

From: Mark Protsik
Sent: Thursday, December 06, 2012 8:58 PM
To: RCE outreach
Subject: [Docket No. PTO-P-2012-0043] Request for Comments on Request for Continued Examination (RCE) Practice

From: Mark Protsik, Patent Agent
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To: United States Patent and Trademark Office
Mail Stop Comments - Patents
Office of Commissioner for Patents
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Sir:

Responsive to questions 2, 6 and 7:

In my experience, I'd say that the main cause for the filing of an RCE during prosecution of a patent is that the case is not yet ready for appeal due largely to the following combinations of Office policies, procedures or regulations:

¶ 7.40 Action Is Final, Necessitated by Amendment

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a).

Advisory Action

The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered, because

- a) They raise new issues that would require further consideration and/or search.

The so-called "shortened" prosecution procedure, reflected in the PTO's policy on making second Office actions final even when new prior art is cited, does not really shorten prosecution, but instead leads to filing of an RCE because substantive amendment of claims will often be needed to address newly cited art. The fact that applicant has successfully amended so as to overcome the previous grounds of rejection is not credited at all but made an excuse by the Examiner to present the second action as FINAL, even where the additional searching and citation of references should have been part of a thorough and complete initial examination under 37 CFR 1.104. It is only where an amendment completely shifts ground as to the subject matter being claimed, as opposed to simply narrowing the scope of the claims, that such amendment really warrants a final action. Modifying the PTO's policy of making actions final on second office actions should reduce the number of RCEs required.

Regarding the non-entry of amendments after final action, in many cases entry should be permitted where an amendment incorporates subject matter from one or more existing dependent claims into an independent claim, as the issues such an amendment may raise should already have been part of a thorough consideration of the associated dependent claim(s) from which such language derives. However, some examiners appear to use the advisory action to simply dispose of a case and force an RCE, rather than entering an amendment that would allow the case to proceed to appeal. The “raise new issues” box on the advisory action becomes simply one more routine to follow that doesn’t always seem to be well considered. In view of the fact that the time for filing an RCE or appeal continues to run after final action, the filing of a petition to protest either the finality of an action or the non-entry of an amendment is not really a viable option.

We would not proceed to appeal a case until we have claims entered that best presents the applicant’s case. RCEs are often the only way to ensure this under the present system of procedures as applied in practice by the PTO examining corps.

Responsive to questions 3 and 4:

Regarding examiner interviews, their helpfulness is somewhat mixed. In one case, it helped clarify the real underlying issue behind the formal ground of rejection, which eventually led to a more appropriate amendment resulting in an allowance (albeit after an RCE). In another case, the interview was not really helpful at all and another final rejection was issued (with newly cited prior art), leading to a further RCE. I’d say the interviews, while sometimes helpful in better understanding the respective positions regarding patentability of a case, don’t generally lead to fewer RCEs, since we are usually ready for appeal after using just one RCE, with or without an interview.

Sincerely,

Mark Protsik

Note: The views expressed herein are my own, and do not necessarily represent those of either the partners or other patent practitioners at Schneck & Schneck.