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## The Post-Prosecution Pilot (P3): A New After Final Program

By: Bradford F. Fritz

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# Post-Prosecution Pilot (P3)

- A new after final program that combines the “best features” of the Pre-Appeal Brief Conference and After Final Consideration (AFCP 2.0) pilot programs.

# Post-Prosecution Pilot (P3)

- The Post-Prosecution Pilot (P3) combines:
  - 1) an after final response considered by a panel of examiners (*from Pre-Appeal Brief Conference*),
  - 2) an after final response that may include a non-broadening amendment (*from AFCP 2.0*),
  - 3) an opportunity to make a 20 minute oral presentation to the panel of examiners (*new feature*), and
  - 4) written explanation of the panel's recommendation after the panel confers (*expanded from Pre-Appeal*).

## P3 Background

- Created under the Enhanced Patent Quality Initiative (EPQI), pillar 3 – Excellence in Customer Service, and responds to stake holder input gathered during public forums.
- To test the impact on enhancing patent practice during the period after a final rejection and prior to the filing of a notice of appeal.

## P3 Goals

- Three main goals include 1) increase the value of after final practice, 2) reduce the number of appeals, issues taken on appeal and the number of RCEs, and 3) stream line options available to applicants during after final practice.
- Office requests comments on the new P3 program addressed to [afterfinalpractice@uspto.gov](mailto:afterfinalpractice@uspto.gov), which will be public.

## P3 Pilot Duration

- Began on July 11, 2016, and will run for 6 months to January 12, 2017, or when 1,600 requests have been accepted, whichever comes first.
- Each individual technology center (TC) will accept no more than 200 compliant requests, which means that P3 may close for a given TC, even if it continues to run for other TC's that have yet to accept 200 compliant requests.

## Counter by Technology Center



Counter by Technology Center (updated as of August 31, 2016)

1600	29	1700	33	2100	47	2400	60
2600	46	2800	54	3600	76	3700	71

- At the current rate of compliant requests, the P3 Pilot may close for some technology centers within the next month.
- The P3 Pilot has been available since July 11, 2016, and TC 3600 (business methods) is almost half way to the 200 request limit.

## P3 Eligibility Requirements/Limitations

- Must have an outstanding final rejection.
- Must be (i) an original utility non-provisional application filed under 35 U.S.C. 111(a), or (ii) an international utility application that has entered the national stage under 35 U.S.C. 371 (reissue, design and plant applications, and reexams are not eligible).
- No previous Pre-Appeal Brief, AFCP 2.0, other P3 requests, a notice of appeal or RCE for the same outstanding final rejection.
- Impermissible to participate in the Pre-Appeal program or AFCP 2.0 once a P3 request has been accepted.
- After a P3 request is accepted, no additional responses under 37 CFR 1.116 for the same final rejection.



## P3 Request Requirements

- 1) No Fee is required,
- 2) Must be filed within **two months** from a final rejection and prior to a notice of appeal,
- 3) No more than **five pages** of arguments (can be single spaced, can reference previous remarks but needs pin point reference – e.g., date and page number). Claim amendments and signature do not count towards the five page limit,
- 4) A **transmittal form**, on a separate page, such as form PTO/SB/444, that identifies the submission as P3 and requests consideration under the P3,
- 5) A **statement** that applicant is willing and available to participate in the panel conference (included in form PTO/SB/444),
- 6) All associated papers must be **filed via EFS-Web**, and
- 7) Response is limited to **appealable**, not petitionable matters.
  - (optional) - a proposed non-broadening amendment to a claim(s).

## P3 Option To Propose an Amendment

- The response under 37 CFR 1.116 included with a P3 request may optionally include a proposed amendment.
- The proposed amendment may not broaden the scope of a claim in any aspect.

## P3 Option To Propose an Amendment

- A proposed amendment that focuses the issues with respect to a single independent claim that provides the best opportunity for leading the application being placed into condition for allowance.
- Extensive amendments (nature of the changes or number of amended claims) probably will require extensive further consideration and would be unlikely to place the application in condition for allowance.
- Extensive amendments will be considered only to the extent possible under the time allotted to the examiner under the P3. The Examiner receives three (3) hours for handling a P3 request (including the 20 min presentation and conference) and one (1) additional hour for a proposed amendment (4 hours total).



