doctrine of obviousness-type double patenting over prior U.S. Patent A. The Examiner makes only a cursory rejection, without providing any specificity or comparing claim 1 of the application with the claims of U.S. Patent A.

The Manual of Patent Examining Procedure (M.P.E.P.) § 804 II.B.1 states that:

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

electronic publication was publicly posted, the reference is still not available as prior art under [pre-AIA 35 U.S.C. § 102\(b\)](#). If the Examiner is convinced the content was known before the date the electronic publication was publicly posted, the Examiner should find another reference that is proper prior art.

Since the rejection of the claims fails to identify the differences between the claims in the application and the claims of U.S. Patent A, nor does the rejection of the claims explain why the differences would be considered an obvious variant of the claims of U.S. Patent A by a person of ordinary skill in the art, the rejection of claim 1 is not proper.

How Are Improper Office Actions Identified?

Since improper Office Actions will not move the application forward to a final disposition, it is self-evident that an Examiner is not going to intentionally prepare an Office Action that is improper. Therefore, presumably, an improper Office Action will be mailed by accident, and the Examiner will believe the Office Action is proper.

I propose that the Applicant can object to the propriety of an Office Action in writing at any time until the Examiner mails the next Action in the application. The objection to the propriety of the Office Action can be made as part of a Response to the Office Action, or the objection can be made separately.

The burden on the Applicant to object to the propriety of an Office Action should be no greater than the burden on the Examiner in rejecting the claims in the first place: a prima facie objection is all that is required. The Applicant only needs to state that he or she objects to the propriety of the Office Action, identify the claim rejection that is not properly rejected, and give a short synopsis as to why the claim rejection is not proper. This short synopsis should not require more than a statement, such as “The rejection of claim 2 is broader than the rejection of claim 1, from which claim 2 depends. Claim 2 is rejected as anticipated by reference A, but claim 1 is rejected as obvious over reference A in view of reference B. The omission of reference B in the rejection of claim 2 is improper.”

Once the Applicant has objected to the propriety of an Office Action, the burden shifts to the Examiner to respond. The Examiner can either acknowledge that the claim rejection was improper, or the Examiner can respond and state why the rejection was proper. An Examiner’s failure to respond should be equivalent to acknowledging that the claim rejection was improper. If the Examiner is going to argue that the Office Action was proper, the Examiner must respond

to the Applicant's objection in the Examiner's next Action: otherwise, the Applicant's objection would be automatically sustained.¹⁴

There are other ways in which the Applicant might proceed. These alternatives are worth considering for the same reasons they are useful in addressing Office Actions generally.

Telephone interviews with the Examiner or the Examiner's supervisor can be used to discuss whether an Office Action is improper, and a petition should be possible if the Applicant and the Examiner are unable to agree as to whether an Office Action is improper.

¹⁴ I realize that the U.S. Patent & Trademark Office would likely prefer a different approach. I suspect the U.S. Patent & Trademark Office would prefer to have the question of an improper Office Action (which is a procedural issue) resolved before the substantive issue (the actual rejections) are addressed, so that the Office Action is not "wasted". But I think this approach is flawed, for a couple of reasons.

First, forcing the Applicant to wait until the procedural issues are resolved before addressing the substantive issues can put the Applicant into a no-win situation. Since the Examiner has no deadline by which to act, there is no guarantee that the procedural issues will be decided before the deadline to respond to the substantive issues arrives. And since the deadline to respond to the Office Action is statutory, the U.S. Patent & Trademark Office has no authority to extend that deadline. The Applicant could find himself in a position of having to choose whether to give up the procedural objection or risk the application going abandoned for failure to respond to the Office Action.

Setting a deadline on the Examiner would not be helpful. Say the Examiner was given a deadline of two months to respond to the Applicant's argument that the Office Action was improper. If the Examiner were to just wait for two months, the Applicant would then have to proceed with other procedural remedies: for example, filing a petition. But this further delays when the Applicant can start work on a substantive response, and again risks the deadline to respond to the Office Action arriving without resolution on the procedural objection.

