

# USPTO RCE ROUND TABLE

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## INTRODUCTION

- Ken Fagin
  - Practicing since 1992, largely prosecution
  - Mainly mechanical and electromechanical art units, but many others as well
- Two-Sided Problem
  - PTO-Related Factors
  - Applicant-Related Factors

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## PTO DOESN'T UNDERSTAND THE PROBLEM

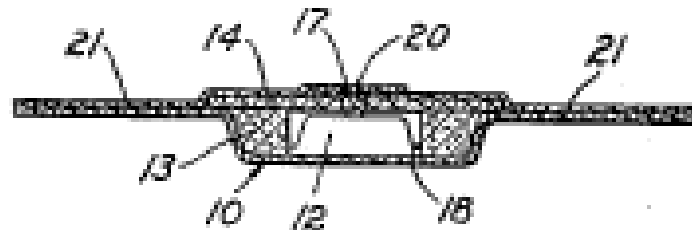
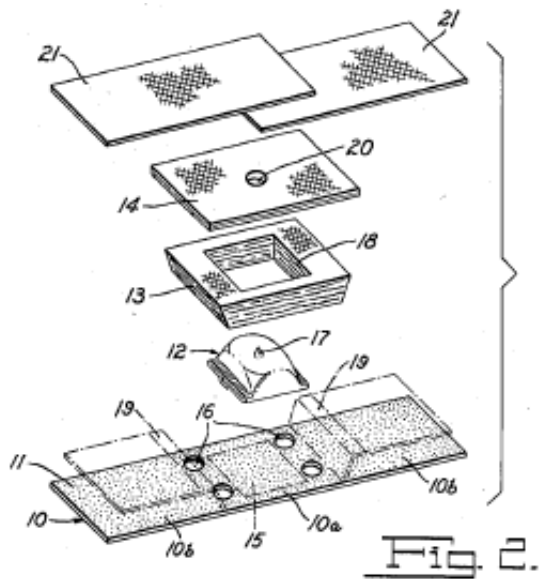
- **Feedback Questions, Federal Register Statement**
  - (6), (7) When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE/favor the filing of an amendment after final
  - (9) How does client preference drive your decision to file an RCE or other response after final?
  - (11) Do you have other reasons for filing an RCE that you would like to share?
  - “Since most applicants resolve their issues with the first RCE, the Office determined that applicants that file more than one RCE are using the patent system more extensively than those who file zero or only one RCE.”
- **RCEs are NOT applicants’ voluntary choice; applicants are not abusing the system**
- **PENAL FEE INCREASE UNFOUNDED AND PREMATURE**



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## CLAIM INTERPRETATION-RELATED FACTORS

- Examination should be like Socratic method → **Better Quality Patents**
- Examining in vacuum, without understanding subject matter or the claimed invention → time/\$ ↑, PQ ↓
- Broadest possible, make-it-fit interpretation:



Per examiner, capsule 12 is located at an “end portion” of the bandage. Really?!

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## CLAIM INTERPRETATION-RELATED FACTORS

- First amendment becomes “remedial” and does not advance prosecution; first amendment is wasted amendment → subsequent amendment is final → RCE required to get meaningful prosecution
- **Proposed solutions:**
  - Require examiner to actually read whole application before conducting search/examination
  - Examiner provides his/her own summary of understanding of disclosed subject matter before conducting search/examination
  - Examiner provides explicit claim interpretation before conducting search/examination
  - Applicant has non-extendible, time-limited opportunity to challenge/correct/contest; otherwise, examiner’s interpretation/understanding sticks

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## SUSPECT PROCEDURES

- “Mulligan” or “Do-Over” Final
  - Recent (last four years or so) increase → count-focused examination
  - TC-wide or AU-wide edicts to do it this way
  - Contravenes M.P.E.P. 706.07(a) “second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims[,]**” (even if there were some new grounds of rejection that were → fairness to applicant)
  - Contravenes Federal Register Statement (Vol. 78, No. 13, page 4246, January 18, 2013)
  - OPLA has quietly acknowledged it is wrong (personal conversation)
  - Internal PTO email posted online shows it's wrong (see [http://www.intelproplaw.com/ip\\_forum/index.php?topic=13184.0](http://www.intelproplaw.com/ip_forum/index.php?topic=13184.0) and next five slides)



