

From: Hopkins, Susanne M.

Sent: Friday, January 25, 2013 4:53 PM

To: RCE outreach

Cc: Hopkins, Susanne M.

Subject: RCE Practice Comments

Dear RCE outreach:

Below are my comments. I have been practicing since 1987, my reg. no. is 33247.

The USPTO's questions in this Federal Register Notice focus on the reasons why applicants file RCEs:

1. If within your practice you file a higher or lower number of RCEs for certain clients or areas of technology as compared to others, what factor(s) can you identify for the difference in filings?

Much higher number filed in complex technologies, i.e., biotech, pharma, business methods.

2. What change(s), if any, in Office procedure(s) or regulation(s) would reduce your need to file RCEs?

Incentivize Examiner's to enter and consider after-final amendments, grant after-final interviews. Examiner's rarely will consider ANYTHING after final regardless of the law. The bargaining chip is the RCE, you agree to file, they agree to allow.

3. What effect(s), if any, does the Office's interview practice have on your decision to file an RCE?

Interviewing is essential and Examiner's should be incentivized to interview as much as possible since interviewing is the single most important factor in advancing prosecution. But again, nothing happens after-final.

4. If, on average, interviews with examiners lead you to file fewer RCEs, at what point during prosecution do interviews most regularly produce this effect?

Interesting question since a round of prosecution is a non-final OA followed by a final OA. There is NO adequate time to prosecute an application to allowance in a single round of prosecution especially when we are talking about foreign originated national phase applications. Generally a first interview (always with SPE) is helpful after a first OA to ensure the Examiner understands the invention and to force the Examiner to read the specification or at least part of it. Thereafter, I would file a response to the OA, interview again (always with SPE), and then file a Supplemental Response if necessary. This is the way to get the most out of a single round of prosecution.

5. What actions could be taken by either the Office or applicants to reduce the need to file evidence (not including an IDS) after a final rejection?

Compact prosecution. Many Examiners still ignore this.

6. When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE?

See 7 below.

7. When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an amendment after final (37 CFR 1.116)?

Given my answer to 2 above, if I am filing an amendment after-final it will almost always be with an RCE, or I will file the amendment early and file the RCE if it appears necessary after receiving an AA, or I will file without an RCE if I have an agreement on the record (interview summary) from the Examiner that the case will be allowed.

8. Was your after final practice impacted by the Office's change to the order of examination of RCEs in November 2009? If so, how?

No see 2 and 4 above. There is no real choice BUT TO FILE an RCE.

9. How does client preference drive your decision to file an RCE or other response after final?

Clients ultimately make the decision. Clients (especially overseas clients) tend to fight for broad claims, we tend to urge reasonableness and appropriate claim scope. Generally clients begin to understand this after at least one round of prosecution.

10. What strategy/strategies do you employ to avoid RCEs?

Know the landscape, know the closest prior art, draft and file claims of appropriate scope, include many claims of broad, intermediate and narrow scope, write your application with adequate foresight and adequate written description to provide support for all possible claim amendments including negative limitations, interview early and often, always interview with a SPE who has the authority to make an actual decision/commitment ...unfortunately while the foregoing works for US clients, it may not work as well for overseas clients filing US national phase applications.

11. Do you have other reasons for filing an RCE that you would like to share?

We all file RCE's because we have to. There is no alternative under the current system given the average Examiner's lack of experience and understanding of the law, combined with production requirements and lack of incentive to do anything at all after final.

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