

From: Perry, Linda
Sent: Wednesday, February 13, 2013 9:50 AM
To: RCE outreach
Subject: My comments on RCE situation

The 11 questions are clearly for inventors/their attorneys.

You might be focusing on the wrong thing. Arguments in amendments take me as long to answer carefully as doing an RCE takes. I do amendments first, because if I do not keep the number down it can quickly run into a lot of overtime. I also try to respond quickly if the attorney has taken the trouble to file the amendments in under 6 months (fairly rare), and after a bi-week with many amendments done, it is natural to make up the points with new cases. Loop, repeat. The obvious fix: make new case worth the same as an RCE, or 1 point, and take at least the 0.25 points deducted from a new case's points and tack it on to the amendment points.

For me, .75, .75, .75 would be more representative of the time it actually takes; and up to 2 hours for really useful interviews, discretionary, would help. Possibly, equal points for amendments would lead to better examiner responses and to fewer RCEs filed-or at least fewer second RCEs.

For more detail, consider this: the new case almost always has broad new claims open to a wide range of interpretations, and often the Specification repeats the broad terms, or else is a hundred pages of variations on the theme. So unless I am able to reach the attorney and learn his interpretation, I use art which teaches the claim but can say something different from what the attorney intended. (S)He doesn't get around to expressing the detailed invention until at least first set of amendments, or more often, (especially now that we have reduced the backlog, so that this week's filing of a case no longer means the attorney can expect to have work for 3 solid years) until 3 sets of amendments have been made to the original claims. The obvious fix: adjust the filing fees to put pressure on the attorney to express the invention as fast as possible. I imagine that would lead to attorneys' salaries' rising as they pass the costs on to the inventor with interest. I haven't scrutinized the recently updated fee structure to see what an uproar it would cause.

I also have not kept track of what other data might be helpful-such as some kind of "difficulty" ranking and whether that correlates (positively or negatively) with length of prosecution. In my area, the cases are not so evaluated and the tougher ones distributed to more experienced examiners- don't know how that would affect the RCE backlog, if at all. Or whether number of claims has an influence. Or, whether there is any difference in prosecution path for attorneys who file 3 short claims and then amend the independent ones to 2 pages long and add 30 new claims. Or for attorneys who file one 150 page Specification and file 6 cases in parallel using the same Specification. . Or whether older or more degree-laden examiner's dockets, or dockets of more specialized examiners (think: PhD in bio-something) look different from other new hires'. Lots more data to crunch and use to adjust fees or GS levels or hiring patterns.

The after final pilot is helpful, but I find that those who file after final amendments at all tend to file many pages of arguments too, so an hour is less than it takes me to answer those. I can spend half a day on one. A different charge number for specials has also helped.

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