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By email oira_submission@omb.eop.gov
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Office of Management and Budget
Room 10102, NEOB
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CC: Nicholas A. Fraser, OMB Desk Officer for Patent and Trademark Office
CC: Kevin Rivette, Chairman, Patent Public Advisory Committee
Re: Request for Comments, Federal Regulatory Review, 74 Fed. Reg. 8819 (Feb. 26, 2009)

Dear Ms Echols:

Thank you for seeking public comment on the new administration's regulatory review policies. I offer some observations on the U.S. Patent and Trademark Office (PTO) and its pattern of non-compliance with Executive Order 12,866 (as amended) and the Final Bulletin for Agency Good Guidance Practices. I also offer some suggestions for how OMB can help correct some of PTO's difficulties.

Much of the PTO's problem stems from basic principles of procedural law that are addressed in the Final Bulletin for Agency Good Guidance Practices. Though this comment period is not directed to the Good Guidance Bulletin *per se*, I have two classes of suggestion here: (a) the Executive Order and Good Guidance Bulletin should be strengthened in a few respects, and (b) OMB should run a "pilot program" for Good Guidance, with the PTO as the target agency.

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¹ I am writing in my individual capacity, not on behalf of any client.

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I. Many Problems at the PTO Stem from Failure to Implement Good Guidance Practices and Regulatory Review Policy

A. The Patent Office

The PTO is an agency in crisis. But this crisis is largely self-inflicted, the product of two policies of PTO management that fall within the regulatory review jurisdiction of OMB.² First, senior PTO management has a stated (but unpublished) policy of refusing to

² The PTO has stated in several public meetings, though never in a published statement, that it has an alternative hypothesis for the cause of its backlog, that applicants are filing poor

enforce intra-agency rules of procedure, leading to haphazard and unpredictable – and therefore protracted – procedures. This policy is not stated in any document published under the Administrative Procedure Act, rather, the PTO springs it on patent applicants when applicants seek the help of PTO supervisory personnel to resolve issues. Only then are applicants told that the PTO does not enforce its guidance.³ Second, the PTO has a flawed compensation system that encourages agency personnel to run up fake production numbers by churning applications.⁴

In 2006-08, the PTO proposed to cure its backlog by placing regulatory limits on the complexity and substantiality of the patent applications that could be filed. These rules would have imposed **tens of billions of dollars** of economic effect, and could easily have destroyed the innovation sector of the economy, particularly large-molecule biotech.⁵ Fortunately, three of the PTO's five major rules have apparently been blocked, because of violations of the Administrative Procedure Act, or the Paperwork Reduction Act.⁶

Yet the public was forced to bear several tens of millions of dollars of costs in getting these PTO actions blocked, and in prophylactically taking actions as effective dates for new rules approached, actions that turned out to be unnecessary when the various regulatory actions were blocked. Neither the public nor OMB – nor, for that matter, the PTO – should be forced to bear the huge costs of the PTO's "near misses." Rather, the early stages of intra-agency regulatory review should be strengthened, so that the PTO is forced to account for burdens on the public (both paperwork and regulatory burdens) before rules get to the Notice of Proposed Rulemaking stage. Had the PTO simply asked questions and gathered information in the same way any competent business would have, and as required by the Paperwork Reduction Act and OMB Circular A-4, the PTO would have understood that its proposed rules were economically disastrous for both the economy and for itself. Regulatory review should be strengthened to ensure that rogue agencies such as the PTO cannot get to the point of imposing tens of

applications. As far as I know, the PTO has never supported its view with any data, and data obtained from the PTO itself squarely contradicts the PTO's hypothesis. The PTO's hypothesis and the contradictory data are discussed in Appendix 4 of this letter.

³ Examples of statements by PTO management to this effect – in court briefs, in emails from the Deputy Commissioner's office, and in unpublished formal decisions, but never in a document that would be enforceable under the Administrative Procedure Act, are discussed in § III.A at page 7 of this letter.

⁴ This is discussed in more detail in our submission to OMB of June 15, 2007, <http://www.whitehouse.gov/omb/assets/omb/oira/0651/meetings/619-3.pdf>, Attachment F (PDF pages 34-44)

⁵ Richard B. Belzer, "Letter to Susan E. Dudley, Administrator, Office of Information and Regulatory Affairs." <http://www.reginfo.gov/public/do/DownloadDocument?documentID=57744&version=1> (estimating paperwork burden for four of the five rules at \$13-34 **billion** per year).

⁶ *E.g.*, Patent and Trademark Office, Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates, 73 Fed. Reg. 74972 (Dec. 10, 2008)

millions of dollars of costs, without ever gathering the necessary information or making required disclosures.

B. The Manual of Patent Examining Procedure (MPEP)

The PTO's primary guidance document is the Manual of Patent Examining Procedure, or "MPEP." The expectations of the patent bar largely parallel the standards set out in Good Guidance Practices, that the MPEP is binding against the PTO itself, and should be a reliable guide to PTO disposition of certain issues, but the MPEP is only advisory against applicants. However, the PTO has not implemented Good Guidance Practices. Further, because the PTO failed to conduct required regulatory review, the PTO never conducted the introspection that would have focused attention on the source of the problem. Many of the PTO's problems stem from this mismatch of expectations – applicants never know what to expect from the PTO.

The PTO has two paths of intra-agency review, called "appeal" and "petition." Without support in any law, the PTO has insisted for decades that procedural issues stated in the MPEP underlying examiners' determinations of patentability are immune from review under either path. Examiners are aware of this anomaly, and quite consciously game the system. Further, the PTO's compensation scheme incentivizes examiners to reject patent applications on grounds that violate the PTO's procedural law, and incentivizes supervisory personnel to overlook those procedural breaches. Because the PTO incentivizes shortcutting the law, and provides no supervisory enforcement of procedure, examination dissolves into chaos. When applicants and their attorneys take actions that – according to the PTO's guidance – should result in prompt allowance of applications, examiners refuse to follow the written rules, and agency supervisory personnel refuse to enforce. Applicants cannot move applications through the pipeline; instead, meritorious applications must cycle through the process over and over merely to get examiners' errors corrected.

The result, of course, is procedural chaos, and a backlog.

To compound the problem, the appeal process – which should be the circuit breaker that permits prompt resolution of these issues – is often confounded by the very lack of procedure that creates the need to appeal. The Board of Patent Appeals and Interferences often remands applications back to the examiner without decision, because the examiner's failure to observe procedure resulted in such a haphazard record and incomplete statement of the disagreement between the applicant and examiner that the Board finds that it cannot reach issues for final resolution.⁷

⁷ The Board has persistently noted that it cannot render a decision when the examiner's analysis is incompletely set forth in the written record. *E.g.*, *Ex parte Daleiden*, Appeal 2007-1003, <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2007100303-14-2007> at 2, 2007 WL 774805 at 1 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); *Ex parte Domel*, Appeal No. 2001-2358, App. 09/454,723, <http://www.uspto.gov/go/dcom/bpai/decisions/rm012358.pdf> at 5-6 (BPAI Feb. 7, 2002) ("Without a fact-based explanation from the examiner as to why appellants' arguments and evidence are insufficient ... this merits panel is not in a position to evaluate the ultimate propriety of the examiner's rejection. The Board serves as a board of review, and does not perform

In sum, a large part of the PTO's problems arise because of PTO management's failure to implement the Final Bulletin for Agency Good Guidance Practices and sound regulatory policy required by Executive Order 12,866.

II. Suggested Clarification of Scope and Definitions in the Executive Order

A. Use the Word "Rule" Instead of "Regulation" to Clarify that Repeal and Guidance Are Covered

It may reduce confusion to use the terms "rule" and "rule making" (rather than "regulation" and "regulatory action") in a revised Executive Order, to clarify that the scope of the Executive Order includes guidance documents, and is not limited to only regulations that are codified in the Code of Federal Regulations. With the January 2007 amendment, the scope of the Executive Order is very close to the scope of the terms "rule" and "rule making" as those terms are defined in 5 U.S.C. § 551.

The Executive Order should clarify that it covers an agency's repeal or relaxation of existing regulations that bind the agency's own conduct. ("Repeal" is part of the definition of "rule making" in 5 U.S.C. § 551(4).) An email from senior PTO officials set forth in Appendix 1 suggests that the PTO may be planning to remove many of the mandatory requirements that currently bind examiners. The Executive Order should make clear that removing procedural safeguards that operate in favor of the public and that provide procedural predictability by an agency fully implicate concerns of sound regulatory policy, and require full regulatory review.

examination in the first instance. See 35 U.S.C. § 1.6(b);" remanding with an order to the examiner to examine, but without MPEP-class instructions to identify what that job is); *Ex parte Stache*, Appeal No. 2003-1034, <http://des.uspto.gov/...&fNm=fd031034> at 4, 6-7, 2003 WL 23280012 at *3-*4 (BPAI Nov. 28, 2003) (remanding without decision and without instructions—suggesting, but not ordering, that the examiner set forth written findings); *Ex parte Borody*, Appeal No. 2002-1371, <http://des.uspto.gov/...&fNm=fd021371> at 3, 5, 2004 WL 77301 at *1, *3 (BPAI Feb. 27, 2003) (because "rejection ... is not based upon the correct legal standards ... we vacate.... In addition, there are a number of issues that need to be clarified by the examiner," with reminder to examiner to make findings supported by substantial evidence); *Ex parte Govindan*, Appeal No. 2001-0758, <http://des.uspto.gov/...&fNm=fd010758> at 7, 2002 WL 32334569 at *5 (BPAI Nov. 15, 2002) ("[W]e find that the incomplete, inconsistent analysis of the claims, and the inaccurate analysis of the prior art, preclude meaningful review. Accordingly, we vacate the rejection of record and remand the case to the examiner"); *Ex parte Forest*, Appeal No. 2000-1901, <http://des.uspto.gov/...&fNm=rm001901> at 4, 2002 WL 33951036 at *2 (BPAI May 30, 2002) (when examiner treats claims in "broad brush" manner, Board can only vacate and remand without decision); *Ex parte Rozzi*, 63 USPQ2d 1196, 1200-03 (BPAI Jan. 16, 2002) (when "the examiner makes no cogent attempt" to explain basis, Board remands without decision); *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (BPAI Dec. 10, 2001) ("We decline to tell an examiner precisely how to set out a rejection."); *Ex parte Jones*, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to decide an issue that the examiner has not developed: "The board cannot examine, in the first instance, all applications which come before it in an *ex parte* appeal"); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI Jun. 7, 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); *Ex parte Braeken*, 54 USPQ2d 1110, 1112-13 (BPAI Dec. 21, 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

B. Use the Word “Significant” Instead of “Substantive,” to Clarify that Procedural Regulations are Covered

E.O. 12,866 § 3(e) defines “Regulatory action” as “any substantive action by an agency that...” Perhaps the word “significant” would be better than the word “substantive.” It is reasonably clear from the rest of the Executive Order that procedural rules are within the intended scope. Use of the word “substantive” introduces confusion.

Because the PTO characterized the five major rules of 2006-08 as “procedural” (a determination that was determined to be incorrect by the federal district court⁸), perhaps the PTO believed that there could be no non-Paperwork regulatory burden. Either the text of the Executive Order itself, or a guidance supplement for agencies, should spell out that even procedural rules can have large economic effects, and the agency is responsible for objectively estimating them.

C. Consider Defining the Terms “Significant,” “Economic Effect,” and “Not Significant,” and the Classes of Economic Effects to Be Summed

Executive Order 12,866 does not define the terms “not significant” or “annual effect on the economy.” The Executive Order, or a guidance document for agencies under the Executive Order, should include definitions, or at least guidelines or examples, of these key terms. For example, the SBA gives agencies significant guidance to determining the scope of “significant number of small entities” and “substantial economic impact” under the Regulatory Flexibility Act and Executive Order 13,272.⁹

The PTO estimated several of its major 2006-08 rules as “not significant” or as imposing no paperwork burden. When knowledgeable patent attorneys and patent business people estimated the economic effects, the estimates ranged from \$3 billion to \$30 billion per year.¹⁰ If the PTO has a good faith explanation, it relates to the definition of “economic effect.” Perhaps this discrepancy could have been avoided had OMB given the PTO more guidance in identifying the economic effects that were to be included in its estimates.

In particular, in several of PTO’s submissions under the Paperwork Reduction Act and Regulatory Flexibility Act, it seems PTO may have been playing a shell game – in one context assuming that applicants would fully exercise the new rules to avoid booking economic loss, and in other contexts assuming that applicants would not do so, thereby minimizing paperwork burden. In analogous cases, agencies should be required to state the number of applications affected by a proposed rule (with a recognition of year-over-

⁸ *Tafas v. Dudas*, 541 F.Supp.2d 805 (E.D. Va. Apr. 1, 2008).

