



**NETWORK**

**EDGE (/EDGE)**

**BRANDS ([HTTPS://WWW.UNIFIEDBRANDS.US](https://www.unifiedbrands.us))**

**CONSULTING ([HTTPS://WWW.UNIFIED-CONSULTING.COM](https://www.unified-consulting.com))**

**ALIUM ([HTTPS://WWW.ALIUM-LLC.COM](https://www.alium-llc.com))**

**PATENTS ([HTTPS://WWW.UNIFIEDPATENTS.COM](https://www.unifiedpatents.com))**

**PORTAL ([HTTPS://PORTAL.UNIFIEDPATENTS.COM](https://portal.unifiedpatents.com))**

**PATROLL ([HTTPS://PATROLL.UNIFIEDPATENTS.COM/](https://patroll.unifiedpatents.com/))**

**ZONES**

**NPE (/NPE)**

**SEP (/SEP)**

**ANALYTICS**

**OPAL - LANDSCAPE ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/STANDARDS/OPAL/HEVC](https://portal.unifiedpatents.com/standards/opal/hevc))**

**OPEN - STANDARDS SUBMISSIONS**

**([HTTPS://PORTAL.UNIFIEDPATENTS.COM/STANDARDS/OPEN/HEVC](https://portal.unifiedpatents.com/standards/open/hevc))**

**ISIX - BEST LAW FIRMS ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/PTAB/ANALYTICS/CASE-LEVEL/ISIX?SORT=-FILING\\_DATE](https://portal.unifiedpatents.com/ptab/analytics/case-level/isix?sort=-filing_date))**

**PVIX - PATENT VALUE ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/PATENTS/PORTFOLIO](https://portal.unifiedpatents.com/patents/portfolio))**

**DATA**

**UP DAILY (/DOCKET)**

**PTAB ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/PTAB/CASELIST?SORT=-FILING\\_DATE](https://portal.unifiedpatents.com/ptab/caselist?sort=-filing_date))**

**LITIGATION ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/LITIGATION/CASELIST](https://portal.unifiedpatents.com/litigation/caselist))**

**EXAMINER ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/PATENTS/EXAMINER](https://portal.unifiedpatents.com/patents/examiner))**

**PATENTS ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/PATENTS/SEARCH](https://portal.unifiedpatents.com/patents/search))**

**REEXAM ([HTTPS://PORTAL.UNIFIEDPATENTS.COM/EXPARTE/SEARCH?](https://portal.unifiedpatents.com/exparte/search?requester=unified%20patents%20llc&requester=unified%20patents%2c%20llc)**

**REQUESTER=UNIFIED%20PATENTS%20LLC&REQUESTER=UNIFIED%20PATENTS%2C%20LLC)**

**NEWS**

**NEWS & VIEWS (/INSIGHTS)**

**RPI (/RPI)**

**OPEN COVID PLEDGE (/OPEN-COVID-PLEDGE)**

**INSIGHTS WEBINAR (/INSIGHTS-WEBINAR)**

**ABOUT**

**FAQ (/FAQ)**

**SUCCESS (/SUCCESS)**

**EVENTS (/EVENTS)**

**OFFICES (/OFFICES)**

**MEMBERS (/MEMBERS)**

**TEAM (/TEAM)**

**JOBS (/JOBS)**

**JOIN (/JOIN)**



Search

Archive



Email Address

SUBSCRIBE

Or [Subscribe to Our RSS](#)

(<http://www.unifiedpatents.com/insightformat=rss>).

# Improving Patent Quality by Changing the USPTO's RCE and Continuation Practices (/insights/2022/6/6/improving-patent-quality-by-changing-the-usptos-rce-and-continuation-practices)

The U.S. patent system affects the work of every company and individual in the country, but can be highly technical and difficult to understand. Unified Patents (<https://www.unifiedpatents.com/>) is proud to celebrate **Patent Quality Week - June 6-10, 2022** (<https://patentqualityweek.engine.is/>) with a few blog posts on why patents matter and educate others about the effects of low-quality patents that can create barriers to innovation and competition.

**By: Sean Keller**

(<https://www.linkedin.com/in/sean-r-keller/>)

## Background

On January 3, 2006, the United States Patent and Trademark Office (“USPTO”) published two new rules in the Federal Register to reduce the number of continuation applications and narrow the scope of patent examinations.

The new rules would have required second or subsequent continuation applications to “be supported by a showing as to why the amendment, argument, or evidence presented could not have been previously submitted.” [1] Additionally, the new rules would have required the initial examination to focus on claims the applicant designates as “representative claims.” [2] Although the proposed rules were met with overwhelmingly negative comments, the USPTO nevertheless published the Final Rules on August 21, 2007.

GlaxoSmithKline (“GSK”), a pharmaceutical company, joined Tafas, an inventor, in suing the USPTO to prevent the proposed rules from being implemented. [3] The day before the rules were set to take effect, Judge Cacheris of the District Court for the Eastern District of Virginia granted GSK’s motion for a preliminary injunction. [4] Judge Cacheris later ruled in favor of Tafas and GSK, finding the rules exceeded the USPTO’s statutory authority.

