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## **A New Approach to Finality: Requisite Number of Office Actions**

In the first two articles in this series, I presented some preliminary concepts for my proposed new test for Finality and explained when Examiners could issue a Final Office Action based on a test for new grounds of rejection. In the third article, I explain when Examiner could make a proper Office Action<sup>1</sup> Final based on the number of Office Actions issued.

As a reminder, the proposed test itself is fairly simply described: A proper Office Action may be made Final if:

- 1) The proper Office Action does not introduce a new ground of rejection of any claim that was previously examined; or
- 2) The requisite number of proper Office Actions has previously been issued.

### **Applying the Second Part of the Test**

As noted in the previous article, which explained when the Examiner could make an Office Action Final based on there being no new grounds of rejection, the Applicant could theoretically keep an application pending indefinitely by amending the claims in a manner that would force the Examiner to reject the claims using new grounds of rejection. To give the Examiners certainty that examination will eventually end, a second part of the test is needed.

My initial idea was to keep things very simple: I was going to propose that the fifth<sup>2</sup> or later Office Action could be made Final. There is certainly no problem with determining when the Examiner has issued the fifth Office Action: all one has to do is look through the record and

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<sup>1</sup> From this point forward, unless otherwise stated, any reference to “Office Action” is intended to mean a “proper Office Action”.

<sup>2</sup> I have always felt that permitting a second Office Action to be made Final was far too soon. Examiners have the ability to drag out examination for as long as they want: the Applicant has no ability to assert that examination has gone on for too long. After all, as long as the Examiner can issue a decent (this term is used *very* loosely: I have seen too many Office Actions where I think the rejections had no merit) rejection, the Examiner is within his rights to issue an Office Action. But while Examiners can make as many rejections as they way, the U.S. Patent & Trademark Office only gives Applicants one opportunity to amend the claims. This dichotomy has never seemed fair.

I had based my selection of the fifth Office Action for Finality starting with baseball as a metaphor. So many things in life follow the adage of “three strikes and you’re out!”, and Finality also seemed to benefit from that concept. But I then added one more to three (non-Final Office Actions) for two reasons. First, with so many Examiners apparently not understanding the invention until after they read the Applicant’s Response to the first Office Action, allowing the fourth Office Action to be made Final would still effectively give Applicants only one opportunity to amend after the Examiner really understands the invention. Second, five is in some respects an easier number for the human mind to process, as we have five fingers on each hand: we can more easily count by fives than by fours.

count the Office Actions. But I realized that there was a flaw in the design. Consider the following scenario:

The Applicant files a patent application with a set of claims. The Examiner performs a search and finds some really pertinent prior art, which the Applicant would not be able to overcome via argument: the Applicant would have to amend the claims. But instead of rejecting the claims over this prior art, the Examiner instead issues a much weaker rejection over other prior art<sup>3</sup>. The Applicant argues why the weaker rejection is not appropriate, and the Examiner makes another weak rejection. This pattern repeats until the Examiner issues the fifth Office Action. At that point, the Examiner brings out the pertinent prior art and issues the “killing” rejection.

What can the Applicant do? Presumably the Applicant does not want to let the application go abandoned. But he cannot argue to overcome the rejection. Nor can he appeal, again because the prior art is pertinent. And since the application is under Final, the Applicant cannot amend the claims (the Examiner would most likely issue an Advisory Action refusing entry of the amendment on the grounds that it raises a new search). The Applicant would have no alternative but to file a Request for Continued Examination (RCE), which costs the Applicant money and time.

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<sup>3</sup> While Examiners are supposed to use the best prior art available (*see* [Manual of Patent Examining Procedure \(M.P.E.P.\) § 706.02](#)), it is hard to imagine how any teeth can be used to enforce that provision. I recall an Office Action where the Examiner had initially rejected the claims as obvious over a combination of two references. I thought the Examiner had a point with the rejection, and so I amended the claims, making strictly narrowing amendments. The Examiner then issued a second Office Action rejecting the claims as *anticipated* by a third reference. I called the Examiner to complain that the first Office Action should have rejected the claims as anticipated by the third reference: after all, if a narrow claim is properly anticipated, a broader claim is properly anticipated. So the Examiner should have made the anticipation rejection in the first Office Action, and it was unfair to make the second Office Action Final. The Examiner’s response was “I didn’t find the third reference when I searched the application the first time”. What possible response would there be? Even if the Examiner is lying, that fact cannot be proven.