⁹ Executive Order 13,272, Proper Consideration of Small Entities in Agency Rulemaking, 67 Fed. Reg. 53,461 (Aug. 16, 2002); A guide for Government Agencies, How to Comply with the Regulatory Flexibility Act, <http://www.sba.gov/advo/laws/rfaguide.pdf> (May 2003); SBA Procedures For Compliance With The Regulatory Flexibility Act and Executive Order 13272, at http://www.sba.gov/idc/groups/public/documents/sba_homepage/sba_010301.htm at page 17.

¹⁰ *E.g.*, <http://www.whitehouse.gov/omb/oir/0651/meetings/663.pdf>, <http://www.whitehouse.gov/omb/assets/omb/oir/0651/comments/477.pdf>, <http://www.reginfo.gov/public/do/DownloadDocument?documentID=57744&version=1>,

year growth), and state the assumptions for how many applications will use the procedure afforded by the new rule, and how many will be abandoned or not filed, and the agency should be required to fully account for the economic effect – including appropriate multipliers – of the “opt outs” under the regulation.

D. Regulatory Reviews Should be Noticed in the Federal Register

Agencies should be required to post notice of Executive Order regulatory review in the Federal Register. This would be consistent with President Obama’s focus on transparency and participation.

In cases where rules are modified as a result of notice and comment and the agency must make a filing under the Paperwork Reduction Act, 44 U.S.C. § 3507(d)(4)(D)(ii), the Paperwork filing should be coordinated with Executive Order 12,866 review, so that the public has access to the text of the rules presented for review under the Executive Order. It is very difficult for the public to advise OMB of the economic effects and paperwork burdens of rules whose content is not available.

III. Regulations of Internal Procedure

A. Agencies Should Not Be Permitted to Deny Enforcement of Internal Agency Rules

One of the largest sources of inefficiency and regulatory burden at the PTO is the PTO’s refusal to enforce its own procedural regulations. The PTO creates procedural non-accountability through a number of different mechanisms:

- For years, most PTO supervisory personnel have been free to define the scope of their own jurisdiction. Supervisor A (who decides petitions) says that the responsibility for supervising a particular issue lies with supervisor B (who decides appeals), and B would insist that the responsibility lies with A. (This is particularly true with respect to MPEP procedural law underlying rejections of claims – call Charles Pearson, the head of the Petitions Office, and Michael Fleming, the Chief Administrative Patent Judge – both will absolutely insist that they have no jurisdiction over MPEP procedural issues underlying rejections of claims, and that the issue should be presented to the other. Judge Fleming will confirm that a significant fraction of all appeals are dismissed without decision because the examiner failed to set forth findings on all procedurally-required issues.) Since there is no written guidance defining the scope of certain supervisors’ responsibilities (see § III.C at page 10 of this letter), patent applicants have no way to get out of this game of 3-card Monte.
- Recently, this has escalated: the Office of the Deputy Commissioner for Patent Examination Policy, and the editor of the MPEP (the PTO’s most significant guidance document) now go one step further, and insist that the most important chapter of the MPEP is totally non-binding against agency employees, because no agency supervisor has responsibility for enforcing it. (See Appendix 1.)
- One procedure for correcting examiner errors is a “petition to withdraw premature final rejection.” The PTO often refuses to follow its guidance, and

thereby denies applicants any effective means to have PTO guidance enforced. For example, in application 09/385,394, a first petition for premature final rejection in 2003 was dismissed as not directed to petitionable subject matter, even though MPEP § 707(c) states “it is reviewable by petition.” A second petition in the same application was filed in January 2006. The PTO has simply refused to act on this petition, and it sits undecided three years later.¹¹

- One path available for correction of examiner error, MPEP § 710.06, allows an applicant to send an erroneous examiner paper back to have it reissued in corrected form. However, the PTO consistently refuses to follow its own guidance here. For example, Appendix 2 is a series of papers that begins with a request for corrected paper under MPEP § 710.06. This should have gone to the examiner, who should have issued a corrected paper. Instead, Technology Center Director Jack Harvey (a T.C. Director is an examiner’s “grand boss,” typically responsible for 300-500 examiners) intervened, and recharacterized the paper as if it were a petition under 37 C.F.R. § 1.181 (which the paper is clearly not). T.C. Director Harvey “decides” issues that were never presented, and avoids deciding the issues that were presented. Typically, after a decision on petition, the next decision by the examiner takes several weeks. However, here, the examiner acted the very next day, while the petition decision was still in the mail, and issued a notice of abandonment.¹²
- Appendix 3 is a rough transcript of a telephone call with a Supervisory Examiner (a first-line supervisor) in which the Supervisory Examiner explains that she does not enforce MPEP procedural requirements vis-à-vis her examiners. This conversation predates the Good Guidance Bulletin effective date in summer 2007, but is representative of other conversations I have had with other supervisors since then.

Regulatory review should require agencies to conduct substantial introspection, to ensure that an agency’s problems are not caused by the agency’s own procedural lapses.

B. Agencies Should be Required to Provide Strong Self-Regulatory Guidance – e.g. Checklists

Agencies cannot leave junior employees to make up the law for themselves. The PTO has a rather unique problem, in that it must make hundreds of thousands of very complex legal/technological decisions per year. For reasons that are perfectly understandable, most of these decisions are made by technologically-trained but legally-

¹¹ I am aware of several other applicants that have petitions that the PTO has refused to decide for 3, 4, 5 and 7 years. In each case, the applicant’s only apparent crime is to be quite adamant in asking that the PTO follow its own rules. Apparently the PTO uses delay as a means to retaliate.

¹² Likewise, there are further surrounding facts and circumstances that suggest that this forced abandonment is an act of retaliation by T.C. Director Harvey against an applicant that requested that the PTO follow its own procedures. I will discuss these facts with you by phone, if you need further elaboration.

untrained examiners. The PTO, and similarly-situated agencies, must not leave such employees at personal discretion to make up the law.

It's essential that PTO examiners have robust, and mandatory, guidance on procedures, including procedural rules for making substantive determinations.

Agencies should be required to provide strong checks and balances to ensure compliance with guidance procedures. Supervision of procedural guidance must be delegated to supervisors that are not compensated based on production, and that therefore do not have direct financial incentives for allowing subordinates to breach procedure. Such supervision should occur in more or less real time; agencies should not require the public to engage in long-delayed and expensive "appeal" processes when the error is simply an employee who won't follow the rules. The PTO should move "petitions" decision-making from Technology Center Directors, who are compensated based on production numbers, to an ombudsman role that is not so compensated.

Agencies should be required to self-examine for both Type I and Type II errors. The PTO has a fairly robust quality review for applications that have been allowed; which catches applications that were wrongly allowed and should be rejected. However, the quality review for applications that are wrongly rejected is conducted on (anecdotally) less than 1% of applications. More importantly, the accountability, compensation, and promotion consequences for wrongful rejections are essentially non-existent, while the consequences for wrongful allowances is rather harsh. (One mid-level PTO employee told me that an erroneous allowance is treated as a "felony" that can end hopes for promotion, while erroneous rejections are "misdemeanors" with essentially zero consequence, no matter how numerous or egregious.) This skewed accountability system leads to skewed decision-making.

Agencies might be required to account for the costs they impose on the public by sloppy decision-making, and by failing to provide appropriate supervision of employees, using an accounting system somewhat analogous to the Paperwork Reduction Act paperwork budget. The costs should be reported by regulated parties. Agencies do not see the budgets or attorney bills for regulated parties, and should not be responsible for generating this information, only reporting what they collect from regulated parties.

The medical profession has recently awakened to the value of checklists.¹³ Similarly, agencies should be encouraged to give checklists to their decision-making employees. For example, the PTO should give its examiners checklists for the primary classes of actions that examiners decide. A sample checklist for obviousness determinations might look something like this:

- Every obviousness rejection must show that all elements are known in the prior art that is applied
- It is never obvious to create a new element out of nothing

¹³ E.g., Atul Gawande, The Checklist, New Yorker (Dec. 10, 2007), http://www.newyorker.com/reporting/2007/12/10/071210fa_fact_gawande

- Every multi-reference obviousness rejection must show some reason to combine, supported by substantial evidence. Possible ways to show reason to combine:
 - some improvement, predictable solution, incentive, or known method to achieve a predictable result, shown in the art and applicable to the combination posed in the rejection
 - “a finite number of identified, predictable solutions”
- Every obviousness rejection must show some “reasonable expectation of success,” supported by substantial evidence. Possible ways to show:
 - “predictable results”
 - “improve similar devices” in the same way as known devices
 - “a finite number of identified, predictable solutions,” with “anticipated success”
 - “the variations are predictable to one of ordinary skill in the art.”

The overwhelming majority of all rejections issued by the Patent Office omit one or more required showings – For several years in a class I teach, I have asked the students (all experienced patent attorneys) for the rate of omission they see vis-à-vis this checklist, and everyone else’s experience is the same as mine – the rate of compliance with existing guidance for stating rejections is well below 10%. If examiners were given simple checklists, the error rate would drop. If applicants are given these checklists in the PTO’s guidance document, and the PTO institutes procedures by which applicants can return defective work to the examiner to be done over with no additional production counts for the examiner, the PTO’s error rates and rework problems will vanish in two quarters.

C. Definitions of Terms of Art that Govern Scope of Agency Obligations

Several key terms that define the scope of protections for the public under PTO procedural rules are defined at some length in the case law, but not in the PTO’s guidance documents. Consequently, every PTO employee feels free to make up the definitions of key legal terms of art, and procedural protections that appear strong on paper vanish in practice. Examples at the PTO include the word “action” in 37 C.F.R. § 1.181(a), “appealable subject matter,” and “new ground of rejection.”¹⁴

Lawyers who practice in the courts understand how crucial definitions are, and that definitions for key terms are often defined in case law. Non-lawyer agency employees often do not understand this. Executive Order 12,866 (or OMB guidance to agencies) should strongly encourage agencies to set out definitions of key terms that define the scope of procedural protections.

¹⁴ Suggested definitions for key terms were provided to the PTO in notice and comment letters. The PTO did not reject these suggestions for definitions, the PTO simply ignored the comments in its final rule notices. Ignoring comments is, of course, illegal under the Administrative Procedure Act and the Paperwork Reduction Act. A new Executive Order could substantially improve regulatory transparency by requiring agencies to include definitions of key legal terms, especially procedural terms, in their guidance documents.

IV. Cheating

A. OMB Should Create Some Form of Sanctions Against Agencies that Cheat, and Against the Individuals in the Agency that Sponsor the Cheating

In its five major rule makings of the last three years, the PTO made the following errors that crippled OMB's ability to provide regulatory review:

- Both E.O. 12,866 § 6(a)(1) and the Paperwork Reduction Act, 44 U.S.C. § 3506(c)(2)(A) require agencies to confer with the public to ensure that any rule is well-designed to achieve its objectives, at minimum burden to the public, and that burden estimates are objective. Either the PTO breached these laws by not conferring with respect to the Continuations and Claims Rules (RIN 0651-AB93 and -AB94), IDS Rule (RIN 0651-AB95), Appeal Rule (RIN 0651-AC12), Alternative Language Rule (0651-AC00), and an MPEP revision planned for February 2009, or else the PTO withheld any record of such meetings from FOIA requests I made, from the record the PTO produced in the *Tafas v. Dudas* litigation, and from its submissions to OMB.
- The PTO's IDS Rule (RIN 0651-AB95), Appeal Rule (RIN 0651-AC12), and Alternative Language Rule (0651-AC00) were all "determined to be not significant." High-quality, peer reviewed estimates by knowledgeable patent attorneys determined that they would impose billions or tens of billions of dollars of burden.¹⁵
- The PTO classified both the Continuations and the Claims rules (RIN 0651-AB93 and -AB94) as "other significant," by the device of splitting them apart, and reporting to OMB only the costs of each as if implemented separately. The PTO simply ignored the costs imposed by the interactions between the two. Surprisingly, the PTO split the two rules only for E.O. 12,866 purposes. Ironically, in order to reduce its own paperwork, the PTO treated them as a single rule for Paperwork Reduction Act purposes.
- In October 2007, in a meeting with Mr. Neyland, Robert Bahr (the PTO's representative at an E.O. 12,866 meeting) acknowledged that the PTO's certification of "not significant" for the IDS rule was a "typo." Mr. Bahr acknowledged that the PTO had not corrected the "typo" in fifteen months. In this meeting, Mr. Bahr was shown private sector estimates that the paperwork burden was in the range of \$ 2 billion to \$ 7 billion per year – Mr. Bahr did not

¹⁵ See Letter of David Boundy to Susan Dudley, Oct. 17, 2007, <http://www.whitehouse.gov/omb/oira/0651/comments/477.pdf> (estimating partial cost of IDS rule 0651-AB95 at about \$2 billion per year in direct paperwork costs); Letter of Richard Belzer to Susan Dudley, Oct. 26, 2007, <http://www.whitehouse.gov/omb/oira/0651/comments/478.pdf> (estimating a more-comprehensive set of costs at about \$7 billion per year); Letter of Richard Belzer to Susan Dudley, Jan. 16, 2008, <http://www.reginfo.gov/public/do/DownloadDocument?documentID=57744&version=1> (estimating costs of four of the five rules at \$13-34 billion per year).

disagree. Eighteen months after the PTO's billion-dollar "typo" has been brought to its attention, the PTO has still not published a correction of its "typo."

