



The Narrow Scope of Current 37 CFR § 1.97(e): A Root Cause of Numerous RCE Filings

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Base Statistics

- Our firm filed 951 United States Patent Applications in 2012
- We filed 328 Requests for Continued Examination (RCEs)
- A significant number of our RCEs were filed to obtain consideration of an Information Disclosure Statement (IDS) after receipt of a Notice of Allowance or Final Rejection
- Virtually all areas of technology
- Both non-U.S. and U.S. companies



Post-Allowance IDS Practice

- An IDS filed after a Notice of Allowance will only be considered if it complies with 37 CFR § 1.97(d)
- Compliance with 37 CFR § 1.97(d) requires both:
 - (1) payment of a fee (currently \$180) and
 - (2) a statement under either 37 CFR § 1.97(e)(1) or (e)(2)
- Many RCEs are filed because applicants perceive they cannot make either of the statements under § 37 CFR 1.97(e)



37 CFR § 1.97(e)(2)

(e)

A statement under this section must state . . .

(2)

[t]hat no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.



Difficulties in Making a Proper Statement under 37 CFR § 1.97(e)(2)

- Requires certifying practitioner to state that a potentially large group of people have, for basically their entire professional careers, never seen a particular document
 - impractical (at best)
- Concerns about later allegations of inequitable conduct
- Counterpart foreign application vaguely defined
 - MPEP 609: claim for priority, or “substantively identical”
 - are PCT/International applications “foreign” counterpart applications?
 - what is the meaning of “substantively identical”?



37 CFR § 1.97(e)(1)

(e)

A statement under this section must state . . .

(1)

[t]hat each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement



Difficulties in Making a Proper Statement under 37 CFR § 1.97(e)(1)

- Limited to communications from a foreign patent office in a counterpart foreign application
 - does not extend to related or counterpart U.S. (or PCT?) applications
 - arguably may not extend to the foreign communications themselves
- Counterpart foreign application vaguely defined (see above)
- Concerns about later allegations of inequitable conduct
- Particularly problematic in cases where a family of related U.S. applications are being prosecuted simultaneously



The Current Language of 37 CFR § 1.97(d) and (e) is a Root Cause of Many RCE Filings

- Limited scope of 37 CFR 1.97(e)(1)
+
• Difficulty of accurately confirming the information
requiring certification under 37 CFR 1.97(e)(2)
=
• Many Post-Allowance (and After-Final) RCE
Filings



The Current Language of 37 CFR § 1.97(d) and (e) is a Root Cause of Many RCE Filings

- Post-allowance information often not nearly as relevant as other information already on file
- But IDS still filed because of inequitable conduct concerns
- Increase in pendency without improvement in patent quality



Proposed Changes in Office Procedure(s) or Regulation(s) that would Reduce the Need to File RCEs

- Updating the language of 37 CFR 1.97(d) as proposed below
- The relatively higher fee for proceeding under below-proposed 37 CFR 1.97(d)(3) would encourage applicants to file IDSs in accordance with 37 CFR 1.97(d)(1)/(2) - *i.e.*, by making a 37 CFR 1.97(e) statement plus paying the § 1.17(p) fee - whenever possible
- If not possible, applicants could opt to proceed under below-proposed 37 CFR 1.97(d)(3)
- Could be expanded to address IDS filings after issue fee payment (by QPIDS program, for example)



PROPOSED NEW LANGUAGE FOR 37 CFR 1.97(d)

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by *either*:

- (1) The statement specified in paragraph (e) of this section; and
- (2) The fee set forth in § 1.17(p);

or

(3) *The fee set forth in § _____ [which could be, for example, \$400, or roughly twice the current fee set forth in § 1.17(p)].*



Other Option(s)

- Amend 37 CFR 1.97(e)
- Either during current RCE outreach or during upcoming IDS practice revisions



Thank you