

From: Smith, John G.

Sent: Friday, February 01, 2013 1:20 PM

To: RCE outreach

Subject: Comments on RCE Practice

Perhaps the most common reason for filing RCEs in cases that our firm handles for non-U.S. companies - in virtually all areas of technology - is the need to file an Information Disclosure Statement (IDS) after the USPTO has issued a Notice of Allowance or Final Rejection. In such cases, an RCE must be filed because we and/or our clients have difficulty in accurately ascertaining whether either of the statements under 37 CFR 1.97(e) necessary to file the IDS under 37 CFR 1.97(d) can be made.

As a first point, the statement under 37 CFR 1.97(e)(1) is limited to communications from a foreign patent office in a counterpart foreign application; thus it does not extend to related or counterpart U.S. or PCT applications. As second point, it is extremely difficult and burdensome to ascertain with any degree of accuracy in many cases (when the statement under 37 CFR 1.97(e)(1) cannot be made) whether the statement under 37 CFR 1.97(e)(2) is appropriate. The limited scope of 37 CFR 1.97(e)(1), and the difficulty of accurately confirming the information requiring certification under 37 CFR 1.97(e)(2), result in our clients filing many RCEs for the sole purpose of having information from counterpart or other related cases considered after issuance of a Notice of Allowance or Final Rejection. Unfortunately, this information is often not anywhere near as relevant as the other information already on file; but because of the concern about potential allegations of inequitable conduct, an RCE and IDS are often routinely filed. The net effect is an increase in pendency without any commensurate improvement in patent quality.

Updating the language of 37 CFR 1.97(d) consistent with the following proposed revision would allow applicants to file an IDS under 37 CFR 1.97(d), and thereby avoid filing an RCE after a Notice of Allowance or Final Rejection, in a number of commonly-occurring situations. The relatively higher fee for proceeding under below-proposed 37 CFR 1.97(d)(3) would encourage applicants to file IDSs in accordance with 37 CFR 1.97(d)(1)/(2) - i.e., by making a 37 CFR 1.97(e) statement plus paying the § 1.17(p) fee - whenever possible. But whenever that is not possible, applicants could opt to proceed under below-proposed 37 CFR 1.97(d)(3), thereby drastically reducing the number of RCEs that need to be filed in these types of cases.

PROPOSED NEW LANGUAGE FOR 37 CFR 1.97(d)

• (d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by either:

• (1) The statement specified in paragraph (e) of this section; and

• (2) The fee set forth in § 1.17(p);

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• or

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• (3) The fee set forth in § \_\_\_\_ [which could be, for example, \$400, or roughly twice the current fee set forth in § 1.17(p)].

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