- The PTO refused to make required Paperwork Reduction Act submissions to OMB at the time of the Notices of Proposed Rulemaking for the Alternative Language and Appeal Rules, for reasons that have no grounding in any statute.
- In late 2005 and through 2006, the PTO at least made the required filings (though with poor-quality estimates). After spring 2007, as public pressure against these rules mounted, the PTO consistently characterized these rules under E.O. 12,866 and the Paperwork Reduction Act into categories that would exempt them from OMB review.

Meanwhile, the PTO showed that it understood the law – for example, for 0651-AB55, the PTO made appropriate Paperwork Reduction Act filings as this rule progressed, and made corrective filings to correct earlier errors.

The errors in the five major, contentious rules are all of the kind one would expect to see if the PTO has been attempting to "fly under the radar" by mischaracterizing its rules so that OMB would not give them serious review. Especially when contrasted with the PTO's rule making on non-contentious rules, it's hard to explain the PTO's conduct of the last three years as anything other than deliberate cheating.

In addition, the PTO has breached a number of provisions, apparently by simply refusing to implement the Executive Order or Good Guidance Bulletin:

- Since July 2007, the PTO has issued several guidance documents that are clearly "economically significant," with none of the process required by the Executive Order or Good Guidance Practices. The include revisions to the MPEP, new guidelines on obviousness, and new examiner training materials.
- The various lists of guidance documents, contact information for guidance enforcement officials, etc. required by the Good Guidance Practices Bulletin are not up on the PTO's web site.
- The "officials" and "offices" whose designation is required by the Good Guidance Bulletin have apparently not been designated – at least contact information for them is not on the PTO's web site.

The PTO cannot plead ignorance. I personally discussed the Good Guidance Practices Bulletin with John Love (then the Deputy Commissioner for Patent Examination Policy) at a conference in September 2007, and the Bulletin has been brought to the PTO's attention repeatedly in notice and comment letters. OMB should ask PTO to explain its refusal to implement Good Guidance Practices.

The Executive Order should be strengthened so that agencies can't cheat. Agencies should not be tempted to simply ignore analysis of economic effect (so the effect can be estimated at zero), or to under-report.¹⁶ Agencies that have had difficulties

¹⁶ The PTO classified the IDS, Alternative Language, and Appeal rules as "not significant," that is, having essentially zero economic effect.

complying with their obligations should be required to provide OMB and the public with progress and implementation reports, and perhaps extra procedural remedies to cure the agency's breaches.

When a regulation is clearly directed solely to reducing an agency's workload, the range of sanctions available is clearly larger than in the case of regulations directed to the protection of the public.

B. Based on "Best Obtainable Economic Information"

E.O. 12,866 § I(b)(7) requires "Each agency shall base its decisions on the best reasonably obtainable scientific, technical, economic, and other information concerning the need for, and consequences of, the intended regulation or guidance document." Requirements for objectively estimating compliance paperwork burden and regulatory burden should be strengthened.

In the PTO's five major 2006-08 rule makings, the PTO never conferred with any member of the public to assess economic impact (or if the PTO did, no records of that consultation was included in the record produced for the *Tafas v. Dudas* litigation). In particular, whenever the PTO stated estimates of paperwork burden, compliance, and regulatory burden, the PTO based its estimates solely on "discussions with USPTO staff,"¹⁷ who, at the time, had no private sector experience in preparing the papers.

OMB should strengthen the ICR rules of 5 C.F.R. Part 1320, and the rules for estimating compliance and regulatory burden costs under E.O. 12,866. In particular, agencies should be required to consult with members of the public who have actual experience in the relevant field. *E.g.* for costs of preparing patent prosecution papers, the only people who know are patent attorneys. For economic impacts of various patent laws, in-house counsel, law firm "deal" patent counsel, corporate management, etc. must know, PTO staff have no access to reliable information. When an agency has no contact with substantive law or the economic life of its regulated subject matter, the agency should be strongly discouraged from relying on opinions of its own staff.

C. High-Risk Agencies

Agencies that have the following characteristics might warrant closer scrutiny than others.

¹⁷ ICF International, Certification Analysis Under The Regulatory Flexibility Act , Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications (Jun. 29, 2009), <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ccfrcertificationanalysis.pdf>. All of the burden estimates in this document were based on "discussions with USPTO staff," none on consultation with any member of the public who would have relevant knowledge. Many of the estimates of "USPTO staff" that can be objectively checked against the PTO's own databases are simply wrong. Even when the PTO relied on objective external sources, the PTO failed to confirm that the estimate on which it relied was at all relevant to estimating the information collection that the PTO proposed.

At a few agencies, senior officials receive performance-related bonus payments based on “measurable goals.”¹⁸ Interestingly, the PTO has disclosed the amounts of these bonuses – typically 12-20% of salary – but not what the “measurable goals” are, let alone the measurements against goals. Agencies that have such bonus structures should take care not to use rule making to manipulate agency performance against those goals. For example, some PTO documents¹⁹ suggest that the rate of affirmance/reversal by the Board of Patent Appeals is one of the criteria used in computing management bonuses. The PTO’s 2007-08 rule on appeals (RIN 0651-AC12) would have shifted the burden of proof during appeals from the PTO to the applicant, which would substantially change this affirmance/reversal rate. The PTO’s rulemaking notices did not identify any public policy goal to be served by this change. Agencies with bonus structures should be very transparent about the criteria used in determining bonuses, and take some care to ensure that rule making is not used to artificially manipulate staff bonuses.

Agencies that have only procedural rulemaking authority often do not participate in or oversee enforcement, private sector conduct, or commercial transactions in their subject matter areas. This lack of practical feedback deprives these agencies of understanding of how their rules can affect costs, outcomes, and derivative economic activity. Similarly, some agencies – including the PTO – have very little inflow of personnel from the private sector, and therefore have little insight into the real-life economic effects of agency rules. These agencies might be required to seek more external help before regulating.

V. Conclusion

I can document most of the claims in this letter if you require, but assembling that documentation is very time consuming, so I have only skimmed the surface. Let me know if you need anything specific.

I appreciate the opportunity to submit these comments. Feel free to call me with any questions, at (212) 294-7848.

¹⁸ “the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation ... of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary.” 35 U.S.C. § 3(b)(2)(B).

¹⁹ http://www.uspto.gov/web/offices/com/advisory/reports/ppac_2007annualrpt.pdf, page 2, n. 2

**Appendix 1: Email From Office of PTO's Senior-Most Patent Examination
Policy Officer Stating PTO's Policy of Non-Supervision**

A colleague recently forwarded this email string to me.

Note that the original question is framed in the exact words of the Final Bulletin for Agency Good Guidance Practices; the PTO states that it does not implement the Bulletin, and that there is no mechanism for obtaining supervisory review by any lawyer, or by any mid-level or senior PTO official.

John Love is the recently-retired Deputy Commissioner for Patent Examination Policy, the PTO official most responsible for PTO rule making and rule enforcement governed by the Executive Order, and for guidance governed by the Final Bulletin for Agency Good Guidance Practices. Magdalen Greenlief is the editor of the Manual of Patent Examining Procedure, the PTO's key guidance document (well over 2000 pages), which is on the desk of essentially every patent attorney.

The name of the attorney is redacted.

From: Greenlief, Magdalen
To: [attorney]
Cc: Love, John
Sent: Wed
Subject: FW: MPEP Questions

Dear [attorney]

Your e-mail was forwarded to me for reply.

... Any failure by the examiner to follow the MPEP is neither appealable nor petitionable. ...

There are too many scenarios in the MPEP where we state "the examiner must" do something. ...

Hope this answers your questions.

Best regards,
Magdalen Greenlief

From: Love, John
Sent: Thursday 8:45 AM
To: Greenlief, Magdalen
Subject: FW: MPEP Questions

Magdalen, please respond to this individual and cc me. . thanks.

-----Original Message-----

From:[attorney]

Sent: Wednesday 9:40 PM

To: Love, John

Subject: MPEP Questions

Deputy Commissioner Love:

... I am writing to seek your feedback on several questions concern the level of reliance that may I place on the MPEP.

Does the PTO consider the MPEP binding on examiners or the BPAI? When the MPEP uses mandatory language ("must", "will", etc), does a patent examiner have authority to depart from such MPEP requirements? Do examiners need to obtain appropriate supervisory concurrence prior to such departures? What is the procedure for doing so?

Do you have any advice as to what is the most appropriate way to raise such departures and to obtain enforcement of MPEP requirements (if that is possible)?

Thank you and best regards,

[attorney]

**Appendix 2: Decision of a Technology Center Director Who Intervened to
Prevent an Examiner from Following PTO Guidance**



PATENT

ATTORNEY DOCKET NO. 114596-30-0126BS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/672,841
Applicant: T.R. Ramesh, et al.
Title: VALIDATION OF MEMORY REFERENCES
Filed: September 28, 2000
Art Unit: 2183
Examiner: Richard Ellis
Atty. Docket: 114596-30-0126BS
Customer No. 68536

Confirmation No.: 7298

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on November 24, 2008 as Express Mail, Post Office to Addressee, Express Mail Label No. EH 470 710 396 US, in an envelope with sufficient postage addressed to Mail Stop 2100 SPRE Shop, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Handwritten signature of the Commissioner for Patents.

REQUEST FOR CORRECTION, WITHDRAWAL OF ABANDONMENT, PROCEDURALLY-COMPLETE EXAMINATION, AND ENFORCEMENT OF GOOD GUIDANCE

Mail Stop 2100 SPRE Shop
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant calls the Office's attention to a number of defects in the Office papers of September 22 and 23, 2008, and requests that:

- (a) The "Decision" of September 22, 2008 should be vacated, because it was issued in violation of Presidential instructions to agencies, and outside the authority delegated by the Undersecretary to the T.C. Director.
(b) The Notice of Abandonment of September 23, 2008 should be vacated because no Office Action was outstanding to which any reply was due.
(c) This application and other related applications should be reassigned to a different examiner. This is a renewal of a request that has been presented several times and has now been pending for nearly two years.
(d) Once item (c) is decided, the application should be examined as provided by 37 C.F.R. § 1.104 and MPEP Chapters 700 and 2100.

114596-30-0126BS S/N 09/672,841

I. Background

An incomplete Office Action was issued April 5, 2007. As will be discussed further below, the April 2007 "Office Action" contains a number of errors, mostly omissions of components required under 37 C.F.R. § 1.104(c) and MPEP Chapter 2100.

Applicant timely filed a request under MPEP § 710.06 requesting correction of those errors and omissions, on July 4, 2007. Applicant's MPEP § 710.06 request does not raise issues relating to "premature final rejection" or 37 C.F.R. § 1.104(a).

In a paper of September 22, 2008, captioned "Decision on Petition to Withdraw the Finality of an Office Action," the Office responds by noting that the Office paper of April 2007 complied with § 1.104(a). This "Decision" does not address the issues arising under § 1.104(c)(2) or MPEP Chapter 2100 that were raised in the July 4, 2007 MPEP § 710.06 request.

After this decision, the Office acted with uncharacteristic haste: the next day, September 23, 2008, the Office issued a Notice of Abandonment.

II. First Error: This is a Request Under MPEP § 710.06, not a Petition

The "Decision" of September 22, 2008, at page 1, states that "The Request under MPEP 710.06 is treated as a petition under 37 CFR 1.181..." The "Decision" states no basis for recharacterizing Applicant's MPEP § 710.06 request from MPEP § 710.06 to § 1.181. Applicant's attorney is unaware of any law that would permit the Office to unilaterally recharacterize a paper filed under a specific provision into something else that it is not.

Applicant's July 4, 2007 MPEP § 710.06 request is clearly captioned a "Request for Completion of Office Action Pursuant to MPEP § 710.06." Applicant's July 4, 2007 MPEP § 710.06 request asks for precisely the kinds of corrections provided by § 710.06, "explaining the references more explicitly or giving the reasons more fully." The July 4, 2007 MPEP § 710.06 request was filed in EFS as "Applicant Arguments/Remarks Made in an Amendment," which would have directed it to the correct place, the examiner.

It is clearly not a petition. Neither the word "petition" nor any citation to 37 C.F.R. § 1.181 is used in the July 4, 2007 MPEP § 710.06 request.¹

The Office states no basis for recharacterizing it as a petition, or redirecting it from the examiner to the SPRE. This action of the Office was error.

