



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.
- ❑ Secondly 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