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Via Electronic Mail
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IBM Corporation comments in response to “*Request for Comments on Request for Continued Examination (RCE) Practice*” 77 Fed. Reg. 235, 72830 (December 6, 2012).

IBM thanks the United States Patent and Trademark Office (“Office”) for the opportunity to provide input and comments regarding Request for Continued Examination (RCE) Practice described in Request for Comments on Request for Continued Examination (RCE) Practice.

We focused our answers on questions 1-4, 6, and 10 and did not answer the remaining 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?

IBM has noticed that certain art units are more prone to protracted prosecution, including multiple RCE filings, and less prone to compact prosecution than other art units. Patent applications examined in art units with a crowded field of prior art tend to fall in the protracted prosecution category because often the most relevant prior art is cited after a first Office Action and responding Amendment. Generally speaking, in addition to the most relevant prior art being cited after the first Office Action, the Examiner’s best interpretation of the application of the prior art to the claims is recited after the first Office Action. If the Examiner presented the most relevant prior art as well as the Examiner’s best interpretation of the application of the prior art to the claims in the first Office Action, attaining more compact prosecution is achievable. Although we can not say with certainty why these art units are more prone to

RCE filings, perhaps it is harder to generate a targeted search in a crowded art unit, and that explains why art units with a crowded field of art result in less compact prosecution.

IBM has also observed that certain art units generate first Office Actions with a higher proportion of §101 and §112 rejections than other art units, which diverts the Examiner from citing the most relevant prior art until after the first Office Action and corresponding Amendment addressing the §101 and §112 rejections. Compact prosecution would be best attainable if in addition to the §101 and §112 rejections, the Examiner cited the most relevant prior art in the first Office Action. If the Examiner does not understand the invention because of the §101 and §112 issues, we recommend an interview before the first Office Action.

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

IBM applauds the Office for implementation of both the After Final Consideration Pilot (AFCP) as well as the Quick Path Information Disclosure Statement (QPIDS). We strongly recommend that both the AFCP and QPIDS programs convert from pilot to permanent status. We have found both programs reduce RCE filing.

IBM recommends the following additional changes to the Office's procedures. First, we strongly urge Examiners to more clearly identify the type of claim amendments that would require additional search in response to a Final Office Action and those that would not. We find that Examiners generally indicate that any claim amendments will "require further search," but if Examiners would more specifically identify those claim amendments that really do require further search and those that do not, Applicants would more easily remain within the bounds of the latter type of claim amendment and would thereby avoid the filing of an RCE. It is in this particular scenario, that IBM finds the After Final Consideration Pilot (AFCP) especially helpful. If the Examiner needs a few hours to determine whether an amendment places an application in condition for allowance, we support giving the Examiner the additional time, as is championed in the AFCP program. Examiners should give an indication in a final Office Action of allowable subject matter or a suggestion of what would be allowable (in the case where none of the claims are allowable). Also, the Examiner could give an indication such as "encouraging the Applicant to set up an interview" (e.g., because the Examiner believes the claim rejection(s) are "close" to being overcome and wants to verbally discuss his/her suggestions for overcoming the rejections). This feedback from Examiners would give Applicants a better indication of when to file an After Final amendment without an RCE. The Office could provide a monetary award or even a portion of a count for Examiners who initiate interviews and/or recommend amendments that result in an allowed application prior to an RCE being filed.

Second, we urge Examiners to ensure close search and examination of both independent and dependent claims. IBM recommends that the search and examination of the independent and dependent claims happen prior to the first Office Action for the best chance of avoiding protracted prosecution. We find that many times the dependent claims are grouped with the independent claims, such that the same references used to reject the independent claims are used to reject the dependent claims, even if such rejection is improper because, e.g., the references do not contain the elements added by the dependent claim and as a result these added elements are simply not addressed by the Examiner. Examiners should also address any amended or new claims in the subsequent Office Action. In other words, if claims are amended or added, Examiners should cite the best prior art against these amended or newly added claims as promptly as possible.

We also urge Examiners to act within 10 days of the receipt of an After Final Amendment. Often we gauge whether to file an RCE based upon the contents of the Advisory Action. If we file the After Final Amendment by the two month date and receive a timely Advisory Action, we can determine whether it makes sense to file an RCE by the three month date. If Examiners do not act on the After Final response within 10 days, then Applicants often file RCEs by the three month date to avoid additional extension fees, when otherwise the RCE may have been avoided.

IBM offers the following as suggestions or “best practices” which would enhance prosecution and should avoid RCE filings in many instances if adopted by the Office. As a first suggestion, when an Applicant makes a statement in the Remarks of an Amendment, and the Examiner knows that a feature mentioned in the Remarks would be allowable but is not claimed, Examiners should communicate this to the Applicant. As a second suggestion, should a specification cover multiple embodiments, and Examiner’s search was broad enough to cover some embodiments described but not claimed, it would be helpful if the Examiner indicated which, if any, of the other embodiments is novel based upon the Examiner’s search. The Office could charge an additional fee corresponding to the cost of the extra work associated with examination of embodiments disclosed in the specification, but not claimed.

The Office should generate some statistics on RCE practice. For example, the Office should generate statistics on an art unit basis regarding the prevalence of RCEs. More specifically, the Office should generate statistics on an art unit basis examining which art units generate the highest number (or percentage) of RCE filings and which generate the lowest number of RCE filings. The Office should then take the best practices from the art units generating the lowest numbers of RCE filings. The Office should also generate statistics on how often the Office issues non-final actions to reject claims that were not searched or examined when first presented. Delay in examination is likely correlated with

RCE filing. The Office could provide a monetary award or other recognition to art units and/or Examiners with the fewest RCEs being filed.

