

# Patent Public Advisory Committee Meeting

## RCE Outreach



Andrew Faile

Deputy Commissioner for Patent Operations

March 14, 2013



# Progress to Date

- Completed Roundtables and Focus Sessions
  - Santa Clara, Dallas, New York City and Chicago
  - In process of rescheduling the Alexandria events
- Comments collected from
  - Written responses to the FR notice
  - Via email from the RCE Outreach web page
  - IdeaScale crowd sourcing online
  - Internal and external blog postings
  - Roundtable presentations
  - Focus sessions



# External Data Collection Overview

Ideas are logged in database

- Categorized to help quantify results
- More than 500 comments logged to date
- Not every respondent addressed every question



# 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?
- (2) What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs?
- (3) What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE?
- (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?
- (5) What actions could be taken by either the USPTO or applicants to reduce the need to file evidence (not including an IDS) after a final rejection?
- (6) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of 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)?
- (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?
- (9) How does client preference drive your decision to file an RCE or other response after final?
- (10) What strategy/strategies do you employ to avoid RCEs?
- (11) Do you have other reasons for filing an RCE that you would like to share?



# Demographics

- Respondents included:
  - 5 Organizations (AIPLA, IPO, ABA, JPAA, IEEE)
  - 4 Corporate attorneys / Corporations
  - 3 Academics
  - 28 Practitioners
  - 36 Examiners
  - 1 Pro se Inventor



# High Level Feedback

- Comments focused on:
  - After-final practice
  - Overall quality of Office actions
  - Final rejection practice
  - Management and supervisory oversight
  - Docket management system
  - Production system



# High Level Feedback

- Addressing the submission after allowance of IDSes with increased fees/no certification or modified certification
- Compact prosecution of applications with a shorter, set period of time with more interaction with the examiner and perhaps an additional action—so while there is more back and forth, the conclusion of the application would happen sooner.
- Many RCEs are filed because of the expectation that the amendments required to advance prosecution would not be entered by the examiner after-final



# Next Steps

- Complete Data Analysis
- Develop Recommendations



# CONTACTS

- [http://www.uspto.gov/patents/init\\_events/rce\\_outreach.jsp](http://www.uspto.gov/patents/init_events/rce_outreach.jsp)
- <http://uspto-outreach.ideascale.com/>