

We use cookies to customise content for your subscription and for analytics.

If you continue to browse Lexology, we will assume that you are happy to receive all our cookies. For further information please read our Cookie Policy.

LEXOLOGY®

Register now for your free, tailored, daily legal newsfeed service.

Questions? Please contact customerservices@lexology.com

Register

Behind the scenes at the USPTO: Accounting for the Supervisory Patent Examiner

USA | July 14 2011

“I think the claims are allowable.” To a patent practitioner, those are the sweetest words you can hear. You’ve worked hard to establish a good relationship, and have finally convinced the examiner that your claims are patentable. Then, without warning, you get another rejection. What happened?

When a patent application is examined at the United States Patent and Trademark Office (USPTO), amendments and/or arguments may persuade the examiner that the application is allowable. However, in discussions never seen by the practitioner, the examiner must seek the approval of a Primary Examiner (PE) or a Supervisory Patent Examiner (SPE), who may overrule the examiner (sometimes without substantive basis, often on intuition alone) and instruct the examiner to issue another rejection. This article, through a survey of former examiners and the authors’ own experience on both sides as examiner and practitioner, describes the examination structure and process at the USPTO, and how practitioners can help an examiner convince the SPE/PE of the patentability of a case.

The General Context at the USPTO

There are over 6,000 USPTO patent examiners, organized into art units. An art unit is a group of examiners who specialize in a specific technology or “art.” Each art unit typically has 13-20 examiners, managed by a SPE. An art unit includes PEs with “signatory authority” and assistant examiners without signatory authority.¹

Assistant Examiners. Assistant examiners (AEs) examine patent applications. As there are more AEs than PEs, it is more common to receive Office Actions from an AE. All newly hired examiners begin as AEs. Although AEs are sometimes called “junior” examiners, there can be a wide range of skill levels among AEs. Some may be new hires, and others may be veteran examiners. Nevertheless, all Office Actions from AEs require approval from a PE or a SPE before issuing from the USPTO. You can tell if an AE is handling your application if the Office Action has both the name of the AE and the reviewing PE or SPE.

Primary Examiners. PEs also examine applications. In order to become a PE, an AE must pass a rigorous internal review process. In addition to their relatively high level of procedural competence, other notable characteristics of PEs include their autonomy and knowledge of the art. PEs have the authority to issue Office Actions without SPE

approval, including their own Office Actions and the Office Actions of AEs. Within an art unit, PEs generally know the art the best, even more so than SPEs. You can tell if a PE is handling your application if the Office Action only has the PE's name signed on it, along with the title of the Primary Examiner.

Supervisory Patent Examiners. SPEs are internally promoted from within the ranks of PEs. In contrast to PEs and AEs, SPEs are part of USPTO management and no longer examine applications. A new SPE can sometimes be assigned to an unfamiliar art unit, and therefore in some cases may be the person who is the least knowledgeable about the art. Instead of directly examining applications, a SPE's main functions are supervising the art unit, training AEs, and implementing current USPTO policy directives.

The SPE Approval Process

Not surprisingly, the SPE has the final word on the patentability decision of an AE.² During the approval process, if a SPE disagrees with the AE's allowance recommendation, the SPE may provide new art, a new interpretation of the claims, new search suggestions, or an instruction to consult with a PE for further technical or search advice. After further searching or considering the new information, the AE may reverse course and issue another rejection. Alternatively, the AE may be unpersuaded and return to the SPE. If the SPE still feels that the application is not allowable, the SPE may simply instruct the AE to write his or her best rejection argument and issue a rejection.

If the reverse occurs, and a SPE disagrees with the AE's rejection recommendation because it is unreasonable or unsupported by the art, the SPE may simply instruct an allowance. More frequently, the SPE will permit another rejection as the more conservative approach.

Background Factors Affecting a SPE's General Attitude Toward Applications

Due to the SPE's role in approving Office Actions, a SPE can have a notable affect on the allowance rate of an art unit. From the authors' own experience and discussions with former examiners, a SPE's general attitude toward allowing applications is affected by background factors such as experience level, personal management approach, and current USPTO policy.

New SPEs are more likely to issue rejections out of caution or inexperience with the art. New SPEs are also subject to an initial probation period and therefore are more inclined to manage their art units "by the book." However, as they build working relationships with their AEs, SPEs learn each AE's examination style and qualities and may become more deferential towards an AE's allowance recommendation.

Veteran SPEs, on the other hand, because of their knowledge of the art, their examiners, and managerial independence, are more confident in their ability to quickly identify allowable subject matter. This latitude allows the SPEs to create their own "fiefdoms" with individual SPE management styles that can have a direct bearing on the allowance rate of the art unit. For example, one former examiner recalled that when he was a new AE, his SPE instructed him to issue at least one rejection per case for about six months so that he would learn how to write rejections.

Prevailing USPTO policy can also affect allowance rates. Multiple former examiners recalled times when rejections were more easily approved, and other times when AEs were encouraged to identify allowable subject matter more quickly. One former examiner recalled that allowances were being encouraged at the same time that USPTO fee revenues were reported as being low.³

Practical Tips and Suggestions

Know your examiner. Understanding the AE is key. Experience level and personal examination style can be significant factors. An uncooperative AE can effectively foreclose any attempts by a practitioner to facilitate a positive AE/SPE interaction. On the other hand, a cooperative AE can provide opportunities for the practitioner to promote productive AE/SPE interaction.

