

**From:** Mark Reichel  
**Sent:** Sunday, February 17, 2013 12:55 PM  
**To:** RCE outreach  
**Subject:** RCE comments

(1) If within your practice you file a higher or lower number of RCEs for certain clients or areas of technology as compared to others, what factor(s) can you identify for the difference in filings?

**Not applicable to my practice**

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

**If the USPTO would end its practice of having a second office action routinely be a final office action. I have seen many cases where we obtain an allowance after filing an RCE, and if the applicant had an opportunity to respond to a second non-final office action, less RCEs would be filed.**

(3) What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE?

**Interview practice is helpful, but I generally still need to file RCEs after interviews.**

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

**I have not experienced this situation**

(5) What actions could be taken by either the USPTO or applicants to reduce the need to file evidence (not including an IDS) after a final rejection?

**I have no comment on this question**

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

**I always choose RCE over appeal if under a first final office action. I do, from time to time, file early responses to final to obtain advisory actions, but (a) they typically don't advance prosecution, and (b) the Examiner will generally not consider any content therein if any claim amendments are made, even if technical (antecedent basis, clarification, etc.) in nature versus to the substantive merits on allowability.**

(7) 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)?

**This is application-specific, and sometimes based on client cost concerns. I have used the early response (amendment after final) to provide arguments that I would otherwise have**

**provided within an RCE, if those arguments are not tied to any claim amendments. If I intend to amend, I do not file an amendment after final as they are not considered 99% of the time.**

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

**No change.**

(9) How does client preference drive your decision to file an RCE or other response after final?

**It does, and is generally tied to either cost concerns, or with respect to applications that are particularly important to obtain patent protection on sooner than later.**

(10) What strategy/strategies do you employ to avoid RCEs?

**Do not include any claim amendments, even technical/grammatical in nature, within responses to non-final office action. If I don't amend claims, and if I provide suitable arguments, I do not expect to receive a next action final, but I almost always do receive one.**

(11) Do you have other reasons for filing an RCE that you would like to share?

**The USPTO should consider changing its practice so that an applicant gets at least two attempts under non-final before receiving a final office action, as an applicant should have more than one opportunity to argue and/or amend before receiving a final office action. The USPTO should also consider its practice of issuing first action finals after RCE, which does not help applicants at all. An action after RCE should be non-final in nature every time.**

Thank you for considering these comments.

Mark

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