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Sent: Saturday, March 09, 2013 2:24 PM
To: RCE outreach
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Subject: RCE COMMENTS

Note: I am a solo patent practitioner with over 30 years experience in corporate, law firm and independent practice. The following are my comments on the 11 RCE outreach questions.

1. Although I presently prosecute only a few applications per year, it appears that some art units and examiners are less helpful in assisting applicants in identifying patentable subject matter.

2. If examiners were required to actually search the invention as claimed and disclosed, amendments adding limitations disclosed in the spec and/or drawings but not previously claimed should not require further searching and repeated office actions. Otherwise, applicants are faced with filing principal claims which are unduly narrow or including in dependent claims every conceivable disclosed limitation which might be required during prosecution. The latter is costly for complex inventions, and the PTO is already discouraging large numbers of claims.

3. Interviews are generally appropriate prior to filing an RCE, while the details of the latest Action are still fresh in the minds of both attorney and examiner, and some agreement might be reached on possible patentable subject matter. However, if an RCE is essential to put the claims in optimum form for appeal and the examiner has shown no sign of yielding on issues underlying the rejections, an interview may be pointless until after the RCE and amendment are filed. However, with the current delays in consideration of RCE filings, it is difficult for an attorney to gauge when an interview may be appropriate. An interview after a new Action is issued may be too late, but there is probably little point in suggesting an interview before the application has been taken up for action.

4. Partially discussed above, but when an interview after a final rejection is unproductive, an RCE may be required to obtain entry of amendments, evidence and comments which are desirable for an appeal. On the other hand, willingness of an examiner to consider an amendment after final might permit prosecution to proceed.

5. Including ample discussion and examples in an application, if possible, may demonstrate evidence of "surprising/unexpected results," long-felt need, commercial success, etc., but the supporting info is often not available before filing, and there may not be time or funds to allow the inclusion of such materials during the preparation of an application. Examiners could be more open to considering arguments presented with the aid of applicants rather than brushing them off as "mere attorney arguments;" with some examiners it may appear

necessary to document every conceivable point with a declaration or other evidence, and even then some examiners will directly contradict the testimony of applicants and/or experts. Enforcing PTO rules re examiner support for "official notice" or personal opinions would help.

6. If an examiner appears to have taken a strong position re rejections and is unreceptive to exploring patentable subject matter, an amendment after final, supporting evidence and an RCE might as well be filed together, even though it will be many months before another office action can be expected.

7. An amendment after final may be necessary if an examiner provides an indication of amendments which might produce allowable claims, or if the claims need to be amended into optimum form for appeal. If the claims are already in optimum form, going directly to appeal rather than waiting out a response to an RCE filing may be more cost effective.

8. The significant delays in examiner responses to RCE filings makes it much less efficient to complete prosecution, as both examiner and attorney must refresh their memories and impressions of the record before continuing. If a positive response cannot be expected from the examiner even after such delay, going to appeal sooner rather than later may be preferable.

9. Clients are still learning about the nasty secrets of RCE practice and the intransigence of some examiners. Given timely responses, most individual and small company applicants would probably prefer to try an amendment after final and RCE to going to appeal, given the cost of a full appeal. However, when it takes a year or so to get a response to an RCE and the examiner seems unwilling to consider applicant's arguments, filing an appeal sooner may be shown to be more cost effective than waiting out the response to an RCE.

10. Normally I try to present a set of claims ranging from independent claims of reasonable breadth to more detailed dependent claims with limitations which might be added to independent claims in prosecution. However, it is becoming apparent that one may need to include enough claims in the initial filing to lay out all possible features and limitations of the invention so that the examiner will include them in the search.

11. While some applicants hope to receive their patents promptly, others do not mind, or even seek, delays, which presently result from RCE filings. However, the effects on patent term are unfavorable compared to a full appeal.

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