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

IBM finds interview practice to be an effective tool for moving an application efficiently towards allowance, particularly if done after a first Office Action. The Office's own statistics show that an interview prior to final disposition reduces improper allowances and rejections by 40%¹. Interviews After Final, may also be effective if the interviews are conducted with both the Examiner and Supervisory Patent Examiner present. During After Final interviews, the Examiner and Supervisory Patent Examiner may help assess the need to file an RCE. For example, the Examiner and Supervisory Patent Examiner may indicate that the claim amendments made after final overcome the existing rejections of record in which case the costs of continued examination with an RCE may be worthwhile. Alternatively, the Examiner and the Supervisory Patent Examiner could agree to enter an amendment because it is compliant and would not require further search. Finally, the Examiner and the Supervisory Patent Examiner may indicate that the claim amendments made after final do not overcome the existing rejections of record in which case appeal or abandonment may be the more worthwhile avenue of pursuit.

IBM suggests that Examiners and their Supervisory Patent Examiners make their calendars available online. Applicants could then schedule an interview with an Examiner and Supervisory Patent Examiner by reviewing their online calendars. Applicants avoid bothering the Examiners with a phone call only to set up a future phone call for an interview. Online scheduling would be most efficient.

(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?

IBM finds that interviews earlier in the process are most effective at RCE reduction. When an interview is conducted before the first Office Action, the Examiner can share with the Applicant his/her interpretation of the most relevant references and the Applicant can share his/her best interpretation of claim scope.

Interviews after the first Office Action are helpful to understand how the Examiner applies the cited references to the claims. If, during an interview, particularly with the Supervisory Patent Examiner present, agreed upon allowable subject matter is established, then Applicants can appropriately amend

¹ USPTO Director's Blog http://www.uspto.gov/blog/director/entry/interviews_and_patent_quality (January 15, 2013).

the claims such that they're put in condition for allowance. If allowable subject matter is not established, then, whenever possible, we strongly urge Examiners to provide a suggestion of the type of claim amendments that may result in allowable subject matter with as much specificity as practicable.

Interviews after a final Office Action are beneficial to understand just how far apart the Examiner and the Applicant are with respect to allowable claim scope. If the Examiner indicates that the Applicant's proposed After Final claim amendments would be allowable over the cited references, Applicants would be more likely to continue prosecution with an RCE. Alternately, if Examiner indicates in an after final interview that even the Applicant's proposed After Final amendments do not overcome the prior art, Applicants would be more likely to appeal or abandon the case. Thus, as discussed above, when allowable subject matter is not established, we strongly urge Examiners to more clearly identify (during the interview, if possible) which of Applicant's proposed claim amendments would or would not require further search in response to a Final Office Action. We find that Examiners generally indicate that any amendments presented in an After Final amendment will "require further search," even if some of the amendments put one or more of the claims in condition for allowance. However, if Examiners would more specifically identify those claim amendments that really do require further search and those that do not, Applicants could make a more informed decision on whether to pursue the entire claim set in an RCE or to just pursue only the claims that would not require further search or consideration (e.g. allowable dependent claims rewritten in independent form) in a subsequent After Final response. Once again, the AFCP program is beneficial in this capacity, because if the Examiner needs just a few more hours to examine an application, the AFCP program gives the time to the Examiners. We again assert that the AFCP program should become a permanent tool Examiners may use in appropriate circumstances.

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

Appeals are preferable over RCE, whenever it seems that the Applicant and Examiner have trouble understanding each other's interpretation of the cited references or the claim scope. Otherwise, if the Applicant and Examiner can reach a compromise, then RCE is preferable.

After final interviews are helpful tools for understanding whether appeal, RCE or abandonment is the best alternative. If the Examiner indicates in an after final interview that the amendments after final would overcome the cited references but would "require further search," then filing the amendments after final and an RCE would be the best route forward.

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

IBM employs various strategies to avoid RCE filings. As we noted earlier, we take full advantage of interviews with Examiners at each stage of prosecution practice. According to the Office's statistics, a good percentage of After Final amendments would have resulted in an allowance without the need to file an RCE. IBM's own statistics support the Office's statistics because our own statistics indicate that nearly one third of all RCE filings are immediately followed by a full or partial allowance of the claims. In other words, IBM statistics indicate that if some action were taken earlier in the prosecution of the application, perhaps the RCE would have been unnecessary. As mentioned earlier, sometimes we file our After Final amendment by the two month date, and then after having reviewed an Advisory Action, if need be, by the three month date file the RCE. We urge the Office to remind the Examiners that a response to an After Final amendment must be filed within ten days. If Examiners meet this deadline, Applicants are able to work towards RCE reduction, because they will have the benefit of the Advisory Action before deciding whether to file an RCE. Finally, in appropriate cases, we endeavor to bring the Supervisory Patent Examiner into the prosecution of the patent application as early as possible. As an example, if the Examiner states that a certain claim amendment would bring the application to allowance, we would want the Supervisory Patent Examiner in agreement with the Examiner before we filed the amendment.

Conclusion

IBM thanks the Office for providing the public an opportunity to submit comments regarding RCE Practice described in the Request for Comments on Request for Continued Examination (RCE) Practice. We look forward to working with the Office on forthcoming notices.

Respectfully Submitted,

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