

My Perception as a Practitioner of the Reasons So Many RCEs are Filed

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These remarks are solely the views of the author, not his firm or clients

Solution to reduce RCE Backlog:

Examiner Compliance with 37 CFR § 1.104(a)(1)

- thorough prior art search
- complete first Office action on merits.

My Background

- Registered 35 years
- Main focus has always been patent prosecution, including reissues, reexams.
- I teach RCE and continuation practice for AIPLA prosecution boot camp
- Mainly chemical, mechanical technologies
- Have some experience with litigation
- Clients frustrated, resources drained, by elongated patent prosecution

Preliminary note

- My comments are not directed at the majority of Examiners today
- A minority of Examiners probably account for a majority of excessive resort to RCEs
- Often a carryover from “zero allowance” practices adopted from ~2005-2009.
- Some prosecutors also use RCEs serially.
 - Dumb – no patent term adjustment

Choices after final action

- Request for Continued Examination (RCE)
- Appeal
- Continuation
- Abandon

... in approximate order of frequency

Appeal

- Used to present same claims, evidence to Board of Appeals instead of examiner
- Used to correct perceived Examiner error
- Currently a very long process, with fairly long odds
- More expensive than RCE – fees, cost to do legal research and write brief
- The only rational choice in former “zero allowance” regime

- Unusual
- Main situation – where some claims allowed, others rejected, final rejection
 - Take first patent on allowed claims
 - Pursue rejected claims in continuation
 - Using RCE is risky – potentially throwing out “bird in the hand”
- Other specialized, infrequent uses

Abandon

- I am out of ideas (infrequent), or
- Client is unwilling to devote further resources (too common)

- Used to present new claim amendment or evidence before the same examiner
- i.e. advances prosecution by changing issues
- I don't use to rehash same issues
- Special use: late-received prior art presented to Examiner
- Until recently, moved quickly
- USPTO has recently lowered priority of examination

Why needed so often? Several reasons



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- Negotiation requires more than two “rounds”
 - Examiner is able to meet amendments before final with new prior art.
 - OK.

Why needed so often? Several reasons

- Piecemeal prosecution
 - Incomplete non-final Office action
 - If overcome by amendment, “necessitated new ground of rejection,” made final
 - If no amendment, incomplete grounds maintained
 - not OK.
 - Often results in series of RCEs.

Why needed so often? Several reasons

- Appeals steered back into prosecution by Examiner
 - Examiners can find a new ground of rejection and withdraw appeal without applicant consent
 - Encourages applicants not to file appeal, only to lose time and be steered back into prosecution.

Example of Serial Prosecution

- First action on merits – 2-page double patenting rejection –
 - No merit
 - maintained through final action,
 - withdrawn when case appealed,
- Replaced with 1-page prior art rejection, 102 only
 - Response required amendment
 - Next action final
 - Next step, RCE, claim amendment

Example of Serial Prosecution

- Another 1-page Ofc. Action, making a 103 combination
 - Response required amendment
 - Next action final
 - Withdrawn and case allowed only when appealed again.
- Eight Office actions
- Compounding problem – no PTA.
- This is a real case.

37 CFR § 1.104 Nature of examination.

“(a) *Examiner’s action.*

“(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. * * *”

What should happen

37 CFR § 1.104 Nature of examination.

“(a) *Examiner’s action.*

“(1)* * * The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.”

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Thank You

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