USPTO RCE Outreach

A Framework for Reducing Backlog

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Current RCE Practice: Standard Part of Prosecution Process

- Extensive use
  - multiple RCEs per filing to obtain suitable claim scope
  - considered necessary
  - consistent with continuation practice prior to RCEs

- Some movement to prefer appeals
  - greater delay for RCEs

- Clients' views
  - dislike endless RCEs
  - understand RCEs are often necessary to obtain claim scope
  - but, do want to see interviews
Reasons RCEs Are Extensively Used

1. Premature final status: failure to flesh out issues prior to final
   - No meeting of minds between applicant and examiner on meaning of claim terms or application of art to claims
   - Good art presented for first time after final

2. Often the best option after final
   - Pre-appeal -- no longer a useful option
   - Response after final -- rarely useful; clients dislike
   - Appeal
     - long delay; more expensive
     - but can be a good option
   - Abandon -- usually not desirable
Framework to Reduce RCE Filings:
1. Fleshing Out Issues Prior to Final

- Procedures to further meeting of the minds
  - Encourage interviews prior to final
    - not a call to offer token claim, but substantive discussions on reasoning behind rejection
    - induce examiner and also applicant?
  - Encourage better presentation of rejection
    - claim term interpretation?
    - telephone call to explain rejection?
    - better explanations?

- Good art presented for first time after final
  - Encourage pre-filing searches?
  - Encourage reliance on best art in first office action
    - discourage poor first office action
  - Applicant writes substantive dependent claims
Framework to Reduce RCE Filings:
2. Make RCEs Less Desirable (Make It The PTAB's Problem)

- RCEs are often the best option after final

- If RCEs become less desirable, the next best option will be selected -- appeal
  - large appeal backlog
Framework to Reduce RCE Filings:

2. Make Alternatives More Desirable

- Shift resolution to more efficient alternative

- Improved implementation of pre-appeals could reduce burden caused by RCE and Appeal backlog by encouraging applicants to pre-appeal where pre-appeal is more suitable than an RCE

- This would also systematically discourage premature finals if examiner knows pre-appeals will be consistently applied
Conclusion

- **Focus primarily on ways to avoid premature final**
  - Making RCEs less desirable merely shifts problem, but does not solve it

- **Interviews are key**
  - Applicants should extensively use
  - Incentives for examiners would also help

- Also, renewed pre-appeal process would result in more efficient resolution of disagreements