

From: Sinai Yarus

Sent: Sunday, December 16, 2012 4:34 AM

To: RCE outreach

Subject: feedback on RCE practice

Gentlemen,

Requested feedback is interleaved with your questions:

(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?

As USPTO data indicate, RCE filings are not a function of technology area.

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

Increased willingness by Examiner's to point out patentable subject matter, as part of an OA, during an interview, or in the form of an Examiner's amendment.

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

The more available interviews are, the less likelihood there is that an RCE will be filed in a specific case.

(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 first Office action, but before filing a response.

(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?

Indicate patentable subject matter in the final rejection; indicate in the first OA where evidence beyond citations from the references might be appropriate.

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

If substantive amendments are appropriate, an RCE is necessary. Otherwise, we request an after final interview.

(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 we do not believe we can overcome the rejection without an amendment, an amendment is filed.

(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?

Yes. We try to avoid RCEs which now delay prosecution significantly.

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

Client preference governs all prosecution decisions including RCE.

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

Sound legal arguments based upon the burden shifting paradigm during prosecution.

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

Some Examiners seem to use an RCE as a way of boosting their performance metrics if they spent too many hours on the initial examination. Often the first office action in an RCE is a notice of allowance.

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