

From: Bart Eppenauer (LCA)
Sent: Monday, March 11, 2013 7:36 PM
To: RCE outreach
Subject: Microsoft Response to PTO Request for Comments on RCE Practice

Microsoft is pleased to provide the attached Comments to the PTO Request for Comments on RCE Practice. Our comments are provided in both Word and PDF document formats.

If you have any questions or need additional information, please do not hesitate to contact us.

Best regards,

Bart Eppenauer

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March 11, 2013

Via Electronic Mail Only to: rceoutreach@uspto.gov

Director of the U.S. Patent and Trademark Office
Mail Stop Comments—Patents
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Re: Request for Comments on Request for Continued Examination (RCE) Practice

Microsoft Corporation appreciates the opportunity to offer comments on the Request for Continued Examination (RCE) Practice, published in the Federal Register on November 30, 2012. We support the objectives underlying the request for comments, namely: to assist USPTO (Office) in obtaining feedback to better understand the factors that impact the decisions by applicants to file RCEs, so that the Office might design additional programs and initiatives aimed at reducing RCE filings and the RCE backlog.

Answers to the specific questions presented in the Request for Comments on RCE Practice are set forth below.

Question 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?

Answer 1 - The majority of Microsoft's cases are examined in the 2100, 2400, 2600, and 3600 Patent Technology Centers. We do not see a large discrepancy in the average number of RCEs filed per allowed application across these broader technology centers. We do, however, see a large discrepancy in the average number of RCEs filed per allowed application across individual art units within these technology centers. In examining those discrepancies, it is difficult to pinpoint distinctions related to particular technologies.

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

Answer 2 – The USPTO has been running the Quick Path Information Disclosure Statement (QPIDS) pilot program since May 10, 2012. The QPIDS pilot program eliminates the requirement for processing of a request for continued examination (RCE) with an information disclosure statement (IDS) filed after payment of the issue fee in order for the IDS to be considered by the examiner. Where the examiner determines that no item of information in the IDS necessitates reopening prosecution, the USPTO will issue a corrected notice of allowability. The QPIDS program is currently set to expire on March 23, 2013.

Microsoft has found this program to be particularly useful and effective in reducing our overall RCE filings. Therefore, we would support either extending the program or making the QPIDS program permanent.

The QPIDS program requires the filing of a timeliness statement under 37 CFR § 1.97(e). For those applicants that have a significant number of related US and International applications pending at a given time, it is often difficult to identify and cross-cite references from those applications within the three months specified in 37 CFR § 1.97(e). For this reason, we suggest that the Office consider extending the three month time period.

37 CFR § 1.97(e) also requires the signer of the timeliness statement to attest that no item of information contained in the IDS was known to any individual having a Rule 56 duty more than three months prior to the filing of the IDS. Individuals may be reluctant to sign the timeliness statement, because they cannot be positive that others having a rule 56 duty did not become aware of the references more than three months before the filing of the IDS. This is particularly true for large organizations and for applicants that file internationally. For these reasons, it is our belief that the program is not being used as extensively as it could be. With this in mind, we suggest that the Office consider eliminating the requirement for a timeless statement under 37 CFR § 1.97(e).

The USPTO has been running the After Final Consideration Pilot (AFCP) program since March 25, 2012. The AFCP authorizes extra time for examiners to consider responses filed after a final rejection. It is our understanding that the After Final Consideration Pilot (AFCP) has also extended until March 23, 2013.

As with the QDIPS program, we believe that this program has been very effective in reducing our RCE filings. Therefore, we support making the QPIDS program permanent. Additionally, we would recommend a slight increase in non-production time allocated to examiners for this work.

In view of what seems to be a high level of allowances immediately following a first RCE, one change the Office might consider to reduce the number of RCEs overall is to move to a process where two non-final actions must be issued before a final action. We appreciate that this would be a substantial change to current PTO practice. However, we are confident this change could significantly reduce the number of RCEs filed.

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

A3 - As discussed below in our answer to question 4, we have found interviews after final often play a significant role in whether we do or do not file an RCE. As such, our decision to file an RCE is affected to the extent that PTO practice allows and/or encourages after final interviews.

Question 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?

Answer 4 - Our experience indicates that there are two points during prosecution where interviews are most likely to help reduce the number of RCEs. The first point is prior to a first Office action. We have found that interviews prior to the first action are particularly helpful when the subject matter of the application is very complex. In such cases, discussion of the application at this stage helps the examiner to better understand the

invention so that he or she can perform a more accurate and focused search. This, in turn, helps the examiner and applicant move more quickly to a common understanding of the claims and the references, thus reducing overall prosecution time and RCE filings.

