

From: Todd Juneau
Sent: Thursday, March 07, 2013 6:03 PM
To: RCE outreach
Subject: RCE feedback from patent practitioner

Re:
RCE practice

Thank you for asking about RCE practice. I have been practicing patent law for 18 years and I have been primarily involved in patent prosecution. I have been based in the Washington Dc area my entire career. I have worked for/represented very large companies, start-up companies, universities, and government labs/contractors. I have personally written several hundreds of patent applications and filed several thousands of U.S. and foreign applications. Being based near the USPTO, I have advised my clients to interview every application and I have a good reputation for obtaining patents for clients.

RCE filings have historically been a critical element in my prosecution strategy. A description of my RCE use is provided below.

1. Aggressively Amend Claims

In patent prosecution, I advise clients that the patent system is akin to a "one swing and you're out" ballgame. That when the patent office says "final", that they mean "final" - game over, application not approved. Then, I explain that, given this reality, it is incumbent upon applicants to understand that it will commonly be required of them to make substantial cuts to claim scope, in response to the first action, to make any headway towards obtaining a "Notice of Approval" from the patent office, since the next office action (Examiner's Report) will be final and Examiners will not generally allow any further discussion or consider any further amendments, except those that might be considered to be minor, e.g. typos. Accordingly, my practice has often been to do just that, which is, to make substantial amendments to move the claim scope away from the prior art.

2. Interview Examiner

After filing the initial amendment (with very little commentary or argument since Examiner's a rarely persuaded anyway), I then follow this up with an interview with the Examiner. At the interview, my goal and attitude is to ask the Examiner what else we can do to put the claims into condition for allowance. We would discuss the prior art and the previous amendments. I usually try to find out what the Examiner might view favorably, and then I agree to do this, pending client approval. The Examiner's invariably cannot make a commitment at this time. So I then submit a supplemental amendment with the claims the Examiner suggested to us at the interview.

3. Final & RCE

Then next action is, of course, always a "final rejection". However, progress had been made. Oftentimes the Examiner had performed a second search, claiming that we "raised new issues". But this is fine, since the eventual patent will be all the stronger for it. As an aside, we always thought it strange that we go out of our way to provide the Examiner with the very best prior art in our IDS's, but then they go and do their own search and invariable find worse prior art than we gave them. Anyway, at that point, there is usually one additional amendment that is

required to put the claims into condition for allowance ("get them approved"). Because it is "after final", and I know the Examiners are required to make their counts within an allotted time depending on seniority, i.e. 14 hours, and that the Examiner is probably going to find it difficult to put more time into a case when there is no additional count to be received, that my chances of getting the Examiner to enter this last amendment are nil. Therefore, I would previously file it with an RCE, this would give the Examiner his counts, the amendment would be entered, and a notice of allowance would be issued.

PROBLEM - RCEs are not a sign of failure, but of success

Now, for the past 18-24 months, the USPTO examiner corps has implemented changes to RCE practice which has reduced my ability to quickly obtain allowed claims for my clients. I have been told by Examiner's that "higher ups" believed that RCE's were an indication that an Examiner was being unsuccessful, and so a policy was implemented to put RCE's at the very back of the line in terms of prosecution priority. However, this is completely wrongheaded. For me, RCEs were an indication that I would be able to obtain a client a patent within 18-24 months instead of the usual 3-4 years. Why didn't anybody ask a real examiner or a real patent attorney before implementing the "RCEs to the back of the line" strategy?

RCE Outreach Focus 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?

I used to file RCEs in every case; now I no longer file them because the PTO discriminates against them.

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

Give the Examiner's an additional count and give the applicants 2 non-finals before a final is issued. Alternatively, do not let the Examiner's conduct a second search.

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

They used to work hand in hand, RCEs and interviews. Now, the Examiner's don't see the point in interviewing; it is difficult to get them to agree to interview, even if you tell them you're trying to make it easier for them to allow vs. reject.

(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?

The earlier the interview, the better the Examiner will receive any discussions. Without RCEs, Examiner's will not usually want to interview after a final is issued.

(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?

Give the Examiner's an additional count and give the applicants 2 non-finals before a final is issued. Alternatively, do not let the Examiner's conduct a second search.

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

An RCE becomes necessary after we have narrowed the claims in response to a first office action and then the Examiner finds a whole new set of prior art and makes the (new) rejections final.

(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)?

I don't ever bother filing an amendment after final. If the amendment has any substance, the examiner never enters them. If the amendment is for typos or minor things, the Examiners just do these by examiner's amendment after calling me.

(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?

My practice was significantly altered in a very, very negative way. To be candid, the "perfect storm" of (1) Bilski, KSR, (2) your RCE change, (3) and the AIA's causing both examiner's and practitioners to no longer know what to do, has created a situation where nobody knows what's going on, nobody knows how to conduct work efficiently, it's a disaster.

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

Clients just want us to get them a patent. It is extraordinarily rare for a client to have an agenda where an RCE would be unwelcome. Usually, these applications involve existing litigation, either themselves or with their brother and sister applications, divisionals.

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

I just don't file them anymore. The only way to accelerate applications is to pay the \$2400 up front or hope your inventor is old. There is no longer a mechanism to let important pending applications advance to grant vs. letting less important ones linger.

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

See strategy 1-2-3 , above.

Regards,
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