

## Carrots and Sticks: New USPTO Initiative Encourages More Efficient Patent Examination

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Good news for patent applicants: the U.S. Patent and Trademark Office (USPTO) is pilot-testing a relaxation in patent examination procedures that could significantly reduce the cost of pursuing a patent application, and pave the way to quicker patent grant.

Under current practice, an applicant is given an initial chance to respond to an examiner's rejection with claim amendments, arguments, and evidence. If the initial response does not convince the examiner to approve the application, a "Final Rejection" results, from which an applicant must file a "Request for Continued Examination" (RCE) in order to permit the examiner to consider further amendments, arguments, and evidence. Another option, appeal, currently takes years to resolve, so applicants avoid it where possible. The far-more-common course is to file an RCE, which essentially re-starts examination.

USPTO Director David Kappos has discouraged RCE filings with aggressive measures because RCEs distract examiners from attending to the huge backlog of new, unexamined cases. So far, the measures have largely been "sticks" aimed at making RCEs less palatable for everyone:

- Reducing the amount of production credit examiners receive for examining RCEs
- Placing RCEs at the bottom of the examiners' dockets for re-filed cases, which imposes essentially no time limit on the examiners to consider the RCEs
- Proposing a huge increase in the RCE filing fee.

Now, finally, the USPTO is offering a "carrot" to Examiners to resolve cases without the applicant having to resort to an RCE to get consideration of a substantive amendment. Under the new "After-Final Consideration Pilot" program, the USPTO is authorizing Examiners to spend up to 3 hours to consider after-final amendments even if the after-final amendment raises new issues that current rules would prevent examiners from considering. Examiners are encouraged to use their professional judgment to determine whether limited additional consideration of an after-final amendment is likely to lead to allowance. Examiners can also use the time to consider a "perfected" evidentiary submission -- i.e., an augmented resubmission of earlier-filed evidence that was found to be insufficient.

The pilot program is available to all patent examiners, so all applicants can benefit from it. Because examiners have discretion to invoke the pilot program, applicants should point out why a proposed after-final amendment is a good candidate for consideration under this pilot. Currently, the pilot program is scheduled to end June 30, 2012, but the USPTO could extend the pilot if it proves popular and effective.

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