

From: Beatus, Carrie
Sent: Tuesday, March 12, 2013 5:00 PM
To: RCE outreach
Subject: Honeywell Comments on RCE Practices

Dear Director Terry Rea,

Attached please find Honeywell International Inc.'s comments pursuant to the USPTO's "Request for Comments on Request for Continued Examination (RCE) Practice," 77 Fed. Reg. 72830 (Dec. 6, 2012). Thank you for your consideration of our comments.

Best Regards,
-Carrie Beatus

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March 12, 2013

Submitted to: rceoutreach@uspto.gov

Hon. Terry Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the USPTO
600 Dulany Street
P.O Box 1450
Alexandria, VA 22313

**Re: Request for Comments on Request for Continued Examination (RCE)
Practice, 77 Fed. Reg. 72830 (Dec. 6, 2012)**

Dear Director Rea:

Honeywell International Inc. is submitting the following comments pursuant to the USPTO's "Request for Comments on Request for Continued Examination (RCE) Practice," 77 Fed. Reg. 72830 (Dec. 6, 2012) ("Federal Register Notice").

Honeywell (www.honeywell.com) is a Fortune 100 diversified technology and manufacturing leader, serving customers worldwide with aerospace products and services; control technologies for buildings, homes and industry; turbochargers; and performance materials. Based in Morris Township, New Jersey, Honeywell's shares are traded on the New York, London, and Chicago Stock Exchanges. For more news and information on Honeywell, please visit www.honeywellnow.com.

The Federal Register Notice sets forth a number of questions regarding RCE practice to which Honeywell provides the following general comments to selected questions.

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

Under the current system, there is limited opportunity to amend claims in response to examiner-identified art without filing at least one RCE. Allowing for two non-final actions prior to an examiner issuing a final office action would likely reduce the need to file an RCE. In addition, office procedures or regulations that would reduce the need to file RCEs include those that would lead to: (1) increased availability of examiners for interviews including, but not limited

to, both after the first office action issuance and after a final rejection; (2) increased guidance by examiners during the interview as to allowable subject matter; and/or (3) increased consideration by examiners of amendments submitted after a final rejection.

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

Interviewing gives an applicant a sense of the potential success of proposed prosecution (e.g. to determine whether there is patentable subject matter particularly when the examiner has cited new art in the final rejection), the ability to clarify arguments, and provides the applicant with some basis to decide whether to file an RCE or appeal.

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

Conducting an interview after a non-final rejection leads to filing fewer RCEs if the examiner and applicant can agree on the allowability of claims. An interview after a final rejection, however, is less effective in reducing RCE filings because the examiner often refuses to enter even minor amendments.

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

An RCE may be considered instead of an appeal when the applicant believes that an appropriate and reasonable amendment will overcome all outstanding rejections.

5. *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)?*

An applicant may file an amendment after a final rejection when: (1) the final rejection invites an amendment, (2) an agreement on the amendment is made during an examiner interview, (3) there is an indication of allowable subject matter in the final rejection, (4) correcting minor formality issues, (5) it is desirable to get an argument on record prior to filing an RCE or appeal, or (6) trying to reduce the likelihood the examiner will issue a final rejection immediately after filing an RCE.

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

Increased interviews and appeals have been utilized to avoid filing RCEs where possible.

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

An RCE may be filed when the applicant believes that an amendment will result in an allowance, to put the application in better condition for appeal or to have late-discovered art considered.

Honeywell thanks the USPTO for its consideration of the above comments.

Sincerely,

HONEYWELL INTERNATIONAL INC.

/Carrie A. Beatus/

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