From: Lester Rules
Sent: Wednesday, December 12, 2012 3:36 PM
To: RCE outreach
Subject: RCE Practice Comments

Dear RCE Reachout -

My answers to some of your questions are presented below.

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

Stop rushing to finality. Follow MPEP 706.07: Before final rejection is in order a clear issue should be developed between the examiner and applicant.

In a second action final system, meeting this recommendation would require that a clear issue be developed in the first office action. This is almost never the case. Nothing is made clear in a document that is generated by pasting in claim language and inserting paragraph numbers with little or no explanation as to why the paragraphs are being cited. Yet the office pretends that that such actions are clear and issues second action finals 90% of the time. Even if the first action is articulate, the issues most likely can not be clear until after the examiner has responded to Applicant's replying arguments. The only way MPEP 706.07 can be followed is in a three action minimum system. The only exception is if the first action clearly presents anticipating art.

Remember: Haste makes Waste.

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

If an interview leaves me with the impression that a reasonable amendment or the Examiner's reconsideration of an argument will take the application closer to allowance, I'll file a paper and an RCE. If the interview leaves me with the impression that the Examiner is wrong and/or unreasonable, I'll file an appeal.

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?

After final rejection, of course.

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

Don't go final before a third action. Then need to file evidence is not apparent until the Examiner clearly articulates a defensible rejection. This almost never happens and certainly rarely happens before a second action. Accordingly, the need to go through the expense of gathering, organizing and summarizing evidence and collecting signatures is not apparent until then.

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

If the Examiner articulates a fair (if unintended) interpretation of the claim language and/or the cited documents and the only way to get an amendment entered that would eliminate the fairness of the unintended interpretation is to file an RCE, I file an RCE.

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)?

If the Examiner articulates a fair (if unintended) interpretation of the claim language and it is necessary to file an amendment that would eliminate the fairness of the unintended interpretation, I file the amendment after final.

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. If its necessary to file and RCE, it is necessary to file an RCE.

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

I try to draft claims that are allowable and I pray for a reasonable Examiner.

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

Getting newly discovered documents (usually cited by a foreign office) considered. Couldn't the Office make itself aware of art cited by other Offices without requiring the applicant to file IDSs?