An example of a proper Office action in response to a request under MPEP § 710.06 is illustrated at 10/023,241. A request was filed September 4, 2007, and a new Office Action (non-final) was mailed October 15, 2007.

This application has been pending for over eight years. As Applicant noted in Applicant's MPEP § 710.06 request, the dominant factor in the extraordinary delays has been the examiner's consistent failure, and occasionally expressly stated (see Exhibit A), refusal to honor PTO guidance and to follow PTO procedures. When both sides follow the written procedures, it is easy to reach an agreement and move an application forward. However, when the PTO ignores written procedures, or makes up new procedures out of the blue, forward progress is impossible. Applicant respectfully urges that the role of a T.C. Director is to ensure compliance with rules and guidance, not to spin things further out of control by improvising new procedures.

III. Second Error: Applicant's MPEP § 710.06 request was timely

At page 7, the "Decision" of September 22, 2007 states that Applicant's July 4, 2007 MPEP § 710.06 request is denied as untimely, because not filed within two months. The "Decision" is wrong.

¹ It is gratifying that the Office now recognizes that issues relating to rejections of claims may be petitionable subject matter, if the relief requested is the procedural or supervisory relief that the Board of Patent Appeals cannot grant (rather than the substantive determination of patentability that is the exclusively within the jurisdiction of the Board), or if the issues arise under procedural guidance in the MPEP that are not within the Board's subject matter jurisdiction. This of course is the only possible result under January 2007 instructions from the President to all agencies. Executive Office of the President, "Final Bulletin for Agency Good Guidance Practices," OMB Memorandum M-07-07, <http://www.whitehouse.gov/omb/memoranda/fy2007/m07-07.pdf> (Jan. 18, 2007), 72 Fed. Reg. 3432 (Jan. 25, 2007); and "Implementation of Executive Order 13422 (amending Executive Order 12866) and the OMB Bulletin on Good Guidance Practices," OMB Memorandum M-07-13, <http://www.whitehouse.gov/omb/memoranda/fy2007/m07-13.pdf> (April 25, 2007).

MPEP § 710.06 clearly states that a request for a new Office Action is timely any time “within the period for reply set in the Office action,” in this case, three months. There is no dispute that Applicant’s July 4, 2007 MPEP § 710.06 request was filed within the time specified.

If MPEP § 710.06 sets a three-month deadline for a request, then the July 4, 2007 MPEP § 710.06 request cannot possibly be a petition. Filing within the 3-month deadline was timely. This alone shows that the T.C. Director erred.

IV. Third Error: The September 22, 2008 “Decision” Omitted Consideration of Issues

Even if the July 4, 2007 MPEP § 710.06 request were a petition – which it is not – the September 22, 2008 “Decision” erred by failing to decide the issues presented. “In accordance with the Administrative Procedure Act, the agency must assure that an applicant’s petition is fully and fairly treated at the administrative level...” *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005).

First, Applicant’s MPEP § 710.06 request presented 33 issues. Taken at its most generous, the September 22, 2008 “Decision” addresses only four. By failing to treat the July 4, 2007 MPEP § 710.06 request “fully,” the T.C. Director violated the Administrative Procedure Act.

Second, the errors noted in Applicant’s MPEP § 710.06 request relate to breaches of 37 C.F.R. § 1.104(c)(2), failure to “designate portions relied on” or “explain their pertinence.” No error arising under § 1.104(a) was raised. The “Decision” of September 22, 2008 never discusses any issue arising under § 1.104(c)(2). Instead, it quotes § 1.104(a) in bold and states that the April 2007 Office Action complied with § 1.104(a). Even the minimal analysis of only four issues in the September 22, 2008 “Decision” is totally irrelevant to the issues raised. The September 22, 2008 “Decision” failed to treat the issues presented “fairly,” and thus broke the law.

Items 19-26 are especially clear – the Office Action of April 2007 does not explicitly discuss claims 38 or 41, it only says claims 38 and 41 are “rejected for the same reasons [as] claim 25” and 22. But claims 38 and 41 have a number of claim limitations that are not found in claims 25 and 22. The Office Action cannot possibly be anything but “error,” because Examiner

Ellis failed to address the claim language. The Decision does not explain how the Office Action can be anything else.

Item 32 is also particularly clear: the Office Action of April 2007 is dead silent on "reasonable expectation of success." In April 2007, MPEP §§ 2143 and 2143.02 required such a discussion. Analogous requirements exist in current MPEP § 2143. This factor is mandatory; failure to consider it cannot be anything but "error."

The examiner's papers have been incomplete, and have failed to address relevant and required issues. It is ironic at best that the T.C. Director would dismiss a request for complete examination within the rules by issuing an incomplete paper that failed to address relevant issues and stepped outside the bounds of the law.

V. Fourth Error: The September 22, 2008 "Decision" does not show that the Examiner's April 2007 paper had no error, it merely highlights the errors

The September 22, 2008 "Decision" states as follows:

1. Paragraph 10(A). What particular instruction of Ben-Meir '073 corresponds to the "younger instruction" of claim 15?
2. Paragraph 10(B). What particular instruction of Ben-Meir '073 corresponds to the "older instruction" of claim 15?
3. Paragraph 10(B). What feature of Ben-Meir '073 corresponds to the claim language "based on"?
4. Paragraph 10(discussion) Claim 15 recites that "partial execution" of a "younger instruction" affects execution of an "older instruction." The Office Action is not clear, but suggests that perhaps the "older instruction" corresponds to "all instruction that occur after the store." If this interpretation of the Action is correct, an explanation will be required of any sense that instructions "after" are thought to be "older."

With respect to the questions/issues reproduced above relating to claim 15, it is noted that examiner has mapped the limitations of "younger instruction", "older instruction", etc. to specific portions of the prior art cited, and has provided an explanation as can be seen from a reproduction of the rejection of claim 15 below:

Ben-Meir et al. taught (e.g. see figs. 1-7) the invention as claimed (as per claim 15), including a data processing ("DP") system comprising:
A. partially executing (col. 4 lines 56-67, col. 16 lines 29-44) a younger instruction in a portion (fig. 1, 130, 140, 141, 142, 143) of an instruction pipeline (fig. 3, col. 4 lines 6-9) above an issue buffer (fig. 1, 180) of a computer, and;
B. based on that partial execution (col. 7 lines 13-22, col. 16 lines 14-20), preventing completion of an instruction older than the younger instruction (col. 7 lines 19-28, col. 16 lines 19-29) Based upon the data obtained from the "partial execution" (243,443.1 ... 443.4) the detection of a match of that data with a store operation results in flushing all instructions from the pipeline that occur after the store (col. 7 lines 22-28). Therefore, a younger instruction whose address fields (243,443.1 ... 443.4) match a store address will cancel not only itself, but all other instructions in the pipeline, including instructions older than itself and younger than the store operation that generated the matching address.

The "Decision" itself makes clear that the omissions raised in Applicant's MPEP § 710.06 request are genuine errors: the T.C. Director was unable to identify any "pertinence" of the reference to the particular claim language questioned based on the incomplete discussion in the Office Action. If the pertinence is "apparent" as required by § 1.104(c)(2), the T.C. Director should have no difficulty providing "clearly explained" answers to all 31 questions, as required by 37 C.F.R. § 1.104(c)(2).

If one compares the Office Action to the Ben-Meir reference, it is indisputable that some parts of the claim language have been considered by the examiner, and some have not – or at least no "pertinence" of the "designated portions" of the references to the claim language is "clearly explained" as required by 37 C.F.R. § 1.104(c)(2). Note that the particular claim language questioned in the MPEP § 710.06 request has no "mapping," as highlighted above. The Action "maps" the "portion of an instruction pipeline," but not the "younger instruction." The Action "maps" the "preventing completion" of some unspecified instruction, but not the "older instruction" of the claim. The Office Action never shows the claim's interrelationships among the "older instruction," "younger instruction," and "preventing."

Note that at this procedural point, a wrong explanation from the examiner would be procedurally adequate to meet 37 C.F.R. § 1.104(c)(2). The only thing § 1.104(c)(2) forbids is silence. Replying to a wrong statement is easy; reading an examiner's mind is not.

The September 22, 2008 "Decision" suggests "a disagreement between the examiner and applicant's counsel in the interpretation of the claim language and the prior art." If that were true, this attorney would proceed to reply or appeal without delay. The problem is that Examiner Ellis refuses to state his positions, and refuses to precisely address the claim language. No disagreement yet exists, because there can be no disagreement when one party is silent. When an examiner plays "hide the ball" no progress is possible.

VI. Abandonment was the product of PTO errors and should be withdrawn

The September 23, 2008 Notice of Abandonment is in error.

First, the April 5, 2007 Office Action was void when issued. As noted above, the PTO has never disputed that at least 27 of the errors noted in Applicant's MPEP § 710.06 request are breaches of either 37 C.F.R. § 1.104(c)(2) or MPEP §§ 2143-2143.03. When an agency manual

sets requirements for agency personnel, an agency "action" in violation of that manual is void and without effect. *Vitarelli v. Seaton*, 359 U.S. 535, 545 (1959) (when an agency acts contrary to its own manual, the resulting action is "illegal and of no effect," emphasis added); *Service v. Dulles*, 354 U.S. 363, 374-76 (1957) (unpublished manual was binding, and violation of that manual was ground for setting aside agency action); *New England Tank Industries of New Hampshire v. U.S.*, 861 F.2d 685, 688, 694 (Fed. Cir. 1988).

The Executive Office of the President recently sent instructions to all agencies reminding them of their long-standing obligations to follow their own guidance manuals. (Exhibit B). The April 2007 paper violated the President's instructions, and was therefore outside the scope of authority of a member of the executive branch, and was therefore void on the day it was issued.

Second, the July 4, 2007 MPEP § 710.06 request tolled any period for reply, until the Action is reissued with a new date for reply.

Third, the PTO has not obtained an OMB Control Number for the procedures currently at issue, and failed to display the notice required by the Paperwork Reduction Act. Under 44 U.S.C. § 3512, "no person shall be subject to any penalty for failing to comply" with any requirements that the PTO may believe to apply.

Fourth, Applicant's July 2008 MPEP § 710.06 request is at the very least a *bona fide* reply to a non-final Office Action of April 2007. It was timely filed. Even if the PTO had addressed every single issue in the MPEP § 710.06 request, and had stated its disagreement, the proper next action of the PTO would have been a Notice of Non-Compliant Amendment or Final Office Action. The PTO acted outside its procedures to create an improper abandonment. Abandonment should be withdrawn.

VII. Preliminary Issue: The June 29, 2004 paper has already been "accepted as timely filed"

As the "Decision" itself notes, the June 29, 2004 paper was "accepted as timely filed." Exactly the documents that the PTO requested to establish timely mailing were tendered in October 2006, and they were accepted. No further "clarification of the record" is necessary.

Further, this duplicative request for information does not "display a valid control number assigned by the Director" of the Office of Management and Budget as required by 44 U.S.C.

§ 3512(a)(1), and does not include the language required by 44 U.S.C. § 3512(a)(2). Duplicative requests for information, after the facts are already established, is barred by 44 U.S.C.

§ 3506(c)(3)(B). For three separate reasons, under 44 U.S.C. § 3512, the PTO may not require further duplicative submission of this information, and may not impose any form of penalty when Applicant declines the Office's request.

VIII. Renewal of request for new examiner

Exhibit A is yet another copy of a letter requesting that this application be reassigned to another examiner. This request is within the jurisdiction of the T.C. Director to decide. Even though this letter has been filed several times over two years, the PTO has failed to act on it. This violates 5 U.S.C. § 555(b) ("... within a reasonable time, each agency shall proceed to conclude a matter presented to it.").

If this request is denied and the application is returned to Examiner Ellis, Applicant requests that he be explicitly instructed that he must follow MPEP guidance, as discussed in the President's instructions, provided as Exhibit B.


IX. Conclusion

Applicant again requests a corrected and complete Office Action, fully compliant with MPEP § 1.104(c) and MPEP Chapter 2100. If no such Action can be prepared, the application should issue in due course. The PTO is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3219, Order No. 114596-30-0126BS.

Respectfully submitted,

LAW OFFICES OF DONNA L. ANGOTTI

Dated: November 24, 2008

By: 
Donna L. Angotti
Registration No. 32,679

LAW OFFICES OF DONNA ANGOTTI
140 Broadway, Suite 4600
New York, NY 10005
(212) 858-7515
(212) 858-7750 (FAX)



Exhibit A

Request to Reassign the Following Applications to an Examiner who will Follow the Law

09/385,394

09/672,841

11/003,768

11/004,729

WILLKIE FARR & GALLAGHER LLP

787 Seventh Avenue
New York, NY 10019-6099
Tel: 212 728 8000
Fax: 212 728 8111

January 19, 2007

Hon. John Doll, Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-4150

Re: Complaint against Examiner Richard Ellis, A.U. 2183

Dear Commissioner Doll:

I write to request that several patent applications be reassigned from Examiner Richard Ellis in Art Unit 2183 to another examiner. His consistent technological error and written refusal to follow the Office's procedural instructions have imposed at least \$100,000 in excess costs for five applications, imposed years of delay, and created immense "rework" burdens on the Office. This letter focuses on issues that have arisen in two sample applications among the five.