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From: TC 2600 Directors

Sent: Monday, November 17, 2008 8:02 AM

Cc: Campbell, Dianne; Christensen, Andrew; Groody, James; Hunter, Daniel; Knode, Marian; Powell, Mark; Walker, Wanda

Subject: Instruction Regarding Making an Office Action FINAL

Recently a question has come up about whether a consecutive FINAL Office action with a new ground of rejection can be made after the finality of a previous Office action has been withdrawn. The answer to that question is set forth as follows.

When the second Final OA stated that the finality of the last OA (the first Final OA) is withdrawn, the first Final OA is back to a non-final status, and the AF amendment (hereinafter "entered amendment") filed is entered into the case. See MPEP 706.07(e).



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At this point, we need to take a close look at the entered amendment to determine whether a consecutive Final OA would be proper. Same requirement is applied here, i.e. Final is proper when it is 1) necessitated by amendment, 2) necessitated by IDS with Fee, or 3) necessitated by invoking the Joint Research Agreement Prior Art Exclusion under 35 USC 103(c), see MPEP 706.07(a).

In the case where the entered amendment simply provided arguments without amending any claim, none of 3 reasons to make proper Final discussed above is applicable. Thus, a second Final OA would be improper with a new ground of rejection.



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For example

- (1) The examiner made a first action non-final under 102.
- (2) Applicant filed a reply amending the claims.
- (3) The examiner made a second action final. The claims were rejected under 103 using new prior art. The examiner stated that applicant's amendment necessitated the new ground of rejection and therefore, the second action was made final.
- (4) Applicant filed a reply. The reply only included arguments and the claims were NOT amended.

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(5) The examiner made a third action final. The examiner stated in the third office action that the "finality of the last office action has been withdrawn in view of the new ground of rejection." The claims were rejected under 103 based on different prior art. The examiner stated that applicant's amendment necessitated the new ground of rejection and therefore, the third action was made final.

THIS IS NOT CORRECT.

When the finality of an office action is withdrawn, all the rejections/objections/requirements set forth in that office action are still there. All this means is that that particular office action is now a non-final office action and therefore, any reply submitted by the applicant in response to that office action is treated under 37 CFR 1.111 rather than 1.116.

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\* \* \* \* \*

Once the examiner withdraws the finality of the second action, the reply filed by applicant (item 4) is treated under 37 CFR 1.111 rather than 37 CFR 1.116. To determine whether the next office action can be made final or not, the examiner must look at the reply filed in item 4 and not the reply filed in item 2. Since the reply filed in item 4 did not include any amendments to the claims, the third action (item 5) with the new ground of rejection CANNOT be made final. The examiner's statement in the third office action that applicant's amendment necessitated the new ground of rejection is WRONG since the reply filed in item 4 only included arguments.

\* \* \* \* \*

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## SUSPECT PROCEDURES

- **Knee-Jerk Finality**
  - Examiner refuses to admit his/her own mistake in first action (see above re clarifying amendments) necessitated new ground of rejection, lays blame on applicant
  - Correcting lack of antecedent basis and spelling error does not necessitate new ground of rejection

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## SUSPECT PROCEDURES

- **Two-Step Examination**
  - Reject only for formalities/clear errors (e.g., lack of antecedent basis, spelling error) in first action
  - Follow with art-based rejection in second action and make it final on basis that amendments necessitated the new ground of rejection
  - Force an RCE for subsequent amendments/examination

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## AFTER-FINAL ATTITUDE



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## APPLICANT-RELATED FACTORS

- Mom shouldn't have to tell you to clean up your room (GIGO)
- Advocate, don't regurgitate
- Admit the sky is blue (Be Abe Lincoln)

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Thank You for Opportunity to  
Participate





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