



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**

