

**From:** Gordon Lindeen

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**To:** RCE outreach

**Subject:** The most common reason for an RCE is a final rejection with new references.

RCEs are an issue and in some cases they are necessary to fully develop the issues with the Examiner and the search and the claim language. The new ability to interview cases after Final and the initiative shown by some Examiners to call for an interview after final is fantastic and is making me change how I prosecute cases.

Two reasons are behind the substantial majority of my RCEs:

- 1) A final rejection with a new search and new references. While the Examiner will usually use the form paragraph that my amendments necessitated the new search, this is most often not true. The amendments are further defining an existing feature or incorporating a feature from a dependent claim. The reason for the new search is that the Examiner, after my amendment now understands what the point of novelty is. If this second action were not final, then the RCE would not be necessary. The new Interview rules are helping with some of these cases. In other words, if the norm were three office actions, rather than two, there might be many fewer RCEs
- 2) Mystery Examiner stubbornness. In some cases, the Examiner will simply persist with a rejection with or without new references without any clear explanation of why and without addressing my arguments. These examiners tend to avoid interviews as well. Sometimes talking to the supervisor helps sometimes it does not. I don't know if this is an inability to communicate the real problem with the claim or just trying to kick out Office actions with no effort or a little of both. This issue has improved with the new point counts but it still happens.

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