I can think of one reason why an Examiner might want to use the strategy outlined in this scenario, whether appropriate or not. If the Examiner uses his best art before the Final Office Action, the Applicant might be able to amend the claims to overcome that art. The Examiner might eventually have no choice but to allow the application. Since a Request for Continued Examination (RCE) followed by a Notice of Allowance is a cheap way for the Examiner to increase his counts (*see* the section titled **Counting Down** in [The Problem with Finality \(Part 1\): A Historical Perspective](#): this combination generates counts for both the technical “abandonment” of the application via the RCE and counts for the Notice of Allowance in the RCE application), Examiners prefer this sequence of activity over simply allowing the application in the first place. Saving the best prior art for the Final Office Action gives the Examiner the best chance of forcing this sequence: if the best prior art is used earlier, the Examiner might not be able to force the Applicant to file an RCE.

I am also confident that on at least one occasion, I have encountered an Examiner issuing quick rejections to effectively delay examination, as the Examiner was expecting some pertinent prior art that was still secret (such as an unpublished or unissued patent application) to become public, so that he could cite that prior art.

### So What's the Solution?

Since the problem in this scenario is that the Examiner is essentially “wasting time” by issuing the weak Office Actions, the solution is to figure out when the Examiner is using this tactic and in some way preventing it. In my opinion, the key is that the Examiner is issuing Office Actions where he does not expect the Applicant to amend the claims<sup>4</sup>. So, if the Examiner keeps changing his grounds of rejection, that fact suggests that the Examiner is trying to waste time until he can issue a Final Office Action: the very behavior both Applicants and the U.S. Patent & Trademark Office want to avoid.

But there are some caveats to this idea. First, if we are going to assume that the Examiner often do not understand the invention until after the Applicant responds to the first Office Action, the Examiner should be permitted to make one change the grounds of rejection without falling into this hole. That is, the Examiner should be permitted to change his ground of rejection once, if that change is because his understanding of the invention has improved and not because he is trying to waste time until he can issue a Final Office Action.

Second, when I say that the Examiner is not “expecting” the Applicant to amend the claims, I do not mean that *any* amendment would save the Examiner from being considered to have “wasted time”. Recall that there are several ways in which an Applicant might amend the claims that are not substantive: amending to respond to a claim objection, amending the claims as suggested by the Examiner, and rewriting a claim in independent form, for example<sup>5</sup>. If the Applicant only makes non-substantive amendments, then the Examiner could maintain his previous ground of rejection: the amendments do not change that fact. So if the Examiner changes his ground of rejection anyway after a non-substantive amendment, the change in the ground of rejection should still count against the Examiner.

So, putting it all together, I came up with the following definition of “requisite number of proper Office Actions”, as that term is used in my proposed test:

- a) The “requisite number of proper Office Actions” is the greater of:

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<sup>4</sup> Note that this analysis would also cover an Examiner who makes one poor rejection after another, even without doing so intentionally. I think that result is appropriate. Examiners are expected to make good quality rejections. If an Examiner makes poor rejections in Office Action after Office Action, the Examiner should not be able to benefit from Finality, even if the poor rejections were the Examiner’s best effort. If the Examiner cannot find decent prior art, the Examiner ought to allow the application rather than make repeated poor rejections.

<sup>5</sup> See the section titled **Substantive vs. Non-Substantive Amendments** in [A New Approach to Finality: Preliminaries](#).

(i) three; and

(ii) two plus the number of Office Actions in which the Examiner rejects a claim<sup>6</sup> using a new ground of rejection<sup>7</sup> where the Applicant does not substantively amend that claim.

To see how this would work, let us revisit the scenario where the Examiner is “wasting time” issuing Office Actions just to reach Finality. When the Examiner issues the first Office Action, obviously the Examiner has not yet rejected a claim using a new ground of rejection. So the requisite number would be the greater of 3 and  $(2 + 0)$ , or 3. Since this is the first Office Action, it would not be appropriate to make the Office Action Final based on the requisite number<sup>8</sup>.

Assume the Applicant argues against the prior art, without amending the claims. When the Examiner issues the second Office Action, the Examiner issues new grounds of rejection<sup>9</sup>. Since the second Office Action includes new grounds of rejection where the Applicant did not substantively amend the claims, the requisite number would be the greater of 3 or  $(2 + 1)$ , or 3. Since the Examiner is still on his second Office Action, Finality would not be appropriate.

Assume the Applicant again argues against the prior art, without amending the claims. When the Examiner issues the third Office Action, the Examiner issues new grounds of rejection. Since the third Office Action includes new grounds of rejection where the Applicant did not substantively amend the claims, the requisite number would be the greater of 3 or  $(2 + 2)$ , or 4. Since the Examiner is on his third Office Action, Finality would not be appropriate.

Assume the Applicant again argues against the prior art, without amending the claims. When the Examiner issues the fourth Office Action, the Examiner issues new grounds of rejection. Since the fourth Office Action includes new grounds of rejection where the Applicant did not substantively amend the claims, the requisite number would be the greater of 3 or  $(2 + 3)$ , or 5. Since the Examiner is on his fourth Office Action, Finality would not be appropriate.

