

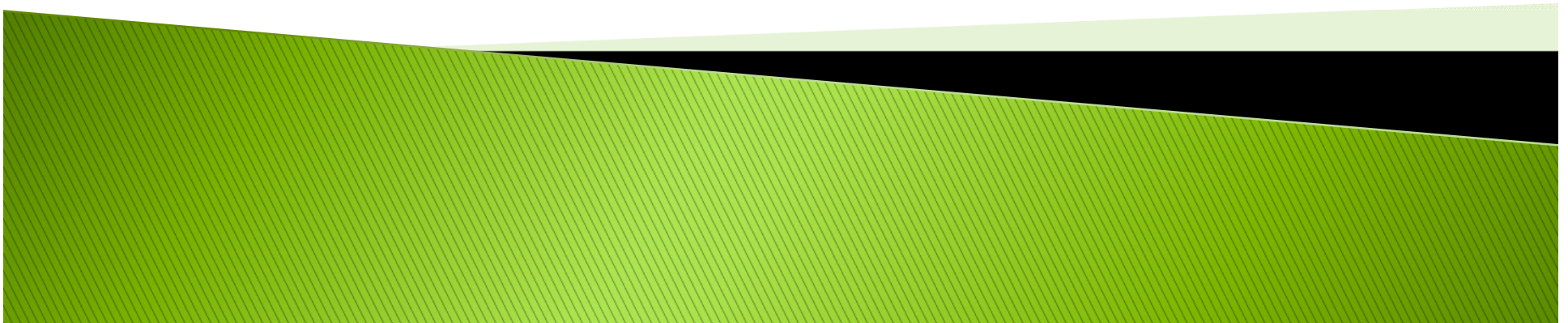


Intellectual[®]
Property
Owners
Association

Comments on behalf of Intellectual Property Owners Association

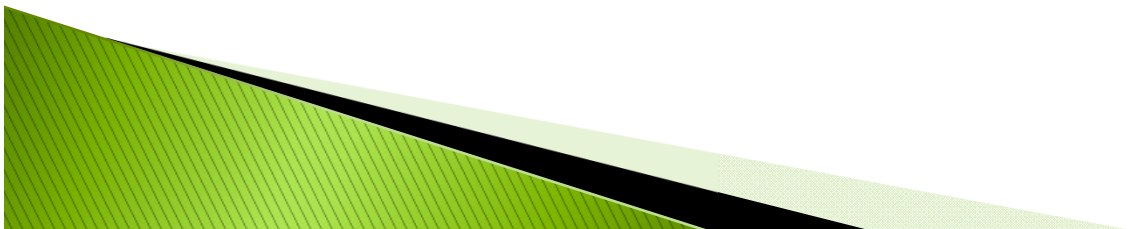
USPTO RCE Roundtable
April 3, 2013

Vanessa P. Rollins



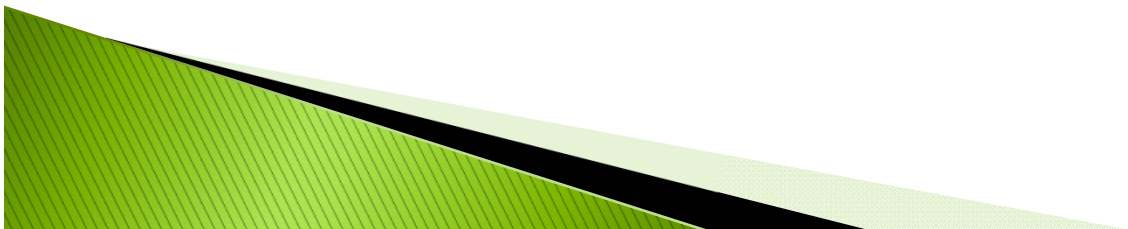
Intellectual Property Owners Association (IPO)

- ▶ Trade association representing companies and individuals in all fields of technology who own IP rights
- ▶ Members include >200 companies and >12,000 individuals
- ▶ Submitted written comments on Feb. 4, 2013



