

WHY SOME PATENT APPLICATIONS GET "VERY" PROMPT ACTION, AND OTHERS DO NOT

By Richard Neifeld, Neifeld IP Law, PC¹

Some patent applications sit for years before a first examination. Others get a first office action in under a year. Why?

Some of the discrepancies can be explained, of course, by the technology area. For example, in the business methods area, the USPTO is miserably behind, with first office actions predicted by the USPTO in many cases to be 5-10 years after their filing date. However, what about the discrepancies *within* a particular technology?

I spoke to a Supervisory Patent Examiner (SPE) about that type of discrepancy on one of my continuation applications in which my firm received an office action about 5 months after filing. The reason I spoke with her on that case is because we filed a preliminary amendment presenting new claims for examination at about 5 months after the application's filing date, which is well before any office action is normally expected. However, in this case, the USPTO issued a first office action about 10 days after we filed the preliminary amendment, and the office action did not examine the claims presented in the preliminary amendment.

Why did the office action not contain an examination of the new claims? Because of a glitch in the USPTO business rules. Specifically, although we filed the amendment electronically and it therefore showed up in the Image File Wrapper (IFW) immediately upon filing, the examiner was unaware of the amendment apparently because the USPTO clerks had not manually reviewed and docketed the filing of the preliminary amendment. Or, the examiner may have prepared the office action earlier in time, and internal USPTO delays prevented issuing the office action until after the date we filed the amendment. In any case, office action began a "comedy of errors" at USPTO.

In response to the office action failing to examiner the claims we presented, I filed a request for a new office action and a request for reset of the date for response to the mail date of the new office action (request for reset). However, PTO officials ignored my first filed request for reset, my initial telephone calls to the examiner and the SPE. As a result, just after the 3 month date for response to the improper office action, I re-filed my request for reset and again called and left messages for PTO officials. In response to the re-filing, the PTO clerks mis-identified my re-filing of the request for reset as a response to the improper office action, entered it as a response to the improper office action, and improperly charged my firm a one month extension late fee. At that point, I again called the SPE and left her a voice-mail message, and also escalated by calling a group director and leaving him a voice-mail message, which finally resulted in some action; return telephone calls from PTO officials. I now expect a new office action withdrawing the prior office action and resetting the date for response, although my firm will have to file a request for refund of the improper USPTO charges.

However, in the process of obtaining this belated procedural relief, I asked the SPE my underlying question: why did we received an office action so promptly; about 5 months after our filing date, even though on a continuation case (which is supposed to receive priority over non continuation applications)? What she told me was enlightening.

The SPE indicated that her more senior examiners (examiner in her art unit) had amended cases dockets that were backlogged, and therefore those senior examiners were not timely getting to newly filed cases since they had to prioritize work on their amended docket. However, she has eight *new* examiners, examiner hired within the last year, and their amended dockets are light, so that they pick up new cases more promptly. Since continuation cases bump to the top of any examiner's new case docket, continuation cases get picked up by *new* examiners very promptly. The examiner in the subject case is a relatively new examiner with a light amended docket. Hence, the subject continuation case, being at the top of his new case docket for a *new* examiner, got acted on unusually promptly after its filing date. Very important information for docket planning!

The moral of this story is, for docket planning purposes, to recognize that cases on a *new* examiner's docket, particularly *continuation* cases on a *new* examiner's docket, get relatively prompt action. So, for example, if your client intends to present a new claim set in a continuation application, determine whether the examiner assigned to the parent case is a *new* examiner, notify your client of the impact on the time limit for presenting new claims on this fact, and docket accordingly.

Addendum - After my initial posting of this article, one examiner (who asked to remain anonymous) identified the following additional reasons affecting time to first action:

1. Hold up in docketing to examiner because of classification dispute.
2. Hold up in examination, because the docketed examiner believes that the application is not his and is trying to transfer to other art units (again a classification dispute).
3. Date Case of art unit (at end each quarter, what is the date that the cases before that date have to be done).
4. Examiner only has to do oldest case, new case, & amended case each month. A strategy employed by an examiner in order to avoid other examiner's date case applications (which are probably a 'dog' that they want to avoid) is not do the oldest cases in order, so that at the end of the quarter, the SPE does not give other people's date cases because you have your own to do.
5. Newer examiners tend to get applications off the middle of someone else's docket, in order to avoid transferring applications that have been picked through, leaving only 'dog' cases.
6. If the examiner works overtime, then he get to more applications than other people and therefore will be ahead of the other examiner's in his art unit.
7. An examiner who left the office or moved to a non-examination position, requires the cases to be handled by other people.
8. The examiner is on a 'detail'. Therefore, the docket waits until he returns to examining.
9. Actions are prompted by messages sent to various people or groups. If the messages are misdirect or not done, then nobody knows that something needs to be done or looked at. Example, at times amendments filed are not acted upon the

examiner because the examiner is never notified that an amendment has been received.

10. Art units may work on split dockets, where one portion of the art unit is well ahead of the other half, but there is only a single date goal for the art unit.

11. Continuations usually are given back to the original examiner. At times it is realized before it is docketed, but if not when noticed, out of courtesy, the application is transferred when noticed, contributing to a delay.

12. For efficiency, an examiner might try to do similar cases together, thereby accelerating examining related cases that require the same or similar search.

13. Again, for efficiency, the examiner may attempt to have transferred to him related cases because they tend to be easier counts and may tend to accelerate examination of these related applications.

14. As a note, recently I did an office action on a continuation that the mailing date was less than 4 months after filing date.

1. I can be reached via telephone at 703-415-0012 or via the firm's web site at www.Neifeld.com.

ran

Date/time code: February 15, 2008 (5:53pm)

Y:\Library\LAW\FirmPublicationsAndPresentationsAndLectureMaterials\RickNeifeld\articles\WHY SOME PATENT APPLICATIONS GET VERY PROMPT ACTION, AND OTHERS DO NOT_1-17-2008.wpd