

From: Deepak Malhotra
Sent: Saturday, February 23, 2013 7:23 PM
To: RCE outreach
Subject: RCE Outreach

This is in response to your RCE outreach questions. My answers or comments appear under each question.

(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?

I file RCEs in response to Final Rejections. Singling out RCEs as meriting a special focus is unfair. The real issue is what can be done to lead prosecution of a patent application to a faster conclusion. The second office action is almost always Final, resulting in the need for an RCE or appeal.

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

Encourage examiners to look at dependent claims or try to find at least one allowable dependent claim, if possible, or, if none exist, to try to suggest an allowable claim to applicants. The ideal scenario would be to have a bright line test for obviousness; e.g., if a combination of more than four references are required to find all elements of a claim, the claim is non-obvious. Of course, such a test would be tested in a court. While the Federal Circuit attempted to have a somewhat bright line test, the teaching-suggestion-motivation test, the Supreme Court in KSR showed their dislike of bright line tests. Without a bright line test, patent attorneys will tend to keep fighting until they get something allowed or the client runs out of money or gives up.

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

None. After an interview, an examiner is often non-committal. After the interview, a new search is sometimes performed and a new ground of rejection is raised. This is particularly true with junior examiners who don't have signatory authority.

Also, some examiners seem to like to see a new claim prior to an interview. For a client, this means increased cost. An interview can speed up the process but, in effect, you are preparing two responses. You are preparing claims for discussion before the interview, as well as a formal amendment after the interview. This requires attorneys to charge more for interviews than for conventional responses. Smaller clients often prefer a conventional processes to reduce costs.

(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?

Not applicable.

(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?

I always recommend an RCE or an appeal after a final rejection. Examiners rarely allow a case in response to an after-final amendment without an RCE. Part of the reason is the points system. They are more motivated after an RCE is filed. The other alternative is an appeal, which results in high cost to the applicant and significant delay. I will usually only recommend an appeal if prosecution is going nowhere after a couple of RCEs. If an application is mostly allowed, and the client provides instructions in the first two months after a final rejection, I might consider an amendment without an RCE. Another factor in the decision to recommend RCEs is the way that the time period for response is calculated after a final rejection. If a response is not filed in the first two months, there is a risk that an advisory action will be mailed after statutory period for response has expired. Whether or not this actually happens, it is too high of a risk to file a response after the first two months, considering the result will most likely be an advisory action.

(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)?

There would have to be some claims allowed and we are just putting the application in condition for allowance by cancelling rejected claims or moving dependent claim limitations into independent claims.

(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?

No.

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

I will obviously do what the client prefers but most seek my advice and I recommend RCEs unless we have some allowable subject matter.

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

None.

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

Simply to attempt to obtain allowance of claims of reasonable scope.

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