Examiner Ellis' papers reflect a lack of basic technological competence. Dr. David Levine, who teaches undergraduate computer science classes and supervises junior engineers in industry, has submitted several declarations in response to Examiner Ellis' work. Enclosed is a letter from Dr. Levine evaluating Examiner Ellis' work: Examiner Ellis lacks "an acceptable level of understanding of ... core concepts," lacks "even the slightest knowledge in the field," is unfamiliar with "elementary undergraduate concepts," and could not meet "minimal requirements" to "be involved [in the computer arts] at even the most junior level." Dr. Levine observes that positions reiterated by Examiner Ellis in multiple papers are "pure nonsense." Further observations by Dr. Levine are set forth in affidavits in 09/626,325 (December 14, 2005) and 09/385,394 (July 3, 2003).

More concerning is Examiner Ellis' repeated and consistent failure to observe Office procedures. More than once he has stated in writing that he refuses to follow the Office's written instructions or Office precedent, and has authority to substitute his personal opinion. His work is replete with sins of omission – where Office procedures require an examiner to make showings or set out a position "clearly," Examiner Ellis is often silent:

- A sizeable fraction of his discussions of independent claims under § 102 or § 103 *totally omit* one or more claim limitations. His analysis is not faulty; he is simply *dead silent*, which denies an applicant any "clear issue developed for appeal." When the omission is brought to his attention, he does not correct his own error in a non-final Office Action (as most other examiners do, and as

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NEW YORK WASHINGTON PARIS LONDON MILAN ROME FRANKFURT BRUSSELS

required by the definition of “new ground of rejection”). Instead, he issues a final Office Action that either (a) ignores the same claim language *again*, or (b) he advances a new and implausible explanation of the type discussed in Dr. Levine’s letter. Both techniques are apparently directed solely at avoiding introduction of a new reference.

- His papers regularly omit *entire claims* except to make *pro forma* statements that they are rejected for unspecified reasons, with no analysis or showings. See, for example, non-treatment of claim 87 in 09/385,394, Action of February 2004; *see also* 09/385,394, first Action of 2/20/2002 (rejecting 87 claims in three pages of discussion).
- Examiner Ellis’ papers consistently fail to timely “answer all material traversed.”
- His practice, so consistently that it appears to be a deliberate effort to game the final rejection rules, is to play “hide the ball,” and to only begin *bona fide* examination and disclosure of his position in *post-final advisory actions*. See, e.g., 09/385,394 (five advisory actions in spring 2003 providing the first discussion of claim language and explanation of his fanciful understanding of how computers work, and then denying entry to an affidavit responding to positions first stated in these post-final papers); 09/385,394, advisory Action of 2/14/05, ¶ 3, third paragraph (expressly admitting that the Office Action of October 2004 was “confusing” because the examiner had erroneously copied an irrelevant paragraph from a prior document, and providing first disclosure of examiner’s view on an issue, yet maintaining finality).

Examiner Ellis frequently disregards procedural rules and definitions that are designed to ensure complete consideration to the merits, and efficient, compact prosecution:

- Technological issues cannot be resolved based on inexpensively-obtained public documents; instead, any progress before Examiner Ellis requires a formal affidavit of an expert, at a cost of \$5 - 10,000. For example, when roughly a dozen dictionaries, treatises, and the like – including those originally cited by Examiner Ellis – disagreed with his conclusion, he maintained his position based on a single source, *a source that he acknowledged is wrong and needs to be corrected*. 09/626,325, Office Action of 10/14/2005, ¶ 9 (conceding that the Microsoft dictionary needs to be corrected, yet relying on it anyway). See 09/626,325, dispute about the term “thread” extending from March, 2004 to January 2006.
- MPEP § 2143.02 requires that any obviousness rejection include a showing of “reasonable expectation of success,” and MPEP § 706(I) requires that standards be uniform “throughout the Office.” Examiner Ellis disagrees with the MPEP – in his view, he has authority to apply a different patentability standard. 09/385,394, Action of 2/10/2003, ¶ 4, second paragraph.
- His papers refuse to accept the courts’ and Board’s definition of “new ground of rejection.” Instead, citing no authority but his own opinion, and making no attempt to distinguish contrary authority, his papers insist that new explanations of new issues late in prosecution are not “new grounds.”

Hon. John Doll, Commissioner for Patents
January 19, 2007
Page 3

A number of smaller issues further demonstrate pervasive neglect and inability to comply with Office policies and procedures:

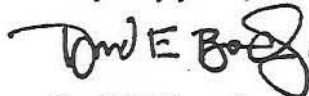
- He amended the title of an application without prior approval, violating MPEP § 606.01, leading to publication with a misleading title. *See* 09/626,325, paper of April 20, 2006.
- Examiner Ellis insisted that an application could only claim benefit from a single priority application; priority benefit could not be obtained from a "grandparent." 09/385,394, Advisory Action of 2/15/2005, page 3.
- There have been a huge number of groundless objections to declarations, drawings, and the like, suggesting an improper purpose, such as "to cause unnecessary delay or needless increase in the cost of prosecution."

These applications demonstrate the point made in many of the public comments on the PTO's proposed "continuation" rules: the underlying cause for a large portion (perhaps a majority) of the PTO's "rework" problem is examiner error – either omission or failure to observe PTO procedural requirements that are necessary to compact and correct substantive examination. Examiner Ellis' omissions and procedural breaches may or may not be intentional, but the practical effect is indistinguishable from deliberate obstruction. These omissions and breaches create extraordinary costs for applicants and for the PTO. Such costs should be borne by those that create them, not by applicants.

Kindly assign applications 09/385,394, 09/672,841 and 11/004,729 to another examiner. (The other two of the five applications pending before Examiner Ellis have been allowed, though after six year pendencies.) Kindly remind Examiner Ellis that the only reason for his continued employment is to assist in carrying out the Commissioner's oath to "take care that the laws be faithfully executed," including the procedural laws that govern examination.

Please feel free to call me at (212) 294-7848 to discuss any of the above issues. The correspondence address for these applications will be changed in the near future to The Law Offices of Donna Angotti, 140 Broadway, Suite 4600, New York, NY 10005. Any written reply may be directed to my attention at that address.

Very truly yours,



David E. Boundy

Encl.

David R. Levine, Ph.D.
Lexington, Massachusetts
c/o David Boundy
Willkie Farr & Gallagher LLP
787 Seventh Ave
New York, NY 10019

January 14, 2006

T.C. Director Jack Harvey and SPE Eddie Chan
Art Unit 2183
United States Patent and Trademark Office
P.O. Box 1450
Arlington, VA 22313

To whom it may concern:

I write in support of Mr. Boundy's request that certain patent applications be assigned to another examiner.

Recently, I have provided technological declarations in two patent applications. In both cases, my primary task was to disentangle a web of confusion created by the examiner – who in both cases happened to be Examiner Richard Ellis.

In both cases, I was surprised at the nature and magnitude of the examiner's confusion. Some of the issues relate to material at the very core of the field, material that one must clearly understand to be involved at even the most junior level. I was struck by the examiner's lack of critical evaluation of the materials or acceptable level of understanding of these core concepts. In my professional opinion, no one of reasonable competence would advance the positions to which I responded, or base them on the flimsy premises that I observed. I would not expect someone of competence and maturity to maintain such positions after being questioned on them, as I observed in Examiner Ellis' papers.

My Affidavit of July 3, 2003, in App. Ser. No. 09/385,394, addressed Examiner Ellis' position that data stored left-to-right and data stored right-to-left are interchangeable, and can be freely mixed, without accounting for the differences in the way they are stored. Examiner Ellis' view was that the number "4321" was equal to the number "1234." This is an issue with a clear "right answer," and the absurdity in Examiner Ellis' view is clearly apparent to anyone with even the slightest knowledge of the field and the slightest open mind. It was quite surprising to me that Examiner Ellis had adhered to his impossible answer – on such a self-evident point – for several rounds of papers.

I also provided a declaration in App. Ser. No. 09/626,325, that was filed as an exhibit to the Petition of December 14, 2005. The depth of confusion in the examiner's comments – and the inappropriateness of his argument – were even more pronounced. “Thread,” “process,” and “concurrency” are elementary undergraduate concepts. An understanding of these concepts, and the ability to clearly understand where they apply and where they do not, is a minimal requirement in the area of Operating Systems, multiprocessing, computer architecture, and instruction processing. Examiner Ellis' papers do not convey that level of understanding. The multiple levels of inadequacy here are distressing:

- Unfamiliarity with – or refusal to apply – key concepts that lie at the heart of nearly every design in the arts of computer architecture, instruction processing, operating systems, and programming languages.
- Use of inappropriate sources, and failure to check alternate sources to verify and clarify the information, especially after his initial position was questioned, and alternate sources were placed before him. (This is particularly important in Computer Science, where there often is no single recognized authority on terminology.)
- Failure to recognize the proper conditions for the use of transitive reasoning. “Fuzzy” definitions directed to non-specialists (such as those used by Examiner Ellis) may be helpful in general overview discussions, but can be seriously misleading in the context of precise analysis. When we find fuzzy statements that “A is a kind of B” and “B is a kind of C”, we cannot blindly make a precise assertion that “A is a kind of C”. The cumulative effect of several “fuzzy” steps in a chain of reasoning leads only to an unreliable conclusion. His result was pure nonsense.
- Unwillingness to accept assistance and clarification, with the effect of adding extra levels of confusion at each turn.
- His assertion that “everything is performed in parallel at the same time” and therefore no scheduling is required (Examiner's paper of 10/14/2005 ¶ 13) is striking. Every undergraduate knows that any given part of a computer can only do one thing at a time. Essentially every resource of every computer must be scheduled carefully, any time it is active. Scheduling and timing is the single most pervasive problem in computer architecture and instruction processing, and is the dominant factor in most design decisions. Examiner Ellis' refusal to even acknowledge, let alone apply, this most basic principle is inexplicable.

These points are discussed in more detail in my Declaration. I would not expect to see this level of work in my university students or members of my organization who wished to continue in good standing.

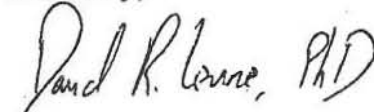
The level of competence demonstrated in Examiner Ellis' papers is beneficial neither to the Patent Office nor to those who have to deal with it, and suggests a

high risk that these applications are not being examined with sufficient care to protect the rights of the public.

Furthermore, Mr. Boundy informs me that the law requires an examiner to articulate his views clearly enough that one of ordinary skill would have reasonable notice of an examiner's view and opportunity to respond. When the examiner has pursued such a tortured chain of reasoning as I've observed here, and has departed so strikingly from commonly understood users of terms in the art, it becomes difficult at best to understand what position he has taken. In one instance, the source of his erroneous thinking was not apparent until his post-final papers. In respect to meeting the requirement for clear articulation of his position, Examiner Ellis' work appears inadequate

I join with Mr. Boundy's request that ATI's applications currently assigned to Examiner Ellis be assigned to another examiner.

Sincerely,

A handwritten signature in cursive script that reads "David R. Levine, Ph.D." The signature is written in dark ink and is positioned above the typed name.

David R. Levine, Ph.D.



Exhibit B

Executive Office of the President, "Final Bulletin for Agency Good Guidance Practices"



THE DIRECTOR

EXECUTIVE OFFICE OF THE PRESIDENT
OFFICE OF MANAGEMENT AND BUDGET
WASHINGTON, D.C. 20503

January 18, 2007

M-07-07

MEMORANDUM FOR THE HEADS OF EXECUTIVE DEPARTMENTS
AND AGENCIES

FROM: Rob Portman *Rob Portman*

SUBJECT: Issuance of OMB's "Final Bulletin for Agency Good Guidance Practices"

The Office of Management and Budget (OMB) today issued a bulletin applicable to all departments and agencies entitled "Final Bulletin for Agency Good Guidance Practices." This Bulletin establishes policies and procedures for the development, issuance, and use of significant guidance documents by Executive Branch departments and agencies and is intended to increase the quality and transparency of agency guidance practices and the significant guidance documents produced through them.

This Bulletin is one aspect of a larger OMB effort to ensure and maximize the quality, utility, objectivity and integrity of information disseminated by Federal agencies, pursuant to the Information Quality Act.

This Bulletin has benefited from extensive public and agency comments received on a draft released by OMB on November 23, 2005.