We have found that interviews prior to the first action are also helpful when the application is one in a family of related applications. In such cases, it is often helpful to bring the examiner up to date and up to speed on the prosecution of the related cases. We will, at that time, typically discuss how the claims of the present application relate to and distinguish from the claims of the related application and the prior art cited therein. We believe this reduces the amount of time that might otherwise be expended by the examiner and applicant going over old ground in subsequent Office actions and responses. We believe that discussing the references from the related cases in view of the present claims also helps the examiner conduct a more accurate and focused search. This, again, helps the examiner and applicant move more quickly to a common understanding of the claims and the references, thus reducing overall prosecution time and RCE filings.

The second point in time that we find effective for an interview is after the first Office action on the merits. At this point, the examiner has had a chance to do a search and develop a reasonable understanding of the invention and the art. Conducting the interview at this point, rather than after the second action, allows the applicant to discuss the claims in view of the cited art and, if required, discuss possible claim amendments that may put the application in condition for allowance before a final Office action is issued. We have also found that examiners are more likely to suggest allowable subject matter at this point, rather than prior to a first Office action.

While typically not as effective in elimination RCEs, interviews after final are often very effective in moving a case toward a quick allowance following an RCE. As would be expected, examiners will typically have their best understanding of the claims and the art at this later stage in prosecution. What we have found is that examiners are also most likely to discuss possible allowable subject matter and other suggestions to put the case in condition for allowance at this stage. Unfortunately, in many cases, examiners are reluctant to accept amendments after final. Rather, the examiner will often suggest that we file an RCE, so that a new search can be performed. In many of these cases, the first action after the filing of the RCE will result in an allowance.

In view of what seems to be a high level of allowances immediately following a first RCE, one change the Office might consider to reduce the number of RCEs is to move to a process where two non-final actions must be issued before a final action. We appreciate that any such changes to the examination process would be a significant change and would not be an easy fix. However, we are confident this kind of change would yield a significant real reduction in the number of RCEs filed.

Question 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?

Answer 5 – While we may occasionally find it necessary or helpful to file evidence (not including an IDS) after a final rejection, this is not typical in our practice.

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

Answer 6 - There are many factors that we may consider when determining whether to file an RCE in response to a final rejection. Some of these factors include, the strength and nature of the final rejection and the cited art, whether we intend to make significant amendments to the claims, and the disposition of the examiner and/or SPE during examination.

While the overall determination to file an RCE will typically involve multiple factors, there are two factors that often weigh heavily in favor of filing an RCE. First, we will typically file an RCE when we are citing new art that we believe will necessitate claim amendments. Second, even if we are not citing new art, we will typically file an RCE if we plan to make substantial claim amendments for other reasons. In either case, it is likely the examiner will need to conduct an additional search and spend additional time examining the amended claims in view of the new art.

Question 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)?

Answer 7 - There are many factors that we may consider when determining whether to file an amendment after final. However, there are three factors that often weigh heavily in favor of filing an amendment after final. First, if the final Office action indicated allowable subject matter. Second, if we have conducted an interview with the examiner and we have reached an agreement on allowable subject matter. Third, if the amendments are minor and we believe that they will clearly put the case in condition for allowance.

Question 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?

Answer 8 - The change in the PTO's order of examination for RCE has not significantly impacted our after final practice. However, we do believe that the change has been detrimental in that it often injects a long delay into the prosecution of an application. This delay frequently results in the examiner and the applicant having to spend considerable time getting back up to speed on the case when it is eventually picked up again. We believe that greater efficiencies would be realized, both to the applicant and the PTO, if RCEs were placed at the top of the examiner's docket.

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

Answer 9 – Not Applicable.

Question 10 - What strategy/strategies do you employ to avoid RCEs?

Answer 10 - There a number of strategies that we employ to reduce prosecution time and to reduce RCEs. We believe that one of the most effective ways to reduce RCE filings is to file original claims that are relatively easy to understand on their face and that use terminology that is consistent throughout the specification. We have found that when claims are difficult to understand or parse, it can take a number of Office actions, interviews,

and/or RCEs before the examiner can grasp the invention sufficiently to perform a reasonably targeted search and issue a rejection that is on point. In contrast, when the originally filed claims are clear and easy to understand, the examiner will typically cite more relevant prior art and that the rejections will typically be more reasonable. This, in turn, reduces overall prosecution time and the need for filing RCEs.

Second, we try to make good use of examiner interviews. As discussed above, we believe that examiner interviews are a very effective way to shorten prosecution and reduce RCE filings.

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

Answer 11 – We have nothing further to share on this point at this time.

Conclusion

Once again, Microsoft greatly appreciates the opportunity to share our views on this important area of the law and patent examination practice. We sincerely hope that our comments will be useful and look forward to engaging in further discussion with the Office on these issues.

Respectfully Submitted on behalf of Microsoft Corporation,

A handwritten signature in black ink that reads "D. Bartley Eppenauer". The signature is written in a cursive, flowing style.

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