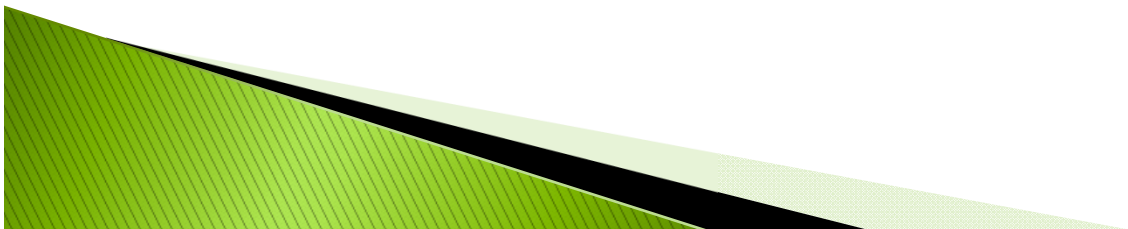
Reasons for filing RCEs

- ▶ To obtain consideration of IDS after final
 - Foreign references received after 1.97(e)(1) time
 - Art from non-counterpart foreign applications
 - Difficult to confirm 1 / 97(e)(2) statements for all people within Rule 56



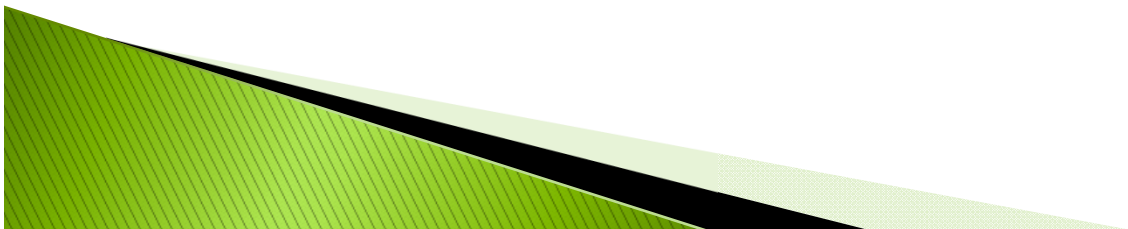
Reasons for filing RCEs

- ▶ To amend claims/respond to new rejections after final
 - New rejections may be “caused by” previous amendments/IDS



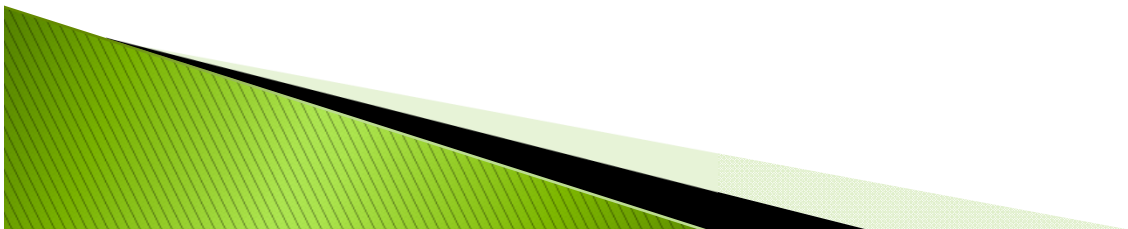
Reasons for filing RCEs

- ▶ To amend claims or present new evidence to address a rejection, where previous arguments, amendments, and/or evidence was not successful.
 - May need more than one “round” of prosecution to fully understand rejections, resolve 112 issues



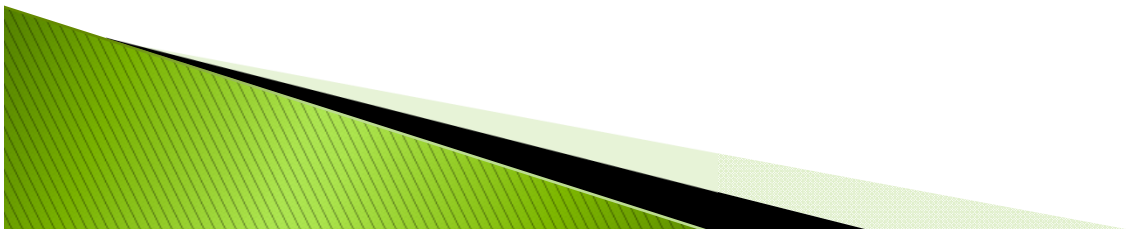
Reasons for filing RCEs

- ▶ To amend claims or present evidence to place application in better condition for appeal
- ▶ At the request of the Examiner, suggesting that an RCE will result in allowance (and earn extra counts)