Even adding a consequence for the Examiner's failing to act doesn't necessarily help. Assume that the Applicant's procedural objection would be automatically sustained if the Examiner fails to respond. If the Examiner does respond at the last possible date, the Applicant could still be forced into a petition, which could fatally delay matters. And even if the Examiner acquiesces, that fact does not mean that the Applicant will not suffer an injury. I had one matter with an Examiner where I said the Examiner was wrong to make an Office Action Final. Between the mailing date of the Office Action and the date when the Examiner finally agreed to withdraw Finality, more than three months had passed (factors that contributed to this delay included: postal delivery time, since this Office Action was before the days of electronic delivery; the Examiner and her supervisor's schedules; and holidays, which complicated scheduling). The Applicant was therefore forced to pay a fee to extend the time to respond to the Office Action.

Second, assume that the Examiner does agree to withdraw an Office Action as improper. Nothing would prevent the Applicant from filing an amendment at that point (with the procedural objection resolved in favor of the Applicant, the substantive issues would go away automatically). So forcing the Applicant to deal with the procedural objection before addressing the substantive issues would only change the timing, not the result.

The U.S. Patent & Trademark Office could bar the Applicant from submitting any amendment while the Examiner withdraws and corrects the impropriety in the Office Action. But such a move is without precedent. While there are times when the Applicant does not have a right to have an amendment entered into the record—after a Final Office Action, after Allowance, or while an Appeal is pending—the Applicant is still permitted to submit an amendment after a Final Office Action or after Allowance. The only question is whether the amendment will be entered into the record, subject to the Examiner's analysis. And the Applicant can submit a Request for Continued Examination after a Final Office Action, after Allowance (provided the issue fee has not been paid), or while an Appeal is pending, if the Applicant wants to ensure the amendment is entered into the record. Establishing an interval of time where the Applicant is prohibited from submitting any amendment would be a new idea under the current rules.

Assuming that the Applicant objects to the Office Action in a timely manner, there should be no time limits on the Applicant to take further action (for example, to petition the U.S. Patent & Trademark Office to reverse an Examiner's decision that the Office Action was, in fact, proper).

What if There is a Question About an Improper Office Action During Finality?

There are two ways in which this situation can arise. One possibility is that the Applicant has raised a question about an improper Office Action that is still unresolved, and the Examiner has now issued a Final Office Action. Another possibility is that the Final Office Action itself is the one the Applicant considers to be improper.

Where the question of an improper Office Action overlaps with a Final Office Action, I think a deadline should be imposed on the U.S. Patent & Trademark Office to act (whether the Applicant asks the Examiner to withdraw the Office Action as improper or the Applicant files a petition with the Office of Petitions). I think that the deadline should be two months from the later of the mailing date of the Final Office Action or the filing date of the Applicant's paper arguing that the Office Action in question was improper. Further, if the U.S. Patent & Trademark Office does not respond by the deadline, there should be a consequence: the Office Action in question should automatically be deemed improper.¹⁵

By setting a deadline of two months for a decision, the Applicant would still have time in which to act before the application becomes abandoned at the end of the statutory period to respond to the Office Action. Even if the Applicant needs to wait for both the Examiner and the Office of Petitions to respond to separate requests, the Applicant should still have some time in which to file a Request for Continued Examination, should the need arise. For example, assume that the Final Office Action itself is the one the Applicant thinks is improper. The Applicant can take two weeks to object to the propriety of the Final Office Action in writing to the Examiner. If the Examiner takes the full two months, the Applicant would still have some time to respond to the Office Action or file a petition and (hopefully) get a decision.

¹⁵ Such a move does not give an Applicant an unfair advantage. In the worst case, an Office Action that was actually proper would be treated as improper. The Examiner might have to issue an additional Office Action, but that would be it. An automatic decision in favor of the Applicant would not result in, say, the patent being allowed when it should not be allowed.

If the U.S. Patent & Trademark Office (*i.e.*, the Examiner or the Office of Petitions) ultimately decides the Office Action in question was improper, that decision might necessitate removing the Finality of an Office Action. Consider the following examples:

Example 1: The Examiner issues the requisite number¹⁶ of non-final Office Actions, which are responded to by the Applicant. The Applicant also objects to the propriety of the last of these Office Actions. The Examiner then issues an Office Action, in which the Examiner argues why the previous Office Action was, in fact, proper. The Examiner makes this last Office Action Final, based solely on the requisite number of proper Office Actions having been issued.

