RCE PRACTICE AND INSIGHTS

USPTO and PPAC Roundtable and Focus Session
New York University Law School
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Agenda

- RCE Use
- Issues Necessitating RCE Filing
- Possible Changes to Decrease Use
- Questions
RCE Use

- At least one RCE is filed in about 50% of base applications.
- Predominately to continue to make substantive claim amendments and arguments after receiving a Final Office action.
- Secondarily to cite relevant references to the Examiner after receiving a Notice of Allowance.
  - Foreign prosecution references
  - PCT search references
- Application not yet ready for appeal.
- Historically improved timeliness in contrast with Appeal so beneficial to continue to work with Examiner.
Issues Necessitating RCE Filing

- Only one “bite at the apple” in terms of making claim amendments when responding to a first Office action.
- Even if prior art rejections overcome in response to first Office action, second Office action with new prior art references made final because necessitated by claim amendments.
- Sometimes difficulty in scheduling interviews prior to the end of the shortened statutory period
  - Forego interview to avoid extension of time fees
- Examiner interviews are not always effective in closing prosecution.
  - Further search and examination is often required post-interview.
  - Two or more interviews often necessary to reach allowance.
Possible Changes to Decrease Use

- Ease of scheduling and conducting interviews after a first Office action.
  - Email access to Examiners for scheduling interviews.
  - Increased Examiner flexibility in scheduling interviews.
  - Improved interview preparation by Applicant and Examiner.

- Permitting greater circumstances that allow an Examiner to make a second Office action non-final.
  - As long as prosecution is being substantially progressed in response to a first Office action.
  - New prior references cited in second Office action.

- Greater latitude in making claim amendments after a Final rejection.
  - If respond within 2-months of a Final Office action, permit more substantive claim amendments in the After Final response.
Questions