The telephone can be an effective tool in determining the cooperativeness of your AE. One of the quickest ways to become familiar with an AE's personal examination style is direct contact. Some may be proactive in identifying allowable subject matter while others may be reticent to admit anything, on or off the record. Therefore, if you have a short question to ask, give the AE a call. If you get voicemail, do not leave a message, but rather try calling several times throughout the AE's work day. If the AE never answers, you may have an AE that prefers to deal with practitioners only on the papers, and avoids personal interaction. Such AEs may limit your ability to facilitate the AE/SPE interaction. However, if the AE answers the phone and is willing to engage you in meaningful conversation, you may have an AE who would be willing to collaborate with you.

The AE's experience level may also affect a practitioner's ability to positively influence the AE/SPE interaction. Newer AEs tend to be more intimidated by practitioners, and thus less likely to engage in dialogue. One simple way to predict the experience level of an AE is to check the AE's phone number. Newer AEs generally have phone numbers beginning with 270. More senior AEs (who are likely to have more experience and independence) generally have phone numbers beginning with 272.

The best place to get to know your AE is through a personal interview. When the AE sees you in full context, including your smile, exchange of pleasantries and other chit-chat, you become a person in the AE's eyes, not a potentially intimidating opponent. The authors have found success in stating up front that the personal interview is intended to help both the practitioner and the AE, and then proceeding with the interview in a collaborative, cooperative manner. By acknowledging certain correct findings or interpretations by the AE and conceding a few secondary points, the practitioner can be seen as someone with whom the AE can work. Establishing such a relationship can provide a foundation for later collaboration to positively influence the AE/SPE interaction. When the AE becomes comfortable with the practitioner, personal information is more forthcoming. For example, the authors have had AEs share their frustrations about not being able to convince their SPE to allow the case, how their SPE told them the claim was too short to allow, and how their SPE told them not to waste time trying to address the applicant's arguments and to simply write up an Advisory Action. When an AE confides in you in this manner, it may be an indication that the AE is open to work with you on a solution that will appease the SPE.

Collaborate with the AE. If the AE wants to allow your application and has been open to discussion, don't assume that your job is done. Consider volunteering additional information that can help the AE close an information gap for the SPE. One former examiner remembered a SPE who consistently asked the AE two questions when the AE wanted to allow a claim. One, *what is the conventional practice in the art and why?* Two, *how is the claim different and why does the applicant do it that way?* An AE who can provide clear and succinct answers to these questions may increase their chances of persuading their SPE. However, such information is not usually conveyed by the practitioner in written responses to Office Actions, with good reason—practitioners try to avoid putting unnecessary characterizations on the record that might later turn out to be harmful. Therefore, consider providing the AE with this contextual information verbally, for his/her possible later use with the SPE.

Another former examiner viewed his meetings with the SPE as a "sales pitch." This former examiner believed that part of a successful allowance sales pitch is to get the SPE to agree to the AE's interpretation of the claims. As the SPE is likely to test the AE's application of the "broadest reasonable interpretation" rule to challenge the allowance,

consider discussing the interpretation of key claim limitations with the AE, and how the specification does not allow for a broader interpretation. The AE may be able to use this information in his/ her “sales pitch.”

Practitioners should also keep an open mind as to language proposed by the AE. The AE may have a better understanding of the art, may already have discussed the application with the SPE, and has probably chosen that language because he/she feels that a good argument for patentability can be made. It may be that the SPE has previously suggested that very language to the AE. Given that AE proposals may carry unspoken assurances of allowability from the SPE, consider whether you can live with the AE’s suggestion, or whether your client’s interests would be better served by holding out for different language.

SPEs instinctively disfavor short claims. Several AEs, pleading with the authors for additional claim limitations, have confided in the authors that their SPEs will apply the “pencil test” or “hand test” to reject claims on that basis alone. That is, if the claim is shorter than the length of a pencil or a hand, the claim will likely be rejected, even if the rejection must be “manufactured.”

To avoid such a bias, consider adding nonlimiting filler language, limitations that would have to be performed by any potential infringer, or limitations directed to the intended context.

Regardless of the length of a claim, the SPE will usually have an intuitive response to the patentability of a claim upon initial review, based on his or her knowledge of the state of the art and understanding of general engineering principles. However, this intuition is often abstracted from the specific real-life context surrounding the invention. Therefore, it can be helpful for a practitioner to provide the AE with information above and beyond the formulaic traversal of a rejection and beyond that captured in the specification, such as descriptions of the current state of the art, advantages, actual products containing the invention, hands-on product demonstrations, and market implications. This information may then be used by the AE in a “sales pitch” to the SPE.

Meet the SPE. To reach the SPE directly, a practitioner can request that the SPE attend an in-person or telephone interview.⁴ However, don’t expect that you’ll be able to negotiate a final resolution to your case just because the SPE is present. In the authors’ experience, even examiners with signatory authority will end interviews with a noncommittal statement such as “further searching will be required.” The ultimate decision will still be made in private, during the AE/SPE meeting. Having the SPE attend the interview can be either a benefit or a detriment. The authors have interviewed cases in which SPEs helped advance prosecution by focusing the AE on the pertinent issues and moving the AE away from unreasonable positions. In those particular cases, practitioners can get a clear picture of how the SPE is thinking, and adjust accordingly. In other instances, the SPE dragged down the interview by trying to understand technology already familiar to the practitioner and AE, or by suggesting claim interpretations that were impermissibly broad. Also, keep in mind that having a SPE present at an interview will cut off any opportunity for frank and candid conversation with the AE.

Conclusion

Understanding that an AE is somewhat of a middleman between the practitioner and the SPE can help practitioners maximize their interactions with AEs to not only reach agreement on the patentability of an application, but also to equip the AEs with information and arguments they will need when meeting with their SPE to discuss the allowability of a case.

Powered by
LEXOLOGY.