Doc Code: A.NE.PCP

Document Description: Prosecution Conference Pilot Request

PTO/Sa/444 (07-16)

CERTIFICATION AND REQUEST FOR CONSIDERATION UNDER THE POST-PROSECUTION PILOT PROGRAM (P3)		
Practitioner Docket No.:	Application No.:	Filing Date:
First Named Inventor:	Title:	
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS CONSIDERATION UNDER THE P3 OF THE ACCOMPANYING RESPONSE UNDER 37 CFR 1.116.</p> <ol style="list-style-type: none"> <li>The above-identified application is (i) an original utility non-provisional application filed under 35 U.S.C. 111(a), (ii) an international utility application that has entered the national stage in compliance with 35 U.S.C. 371(c), or (iii) a continuing utility application (e.g., a continuation or divisional application).</li> <li>The above-identified application contains an outstanding final rejection.</li> <li>This request is being filed within two (2) months from the mailing date of the final rejection and prior to filing a notice of appeal.</li> <li>Submitted herewith is a response under 37 CFR 1.116 to the outstanding final rejection. The response, exclusive of any amendment, comprises no more than five (5) pages of arguments. <input type="checkbox"/> (OPTIONAL) The response also includes a proposed non-broadening amendment to a claim(s).</li> <li>Applicant is willing and available to participate in the P3 conference.</li> <li>This request is being filed electronically using the Office's electronic filing system (EFS-Web).</li> </ol> <p>APPLICANT HEREBY ACKNOWLEDGES THE FOLLOWING:</p> <ul style="list-style-type: none"> <li>Reissue, design, and plant applications, as well as reexamination proceedings, are not eligible to participate in the P3.</li> <li>There is no fee required to request consideration under the P3.</li> <li>Entry of any proposed amendment, affidavit, or other evidence after a final Office action is governed by 37 CFR 1.116. See MPEP 714.12.</li> <li>If applicant is unable to schedule the conference within ten calendar days from the date the Office first contacts applicant, the request will be deemed improper.</li> <li>If a request is deemed improper for any reason, a conference will not be held. The response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection.</li> <li>Once a P3 request has been accepted, no additional response under 37 CFR 1.116 to the same final rejection will be entered, unless the examiner has requested the additional response because the examiner agrees that it would place the application in condition for allowance.</li> <li>The filing of a P3 request will not toll the six-month statutory period for reply to the final rejection. To avoid abandonment, further action, such as the filing of a notice of appeal or RCE, will need to be taken within the six-month statutory period for responding to the final rejection, unless applicant receives written notice from the Office that the application has been allowed or that prosecution is being reopened.</li> </ul>		
Signature	Date	
Name (Printed/Typed)	Practitioner Registration No.	
<p><b>Note:</b> This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.</p>		
<p><input type="checkbox"/> * Total of _____ forms are submitted.</p>		

## P3 Compliance

All P3 Requests will be considered for timeliness and compliance before entry into the pilot.

For Requests considered untimely or otherwise non-compliant (or if filed after the technology center has reached its 200 limit of P3 Requests):

- The Office will treat the Request in the same manner it would treat any after final response absent the P3 Request.
  - No conference will be held.
- The next communication (e.g., AA) by the Office will indicate:
  - the reason why the P3 request was found to be untimely or otherwise non-compliant,
  - the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment, and
  - the time period for response.

## Treatment of a P3 request

- Treated as a response under 37 CFR 1.116.
- Once a P3 request is accepted, no additional response under 37 CFR 1.116 will be entered, unless requested by the examiner because the examiner agrees it will place the application in condition for allowance.
- If applicant is unable to schedule the conference within ten calendar days from the date the Office first contacts the applicant, the request will be deemed improper (but examiners are encouraged to be flexible).
- If a P3 request is deemed improper for any reason, a conference will not be held. The response and any proposed amendment will be treated under 37 CFR 1.116 (e.g., Advisory Action with explanation why the P3 request was improper, an allowance or a new non-final).

## Treatment of a P3 request Cont.

- No right of entry of the after final amendment.
- Filing a P3 request will not toll the six-month statutory period for reply to the final rejection. To avoid abandonment, a notice of appeal or RCE will needed, unless written notice of allowance from the Office or that prosecution is reopened.
- Clock continues to run for compliant P3 requests – EOTs will be likely.
- Exception - the period for response expires on the six-month date or on the same day the written decision of the panel is mailed, whichever is later.

## P3 Pilot Process

1. The Office will contact the applicant to schedule the P3 conference (SPE is responsible), which should result in a P3 conference within ten calendar days of the initial contact or the P3 request could be deemed improper at that time.
2. The applicant will make an oral presentation to the panel of examiners, limited to 20 minutes, via in-person, telephone or video conference hosted by USPTO (WebEx).
  - a) Any materials used by the applicant will be placed in the file. Entry of claim amendments, affidavits or other evidence included as part of the presentation materials is governed by 37 CFR 1.116. See MPEP 714.12.
  - b) Applicant may present on appealable, but not petitionable matters.
  - c) Applicant may present arguments directed to the outstanding record or the patentability of the amended claim(s) as proposed.