IPO Concerns

- ▶ Growing backlog (over 90,000) of applications not examined since RCE filing



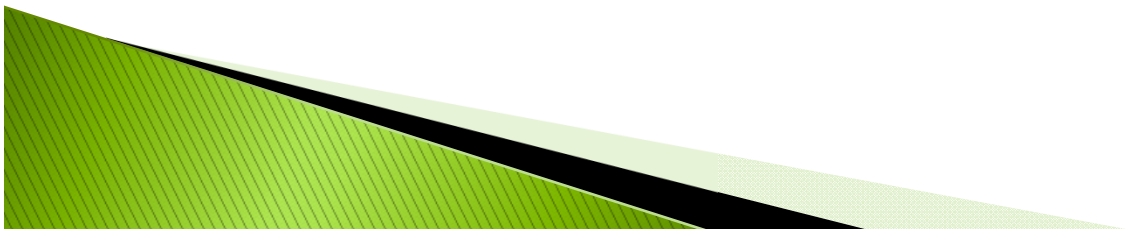
IPO Concerns

- ▶ Federal Register Notice: RCE backlog “diverts resources away from the examination of new applications”
 - IPO understands importance of reducing backlog of unexamined applications
 - But RCE examination is part of overall examination process
 - IPO urges focus on reducing overall pendency from filing to grant



IPO suggestions

- ▶ Develop and implement “best practices” for processing RCEs
 - Current RCE processing varies greatly among art units
 - Develop best practices to serve goals of compact prosecution and prompt grant of allowable claims



IPO suggestions

- ▶ Change docketing of RCEs to incentivize examiners to act promptly
 - Current docketing system puts RCEs as last priority
 - Post-RCE delays wastes PTO and applicant resources

Mid-stream, indefinite delay in prosecution
Examiner may forget invention, prior art, issues
previously raised
Especially frustrating after an interview



IPO suggestions

- ▶ Change count system to at least not discourage examination of RCEs
 - Current count system *disincentivizes* examination of RCEs
 - Some examiners urge applicants to file CON applications because examiners get more credit

Forces applicants to bear additional costs (e.g., resubmitting claim amendments or evidence to bring CON up to date with pending application)



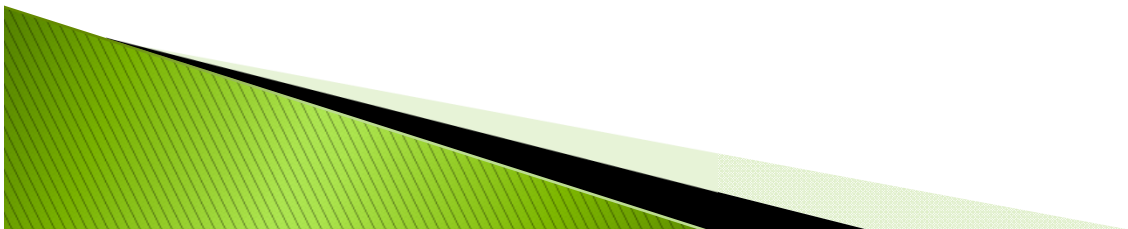
IPO suggestions

- ▶ Do not use fee structure to penalize RCEs
 - New fees are unduly high
 - Raise large entity RCE fee from \$930 to \$1,200 for first RCE and \$1,700 for additional RCEs
 - New fees do not account for the fact that there are many legitimate reasons applicants file RCEs
 - Unfair to require applicants to pay such high fees when RCEs are not promptly examined



IPO suggestions

- ▶ Make After-Final Consideration Pilot permanent
 - IPO commends PTO's creativity and efforts
 - Mixed experience: some examiners very willing to use, others refuse even minor, clerical amendments
 - Conduct widespread training of examiners to encourage use



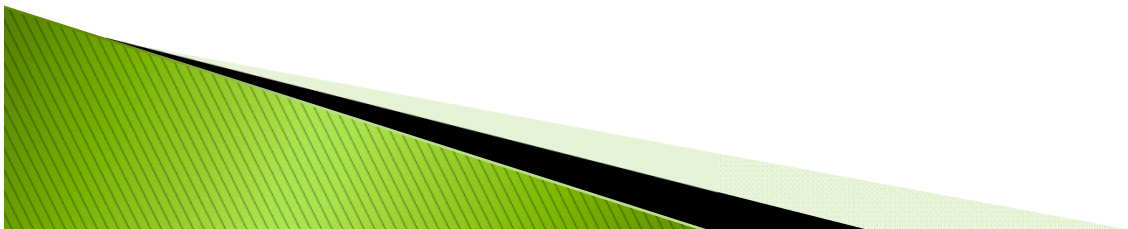
IPO suggestions

- ▶ Provide additional:
 - *incentives* to encourage after final consideration of claim amendments, and
 - *guidance* on when claim amendments can be entered after final
 - To address new reference or ground of rejection
 - To address new explanation in final rejection



IPO suggestions

- ▶ Provide more information in advisory action relating to Examiner's reaction to after-final claim amendments
- ▶ Eliminate MPEP 706.07(b) permitting examiner to make first action final after an RCE in many circumstances



Thank You.

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