

From: Raymond Van Dyke
Sent: Thursday, March 07, 2013 6:27 PM
To: RCE outreach
Cc: Koenig, Andrew
Subject: Comments to After Final Pilot Coordinators

Dear After Final Pilot Coordinators:

I am providing some comments to your questions. The issue of RCEs is a problematic one, but not one where we should make drastic changes. Our patent system permits follow-on examination and that right should not be unduly curtailed. The diminution of the patent term is sufficient detriment against RCEs.

I have been practicing patent law for over 23 years, and find the majority of examiners to be upstanding public servants. A minority, however, treat the prosecution process as an adversarial scenario, as do many practitioners. Of late, I have noticed the introduction of some unfairness in the After Final practice, actually the justification for finality is sometimes deficient. Our patent system is not a European one where continuation/RCE practice is generally forbidden. This is a boon for inventors here, albeit with the downside of a growing number of RCE applications. Nonetheless, the Office generates more fees based on these cases, and Examiners should treat them anew with each new fee paid and not treat them cursorily.

As noted in the comments to the questions below, the RCE process is a buffer for some unfairness in the system. Sometimes examiners have not put enough effort into a case or cannot comprehend it. Applicants are then caught in a dilemma on what to do: educate the examiner, fight the rejection, appeal, etc. The Office has made great efforts to modify the count system to provide a reward for case disposition, and I am not knowledgeable enough about ways to make that better – apart from giving the examiners more time and incentive to work with Applicants directly to resolve their differences.

I have answered most of the 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?

Most of the problematic after final cases are in the Information Technology and Electronics sectors.

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

Examiners and counsel need to be cooperative and fair in the examination process. Examiners sometimes write a poor First Office Action, with inapplicable and irrelevant art cited. Clients often feel that the Office is derelict in not bothering to understand the actual invention. Sadly, even a lengthy exposition by the Applicant on the merits of the case is too often fruitless. Even evisceration of the initial references and rejections cannot prevent the institution of finality.

Some Examiners now provide a blanket statement that Applicant's actions (amendment) necessitated the finality. This is particularly galling when entirely new references and entirely new arguments are thrust at you – and called final. What happened to twice rejected (on the same grounds)? Further, by trying to cooperate with the Office, e.g., by narrowing the claims, you are penalized with instant finality. This is a driver for RCEs. A second, non-Final Office Action is instead warranted in this scenario – new references and new arguments should never be final.

Additionally, on more than one occasion I have had to explain the basic principles of the invention to the Examiner, who is totally ok to finally reject the case without understanding it. Conversely, many Examiners have a hyper-understanding of the case and the negotiation is most often a fair exchange.

Talented and knowledgeable Examiners should not be at a disadvantage vis-à-vis the novices. Bad Office Actions are a problem. Combine that with the rush to finality, and you have an injustice.

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

Interviews are often good at airing the details and positions out. However, at the end of an Interview, the Examiner invariably says that whatever actions needed constitute more search. Hence, no way they will allow the case, even with agreement, and they demand an RCE. More leeway in this instance would allow the process to complete with an allowance.

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?

An Interview earlier in the process, definitely not at the finality stage, would be better.

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?

For the USPTO Examiners, a more open mind and willingness to consider any positions to achieve allowance during after final instead of sticking to the mantra of new issues.

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

Under current after final practice, Applicants under final MUST file an RCE or abandon the case. The only Factor is whether the client wishes to continue. A draconian after-final policy will only drive the RCE count higher and create more dissatisfaction toward the Patent Office by clients.

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)?

The only instance when an After-final amendment has a chance to be considered is when some of the claims have been allowed and you take that allowance.

Apart from this one instance, under the current after final paradigm, it is usually useless to do this. The Examiners invariably state that any consideration of the arguments/changes necessitate further searches/work and they will/cannot thus consider it.

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 comment on this issue.

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

Basically, if the client wants the patent, we file an RCE by necessity. Any response after final, apart from allowed claims, is usually fruitless.

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

I try to be cooperative with the Examiner, open to speaking with them, amenable to an Interview and more. For some Examiners, however, there is little cooperation.

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

Under the current after final paradigm, it is necessary to file an RCE and hopefully get the Examiner back on track.

With some Examiners of late, the Second Office Action finality is a rush to judgment without reason or basic fairness. In particular, if the First Office Action references and arguments are overcome, and the Examiner then cites entirely new references and new arguments in a now Final Second Office Action, this is manifestly unfair. The injustice of this approach is exacerbated by Applicant's earlier narrowing their claims to seek allowance. The amending alone "necessitates" the finality per the Examiner – with zero explanation of why this is so. MPEP 706.07(a). Thus, some Applicants are having an injustice perpetuated on them just by cooperating in the process. Had the claims NOT been amended, then the Examiner would stand pat, but then risk their inadequate rejections and irrelevant references being taken on appeal – creating an unnecessary expense to Applicants. Applicants are, therefore, damned if they do and damned if they don't. This is hardly fair and is not conducive to an orderly patent system.

Examiners should not be allowed to make a blanket statement that any and all amendments necessitate finality. Applicant's making an effort, e.g., by amending their claims, should not be penalized for this attempt. Examiners must be more cooperative with Applicants to reach a fair compromise.

Likewise, Applicants should be willing to negotiate with the Examiner to reach a fair compromise instead of being entirely adversarial. The prosecution process is not a battle, it is a negotiation.

I hope that these comments are helpful in the After Final discussion. The RCE issue has no immediate resolution operating under the current patenting paradigm. I would argue that this shows some health in the patent system. Enough Applicants wish to get their bite at the apple that we have a backlog. Again, the diminution of patent term is a limit on this process, as well as the estoppel effects of the ongoing argumentation and claim amending.

The Office should address the obvious inequities in the after final practice, such as the unjustifiable second action final with new references. With the large influx of new examiners, the backlog will diminish in time on its own, albeit with considerable effort. Draconian measures to curtail opportunities, such as proposed by Doll several years ago, are not at all preferred or warranted.

We practitioners merely request that Examiners reach out to Applicants/counsel in a more cooperative and constructive fashion, meetings of the mind. I recently had such a meeting with an examiner after final and realized that I was in the wrong and (horrors) the examiner was entirely right. Chagrined, I indirectly acknowledged the examiner's acumen and hung up the phone.

The patent process, albeit called prosecution, is not a juridical, winner-take-all proceeding. It is an open negotiation. We have the same end goal: the promotion of a healthy and fair patent system that will benefit all Americans and the world.

Best regards,

Ray

Raymond Van Dyke
Van Dyke Law
Washington Square
P.O. Box 65302
1050 Connecticut Avenue, NW
Washington, DC 20035

Phone: (202)378.3903
Email: vandyke@acm.org
vandykelaw@aol.com
ray@rayvandyke.com