Example 2: The Examiner issues two non-final Office Actions, which are responded to by the Applicant. The Applicant also objects to the propriety of the second Office Action. The Examiner then issues a third Office Action, in which the Examiner argues why the second Office Action was, in fact, proper. The Examiner makes the third Office Action final, based solely on the fact that the third Office Action only repeats rejections from the earlier Office Actions¹⁷, including a rejection made only in the second Office Action¹⁸.

In both of these examples, the Examiner's decisions to make the last Office Actions Final is contingent on the determination that the earlier Office Actions were all proper. Until the question of the Office Actions' propriety is decided (and decided in the Applicant's favor), the Examiner is technically correct in making the last Office Actions Final. But in both cases, if the earlier Office Actions are ultimately deemed improper, the Finality of the last Office Actions will need to be withdrawn: in the first example, the requisite number of proper Office Actions would not have been mailed, and in the second example, the third Office Action would include at least one claim rejection that was a new ground of rejection¹⁹.

¹⁶ This concept of "requisite number" will be covered in a future article. For now, it should suffice to say that under my proposal, an Examiner can make an Office Action Final if the Examiner has mailed a sufficient number of Office Actions.

¹⁷ This concept of making an Office Action Final if it only repeats earlier grounds of rejection will be covered in a future article.

¹⁸ That is to say, at least one of the rejections made in the third (Final) Office Action was only presented in the Office Action whose propriety is being discussed.

¹⁹ Again, this concept that an Office Action can be made Final if it does not present a new ground of rejection will be covered in a future article.

Changes to Petitions and Appeals

There are two other things that I have never liked about the administrative review processes of the U.S. Patent & Trademark Office: the fees required, and the time involved. The fees required for a petition can vary from \$35 to \$1700²⁰. The fees required for various steps in an appeal can vary from \$200 to \$2000²¹, with the total cost of an appeal—from filing the Notice of Appeal through a decision by the Patent Trial and Appeal Board—varying from \$700²² to \$4100²³, and possibly more.²⁴

The time required can also be considerable. The Office of Petitions is currently²⁵ taking four to six months to decide on a petition. The Office of Petitions acts independently of the Examiners examining a patent application, and are not obligated to render a decision to meet a deadline of an application. For example, an application might have a Final Office Action outstanding: but waiting for a decision on a petition from the Office of Petitions could result in the application being abandoned (for failing to respond to the Office Action)²⁶. Appeals are also subject to considerable delay: it can take three years or more between the Applicant filing a Notice of Appeal and the Patent Trial and Appeal Board issuing a decision. “Fortunately”, with appeals, the application will not go abandoned due to the delay in the Patent Trial and Appeal Board reaching a decision²⁷.

While I understand that the U.S. Patent & Trademark Office requires funding to operate²⁸, there is something inherently galling about being told that I (or an Applicant) need to

²⁰ See [USPTO Fee Schedule](#); the fee schedule reviewed was last revised January 1, 2017.

²¹ See [USPTO Fee Schedule](#); the fee schedule reviewed was last revised January 1, 2017.

²² For a micro entity, \$200 to file the Notice of Appeal and \$500 to forward the appeal to the Patent Trial and Appeal Board; no request for an oral hearing.

²³ For a large entity, \$800 to file the Notice of Appeal, \$1300 to request an oral hearing, and \$2000 to forward the appeal to the Patent Trial and Appeal Board.

²⁴ These numbers are for the fees alone, and do not factor in the cost to have an attorney prepare any of the paperwork.

²⁵ As of January 2017.

²⁶ It is possible for an Applicant to request that a petition be expedited. But that request is itself a petition, requiring a fee of \$100-\$400, depending on the size of the entity. An expedited petition is supposed to be decided within two months of the date the petition to expedite is filed. But there are still no consequences if the Office of Petitions misses that deadline.

²⁷ But if the Applicant does not prevail (*i.e.*, the Patent Trial and Appeal Board does not completely reverse the Examiner), any Patent Term Adjustment the application receives does not include the time the appeal is pending before the Patent Trial and Appeal Board.

²⁸ Unlike most government agencies, the U.S. Patent & Trademark Office is actually a revenue-generating agency: the fees collected by the U.S. Patent & Trademark Office exceed those required to support its operations. The federal government uses revenue from the U.S. Patent & Trademark Office to fund other government operations.

pay money to review what I consider to be a mistake of the U.S. Patent & Trademark Office. It does not matter whether the mistake is procedural (and subject to petition) or substantive (and subject to appeal): the Applicant should not have to pay to correct the Examiner's mistake. It is even more galling to have to face the no-win situation of deciding between attempting to correct an Examiner's mistake and not letting the application go abandoned.

