

From: Dan Aleksynas
Sent: Wednesday, February 13, 2013 9:35 AM
To: RCE outreach
Cc: Dan Aleksynas
Subject:

(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? **My medical device cases tend to require more RCEs than other technologies.**

(2) What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs? **In my opinion I believe that the use of restriction/election practice forces me to restrict out my narrower claims because my clients want broad protection. So by examiners filing a restriction/election and withdrawing my narrow claims where 80% of the elements are in the broad claim or a dependent the Examiners are prolonging prosecution. If they just searched the broader claim it would put all of the relevant art in front of me in the first office action so that I can make a more informed decision how to respond to the first office action instead of giving me half of the relevant art in the first OA and then the rest in a subsequent OA when I amend or provide arguments with an RCE.**

- The other thing that creates a lot of RCEs is many examiners "punt" on the first OA. Meaning the first OA is barely on point, half of the elements are not examined, and the heart of the claims are missed. This causes me to respond and they generally take me to final without ever providing a good reference, thus, when the final office action comes out, with the response I should have gotten in the first place and I am forced to make a small amendment with an RCE to overcome the art.

(3) What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE? **I interview 50% of my cases and when I interview it greatly advances the cases; however, sometimes the gap between the claims and where the Examiner is rejecting is too large to overcome in 1 office action thus an RCE is necessary to continue prosecution.**

(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? **If the claims are in a decent position for allowance (i.e., there is some novel feature over the references cited) then I usually interview to explain why the claims define over the prior art. If our claims are much broader than the prior art (i.e., the rejection appears to be valid) then I usually don't interview and I amend the claims.**

(5) What actions could be taken by either the USPTO or applicants to reduce the need to file evidence (not including an IDS) after a final rejection? **A more liberal after final practice would help to get more notice of allowances. With this being said I have not yet taken advantage of the After Final Consideration Pilot.**

(6) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE? **If I have no allowable claims or if there is some novel feature I can introduce to define over the art then I generally file an RCE.**

(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)? **In my practice I only file a response after final in 2 situations. (1) to accept allowable subject matter or (2) put the claims in better position for appeal or pre-appeal. In my experience most examiners are slow to**

respond to after final and the comments they provide are minimal at best so the advantages are not worth the cost to the client. Further, virtually no amendments are ever entered by the Examiners.

(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? Unfortunately I do not know what this is.

(9) How does client preference drive your decision to file an RCE or other response after final? Most clients do not want to pay for both an response after final and then an RCE since after final practice (absent allowable claims) rarely results in a better position.

(10) What strategy/strategies do you employ to avoid RCEs? I file Appeals, pre-appeal, interview, file a very narrow claim. With regard to the very narrow claims – this very rarely works as almost all of the examiners when I employ this strategy file a restriction/election so that I am forced to restrict out this claim. This is frustrating as a majority of the time because the Examiner's logic for this election/restriction is baseless; however, challenging is not with the money or effort so my efforts to assist in advancing prosecution are just frustrated by the Examiner.

(11) Do you have other reasons for filing an RCE that you would like to share? I file 4-5 RCE's a year for art related reasons and it is one of the most frustrating things for me. I wish our IDS system was overhauled to be more liberal or the burden lowered, especially in view of modern technology the Examiner's ability to search and find relevant art is much greater than years ago when the IDS system was developed.