If your staff has questions about this guidance, please contact [REDACTED]

Attachment



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,841	09/28/2000	T.R. RAMESH	114596-30-0126BS	7298

38492 7590 09/23/2008
WILLKIE FARR & GALLAGHER LLP
INTELLECTUAL PROPERTY LEGAL ASSISTANTS
787 SEVENTH AVE
NEW YORK, NY 10019-6099

EXAMINER

ELJIS, RICHARD L.

ART UNIT	PAPER NUMBER
2183	

MAIL DATE	DELIVERY MODE
09/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Abandonment	Application No.	Applicant(s)	
	09/672,841	RAMESH ET AL.	
	Examiner	Art Unit	
	Richard Ellis	2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 05 April 2007.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.

2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.

3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.

4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. The reason(s) below:

/Richard Ellis/
Primary Examiner, Art Unit 2183

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,841	09/28/2000	T.R. RAMESH	114596-30-0126BS	7298

38492 7590 09/22/2008
WILLKIE FARR & GALLAGHER LLP
INTELLECTUAL PROPERTY LEGAL ASSISTANTS
787 SEVENTH AVE
NEW YORK, NY 10019-6099

EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

MAIL DATE DELIVERY MODE

09/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

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SEP 22 2008

TECHNOLOGY CENTER 2100

WILLKIE FARR & GALLAGHER LLP
INTELLECTUAL PROPERTY LEGAL ASSISTANTS
787 SEVENTH AVE
NEW YORK NY 10019-6099

In re Application of: RAMESH, et al.
Application No. 09/672841
Attorney Docket: 114596-30-0126BS
Filed: 28 September 2000
For: VALIDATION OF MEMORY
REFERENCES

DECISION ON PETITION TO
WITHDRAW THE FINALITY OF
AN OFFICE ACTION

This paper provides the decision on the "Request for Completion of Office Action pursuant to MPEP 710.06" filed on July 4, 2007. The Request under MPEP 710.06 is treated as a petition under 37 CFR 1.181 to invoke Supervisory Authority and require examiner to provide a new office action.

The Petition is **DENIED**.

Applicable Prosecution History

September 28, 2000	Instant application filed.
March 29, 2004	Non-Final Office action (FAOM) mailed.
November 7, 2005	A paper styled "Supplement to Response to Office Action" is filed. The paper states "This is a supplement to the Response to Office Action filed June 29, 2004", amends claims 25 and 53, and requests replacement of a paragraph in the remarks/argument section of the June 29, 2004 response.
October 13, 2006	Response to Non-Final action of March 29, 2004, and amendment received, with a certificate of mailing on June 29, 2004. The response was accepted as timely.
April 5, 2007	Non-Final Office action mailed.

Application SN 09/672,841
Decision on Petition
July 4, 2007

Page 2 of 10

Instant petition filed under MPEP 710.06, complaining against the Examiner of record, and requesting a new office action.

RELIEF REQUESTED

Petitioner requests that the Examiner of record examine the application completely and provide a new more complete office action restarting applicant's period for response.

RULES, LAWS & PROCEDURES

37 CFR § 1.181 (f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 710.06 Situations When Reply Period Is Reset or Restarted, states:

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP §707.05(g) for the manner of correcting the record where there has been an erroneous citation.

....
A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

37 CFR §1.104 Nature of examination.

(a) Examiner's action .

...

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and **such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.**

(c) Rejection of claims

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 CFR §1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application *which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court*; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644. (*Emphasis added*)

MPEP § 1201 states in relevant part:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to

relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 703.11(c) states in relevant part:

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides prima facie evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

DECISION

I. Preliminary Issue

A review of the file reveals that no response to the March 29, 2004 Office action was timely matched to the application file, although an internal Office record indicated an incoming amendment for this application on July 1, 2004. A copy of an amendment bearing a certificate of mailing date of June 29, 2004 with each page carrying a legend "Amendment Dated June 29, 2004 - Response to Office of March 29, 2004" was received in the USPTO on October 13, 2006 and was accepted as timely filed.

Applicant is requested to help clarify the record and establish that the paper date-stamped October 13, 2006 was a resubmission of the paper previously submitted on June 29, 2004. To this end, applicant may submit a post card receipt stamped by the Office showing that the original was received in the Office in a timely fashion or absent that, a statement attesting to the submission of the paper as per MPEP 711.03(c)B and 37 CFR 1.8(b)(3).

II. Petition for a New Office Action

a. Petitioner's position

Applicant filed the instant petition on July 4, 2007, (a) requesting a new office action to correct the action of mail date April 5, 2007, and (b) to reset the period for reply based on the reissued office action. Applicant relies on 37 CFR 1.104(c)(2) and MPEP 710.06 (reproduced above) as the basis of the request. Petitioner characterizes the Office action as incomplete and contends that MPEP 710.06 requires the examiner to prepare a new action restarting the period for response. Applicant advises the examiner as to the proposed format a new action should take and provides a set of 33 inquiries that, in petitioner's view, the examiner must address for the action to be properly complete.

b. Relevant Prosecution History

A review of the prosecution history in the instant application, reveals the following:

1. Applicant presented 63 claims for examination: 10 independent, and 53 dependent claims.
2. In the first Office action on the merits, mailed on March 29, 2004, the Examiner, rejected various claims under statutory bases as listed below and also identified allowable subject matter in other claims.

Specifically, the examiner rejected:

- **Claim 31:** Under 35 USC 112, Second paragraph, to correct the dependency of claim 31.
- **Claims 1-2, 12-16, 18, 22-29, 34, 35-36, 38-42, 44-46, and 50-51:** Under 35 USC 102(b), as being anticipated by Fielden (US patent 5,802,337).
- **Claims 3-11, 17, 19-20, 30-31, 33, 37, 43, 47, 49, 53-57, and 59-63:** Under 35 USC 103(a), as being unpatentable over Fielden, U.S. Patent 5,802,337, in view of Intel, Pentium Processor Family Developer's Manual, 1997 ("Intel PPFDM") and Intel, Pentium Processor Family Developer's Manual, Volume 3: Architecture and Programming Manual, 1995 ("Intel V3").

Claims 21, 32, 48, 52, and 58 were indicated to have allowable subject matter.

3. Applicant responded on June 29, 2004, (which was received by the office only on October 13, 2006, and accepted as timely filed) arguing the merits of rejection of the independent claims 1, 12, 15, 22, 25, 35, 38, 41, 53, and 60, and stating that the dependent claims recite additional features that distinguish over the art. Applicant filed a supplemental response on November 7, 2005, to fix a deficiency in applicant's response of June 29, 04. Claims 25, 31, 53, and 60 were amended in this supplemental amendment.

4. A second non-final office action was mailed on April 5, 2007, in which the examiner rejected:

- **Claims 14 and 57:** Under 35 USC 112, Second paragraph for lacking antecedent basis for some terms used in the claims.
- **Claims 1 and 10-12:** Under 35 USC 102(b), as being anticipated by Webb et al. (US patent 5,790,844).
- **Claims 15, 18-20, 21-25, 27-32, 34-36, 38-41, 44, 45-48, and 50:** Under 35 USC 102(b) as being clearly anticipated by Ben-Meir et al., (US Patent 5,826,073).
- **Claims 2 and 13-14:** Under 35 USC 103(a) as being unpatentable over Webb et al. (US patent 5,790,844), in view of Ben-Meir et al., (US Patent 5,826,073).
- **Claims 3-9:** Under 35 USC 103(a) as being unpatentable over Webb et al. (US patent 5,790,844).
- **Claims 16, 26, 33, 42, and 49:** Under 35 USC 103(a) as being unpatentable over Ben-Meir et al., (US Patent 5,826,073), in view of Webb et al. (US patent 5,790,844).

- **Claims 17, 37, and 43:** Under 35 USC 103(a) as being unpatentable over Ben-Meir et al., (US Patent 5,826,073), in view of Blomgren et al. (US patent 5,276,825).
- **Claims 53, 56-59, 60, and 63:** Under 35 USC 103(a) as being unpatentable over Blomgren et al. (US patent 5,276,825), in view of FOLDOC definition of "RISC" (June 3, 1077).
- **Claim 61:** Under 35 USC 103(a) as being unpatentable over Blomgren et al. (US patent 5,276,825), in view of FOLDOC definition of "RISC" (June 3, 1077), and further in view of Webb et al. (US patent 5,790,844).
- **Claims 54-55, and 62:** Under 35 USC 103(a) as being unpatentable over Blomgren et al. (US patent 5,276,825), in view of FOLDOC definition of "RISC" (June 3, 1077), and further in view of Ben-Meir et al., (US Patent 5,826,073).

Claims 51 and 52 were indicated to have allowable subject matter.

5. Applicant filed the instant petition, requesting a new office action and that the period for reply be reset based on the mail date of the reissued office action.

c. Timeliness of the Petition

Applicant's paper denominated as a "Request for Completion of Office Action" is a petition for supervisory review requesting that the examiner be directed to take particular action.

Under 37 CFR 1.181(f) (cited above) a petition for supervisory review not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Applicant's petition was filed 3 months after the issuance of the Office action complained of. For this reason alone, the petitioner is not entitled to relief.

d. The instant application

Petitioner contends that the Office action as incomplete and requests that the examiner be directed to prepare and issue a corrected action restarting the period for response. To this end, the applicant provides a list of 33 questions that applicant believes must be answered in order for the examination to be deemed complete.

A review of the list indicates that the inquiries posed by petitioner are issues (33 in all) directed to questions of "inadequate explanation" and "hindsight reasoning" in the examiner's rejection. These arguments challenge the adequacy of the rejection based upon

the cited prior art in the office action. For example, here is a list of issues posed by applicant that relate to examiner's rejection of claim 15:

1. Paragraph 10(A). What particular instruction of Ben-Meir '073 corresponds to the "younger instruction" of claim 15?
2. Paragraph 10(B). What particular instruction of Ben-Meir '073 corresponds to the "older instruction" of claim 15?
3. Paragraph 10(B). What feature of Ben-Meir '073 corresponds to the claim language "based on"?
4. Paragraph 10(discussion) Claim 15 recites that "partial execution" of a "younger instruction" affects execution of an "older instruction." The Office Action is not clear, but suggests that perhaps the "older instruction" corresponds to "all instruction that occur after the store." If this interpretation of the Action is correct, an explanation will be required of any sense that instructions "after" are thought to be "older."

With respect to the questions/issues reproduced above relating to claim 15, it is noted that examiner has mapped the limitations of "younger instruction", "older instruction", etc. to specific portions of the prior art cited, and has provided an explanation as can be seen from a reproduction of the rejection of claim 15 below:

Claims 15, 18-20, 21-25, 27-32, 34-36, 38-41, 44, 45-48, and 50 are rejected under 35 USC 102(b) as being clearly anticipated by Ben-Meir et al., U.S. Patent 5,826,073.

Ben-Meir et al. taught (e.g. see figs. 1-7) the invention as claimed (as per claim 15), including a data processing ("DP") system comprising:

- A. partially executing (col. 4 lines 56-67, col. 16 lines 29-44) a **younger instruction** in a portion (fig. 1, 130, 140, 141, 142, 143) of an instruction pipeline (fig. 3, col. 4 lines 6-9) above an issue buffer (fig. 1, 180) of a computer, and;
- B. based on that partial execution (col. 7 lines 13-22, col. 16 lines 14-20), preventing completion of an **instruction older** than the younger instruction (col. 7 lines 19-28, col. 16 lines 19-29) Based upon the data obtained from the "**partial execution**" (243,443.1 ... 443.4) the detection of a match of that data with a store operation results in flushing all instructions from the pipeline that occur after the store (col. 7 lines 22-28). Therefore, a younger instruction whose address fields (243,443.1 ... 443.4) match a store address will cancel not only itself, but all other instructions in the pipeline, including instructions older than itself and younger than the store operation that generated the matching address.

As per applicant's claim language of "**partially executing**", applicant's claim language provides no definition nor guidance as to the scope and/or meaning of that term. Applicant's lengthy specification also provides almost zero guidance (despite being 200 pages in length) as to the intended meaning of "partially executing" within the invention as a whole. At best what can be implied from applicant's nearly silent specification is that the invention aspect that "partially executing ...

above an issue buffer" is intended to cover is the disclosure that applicant's processor performs instruction length determination, boundary determination, and decodes branch target offsets in early pipeline stages, prior to the instruction reaching the issue buffer. Given this partial guidance from the specification, applicant's use of the term "partially executing" in the claim does not relate to "execution" (calculation of the result of the instruction) but instead actually relates to performing various decode steps and pre-steps before the instruction reaches the issue buffer. Accordingly, because Ben-Meir et al. not only teaches that his system performs pre-decoding (col. 4 lines 56-67) but also branch prediction (fig. 1, 143) above his issue buffer (180, elements 130, 131, 140, 141, 142, and 143 are above the issue buffer 180) Ben-Meir et al. does in fact disclose the same functionality as applicant discloses. The only difference is that Ben-Meir et al. utilizes the word "pre-decode" which is a correct term to use, rather than using the misnomer "partially executing" as utilized by applicant's.

