

This paper is being filed in response to the USPTO's recent inquiry regarding filing of Requests for Continued Examination.

**(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. I do not find that either client or technology area has much if any effect on filing of RCEs. It is primarily PTO practice which dictates RCE filing.

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

Perhaps permitting (or forcing) examiners to (1) actually consider applicants' arguments in the response to the FOAM, and (2) enter after-final amendments which would avoid the prior art and place the claims into condition for allowance. I would also suggest that the PTO not permit examiners to stretch the meanings of prior art teachings to "fit" the claims. I too often see examiners intentionally misconstruing the meanings and/or teachings of prior art documents in an effort to meet claim language. Having to repeatedly argue against such stupid interpretations is detrimental to the process as a whole, denigrates the examining corps and the reputation of the PTO, and of course results in RCEs, often repeated RCEs.

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

Little if any. More frequently than not, agreement reached during an interview is reneged-upon by the examiner in a subsequent Office Action.

**(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?**

N/A

**(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?**

I'll answer a question with a question: Why can't/shouldn't the examiner consider evidence filed after final rejection? It is often most directly on point, and its import seems to lose effect over the period between its filing, filing of the RCE and issuance of the next Office Action.

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

I almost never file an RCE immediately after receiving a final rejection, unless it is clear that an amendment which should avoid the prior art rejections can be made, but is unlikely to be entered by the examiner after-final.

**(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 claims would benefit from an amendment after-final, I will so amend, regardless of whether the examiner is likely to enter it or not. There is always hope that the examiner will be reasonable (seldom) and that the PTO will really stand by its often repeated but seldom practiced goal of “compact prosecution”.

**(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?**

Not at all.

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

Not at all.

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

Filing of appeals.

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

In my opinion the overwhelming number of RCEs is a problem of the PTO’s own making. Perhaps your Quality Assurance team should take a look at rejection practices and not just at allowed applications. There are a HUGE number of mistakes being made and inappropriate practices being conducted by the examining team, and not corrected by their supervisors.

For example, I recently cited data from the specification itself to contrast with that of a prior art document, which was dismissed by the examiner as merely “attorney argument”. This was data which was sworn-to by the applicants in the inventors’ declaration – that does not amount to “mere attorney argument”.

Likewise, I often point out pertinent case law to examiners which should be dispositive, only to have it ignored in the subsequent response, i.e. without even recognition that the argument was made or that the case law was referred to. Occasionally it would be nice...in order to avoid filing an RCE...if the examining corps would abide by controlling case law and either modify or withdraw the rejection. Are they so incompetent (or afraid) of applying case law to the facts/issues and withdrawing the rejection that it can NEVER be done? Do such issues ALWAYS need to go to the Board of Appeals?

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And to revisit my pet peeve, as stated above examiners too often stretch the meaning of prior art teachings. While I realize they are permitted/expected to construe claims as broadly as reasonable, in light of the specification (I won't get started on this one), the same is not true regarding the "interpretation" of the prior art...it means what it says and not what the examiner wants it to mean.

If the PTO wants to reduce the number of RCEs, it needs to review its own practices first. Applicants spend a considerable amount of money in filing a patent application, likely on the average ten or more times the filing fees. They are not apt to just "give up" after a final rejection because of shoddy examination.

Regards,

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