

# Patent Public Advisory Committee Meeting

## RCE Outreach



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# Data Collection Overview

- Collected ideas from:
  - Written responses to Federal Register (FR) notice
  - Emailed comments to FR notice
  - Posted comments from IdeaScale® Internet site
  - Internal and external blog postings
  - Roundtable presentations & discussions
  - Focus groups
- Ideas are logged in database
  - Categorized to help quantify results
  - More than 1100 responses logged
  - 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:
  - 6 Organizations (AIPLA, IPO, ABA, etc.)
  - 9 Corporate attorneys / Corporations
  - 3 Academics
  - 46 Practitioners
  - 36 Examiners
  - 1 Pro se Inventor
  - Roundtable participants

Results are anecdotal and informational, rather than statistically descriptive of general stakeholder population



# Question One

**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?**

- 22 responses indicated there was some impact on RCE filing
  - Crowded arts
  - Complex arts (biotech, pharma, business methods)
- 21 responses indicated technology did not impact RCE filings
  - Varies more by GAU or examiner than technology or client





# Question Two

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

- 459 responses received in response to this question
- External stakeholders focused on
  - Final practice (2<sup>nd</sup> action final)
  - After-final practice
  - Overall examiner quality
- Internal stakeholders focused on
  - Docket management system
  - Production system



# Question Three

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

- 32 responses indicated that interviews help avoid at least some RCE filings
  - Some RCEs still needed
- 31 responses indicated that interviews did not help avoid RCE filings
  - Examiners non-committal
  - Examiners state proposals require further search/consideration
  - Difficulty scheduling interviews



# Question Four

**If, on average, interviews with examiners lead you to file fewer RCEs, at what point during prosecution do interviews most regularly produce this effect?**

- No clear preference for holding interviews at any particular point in prosecution
  - Before FAOM (9)
  - After FAOM (14)
  - After final (10)
  - Anytime (4)





# Question Five

**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?**

- The examiner being more proactive (8)
  - Pointing out in the FAOM what evidence would be helpful
  - Indicating allowable subject matter
- Higher quality FAOMs or higher overall quality (7)
- More liberal after-final practice (6)
- Interview practice (2)
  - Call prior to mailing final rejection
- Include data in specification on filing (1)



# Question Six

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

- Denying entry of an after-final response (28)
- General benefits of an RCE vs. appeal in terms of time and cost (16)
- Belief that more progress could be made by further prosecution (14)
- Need to file an IDS or declaratory evidence (5)



# Question Seven

**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)?**

- When case is close to allowance (18)
- To overcome a reasonable rejection, or otherwise get the case in better form for appeal (9)
- Minor amendment likely to be entered (7)
- To avoid a first-action final after RCE (4)
- To try to avoid the cost of an RCE (2)
- Some believe after-finals 'never' entered (6)



# Question Eight

**Was your after final practice impacted by the Office's change to the order of examination of RCEs in November 2009? If so, how?**

- Some (29) said the possible lengthy delay after RCE filing made them 'last resorts'
- Others (20) said the docketing change has not had an impact
  - If an RCE is needed, it is needed regardless of docketing order
- Nearly all disliked the delay
  - One favored the extra PTA



# Question Nine

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

- 17 respondents indicated that of course clients ultimately make the decisions
- Client cost concerns were cited by 9 respondents





# Question Ten

## What strategy/strategies do you employ to avoid RCEs?

- Interviews (22)
- Appropriate claim drafting (18)
  - Fair number of dependent claims
  - Claims of varying scope
  - Knowledge of art prior to filing
- General good prosecution (8)
- Early response or submission of evidence after final (6)
- Pre-appeal requests (3)



# Question Eleven

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

- Office issues:
  - Perceived inadequate FAOM quality (32)
  - Perceived premature final rejections (30)
  - Perceived production system pressures (6)
- Applicant issues:
  - Need to file IDS after final or allowance (19)
  - Simple need to continue prosecution (18)
  - Poor initial application quality (17)
  - Deliberate choice to extend prosecution (8)
  - Need for additional time to gather evidence (4)



# Other Comments

Other comments not related to any particular question

- RCEs not necessarily a problem per se
  - Simply another prosecution technique
- Favorable view of existing pilots and desire that they be made permanent
  - AFCP
  - QPIDS
- Generally favorable view of interview practice at office and examiners' willingness to conduct interviews
  - Do not necessarily prevent RCEs



# Top areas

<b>Categories</b>	<b>External</b>	<b>Internal</b>	<b>Grand Total</b>
FAOM and general quality	56	1	57
Final Rejection Practice	55		55
After-final Practice	53	1	54
Docket Management System	17	25	42
Management & Supervision	33	3	36
Interview Practice	30	3	33
Production System	22	8	30
IDS Practice	26	1	27
Fees / Costs	18	6	24
Proactive Examination	19		19
Pre-FAOM Activities	15	1	16
Miscellaneous Suggestions	15		15
Applicant Actions	10	4	14
Appeal and Pre-Appeal Practice	13		13
Communication	10	1	11
Limit right to file RCEs	3	4	7
Single-action RCE	3		3
General comment	3		3
<b>Grand Total</b>	<b>401</b>	<b>58</b>	<b>459</b>