Pillar 3 — Proposal 5: Review of the Current Compact Prosecution Model and the Effect on Quality

Summary: While this topic could also fit squarely under Pillar 1, Excellence in work products, we would like to explore different/additional approaches the Office could take in resolving issues during patent application prosecution. We recognize that effective interaction between examiners and applicants leads to accurate identification and better resolution of issues. In today's brainstorming session, we are looking for your input and ideas on how to increase the quality of the communication between applicants and examiners during prosecution. Better, more focused communication on patentability issues early in prosecution may lead to better resolution of issues without the need for appeal or further prosecution in the form of RCEs. This outcome results from focusing on resolving issues rather than merely concluding prosecution regardless of whether the issues are resolved. We are particularly interested in learning more about your views of our Compact Prosecution model (final disposition in the fewest number of Office actions) and why it does or does not meet the needs of applicants. We are also interested in exploring other approaches which will lead to final disposition in other compact ways.

Concept	Brainstorming Questions
Current Compact Prosecution Model	• How effective is the current compact prosecution model (achieving final disposition in the fewest number of Office actions) in resolving patentability issues in a quality manner and with efficiency? • Beside the number of Office actions it takes for final resolution, what other factors should the Office be looking at when determining if compact prosecution has been achieved (such as, the number of months since the first Office action issued)?
Additional Action Before Final	• Would the ability to receive an additional Office action for a fee before a final Office action is issued be beneficial? How would it allow for more fine-tuning of claims? Would the ability to also interview after the additional non-final Office action be beneficial? If so, in what ways? • Would applicants be able to identify the applications that would benefit from an additional Office action before close of prosecution when they respond to the first Office action on the merits?
No Final Action Model	• Some have suggested that the practice of issuing final Office actions be abolished to allow for more give and take between the applicant and examiner. Would fees per reply be sufficient to incentivize applicants to close prosecution to avoid endless prosecution scenarios? What are other incentives, beyond fees, that would encourage applicants to close prosecution quickly in the absence of final Office actions? • Would more interactions between the Office and applicant make prosecution more efficient and/or enhance quality? If more interactions are useful, when in the process would they be most effective? For example, before search, before first action, before responding to an Office action?