

FINNEGAN



April 2010 Issue

Did You Know?

The USPTO implemented a new examiner “count system” in February. The USPTO’s count system in some respects drives the examination process. It determines the amount of time an examiner spends examining a patent application, allocates the credit the examiner receives at each stage of examination, and is used to evaluate an examiner’s productivity and performance. Previously, an examiner received one count for a first action on the merits and another count for final disposition of an application, which included allowances and abandonments, for a total of two counts per application. In addition, the filing of a Request for Continued Examination (RCE) under the previous system renewed the number of counts available to the examiner. Stated differently, an RCE would provide the examiner with an abandonment count and an opportunity to earn two additional counts, as described above. Some believed that the prior system may have incentivized examiners inappropriately, for example, causing some examiners to short shrift amendments after final action in the hopes of baiting an RCE.

The new count system retains the overall number of counts available per application (i.e., two), but skews the count distribution to favor more thorough initial examination. The new system also incentivizes examiners to work with applicants to identify patentable subject matter. The new system awards 1.25 counts for a first office action on the merits, 0.25 counts for a final rejection, and 0.5 counts for disposal. Notably, after a first action, an examiner may earn the remaining 0.75 disposal counts by allowing the application instead of issuing a final action. The new system also decreases the value of RCEs to an examiner. Unlike the old system, the first filed RCE provides the examiner with an opportunity to earn only 1.75 additional counts, and each additional RCE provides the examiner with an opportunity to earn only 1.5 additional counts. This

decreases the appeal of forcing continued RCE practice. The new system also provides examiners with up to one hour of nonexamination time to initiate interviews.

The USPTO expects this new system, with its emphasis on improved initial examination, to lead to earlier identification of patentable subject matter, greater overall quality, and compact prosecution. To take advantage of the new system, applicants should consider greater use of interviews early in the examination process.