I therefore think that changes are needed to both the appeal and petition processes. I would limit changes to situations where the Applicant is requesting correction of a mistake by the Examiner, particularly if the Applicant is vindicated. I am not suggesting that petition and appeal fees are *never* appropriate: in some circumstances I would agree that certain fees are reasonable. So, for example, I think a fee to petition for a delayed priority claim²⁹ would be appropriate, even if the petition is granted. But I do not think the Applicant should have to pay fees, for example, to petition to reverse an Examiner's decision on Finality.

Nor would I go so far as to say that no fees should be charged, either for a petition or an appeal, to seek review of an Examiner's mistake. If Applicants were never asked to pay fees to review Examiner mistakes, Applicants would petition or appeal everything possible and at every opportunity, which would slow the Office of Petitions and the Patent Trial and Appeal Board down even further. But I think fees should be refunded where the Applicant is successful. If the Applicant prevails on a petition, all fees paid to have the petition considered (including any fees to expedite the petition) should be automatically refunded, in the same manner as the fee was paid³⁰. If the Applicant loses, then the U.S. Patent & Trademark Office can keep the fees.³¹

For appeals, I would suggest a slightly more graded scheme. While petitions either result in a grant or a refusal, appeals have three possible outcomes: the Applicant can prevail outright, the Examiner can prevail outright, or the Examiner and the Applicant can split the result (the Patent Trial and Appeal Board can affirm the Examiner in part and reverse the Examiner in

²⁹ See [37 C.F.R. § 1.78\(e\)](#).

³⁰ So, if the fee was paid by check, the refund should be by check; credit card charges should be refunded with credits to the same card; and deposit account payments should be refunded to the deposit account.

³¹ I would add a caveat that it is the final decision on the petition that matters, if the same petition is submitted more than once. On more than one occasion, I have had a petition refused due to a misunderstanding by the Office of Petitions. After calling the Petitions Examiner and explaining the problem, the Petitions Examiner suggested resubmitting the petition (which did not involve paying an additional fee), after which the petition was granted. But if additional fees would be required to resubmit a petition reviewing what the Applicant believes is an Examiner's error, those fees, as well as the fees paid in the original petition, should all be refunded.

part)³². If the Examiner prevails outright, which can happen if the Applicant removes the case from appeal³³ or if the Patent Trial and Appeal Board affirms the Examiner, the U.S. Patent & Trademark Office can keep any fees paid. If the Applicant prevails outright³⁴, which can happen if the Examiner decides to reopen examination or issues a Notice of Allowance, or if the Patent Trial and Appeal Board reverses the Examiner, then the Applicant should be refunded all fees paid in connection with the appeal. If the Patent Trial and Appeal Board affirms the Examiner in part and reverses the Examiner in part, then the Applicant should receive a 50% refund³⁵ of the fees paid in connection with the appeal.

In the next part of this article, I will explain my proposed test for Finality, and begin the analysis of how the test could be applied.

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³² There are other possible outcomes, such as remand to the Examiner or dismissal without a decision, but those outcomes are not pertinent to this analysis.

³³ For example, by filing a Request for Continued Examination or by abandoning the application.

³⁴ Note that the test is not whether the Patent Trial and Appeal Board says the application should be allowed: the test is whether the Patent Trial and Appeal Board reverses the Examiner on all the rejections under appeal. First, even if the Patent Trial and Appeal Board reverses all of the claim rejections resulting in an application in condition for allowance, the application is still returned to the Examiner (*see* [M.P.E.P. § 1214.04](#)). Second, the Applicant might have decided that some claim rejections that are correct, and therefore might not have appealed those claim rejections. If those claims would remain rejected after the appeal is decided, the application would obviously not be in condition for allowance even if the Patent Trial and Appeal Board reverses the Examiner on all claims subject to appeal.

³⁵ I realize a more complicated scheme can be used: for example, the fees could be refunded in proportion to the number of claim rejections where the Patent Trial and Appeal Board reversed the Examiner. But such a scheme is rather complicated to implement; a simple 50% refund is much more easily used.