From: Bruce Hayden
Sent: Friday, March 08, 2013 1:50 PM
To: RCE outreach
Subject: RCE Outreach Focus Questions

(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?

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

Better enforcement of MPEP requirements for proper examination and for marking OA as final. A lot of examiners seem to mark OAs as Final if they have to research, because the claims have been narrowed due to prior art they found, when the added limitations should have been reasonably expected up front.

Also, reduce the counts for RCEs - it helped a bit when they were reduced before. Most often, it still seems like the root cause of RCEs is examiners gaming the count system.

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

Talking after Final allows you to come to an agreement, BUT, invariably requires an RCE, so that the examiner can get his counts.

(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?

Actually, after final interviews may cause more RCEs - with the RCE filed with the agreed-to claims. Much easier to talk a client into an RCE if you have an agreement with the examiner that they think the claims are allowable, but must re-search JIC.

(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?

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

A lot of small clients cannot afford RCEs, but can afford appeals even less. Large clients, the determination is whether the application is making progress, doesn't appear to be patentable, or the examiner has committed error. If a better set of claims would maybe get the application allowed, then file an RCE. If the spec doesn't support such, or any resulting allowed claims would not be that useful, then abandon.
And, if the examiner appears to be wrong, then appeal.

Surprising amount of the time the examiner has not fully considered the dependent claims, and, thus, has committed error in his rejection of those claims. But, like to have an RCE first before appealing.

(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)?

Usually, only when I want to rewrite objected to claims in independent form, etc. Examiner rarely seem to really consider amendments after final seriously, essentially telling you to file the RCE, and they will consider them at that time.

(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?

Not really.

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

Larger patent savvy clients tend to accept that RCEs are part of the game, and budget accordingly. Have had several with standing orders that allow filing one RCE before consulting them. Unfortunately, just as with restriction practice, the examiners seem to know who these clients are.

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

Talk to the examiners. Nothing else seems to help. In my experience it is an examiner-driven problem, with so many of them out for their own best interests (minimizing work, and maximizing counts).

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

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