

# MUIRHEAD AND SATURNELLI, LLC

*Specializing in Intellectual Property Law*

*IP FLASH*

NEW USPTO PRODUCTION SYSTEM FOR EXAMINERS AND  
CHANGES TO THE TREATMENT OF REQUESTS FOR CONTINUED EXAMINATION

The U.S. Patent and Trademark Office (USPTO) has implemented new internal policies for examiners that are scheduled for enactment beginning in November, 2009. The new policies will affect examiner production guidelines and incentives in the examination of applications, especially in connection with the filing of Requests for Continued Examination (RCEs). The USPTO has stated that a goal of the new policies is to reduce prosecution times and encourage the prompt identification of allowable subject matter and the efficient resolution of prosecution issues.

The examination of applications is internally governed in the USPTO by a production or "count" system for examiners. Examiners must obtain a certain number of counts over time and are awarded counts for issuing Office Actions during the examination of an application and for the "disposal" of the application (for example, an allowance or abandonment). Under the old count system, examiners received one count for issuing a First Office Action on the merits of an application and one count for a disposal. An examiner received no counts for issuing a Final Office Action or an Advisory Action. The filing of an RCE by an applicant credited the examiner with a disposal count and reset the prosecution of the application to provide another two potential counts for examination and disposal of the application. As a result, the old system created certain incentives for examiners to encourage the use of RCEs by applicants in responding to Final Office Actions.

The new count system seeks to reduce counts for RCEs and redistribute counts during examination in order to help appropriately rebalance the examiners' incentives. Under the new count system, examiners will receive 1.25 counts for a First Office Action prior to any RCE, 0.25 counts for a Final Office Action and 0.5 counts for a disposal (or 0.75 counts for a disposal if no Final Office Action was issued). If a first RCE is filed, the total counts available for the next round of prosecution drop to 1.75 (1.0 count for the First Office Action), and for second (and subsequent) RCEs, the total counts available drop to 1.5 (0.75 counts for the First Office Action).

Additionally, the USPTO has recently issued a notice regarding a change in the way RCEs are to be docketed to an examiner for examination. Previously, RCEs were docketed in the same manner as an amendment filed in response to an Office Action, requiring that an examiner consider the RCE within two months of it being placed on the examiner's docket. The USPTO has advised that RCEs will instead be docketed like continuation or divisional applications on a docket known as the "Special New" docket. Applications on the Special New docket are not required to be considered within two months. Therefore, it may now be expected that the examination of RCEs will generally take longer than under the previous docketing policy.

Finally, another aspect of the new system encourages examiners to initiate interviews with applicants to attempt to resolve prosecution issues. Examiners previously received no direct benefit for examiner-initiated interviews. Under the new system, it is now more likely that an examiner will contact the applicant in situations where the examiner believes prosecution issues may potentially be resolved with a telephone conversation.

Although the effect of the new count system remains to be seen, the modification of internal policies at the USPTO appears to be a less drastic mechanism for improving the examination and prosecution of applications than that of previous attempts using other regulatory proposals. The USPTO has advised that they will monitor the effects of the new policies and reevaluate and make further changes as needed to meet USPTO goals.

This IP Flash is being provided for information purposes only and should not be construed as legal advice or legal opinion.

200 Friberg Parkway, Suite 1001  
Westborough, MA 01581  
(508) 898-8601 • Fax (508) 898-8602 • [www.westboro-ip.com](http://www.westboro-ip.com)