

From: Zuccherro, Joseph
Sent: Monday, February 04, 2013 4:22 PM
To: RCE outreach
Subject: Request for Comments on Request for Continued Examination (RCE) Practice

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

When considering Office procedures or regulations that would reduce the need to file RCEs, several issues are addressed below:

I. Pre-Mature Final Office Actions

When looking at patent examination procedures in Mexico, Europe, China, Japan, Korea, Australia and Canada, for example, the patent offices of these countries typically do not issue final office actions as the second office communication. This is an important consideration because in many instances it takes 2 or 3 office actions before the Examiner and the patent attorney clearly understand each other's positions on the scope of patentable subject matter and the cited art. However, current U.S. examination procedure where a final office action is, quite often, issued as the 2nd office action (not including a Restriction Requirement, if applicable) interferes with the examination negotiation before it even truly begins. [Please note that I do not advocate, for example, Mexico's examination procedure wherein you are only allowed a total of four (4) office actions. I believe Mexico's 4 office action requirement is arbitrary, ignores the realities of the examination process, and only works because in many instances the Mexican Patent Office acts as a registration office rather than an examination office. My point is merely that a 2nd office action made final may be premature.]

The Office cannot, and should not, implement procedures or regulations that would cause the Applicants to surrender subject matter that they are entitled simply to avoid an RCE filing. Rather, the Office should look to foster the examination negotiation process and consider procedures/regulations that enhance the negotiation without prematurely implementing an end-point (i.e., final office action) in the middle of the negotiation. The Office needs to understand that one reason so many RCEs are filed is that the Office may be issuing too many final office actions.

II. Improper Final Office Actions

The Office should consider stronger, objective guidelines for when an amendment by Applicants "necessitates a new search" and therefore results in the issuance of an office action made final. I have experienced several instances where I believe office actions have been improperly made final. For example, office actions made final in response to amendments that solely limit the scope of the claims. If the broader invention was searched in the previous office action, the narrower invention was also searched. Additionally, office actions made final where the only amendment to the independent claim was to include subject matter that was previously pending in a dependent claim. As such, Applicants are left with the impression that it can be all too simple for an Examiner to simply fall back on the subjective "necessitates a new search" standard and issue a final office action. While I appreciate that the finality of such office actions can be challenged and, if successful, withdrawn; challenging the finality of an improper final office action still costs the Applicant time and money and is not guaranteed of success.

III. Reopen Prosecution without RCE Filing

There have been instances where I believe progress has been made with the examiner through either an amendment or an interview after final; however, the Examiner is reluctant to reopen prosecution. As a result, I have had to file an RCE so that prosecution can continue. The Office's After Final Consideration Pilot (AFCP) has improved this situation somewhat; however, as noted in the guidelines to the pilot program, only in situations where the response after final rejection places the application in condition for allowance will the response be entered. Allowing a response after final rejection to be entered and prosecution reopened, even when the amendment/response only overcomes issues raised in the final rejection but falls short of placing the application in condition for allowance, would equitably spread the responsibility of the issuance of the final office action between the parties and reduce the need for filing an RCE.

IV. Additional Procedural Option

Consider a procedure that requires a telephonic interview prior to the issuance of a final office action, especially if it is a 2nd office action made final. Such an interview may result in a 2nd non-final office action or a more focused final office action that Applicants can respond to in a manner that places the application in condition for allowance.

Questions (3) and (4): What effect(s), if any, does the Office's interview practice have on your decision to file an RCE? 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 am a proponent of examiner interviews whether they are in-person or telephonic and believe interviews should take place as soon as reasonable as interviews allow the Examiner and the patent attorney to discuss the issues openly and, in my opinion, result in quicker, more efficient prosecution. However, interviews and RCEs are independent prosecution tools; interviews do not play a role in my decision to file an RCE. Rather, interviews can play a role in whether a final office action is issued and an RCE will be necessary.

Furthermore, as stated in response to question (2), unless and until examiners are willing to reopen prosecution after a final office action without the need for an RCE; interviews alone may not be enough to significantly reduce the number of RCEs filed.

Questions (6) and (7): When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE? 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)?

As previously stated, an RCE or amendment after final are simply prosecution tools and, in my experience, an RCE is rarely filed in response to a 102 rejection; the prior art teaches the claimed invention or it does not. Rather, the Examiner and patent attorney are typically dealing with 112 and 103 rejections which are based on interpretations of claim scope, the cited art, and the relevant laws. Factors such as stage of prosecution, teachings and/or relevancy of the cited art, availability of amendments to overcome the rejections while maintaining claim scope value for the client, and the necessity to make amendments in view of the rejections all play a role when considering an RCE or an amendment after final. When possible, I try to file an amendment/response after final within 2-months

of a final office action, without an RCE, so as to receive an Advisory Action. Depending on the Advisory Action, I will consider filing an RCE or Appeal.

Assuming an application is not to be abandoned I will typically an RCE unless prosecution is reopened by the Examiner or a Notice of Allowance is issued. I will only appeal a final rejection where the final rejection is utterly baseless and no further amendment or response is appropriate (not a common situation) or where the amendment(s) that might otherwise overcome the final rejection would render the scope of protection meaningless to the client.

Question (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?

There was no impact on after final practice as a result of the November 2009 changes. Time to disposition for an RCE as compared to an Appeal is a factor but only one factor.

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

I employ three (3) strategies to avoid RCEs: an after final interview; filing a response after final office action within 2 months of the mailing date so as to receive an advisory action; and/or a Pre-Appeal Brief Request for Review submission. When possible, I try to file an amendment after final within 2-months of a Final Office Action, without an RCE, so as to receive an Advisory Action. Depending on the Advisory Action, I will consider filing an RCE or Appeal. However, as stated in several instances above, unless and until examiners are willing to reopen prosecution after a final office action without the need for an RCE these strategies are of limited usefulness. A Pre-Appeal Brief Request for Review can be useful; however, there are only limited circumstances where such a submission is appropriate.

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