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To: RCE outreach

Subject: RCE 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? no
- 2) What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs?
– An RCE is only necessary because the examiner's show little flexibility on after final. If more flexibility can be shown then we would not need an RCE. Presently, almost any meaningful amendment must be filed after first. If additional art is found, an RCE is almost a guaranteed result!
- 3) What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE? – None – we try to interview whenever possible.
- 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? Interview after first is usually helpful. After final interviews RARELY result in allowance, but simply are an invitation to file an RCE
- 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?
- 6) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE? When the examiner has rejected the response, based on a new search, we have no choice but to file an RCE.
- 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)? - Always can try – but rarely is a meaningful amendment allowed
- 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? Unfortunately, no. We file an RCE when the only other choice is appeal.
- 9) How does client preference drive your decision to file an RCE or other response after final?
- 10) What strategy/strategies do you employ to avoid RCEs? Try to get it right on the response to first.
- 11) Do you have other reasons for filing an RCE that you would like to share?

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