## P3 Pilot Process Cont.

3. After applicant's presentation, the panel will confer.
4. The applicant will be informed of the panel's decision, in writing, following complete consideration of the P3 Request.
5. The P3 process **will be terminated** if applicant files any of the following after filing the P3 request but prior to a notice of decision from the panel:
  - A notice of appeal,
  - A Request for Continued Examination (RCE),
  - An express abandonment under 37 CFR 1.138,
  - A request for declaration of interference, or
  - A petition requesting the institution of a derivation proceeding.

## Possible P3 Conference Outcomes

### A. Final Rejection Upheld

- If proposed amendment(s) were included, the status will be communicated.
- The time period for response expires on 1) the mailing date of the notice of the decision, or 2) the date set forth in the final rejection, whichever is later.
- The panel decision is not petitionable, and the Office will not grant a petition seeking reconsideration of a panel decision upholding a final rejection.

### B. Allowable Application

- A notice of decision indicating “allowable application” will be mailed with a Notice of Allowance.

### C. Reopen Prosecution

- A notice of decision indicating “reopen prosecution” will state the rejection(s) is/are withdrawn and a new Office Action will be mailed.



<b>Notice of Decision from Post-Prosecution Pilot Program (P3) Conference</b>	Application Number	Applicant(s)	
	DRAFT	DRAFT	
	Examiner	Art Unit	AIA Status
	DRAFT	DRAFT	

This is in response to the P3 request filed \_\_\_\_\_. A conference has been held.

1.  **Final Rejection Upheld:**

The status of claims has been determined as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

The following rejections have been withdrawn:

\_\_\_\_\_

The proposed amendment would overcome all outstanding rejections in the outstanding final Office action. A determination of allowability, however, could not be made within the guidelines of the pilot program.

For purposes of appeal, the proposed amendment:  (a) will be entered, or  (b) will not be entered (**see box 4 below**).

The time period for filing a response expires on (1) the mailing date of this decision; or (2) the date set forth in the final rejection, whichever is later. Extensions of time may be obtained under 37 CFR 1.136(a). **In no event, however, will the statutory period for reply expire later than six (6) months from the mailing date of the final rejection.**

2.  **Allowable Application:** The rejection(s) is/are withdrawn, and this Notice of Decision is being mailed concurrently with a Notice of Allowance.

3.  **Reopen Prosecution:** The rejection(s) is/are withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

4.  **Explanation of Decision for Boxes 1-3:** \_\_\_\_\_

5.  **Attachments:** \_\_\_\_\_

List of Participants:

(1) \_\_\_\_\_

(3) \_\_\_\_\_

(2) \_\_\_\_\_

(4) \_\_\_\_\_

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## Examiner Panel for the P3 Conference

- The panel of examiners includes the examiner of record, the SPE, and a third primary examiner (likely the reviewing primary examiner if it is a junior examiner).
- The Office can bring in additional examiners (e.g., special expertise).

## Examiner Panel for the P3 Conference

- The panel may ask questions during the applicant's 20 min presentation (not supposed to count towards the 20 min).
- The applicant can ask questions from the panel, but should be limited to requests for clarification.
- The presentation will be mostly one-way, but examiners are encouraged to collaborate.
- Final decision will not be provided during the conference, but received later in writing.

## P3 Advantages

- No Fee (Pre-Appeal requires \$800 Notice of Appeal fee).
- Guarantees an after final interview with the examiner, the SPE and a primary examiner (AFCP 2.0 requests are often denied).
- Receive special attention and the applicant is involved in the panel conference.
- Decision includes a written explanation (Pre-Appeal decision is a checked box).
- Examiner may issue a Notice of Allowance before the P3 conference and can offer an Examiner's Amendment for allowance at any time.
- Issues can be simplified for Appeal.

## P3 Disadvantages

- Must act within two months of receiving the final rejection.
- Must be available to conduct the oral presentation within ten calendar days of the initial Office contact.
- After the P3 decision, applicant is limited to filing an RCE or Appeal.
- Excluded from the Pre-Appeal and AFCP 2.0 pilot programs for the same final Office Action.
- Likely require paying at least one extension of time (EOT).
- Examiner is only allotted 3 hours for a P3 request and 4 hours if it includes an amendment.
- Examiner might be more helpful or candid with a AFCP 2.0 request.
- The P3 program may close soon.

# Questions?

Bradford.F.Fritz@bskb.com