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<sup>6</sup> Note that if even one claim is rejected using a new ground of rejection without the Applicant substantively amending the claim, then the Office Action counts under subpart ii of this part of the proposed Finality test. It does not matter how many claims in the Office Action might justify a new ground of rejection based on a substantive amendment.

<sup>7</sup> This term is intended to use the same definition as in the first part of the proposed Finality test: [see A New Approach to Finality \(Part 2\): New Ground of Rejection](#).

<sup>8</sup> Nor, obviously, would it be proper to make the first Office Action Final based on the first part of the proposed Finality test ([see A New Approach to Finality \(Part 2\): New Ground of Rejection](#)): the claim rejections would, by definition, be new grounds of rejection.

<sup>9</sup> Note that the new grounds of rejection in the second and later Office Actions would mean that Finality would not be appropriate under the first part of the proposed Finality test.

As can be seen from this pattern, if the Examiner continues to issue Office Actions that can be overcome by argument alone (regardless of whether the Examiner did not understand the invention, did not understand the prior art, or was marking time), the Examiner will never be able to issue a Final Office Action. Thus, we avoid the scenario whereby an Examiner issues pointless Office Actions simply to waste time until the Examiner can issue a Final Office Action.

### **Some Observations**

There are a few things worth noting about the requisite number part of the proposed Finality test. First, note that the requisite number for the application is determined after the Office Action is written but before it is mailed. Is this unreasonable? I don't think so. After all, unless the Examiner has decided in advance that he wants a particular Office Action to be made Final<sup>10</sup>, even under the current Finality test the Examiner cannot know whether Finality is appropriate until after the Office Action has been written<sup>11</sup>.

Is the requisite number part of the proposed Finality test a little bit complicated? I would agree that it is not as simple as I had originally hoped. But I do not think the requisite number test is so complicated as to be inapplicable in practice. After all, in any given Office Action, the requisite number is either the same as it was during the previous Office Action or one more than that number, and determining whether the requisite number has increased or not depends solely on an analysis of the Office Action before it is mailed.

One implication of my proposed Finality test is that Examiners could expect to issue three Office Actions before they could issue a Final Office Action. Since the current Count System only awards counts for the first Office Action and the Final Office Action, the current Count System would not award Examiners for the multiple non-Final Office Actions. Now, while there are advantages in moving to Finality as quickly as possible, Examiners should not be penalized for having to issue multiple non-Final Office Actions (as I would expect to happen frequently under my proposed Finality test). While modifying the Count System is beyond the scope of this article, I suggest that the Count System could be modified to award Examiners for multiple non-Final Office Actions: perhaps awarding progressively smaller counts for additional

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<sup>10</sup> Such an approach seems inappropriate, as then the Examiner is writing the Office Action to satisfy his count concerns rather than based on the best possible rejection of the claims.

<sup>11</sup> Although, under the current Finality test, it is fairly simple for the Examiner to write an Office Action specifically to achieve Finality, especially if the Applicant had amended all of the claims, directly or indirectly, in response to the previous Office Action.

Office Actions. For example, Examiners might be awarded four counts for the first Office Action, three counts for the second Office Action, two counts for the third Office Action, and one count for any subsequent Office Actions. And when the Examiner issues a Final Office Action, a bonus count can be awarded. There are many possible strategies: the Examiner might be awarded a fixed number of counts (*e.g.*, 1) for a Final Office Action, or the Examiner might be awarded the same number of counts as the Examiner receives for the Office Action anyway (*e.g.*, 6 total counts if the second Office Action can be made Final: 3 for the second Office Action, and 3 for the fact that the second Office Action was made Final). That way, Examiners are encouraged to terminate prosecution in an efficient manner, but without penalizing Examiners for choosing to continue examination.

### **In Conclusion**

My proposed Finality test improves on the existing Finality in several ways. First and foremost, my proposed Finality test is almost entirely objective in nature, eliminating debate about whether a particular amendment “necessitated” a new ground of rejection. Second, my proposed Finality test provides a little more fairness to Applicants by not rushing to Finality on the second Office Action when the Applicant amends the claims. Third, my proposed Finality test discourages poor examination, denying Examiners who make poor quality rejections the ability to reach Finality and quickly increase their counts. While Examiners are not “guaranteed” a Final Office Action under my proposed Finality test, the existing Finality test did not guarantee Examiners a Final Office Action either. But the existing Finality test enables some Examiners to justify Finality with poor quality rejections, a result my proposed Finality test hopefully avoids. Finally, the existing Finality test essentially places the burden of proof on the Applicant to show that an Office Action should not have been made Final, a burden that effectively depends on Examiner largesse; my proposed Finality test puts the burden back on Examiners to justify making an Office Action Final.

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