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**Sent:** Thursday, March 07, 2013 3:01 PM  
**To:** RCE outreach  
**Subject:** RCE Outreach Focus Questions

### **RCE Outreach Focus Questions**

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

- Allowing an Examiner to more easily withdraw the finality of an Office Action if it is determined that the finality was improper.
- Reducing the reasons that allow an Examiner to issue Final Office Actions, thereby reducing the chance an Office Action is final.
- Providing an incentive and allowing an Examiner to enter claim (or any kind of) amendments into the application (and to conduct a new search on such amendments if needed) without first requiring the filing of an RCE. For example, perhaps an Examiner indicates that the claims may be allowable during an interview but that a new search needs to be conducted. In such a situation where the Applicant and Examiner are not too far apart, provide a procedure where an Examiner would get full credit for doing a search and issuing a communication on same without the need for an RCE. Perhaps similar to the after-final pilot program but more lenient?

(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?

- While it is preferable to conduct a phone interview early on in prosecution, especially after a non-final Office Action, sometimes this is not possible for various reasons. As such, it is always appreciated when an Examiner agrees to an interview even after a Final Office Action has issued. This is the most typical situation in which an interview will help avoid the filing of an RCE if the Examiner and Applicant can work out any issues related to informalities, substantive rejections, etc.

(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?

- If an Examiner requires evidence (e.g., a declaration), I am not sure what an Applicant can do other than comply with the Examiner's request, especially if that's the only way to move the application towards allowance.
- That said, if evidence is required and the Examiner won't budge on that issue, then the U.S. PTO could provide a way to allow an Applicant to submit same after a final rejection by treating that evidence as if it were submitted after a non-final rejection. For example, if the Examiner states that he/she does not disagree with the applicant's remarks in a prior response but needs additional evidence before green-lighting the allowance, then allow the applicant to submit the evidence without needing an RCE. In other words, if the U.S. PTO requests the evidence, treat the request as if it was in a non-final communication.

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

- Usually, an Examiner's position is that an RCE must be filed in order for the Examiner to enter an amendment of any type into the application and to conduct a new search on that amendment. As such, an RCE is favored when an amendment is required. Sometimes an Examiner may agree to enter an amendment without an RCE, but this is not the norm.
- If an amendment is relatively minor and a new search not too burdensome, it would be appreciated if Examiner's received credit for the supplemental search (as mentioned above) without the need to file an RCE. See above comment re: after-final pilot program.

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

- Have phone interviews earlier on during prosecution to make sure everyone is on the same page and to hash out the issues more efficiently to move the application towards allowance.