Applicant raises similar issues with respect to other claims in the application. All claims have been addressed in the Non-Final action mailed on April 5, 2007, by either a rejection under 35 U.S.C. §§ 112, 35 U.S.C. §§ 102, or 35 U.S.C. §§ 103(a), or an objection indicating allowable subject matter.

Pursuant to 37 CFR 1.104(a), the applicants were notified of the examiner's action. The reasons for rejection/objection were stated in an Office action with information or references given to aid the applicant to judge the propriety of continuing the prosecution.

Further, per MPEP 710.06, Reply period is reset or restarted, only when an office action contains errors "that affects applicants ability to reply to the office action".

A review of the prosecution history and the petition in the instant application points to a disagreement between the examiner and applicant's counsel in the interpretation of the claim language and prior art. The petition does not identify any errors that have affected applicants ability to respond to the office action, as can be seen from the list of issues raised by applicant in the instant petition.

Whether the Examiner has established a prima facie case of obviousness and whether the rejections over art are correct, are appealable issues not subject to petition. Pursuant to 37 CFR §1.181(a) and MPEP §1201, it is noted that the correctness of the art rejection is not subject to review by Petition.


Accordingly, Applicant's petition, and request for a new office action is **DENIED**.

CONCLUSION

Petition is **DENIED**.

The period for response to the Non-Final rejection, mailed on April 5, 2007 continues to run from the mailing date of the action. The application is being forwarded to the examiner for appropriate action.

Any inquiry concerning this decision should be directed to Mano Padmanabhan whose telephone number is [REDACTED].



Jack Harvey, Director
Technology Center 2100
Computer Architecture, Software, and Information Security

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/672,841 Confirmation No.: 7298
Applicant: T.R. Ramesh, et al.
Title: VALIDATION OF MEMORY REFERENCES IN A COMPUTER
Filed: September 28, 2000
Art Unit: 2183

Atty. Docket: 114596-30-000126
Customer No. 68536

REQUEST FOR COMPLETION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office to errors in the Office's paper of April 5, 2007, and requests (a) that the Office reissue the paper in corrected and completed form, and (b) reset the period for reply to one month from the date of the reissued Office paper.

Applicant notes that there has been a huge amount of "rework" on the applications in this family assigned to Examiner Ellis. Overwhelmingly, this burden on the Office and on the Applicant has been caused by haphazard and incomplete examination. As discussed below, the April 2007 Office Action omits consideration of a huge number of issues, and many others are considered only carelessly. It is a huge waste of the Examiner's time to omit consideration of issues in an independent claim, then write an Action on the independent and all dependent claims, when the independent claim is allowable as it stands, and was rejected simply because of careless examination. Applicant respectfully urges that the Examiner's time will be much more efficiently spent if the Examiner gives careful thought to every word of every claim, and careful consideration to the technological practicality of any modification proposed. Applicant observes that much of the Office's concern for "rework" burdens would disappear if the Examiner would simply examine claims with the thoroughness required by MPEP Chapters 700 and 2100.

As noted elsewhere,¹ Examiner Ellis' unstated technological inferences are often so *outré* that no one of ordinary skill could have understood them until Examiner Ellis lifts the veil and states them on paper. For example, no one of ordinary skill could have imagined that Examiner Ellis believed that binary numbers have the same meaning when read left-to-right or right-to-left, until he provided an explicit explanation for that view in the Advisory Actions of spring 2003 in 09/385,394. Applicant respectfully urges that the Examiner's errors cannot be corrected while the Examiner keeps them hidden under a veil of silence. Applicant asks that any future Office Actions fully convey the Examiner's view, including all assumptions about how computers work, what additional inferences the Examiner imputes beyond the plain wording of the reference, etc.

MPEP § 710.06 was recently amended to provide an appropriate incentive for an examiner to do complete work the first time, because an applicant now has the authority to return defective work product and require that it be redone, with no advancement toward final rejection. Section 710.06 reads as follows, in relevant part:

710.06 Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected.

...

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

Many of the below queries arise under 37 C.F.R. § 1.104(c)(2), which reads as follows, in relevant part:

§ 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on

¹ 09/625,325, Declaration of 12/14/2005; 09/385,394, Declaration of 7/3/2003.

must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

That is, in situations where the reference discloses anything more than or in addition to the invention claimed, as here, Rule 1.104 requires an Office Action must do two things:

(i) “designate” portions as nearly as practicable, and (ii) “clearly explain” the pertinence.

The following numbered questions are keyed to the paragraph numbers of the Office Action. MPEP § 710.06 and Rule 104 requires that the Examiner prepare a corrected Office Action that answers each of the following questions by both “designating” a portion of a reference, and if that portion discusses more than one thing that could correspond to the claim language, specifically identifying one particular one of the things, *e.g.*, by name or reference numeral. For example, question 1 should be answered by preparing a discussion of claim 15 that designates a portion of Ben-Meir '073 as nearly as practicable, and if that portion discusses more than one instruction, identifying which particular instruction is thought to correspond to the “younger instruction” of the claim. Applicant suggests that the most efficient way to proceed would be for the Examiner to prepare a new Action, with the requested new material inserted at the logically relevant point (not in a separate “Response to Applicant Remarks” section unrelated to the existing text – note that there are no “remarks” here, only a request under MPEP § 710.06). Preferably the new material could be underlined so that the difference between the April 2007 incomplete Action and the future completed Action will be clear. It will not be necessary to expressly refer to these questions by number; rather, answers presented in a logically-ordered and coherent record will likely be the most convenient form for all concerned.

Kindly provide a corrected Action that addresses all of the following issues, or allows the relevant claims:

1. Paragraph 10(A). What particular instruction of Ben-Meir '073 corresponds to the “younger instruction” of claim 15?
2. Paragraph 10(B). What particular instruction of Ben-Meir '073 corresponds to the “older instruction” of claim 15?
3. Paragraph 10(B). What feature of Ben-Meir '073 corresponds to the claim language “based on”?
4. Paragraph 10(discussion) Claim 15 recites that “partial execution” of a “younger instruction” affects execution of an “older instruction.” The Office Action is not clear,

- but suggests that perhaps the “older instruction” corresponds to “all instruction that occur after the store.” If this interpretation of the Action is correct, an explanation will be required of any sense that instructions “after” are thought to be “older.”
5. Paragraph 10(discussion) and paragraph 16(B). “Issue buffer” is a known term of art, and so is “scheduler.” Does the Office Action intend to suggest that the terms are interchangeable? Is the Examiner aware of any substantial evidence that permits the two terms to be used in the manner suggested in the Office Action? If not, what other “reason” is there behind the “broadest reasonable interpretation” given the term “issue buffer?”
 6. Paragraph 10(discussion) and paragraph 16(B). Which component of Ben-Meir '073 is thought to correspond to the “issue buffer” of the claims? Which component of Ben-Meir '073 is thought to correspond to the “portion above the issue buffer” or “segment above the issue buffer?” Where is the “above” relationship between the issue buffer and the “above the issue buffer” component suggested in Ben-Meir '073?
 7. Paragraph 10(discussion) and paragraph 16(B). If any relationship between “scheduler 180” of Fig. 1 and “instruction decode” 320 of Fig. 3 is thought to be relevant to the claims, what is that relationship, and what is the basis for it?
 8. Paragraph 10(discussion). How does the Examiner reconcile his view that “execution” means “calculation of the result of the instruction” but “partially executing” means something unrelated to partially “calculating of the result of the instruction?”
 9. Paragraph 11 is not clear. It is not clear what two things are thought to correspond, and what syllogisms are thought to apply. In what sense is a “write into instruction space” a “control transfer instruction?” If Ben-Meir '073 teaches something with respect to “all writes into instruction space,” and this is only a subset of “all instructions,” what is the basis for extending the teaching with respect to only the subset to apply to the entire superset of “all instructions?”
 10. Paragraph 16(B). The Office Action appears to compare a “younger instruction” of claim 22 to ref 444 of Fig. 4. But Fig. 4 shows ref 444 as “address match logic.” Is this the correspondence thought to apply? Without an “explanation” as required by Rule 104(c)(2) for how “logic” and an “instruction” can correspond, no reply is possible.

11. Paragraph 17(A). What precise feature of Ben-Meir '073 is thought to correspond to the "fault" of claim 25? What precise feature of Ben-Meir '073 is thought to correspond to "the younger instruction [faulting]?"
12. Paragraph 17(A). Does the Examiner agree or disagree that Ben-Meir's RISC "instruction decoder 140" (col. 4, lines 32-33) and "x86 instruction decode" 320 of Fig. 3 are two different and essentially unrelated components? How do these two different components relate to claim 25?
13. Paragraph 17(B). What instruction of Ben-Meir corresponds to the "older instruction?"
14. Paragraph 17(B). Does the Action suggest that a "pipeline flush" of Ben-Meir '073 col. 17, lines 3-6, corresponds to "nullifying" both the younger and older instruction as recited in this claim? Because the Action only "designates" with no "explanation," the Action is not clear, in violation of Rule 104(c)(2).
15. Paragraph 17(B). How does a "pipeline flush" correspond to "nullifying an older instruction?" A typical pipeline flush only affects younger instructions. Does the Examiner have any basis to believe Ben-Meir's "pipeline flush" is different? Without the explanation required by Rule 104(c)(2), the Action is not clear, and no reply is possible.
16. Paragraph 17(C). How is Ben-Meir '073 col. 17, lines 3-6 thought to correspond to the claim language "allowing both instructions to be executed by the pipeline?" The relationship between Ben-Meir's "pipeline flush" and "allowing both instructions to be executed" cannot be understood without the "explanation" required by Rule 104(c)(2).
17. Paragraph 17(C). How does Ben-Meir '073 relate to the claim language "with no further interlocking to ensure that neither instruction will prevent completion of the other?" Rule 104(c)(2) requires both a "designation" of a portion as nearly as practicable, and an "explanation."
18. Paragraph 23. How does the language "the earlier segment" of the second paragraph of the body of claim 35 relate to Ben-Meir '073?
19. Paragraph 25. What is the basis for the Office Action's assertion that "claim 38 does not teach or define above the invention claimed in claim 25?" The language is substantially different. At the very least, a new "explanation" is required by Rule 104(c)(2).

20. Paragraph 25. How does Ben-Meir '073 relate to the language of claim 38, "performing a memory protection check?" This language does not appear in claim 25, and without an explanation of the correspondence thought to exist, no reply is possible.
21. Paragraph 25. How does Ben-Meir '073 relate to the language of claim 38, "effective address referenced by a younger of the two instructions?" This language does not appear in claim 25.
22. Paragraph 25. How does Ben-Meir '073 relate to the language of claim 38, "nullifying the effect of an older instruction?"
23. Paragraph 28. What is the basis for the Office Action's assertion that "claim 41 does not teach or define above the invention claimed in claim 22?" The language is substantially different, and the correspondence between Ben-Meir '073 and claim 41 cannot be understood until it is explained.
24. Paragraph 28. How does Ben-Meir '073 relate to the language of claim 41, "performing a memory protection check?" This language does not appear in claim 22.
25. Paragraph 28. How does Ben-Meir '073 relate to the language of claim 41, "effective address referenced by a younger of the two instructions?" This language does not appear in claim 22.
26. Paragraph 28. How does Ben-Meir '073 relate to the language of claim 41, "nullifying the effect of an older instruction?"
27. Paragraph 47(A). As noted in question 5, "issue buffer" is an established term of art. What component of claim 53 is being compared to "issue buffer" of claim 53? Is it the "execution unit" 18 of Blomgren '825? Or something else? What part of Blomgren '825 is "above" the issue buffer and corresponds to the claim? In machines that have both an "execution unit" and an "issue buffer," the execution unit is almost always separate from and below the issue buffer. Does the Examiner have any reason to believe Blomgren '825 is an exception?
28. Paragraph 47(A). Blomgren '825, at col. 2, lines 51-54, describes features that suggest that Blomgren '825 is directed to a CISC processor, not a RISC. Does the Examiner agree or disagree?

