

PATENTABLY DEFINED

THE PATENT PROSECUTION BLOG OF MICHAEL E. KONDOUDIS

A CASE FOR CITING TO THE MANUAL OF PATENT EXAMINING PROCEDURE BY MICHAEL E. KONDOUDIS

I RECENTLY HAD A DEBATE WITH A COLLEAGUE ABOUT WHETHER IT IS PREFERABLE TO CITE THE MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) OR TO COURT/BOARD DECISIONS IN SUPPORT OF A PATENTABILITY ARGUMENT. ALTHOUGH THIS IS AN OPEN QUESTION, IN MY EXPERIENCE, CITING THE MPEP HAS BEEN MORE EFFECTIVE. FURTHERMORE, ALMOST EVERY PRACTITIONER WITH WHOM I HAVE EVER DISCUSSED THIS TOPIC HAS SECONDED THIS EXPERIENCE.

BUT WHY IS THIS SO? LEGALLY, COURT/BOARD DECISIONS SHOULD BE AT LEAST AS PERSUASIVE AS THE MPEP, ESPECIALLY WHEN SIMILAR FACT PATTERNS ARE PRESENT. THE REASONS FOR THE EFFECTIVENESS OF THE MPEP, AT LEAST ANECDOTALLY, RANGE FROM THE SUSPICIONS THAT EXAMINERS: DISLIKE ANALYZING CASE LAW; BELIEVE THAT ALMOST ANY DECISION CAN BE DISTINGUISHED ON THE FACTS; AND/OR BELIEVE THAT FOR ANY DECISION THERE IS ANOTHER WITH A CONTRARY HOLDING.

WITHOUT OPINING ON THESE SUSPICIONS, WHEN ONE STANDS IN THE SHOES OF AN EXAMINER, THE REASONS FOR THE EFFECTIVENESS OF CITING THE MPEP BECOME CLEARER.

FIRST, ONLY A FRACTION OF THE PTO'S EXAMINING CORPS ARE ATTORNEYS. FEW EXAMINERS HAVE THE LEGAL TRAINING TO COMFORTABLY AND CONFIDENTLY INTERPRET CASE LAW; IT IS PROBABLY A FOREIGN PROCESS TO MANY OF THEM. CONSEQUENTLY, MANY EXAMINERS TEND TO DISCOUNT COURT/BOARD DECISIONS AND TAKE THE DEFAULT POSITION THAT IF A DECISION HAD MERIT, THE OFFICE WOULD HAVE SUPPLIED GUIDANCE ON ITS APPLICATION IN THE MPEP (OR ANOTHER OFFICIAL PUBLICATION).

SECOND, AND RELATED TO THE FIRST POINT, IT CAN BE DIFFICULT AND TIME CONSUMING FOR EXAMINERS TO LOOK UP AND TO ANALYZE DECISIONS. WITH THE PTO'S PRODUCTION QUOTAS, THIS FACT SHOULD NOT BE IGNORED. ALSO, LANGUAGE ISSUES OF SOME OF THE EXAMINING CORPS MAY AMPLIFY THIS DIFFICULTY.

THIRD, I SUSPECT THAT RELIANCE ON CASE LAW CAN BE A RISKY PROPOSITION FOR AN EXAMINER, ESPECIALLY WITH SECOND REVIEWS OF ALLOWANCES. IMAGINE HAVING TO DEFEND AN ALLOWANCE BASED ON AN INTERPRETATION OF CASE LAW, ESPECIALLY WITHOUT CORROBORATION IN THE MPEP. RELIANCE ON THE MPEP, IN CONTRAST, IS THE SAFEST BET FOR AN EXAMINER LOOKING TOWARD THIS REVIEW. AFTER ALL, THE MPEP DESCRIBES ITSELF AS PROVIDING GUIDANCE AND INSTRUCTIONS TO EXAMINERS ABOUT THE PROSECUTION OF PATENT APPLICATIONS. WHAT COULD BE SAFER?

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IN VIEW OF THESE PRACTICALITIES, WHEN YOU NEED AUTHORITY FOR A POSITION, IT MAY BE A GOOD IDEA TO CONSIDER LOOKING FIRST TO THE MPEP. CITING THE OFFICE'S OWN INSTRUCTIONS SEEMS TO AVOID MOST OF THE AFOREMENTIONED COMPLICATIONS. THAT BEING SAID, SOMETIMES IT MAY BE MORE APPROPRIATE TO CITE A DECISION. IN THESE CASES, I SUGGEST CONSIDERING PROVIDING THE EXAMINER WITH AN ANNOTATED COPY OF THE DECISION AS AN ATTACHMENT TO A RESPONSE.

WHAT DO YOU THINK? I WOULD LIKE TO HEAR OTHER'S OPINIONS AND/OR EXPERIENCES. I AM PARTICULARLY INTERESTED IN WHAT MEMBERS OF THE PTO'S EXAMINING CORPS HAVE TO SAY ABOUT THIS ISSUE (AND I SUSPECT THAT MY FELLOW PATENT ATTORNEYS AND AGENTS MIGHT BE AS WELL).

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