

From: E. Nishibori JPAA

Sent: Sunday, February 03, 2013 8:23 PM

To: RCE outreach

Cc: 神林 副会長; 岡部 執行理事; 花田 茜; 鈴木 孝章 先生

Subject: JPAA Comments on RCE

The Honorable David J. Kappos,

Please find the attached document.

Sincerely yours,

Emi NISHIBORI

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February 4, 2013

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Alexandria, Virginia

Re: JPAA's Comments on the "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act"

Dear Under Secretary Kappos:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 9,600 patent attorneys practicing intellectual property law in Japan. Its members practice in all areas of intellectual property law including copyright and unfair competition as well as patent, trademark and design laws. Many are qualified to represent clients in infringement lawsuits. The JPAA would like to submit comments on the "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act".

The following is our comments for the RCE Outreach

Q1 : 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?

Comments:

The following factors affect the probability of filing RCEs:

- 1) Broader or narrower claims at the time of filing.
- 2) Higher or lower number of claims in view of costs for translation and official fees (especially, if a client has a certain internal rule regarding prosecution costs).
- 3) Examiner's interpretation about claims in the application

If Examiner's interpretation about claims is somehow unexpected, it is difficult to figure out how to amend the claim. As a result, the number of RCEs may



become higher than usual.

Q2 : What change(s), if any, in USPTO procedure(s) or regulation(s) would reduce your need to file RCEs?

Comments:

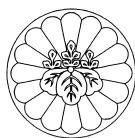
- 1) More opportunities or freedom of claim amendments after receiving a final office action is desirable (for example, it is desirable to have a fewer number of filings that a response to a final office action is regarded to involve a "new issue.")
- 2) The examiners should take more time to review applicants' responses to final office actions
- 3) Lower official fees are desirable for time extensions or the restart of a due date after issuing an advisory action.
- 4) Lower official fees are desirable for additional claims (especially, official fees for dependent claims so that we can seek allowable subject matters more effectively.)
- 5) More chances are desirable for getting Examiner's suggestions toward allowance. For example, the suggestions about an alternative wording other than "new issue" may be beneficial.
- 6) It may be useful to adopt the auxiliary amendment practice like the one used in EPO.

Q3 : What effect(s), if any, does the USPTO's interview practice have on your decision to file an RCE?

Comments:

- 1) When an applicant is told that a proposed amendment is regarded as a "new issue," he or she will have to file an RCE immediately.
- 2) Even if an examiner shows a positive reaction to a proposed amendment, it is sometimes regarded as a "new issue" after filing a formal response to a final office action. In such a case, an applicant has no choice other than filing an RCE.

Q4 : If, on average, interviews with examiners lead you to file fewer RCEs, at what point during prosecution do interviews most regularly produce this effect?



Comments:

1) Before responding to a final office action

Q5 : 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?

Comments:

1) If necessary and appropriate, interviews with examiners so as to share understanding and/or clarify issues relating to existing rejections before issuing a final office action

Q6 : When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE?

Comments:

- 1) When a substantial amendment to pending claims may be necessary
- 2) When the Examiner points out that a “new issue” has been introduced by amendment, we file an RCE.

Q7 : 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)?

Comments:

- 1) Situations in which a necessary amendment to pending claims is relatively minor
- 2) When we feel that the Examiner’s finding that a “new issue” has been introduced is correct.

Q8 : Was your after final practice impacted by the Office’s change to the order of examination of RCEs in November 2009? If so, how?

Comments:

- 1) No, generally. However, if an applicant wishes to obtain a patent earlier,



he or she may hesitate to file RCEs more than before.

Q9 : How does client preference drive your decision to file an RCE or other response after final?

Comments:

1) For example, if a client tends to take longer time to make a decision how to respond to office actions, we may be driven to file an RCE so as to avoid high costs for extension of time. Otherwise, if a client tends to regard an advisory action as waste of time, we may be driven to file an RCE.

2) When the client feels that there is no room to compromise because of the amended claims after non-final rejection or the present claims being very important to protect their invention, we recommend our client to file an RCE.

Q10 : What strategy/strategies do you employ to avoid RCEs?

Comments:

1) For example, filing more dependent claims to seek allowable subject matter at an early stage of examination, if it is acceptable to an applicant

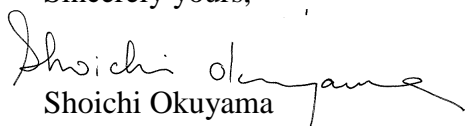
Q11 : Do you have other reasons for filing an RCE that you would like to share?

Comments:

1) When we wish to have the examiner consider an IDS (especially, when an applicant receives an office action in a counterpart application after paying the issue fee).

2) When an applicant wishes to maintain pendency of an application for some reasons

Sincerely yours,


Shoichi Okuyama

President

Japan Patent Attorneys Association