

From: Adenike Adebiji
Sent: Saturday, February 16, 2013 3:11 PM
To: RCE outreach
Subject: Partial answer to RCE Outreach

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

RCEs tend to be filed more in technologies that are crowded, i.e., where there is a lot of prior art and thus problems with obviousness, and where several of the examiners are relatively new to the trade and apply examination guidelines rigidly.

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

Stop making the second office action final. As long as the applicant is making an effort towards moving the application towards allowance, there is no need to cut off the dialogue between the examiner and applicant.

RCEs are often filed because the second office action is made final. The process goes this way:

- i. The examiner issues a first office action with several rejections and cited references.
- ii. The applicant responds to the first office action by amending the claims and arguing for patentability of the claims over the cited references.
- iii. The examiner issues a second office action with several rejections and cited references—some of the cited references may be new or the grounds of rejections may be new. The examiner makes the second office action final because the applicant had amended the claims in the response to the first office action.
- iv. The applicant responds to the second office action by amending the claims and arguing for patentability of the claims over the cited references. Or the applicant responds to the second office action by merely arguing for patentability of the claims over the cited references because the applicant is afraid of amending the claims because the second office action had been made final.
- v. The examiner issues an advisory action refusing to enter the amended claims and alleging that the amendments and arguments do not place the application in condition for allowance. Or the examiner issues an advisory action alleging that the amended claims raise new issues that will require further search.
- vi. If amendments to the claims are necessary to overcome the references cited or place the application in a better condition for appeal, the applicant presently has no choice but to file an RCE.

RCEs are also filed to allow consideration of information disclosure statement (IDS).

What can be improved?

- a. The concept of a final action should be buried. An action should not be final if it comes with a new set of references or new grounds for rejection or new assertions that the applicant had not seen before. An action should not be final if the examiner is not understanding the invention and as a result is not making meaningful rejections.
- b. A refusal of application should occur when it is clear that progress is not being made in prosecution. For example, if the applicant keeps making the same arguments, is not providing any evidence to support non-obviousness, and is not amending the claims to distinguish over the prior art, the examiner should formally refuse the application.
- c. An applicant should be allowed to have an oral interview with the examiner prior to refusing the application. In this case, the examiner should send a notice of intent to refuse the application to the applicant. It may be that outstanding matters may be resolved during the interview, avoiding the need to refuse the application.
- d. After an application is formally refused, only the pre-appeal or appeal route may be followed to keep the application alive.
- e. A search report should be issued before the first office action, and the applicant should be allowed a period of time to make voluntary amendments to the claims before the first office action is issued. Along with the first office action, the examiner may issue a supplementary search report, e.g., if the voluntary amendments were of a nature that required additional search.
- f. After the first office action, there should be restrictions on the amendments that can be made to the claims. The amendments should not be of a nature that would require another search and should be based fairly on the disclosure. This requires that the searches made up to the issuance of the first office action are comprehensive, i.e., are based on a holistic view of the invention as described in the specification rather than just the claims. This way, if the applicant pulls something from the specification into the claims that is a part of the invention originally searched, the examiner should not need to run and perform another search. In particular, while searching, the examiner should consider the problem that is being solved in the disclosure, the known solutions to the problem, and the solution offered by the applicant.
- g. The examiner should address all limitations in the claims even if the limitations are presented in the alternative. For example, an applicant may present a claim where one element has the structure a or b. To reject the claim, the examiner needs only knock out a or b. Let's say the examiner knocks out a. The examiner is then only obliged to express how a is

taught and may remain silent on whether b is taught. It would be helpful to the applicant if the examiner also expressed an opinion about b so that the applicant is better able to assess its options.

- h. There is no denying that examination of applications take work. It may be beneficial to increase the examination fees, e.g., double it, at the outset to allow for more than two office actions before refusing the application.
- i. If suggestions (a) through (h) are implemented, the RCE practice should be restricted to submission of IDS after the application has been allowed or formally refused. Use of the RCE practice may be further reduced by QPIDS.

In general, the USPTO needs to change its stance from that of a rejection machine to a progress machine. Whenever possible, the examiner should identify patentable subject matter to guide the applicant in amending the application to a form that would be in condition for allowance.

Adenike Adebisi

[Dewipat Incorporated](#)

P. O. Box 1017

Cypress TX 77410

USA

Tel 1 281 856 8646