



Comments: USPTO RCE Roundtable

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Disclaimer



My comments today do not necessarily reflect the views of Foley & Lardner LLP or its clients.

The Problem



- In Group 1600, post-RCE delays of months to years is not unusual
- Long post-RCE delays interrupt prosecution midstream, creating inefficiencies
 - When the case is examined again, Examiners and Applicants have to spend more time reviewing the record
 - Previous understandings, nuances, may have been forgotten
 - Post-RCE delays after an interview drastically undermine the value of an interview
 - USPTO focus on backlog of unexamined applications loses sight of the fact that Applicants need granted patents in order support investment, commercialization, etc.

Why Are RCEs Filed?



To submit claim amendments/evidence to address a new rejection in a final Office Action

New rejection may have been triggered by:

- claim amendments that overcame previous rejections
 - clarify claim scope in response to Examiner's claim construction
 - clarify claim scope in response to 112 rejections
 - added features from specification in response to prior art rejection
 - added features from dependent claims in response to prior art rejection
 - Overcame 102 rejection, same art cited in new 103 rejection
 - Overcame first prior art rejection, new art cited in new rejection
- IDS submitted to cite references from corresponding foreign application or related US application

Why Are RCEs Filed?



To submit claim amendments/evidence to address a maintained rejection in a final Office Action

Amendments/evidence may not have been presented earlier because:

- Applicant believed arguments/explanations would be sufficient
- Applicant did not understand Examiner's real concerns until final Office Action
- First Office Action raised numerous issues, final Office Action crystallized "sticking points"
- Applicant is confident of patentability but believes that progress can be made with Examiner and wants to avoid costs/delays of appeal

Why Are RCEs Filed?



To submit an IDS after a final Office Action

IDS Certification may not be possible if:

- Foreign agent/client did not forward references in time
- References were cited in a related but not “corresponding” application
- Applicant cannot confirm that no person encompassed by Rule 56 was not previously aware of the references
- Applicant is correcting a defect in an earlier filed IDS (absent English translation, incomplete citation, etc.)

USPTO Rules/Practices That Lead To RCEs



MPEP 706.07(a):

Permitting a new rejection in a final Office Action based on a reference submitted in an IDS

- The Applicant may have had no control over the timing of submission of the IDS (e.g., an IDS filed to cite a reference newly cited in a foreign application)

MPEP 706.07(b):

Permitting a final Office Action as the first Office Action in a continuation or RCE

- This likely will lead to a further continuation or RCE

USPTO Rules/Practices That Lead To RCEs



Routinely making the second Office Action final, contrary to this guidance in MPEP 706.07

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

Examiners in other patent offices (EPO, CA, AU) seem to use more discretion before closing prosecution

USPTO Rules/Practices That Lead To RCEs



MPEP 609.05(a):

Permitting an Examiner to refuse to consider a reference listed in an IDS if an incorrect or incomplete citation was provided, even if a copy of the reference was provided.

- While the Applicant should be required to supply a full/correct citation, because a copy of the reference was submitted, the Examiner should have considered it

Final Office Action or Ex Parte Quayle Action noting defect in previous IDS

- Could Examiner call the Applicant to provide an opportunity to correct the IDS before a final Office Action is issued?
- Could a corrective IDS be considered without an RCE?

Possible Solutions



- More uniform implementation of After-Final Consideration Pilot program
- More guidance on when amendments/evidence should be entered after final
 - if responsive to a new rejection in a final Office Action
 - if pursuant to an Interview
- Revisions to IDS rules to permit corrections of bona fide attempts to comply with requirements
- Identify and correct outlier examiner behavior using Quality Index Report (QIR) metric
 - USPTO has proposed that RCEs > 10% total "would indicate a quality concern"

Thank you!



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