29. Paragraph 47(B). How does the claim language “in a RISC computer ... checking a memory segment offset ... against an offset limit of a segment descriptor” relate to any reference? The two concepts “RISC” and “segment” are generally incompatible with each other. Does the Examiner believe that some reference is an exception? Does any reference teach this claim language? If so, where?
30. Paragraph 47(C). Blomgren '825 col. 3, lines 38-42 merely states that certain unspecified “existing logic” is reused. How does the specific language of claim 53, “checking ... a destination address of [a] control transfer ... using the same segment limit checking hardware used ... to check a memory segment offset of memory load and store operations” relate to Blomgren’s unspecified “reuse?”
31. Paragraph 48. The Office Action appears to rely on pure hindsight:: because the Examiner asserts that he sees some possible benefit – even though he is unable to describe how circuits might be arranged to achieve that benefit – he asserts that the invention would have been obvious. But the whole design philosophy of RISC processors is to design instructions without the complexities described in Blomgren '825, so that the attendant pipeline complexities of CISC instruction circuitry can be avoided. The invention relates to a technique for ameliorating the problem, so that CISC instructions can be practically executed in a reasonably “clean” RISC pipeline. Using only knowledge known in the prior art, how would one of ordinary skill have known that it would be desirable to add the complexity of Blomgren’s CISC design to clutter up and thereby slow down a RISC design? Why would that one of ordinary skill have abandoned a basic tenet of RISC design? Why would that one of ordinary skill, working in the field of RISC design, have taken a path that is “taught away” from in traditional RISC design?
32. Paragraph 48. MPEP §§ 2142 and 2143.03 require a *prima facie* discussion of “reasonable expectation of success” of the particular modification proposed for all obviousness rejections. Examiner Ellis has stated in the past that he is exempt from this

requirement. If Examiner Ellis continues to believe this², Applicant requests identification of that exemption in writing.

33. Why would it be obvious to take apart known structures and rearrange them as recited in the claim, given that known structures such as Blomgren's are arranged *very carefully* to achieve performance and correct behavior? If the Examiner is aware of any reference that suggests that components of a computer processor can be snipped apart and reassembled willy-nilly without damaging processor performance or correctness, he is invited to supply that reference. Without that reference, Applicant suggests that it cannot be obvious to destroy an existing set of engineering tradeoffs, without an extraordinary compelling and precise reference teaching precisely a reason for doing so, and how to do so with a reasonable expectation of success.

Applicant requests a corrected Office Action, and if no such Action can be prepared, that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3219, Order No. 114596-30-000126.

Respectfully submitted,

LAW OFFICES OF DONNA L. ANGOTTI

Dated: July 4, 2007

By: /David E. Boundy/

David E. Boundy
Registration No. 36,461
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(212) 858-7515
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² "The standards of patentability applied in the examination of claims must be the same throughout the Office." MPEP § 706(I).

**Appendix 3: Record of a Telephone Call with a Supervisory Examiner
Refusing to Enforce PTO Procedural Guidance**

PATENT

ATTORNEY DOCKET NO. 114596-05-4013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

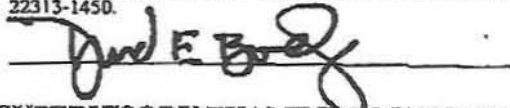
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JUL 24 2005

Serial No.: 09/239,194
Applicant: John S. Yates, Jr., et al.
Title: EXECUTING PROGRAMS OF A FIRST COMPUTER ARCHITECTURE
ON A COMPUTER OF A SECOND ARCHITECTURE
Filed: January 28, 1999
Art Unit: 2127
Examiner: Kenneth Tang
Atty. Docket: 114596-05-4013
Customer No. 38492

Confirmation No.: 9716

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on July 25, 2005 as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



SUMMARY OF INTERVIEW WITH SUPERVISORY EXAMINER MENG AN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned attorney had a telephonic interview with Supervisory Examiner Meng An on Thursday, July 7.

This attorney asked for supervisory intervention regarding the procedural issue of premature final rejection. Supervisory Examiner An stated that she did not consider such issues, that she only considered the merits. Supervisory Examiner An stated that she would not consider granting procedural relief, even if the violation of Patent Office rules complained of was purely procedural.

Supervisory Examiner An stated that she had reviewed the papers and she did not believe that a "new ground of rejection" had been raised. This attorney asked if she had any written rule or publication that supported any definition of "new ground of rejection" that she might be applying. Supervisory Examiner An stated that she did not. This attorney directed Supervisory Examiner An to the definition of "new ground of rejection" stated in *In re Kronig* and *In re Wiechert* and requested that she review the quotes from these cases at pages 1-2 of the Request to Withdraw Finality of Office Action of March 21, 2005. She declined to read that paper. This attorney asked Supervisory Examiner An if she had any basis to disagree with the court's holding in *Wiechert*. She declined to answer the question. This attorney asked Supervisory Examiner An if she had authority to disregard the CCPA. She declined to answer this question.

Summary of Interview with Supervisory Examiner
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FROM MILLIKIE FARR 37FAX DEPT

This attorney twice asked Supervisory Examiner An if she would like to take a couple days to find some written rule that would overrule *Wiechert* or create an exception, or support her view. She stated twice that she would not do so.

Supervisory Examiner An suggested that Applicant should respond in papers. This attorney noted that the position had already been set out in papers, and those papers had been before the examiner twice, once when originally filed in March, once when reconsideration was requested by phone in May. This attorney noted that the examiner's responsive papers had failed to address the procedural issues raised in Applicant's papers, and had failed to provide any requested clarification on the merits. Supervisory Examiner An reiterated that Applicant should respond in papers. This attorney asked Supervisory An why filing the same arguments and requests for clarification a third time would ensure that they received a proper response, when no response had been given them in the past. Supervisory Examiner An declined to answer the question; she simply reiterated her position that a further set of papers should be filed.

Supervisory Examiner An stated that an applicant is responsible for reading the entirety of any reference cited by an examiner (including, apparently, all 144 columns of the Chernoff '028 reference), and that an examiner may freely rely on new portions of an existing reference without introducing a "new ground of rejection." This attorney asked if Supervisory Examiner An knew of any written statement to that effect; Supervisory Examiner An stated that she did not. This attorney invited Supervisory Examiner An to review the quote from *Wiechert* in the Request, which states exactly the opposite of her view. Supervisory Examiner An declined the invitation.

Supervisory Examiner An stated that the issues on the merits should have been addressed by telephone interview with the examiner. This attorney agreed, and noted that an interview with the examiner had been requested on a number of occasions. This attorney noted that the examiner had declined all requests for an interview. We did not reach an agreement for how to proceed on this issue.

Supervisory Examiner An conceded that Examiner Tang's papers were not clear, and yet asserted that clarification of those positions was not a "new ground of rejection." She provided no authority for this definition of "new ground of rejection."

This attorney asked how Supervisory Examiner An made sure that her examiners made correct and fair determinations on the merits, if she enforced no requirements of procedure.


Supervisory Examiner An declined to answer the question; she reiterated that Applicant should file whatever papers were deemed appropriate.

It is believed that this paper occasions no fee. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-05-4013.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: July 25, 2005

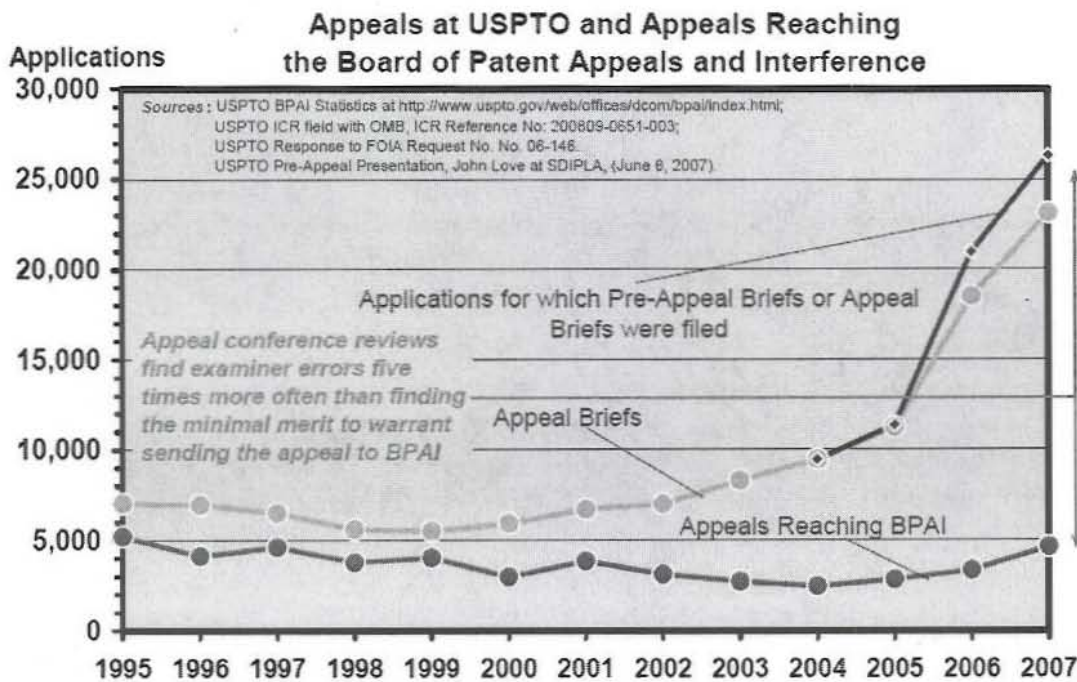
By: 
David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8757
(212) 728-9757 Fax

Appendix 4: The PTO's Alternative Explanations for its Backlog are Contradicted by the PTO's Own Statistical Data

Recently, the PTO's explanation for its backlog is that in 2004 applicants began to file poor quality applications. The PTO offers no reason that applicants would file poor quality applications. Two sets of statistics provided by the PTO itself show that the PTO's assessment is incorrect. It is reasonably clear that the PTO's backlog arises from poor quality rejections of meritorious applications, and the rework that arises when applicants ask the PTO to correct its own mistakes.

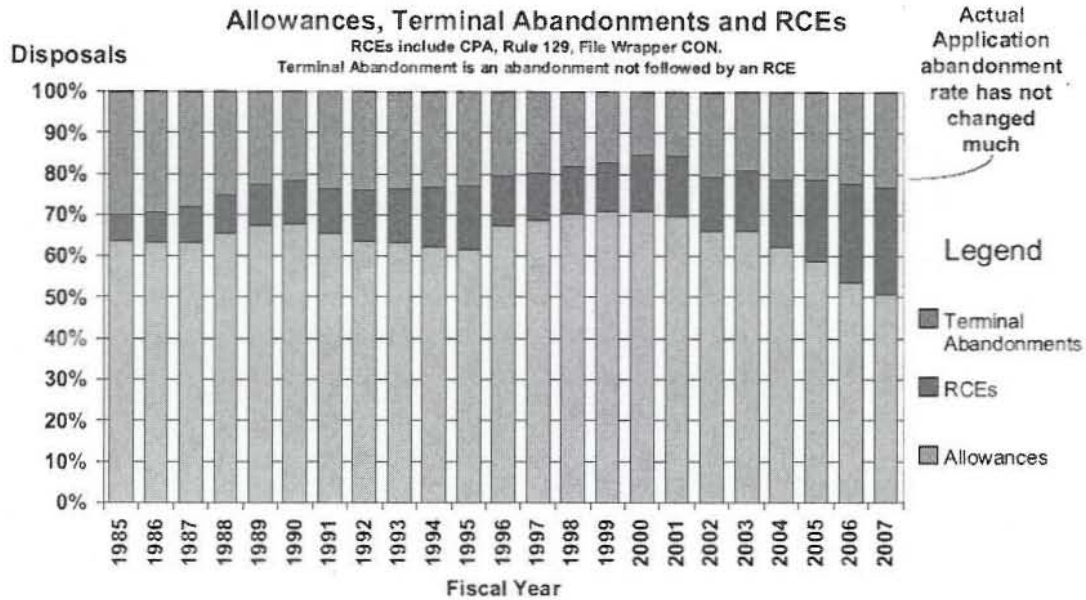
First, statistics obtained from the PTO show that applicants win **ninety percent of appeals** (at least to the extent of requiring the examiner to withdraw all currently-pending rejections and start over). That is, **ninety percent of appealed rejections are the result of error by over-aggressive examiners.**²⁰



Second, the PTO has stated in several public forums that its allowance rate has been dropping due to poor quality of applications filed. The PTO's own statistics show that this is not true. The statistics show that the actual number of applications that are

²⁰ Ron D. Katznelson. "The Perfect Storm of Patent Reform?" Fenwick & West Lecture Series Inaugural Symposium, UC Davis School of Law, Davis, CA. (Nov. 7, 2008), <http://works.bepress.com/context/rkatznelson/article/1053/type/native/viewcontent>, slide 15, based on PTO web page, FOIA requests, and PTO submissions to OMB under Paperwork Reduction Act.

abandoned with no patent has changed only little; all that has changed is a shift from allowance after one or two rounds of negotiation with the examiner to allowance after three or four.²¹ The difference is that examiners (and their supervisors) get more production “counts” for an application allowed on the third round than for one allowed on the second.



Third, the head of the European Patent Office stated that the EPO has not seen a decline in application quality.

²¹ Ron D. Katznelson. "The Perfect Storm of Patent Reform?" Fenwick & West Lecture Series Inaugural Symposium, UC Davis School of Law, Davis, CA. (Nov. 7, 2008), <http://works.bepress.com/context/rkatznelson/article/1053/type/native/viewcontent>, slide 12