

From: Alan Heimlich
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To: RCE outreach
Subject: RCE Outreach

Here is our feedback. Any questions contact me.

(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?

A1) The difference is not due to technology. The biggest factor is new versus experienced examiners with the newer examiners requiring more RCE(s)

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

A2) Have the Examiner BEFORE examination CALL the attorney/applicant and discuss the invention for 5 minutes. This lets them know what patent material is being sought.

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

A3) Yes it does have an effect. The RCE claims are more focused in some cases.

(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?

A4) They are only allowed after the first non-final by right. That's when we do them. They should be BEFORE the first examination.

(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?

A5) Again get the examiner's on track on what is trying to get patented by having the examiner CALL before examination begins and the examiner goes down the wrong path.

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

A6) EXELIXIS and that the examiner just plain does not understand the invention. Both of these favor RCE. Sometimes the examiner is so far off base there is no other choice but RCE and Appeal. EXELIXIS finally gets it right and we can get back all the PTO delays.

(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)?

A7) Amendment only filed if already close to allowance.

(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?

A8) No it was not. In fact it now helps the applicant because the PTO delays are gained back.

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

A9) Not an easy decision. Some clients prefer to go immediately to Appeal. Others are willing to try an RCE if in my opinion we are close to allowance.

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

A10) Examiner interview.

(11) Do you have other reasons for filing an RCE that you would like to share?

A11) While not encouraged, because the PTO now puts RCEs at the bottom of the stack it's a great way to extend the life of the patent/application.

Alan Heimlich
Reg 48808

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