[4] Legal (/term-of-services) | Privacy Policy (/privacy-policy) | DMCA

On March 20, 2009, the Court of Appeals for the Federal Circuit affirmed in part, vacated in part, and remanded the case to the Eastern District of Virginia. [5] After the Federal Circuit decided to vacate its March 20 opinion, reinstate the appeal, and rehear the appeal *en banc*, the Director of the PTO signed a new Final Rule rescinding the controversial continuation rules. [6]

Following the USPTO’s unsuccessful attempt to reduce the number of continuations and RCEs, the USPTO has declined to issue rules or make any internal changes that would change the status quo. In March 2020, 575,797 patent applications were unexamined. [7] As of March 2022, 672,514 patent applications were unexamined. [8] The number of unexamined applications will continue to increase unless the problems plaguing continuations and RCEs are addressed.

## Proposed Changes

One commentator has suggested the USPTO

should replace its current task-based system that provides credits only for certain examining activities with an hours-based system that allocates credit for all examining activities. [9] Under the current system, patent examiners receive two credits, or counts, for each request for continued examination (“RCE”): one count for taking no action and one for a first office action on the merits. At the end of each two-week pay period, the USPTO adds up the number of disposals (two counts per disposal) the examiner received, multiplies that number by the period of time allocated to that examiner per disposal, and then divides that number by the total number of hours worked. Because most of the substantive examination research is completed during the initial prosecution, a patent examiner can obtain six to twenty-five hours of credit for about 30 minutes of work if the changes in the RCE are minor. Patent examiners, therefore, can reduce their workload and maximize the number of credits earned during each two-week pay period by encouraging applicants to file RCEs. If, however, the USPTO adopted an hours-based system that awarded credit for actions like second action non-final rejections, final rejections, restriction requirements, interviews, consideration of IDS filings, etc., examiners would not be incentivized to encourage applicants to file RCEs.

Other commentators have suggested that the USPTO should charge a higher fee for filing RCEs and continuations, limit the number of RCEs and continuations applicants can file, or limit the time applicants have to file RCEs and continuations. The European Patent Office’s (“EPO”) divisional practice provides a framework for possible changes to the USPTO’s RCE and continuation practices. The EPO charges a much higher filing fee for divisional applications than the USPTO. EPO applicants also have 24 months from the first Examination Report or the request for restriction to file a divisional application whereas USPTO divisional applications merely need to be co-pending with the parent application. Furthermore, the number of EPO divisional applications is limited by the number of separate, identifiable inventions disclosed in an

original patent application while there are no limits on the number of USPTO divisional applications. By adopting measures from the EPO's divisional practice, the USPTO could discourage applicants from filing RCEs and continuations to delay prosecution and instead encourage applicants to file RCEs and continuations to further prosecution.

[1] Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, 71 Fed. Reg. 48 (Jan. 3, 2006).

[2] Changes to Practice for the Examination of Claims in Patent Applications, 71 Fed. Reg. 61 (Jan. 3, 2006).

[3] *Tafas v. Dudas*, 511 F. Supp. 2d 652, 658, 86 U.S.P.Q.2d (BNA) 1548, 1552 (E.D. Va. 2007).

[4] *Tafas v. Dudas*, 541 F. Supp. 2d 805, 817, 86 U.S.P.Q.2d (BNA) 1623, 1632 (E.D. Va. 2008).

[5] *Tafas v. Doll*, 559 F.3d 1345, 1364, 90 U.S.P.Q.2d (BNA) 1129, 1143 (Fed. Cir. 2009).

[6] Press Release, U.S. Patent & Trademark Office, USPTO Rescinds Controversial Patent Regulations Package Proposed by Previous Administration (Oct. 8, 2009) (on file with author).

[7] *Patents Production, Unexamined Inventory and Filings Data March 2022*, U.S. Pat. & Trademark Off., <https://www.uspto.gov/dashboard/patents/production-unexamined-filing.html> (last visited May 10, 2022).

[8] *Id.*

[9] Patrick A. Doody, *How to Eliminate the Backlog at the Patent Office*, 37 AIPLA Q.J. 395, 399 (2009).

Tagged: Patent Quality Initiative (/insights?tag=Patent+Quality+Initiative), Patent Quality Week (/insights?tag=Patent+Quality+Week), PQW (/insights?tag=PQW), PQW Learning (/insights?tag=PQW+Learning)

♥ 2 Likes    ↪ Share

Newer Post

IP Valuation entity Lupercal patent challenged (/insights/2022/6/3/ip-valuation-partners-entity-lupercal-patent-challenged)

Older Post

Revisiting the Liability Framework in Patent Infringement to Improve Patent Quality (/insights/2022/6/6/revisiting-the-liability-framework-in-patent-infringement-to-improve-patent-quality)