

## PTO Prosecution Options after a Final Office Action

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### I. INTRODUCTION

Under the decades old policy of "compact prosecution", a patent applicant gets one shot to amend their application in response to an examiners written explanation why the application is not in condition to issue as a patent. If the examiner does not find that the response places that application in condition for allowance, the examiner sets that status of the application to "final," meaning that the applicant is not entitled to further amend the application to address the rejections. Under the original compact prosecution policy, a patent applicant's options to continue to seek a patent for the invention disclosed in an application under final status were, generally speaking, to appeal the examiner's rejections to the Board or to file a continuation application.

Over the years, due to pushback from the patent bar, but more due to the PTO's embarrassment over the unacceptable backlog of applications under appeal and awaiting a decision on appeal, the PTO has softened the limitations on after final prosecution. In 1995, the PTO, by rule, allowed for further prosecution after final status (for applications filed prior to June 8, 1995). In 1999, Congress amended 35 USC 132 by adding subsection (b) providing for continued examination. In response, the PTO introduced RCEs which allow an applicant to pay a fee in an application finally rejected in order to continue prosecution of the application. Since then, the PTO has introduced at least two programs to attempt to reduce the flow of cases to the Board. Now, the PTO introduces a third such program. All three programs remain active.

The first program was started in 2005. This first program is called the "Pre-Appeal Brief Conference Pilot Program. Under the Pre-Appeal Brief program, the applicant files, with their notice of appeal, a short summary why the examiner erred in rejecting the application. The summary is reviewed by a panel of three examiners. If the panel agrees with the applicant the examiner must open prosecution and reexamine the application. If not, the appeal proceeds.

The second program was started in 2013. This second program is called the "After Final Consideration Pilot Program 2.0" and herein the "2.0 program." Under the 2.0 program, the examiner must reopen prosecution and examine an application under final if the applicant submits a response that includes a non broadening amendment of at least one independent claim, even if the response requires further search and consideration. The examiner may also conduct an interview with the applicant. This program occurs prior to any appeal.

### III. The P3 PROGRAM

The PTO has now created a third program, the "P3" program. This program begins this coming Monday, July 11, 2016. P3 combines aspects of the first and second programs. The P3 program, like the 2.0 program, occurs prior to any appeal. Under P3, a panel of examiners must consider an after final response, the after final response may include an amendment, and the P3 program provides the applicant an opportunity to discuss the issues with the panel of examiners. The panel must come to a decision and provide a written summary of their decision. The details of a P3 request follow.

#### III.1 P3 REQUEST TIMING

A P3 request must be filed within 2 months of the final rejection and prior to the filing of

a notice of appeal. Filing of a P3 request does not stay the six month time period to abandonment, running consequent to the issuance of the final office action, as provided by 35 USC 133. Filing of the P3 request also does not moot the requirements of 37 CFR 1.136 to obtain extensions of the 3 month nonstatutory period for entry of a response that does stay the 35 USC 133 six month statutory period.

A P3 request cannot be filed after a 2.0 program request has been filed.

A notice of appeal, RCE, or express abandonment filed after the filing of a P3 request will terminate the P3 request.

A response after final rejection, pursuant to 37 CFR 1.116, filed after the filing of a P3 request, will not be entered.

During the P3 request, an examiner may enter an examiner's amendment if that amendment places the application in condition for allowance. It is not clear whether the applicant must authorize this amendment.

### III.2 COMPONENTS OF A P3 REQUEST

A P3 request must include a transmittal form, argument, and may include a proposed amendment and evidence. A P3 request's response can address appealable issues and cannot address petitionable issues.

### III.3 LIMITS ON THE ARGUMENT COMPONENT

The argument must be limited to not more than 5 pages, which may be single spaced but must have a font size of 12 or greater. The argument may incorporate by reference argument of record, by pinpoint citation. The 5 page limit does not include any proposed claim amendment.

The five page limit does include any affidavit or declaration submitted with the P3 request.

Any affidavit or declaration will be treated procedurally as defined by 37 CFR 1.116. Under 37 CFR 1.116(e), admission of any evidence into an application that is finally rejected requires "a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." The requirement to include within the 5 page limit for argument why the evidence should be admitted is a disincentive to use of the P3 program.

The argument may address the proposed claim amendment.

### III.3 LIMITS ON THE PROPOSED AMENDMENT COMPONENT

The proposed amendment may not broaden the scope of any claim.

Entry of any proposed amendment is governed by 37 CFR 1.116. 37 CFR 1.116(a)(3), an amendment touching the merits of the application "may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented." The requirement to include within the 5 page limit for argument why the amendment is necessary and was not earlier presented are a disincentive to use of the P3 program.

## IV. AFFIRMATIVE STATEMENT REQUIREMENT

The P3 request must state that the applicant is willing and available to participate (by phone, video, or in person) in the conference. This statement may appear in the transmittal. The applicant's participation in the conference with the panel of examiners is limited to 20 minutes.

## V. CONFERENCE PRESENTATION MATERIALS

Any materials used by the applicant during the presentation, e.g., a PowerPoint® or exhibit, will be placed in the file and will not count against the five-page limit on arguments.

## VI. DECISION FROM P3 CONFERENCE

The PTO will communicate to the applicant a "Notice of Decision from Post-Prosecution Pilot Conference (form PTO-2324)" which will state:

- (1) "final rejection upheld";
- (2) "allowable application;; or
- (3) "reopen prosecution."

A Notice upholding the final rejection (type (1) notice) will summarize the status of the claims, the reasons for maintaining any rejection, and identify rejections as a result of the P3 conference, and the status (entered or not entered) of the proposed amendment for purposes of appeal. An examiner's answer (in response to an appeal brief) to such amended claims, may include grounds of rejection identified in the notice without those ground being considered new grounds of rejection. That is, the appellant would not have the right provided in 37 CFR 41.39(b)(1), to reopen prosecution in response to those new grounds.

A Notice indicating the application is allowed (type (2) notice) will be mailed concurrent with a Notice of allowance of the application.

A Notice indicating prosecution is reopened will state that the rejections are withdrawn and that a new office action will be mailed. This Notice will state that 'no further action is required by the applicant until further notice.'

## VII. CONCLUSION

The P3 program has certain procedural limitations compared to the 2.0 program. However, it has the distinct benefit of allowing the applicant to discuss the case, prior to appeal with 2 examiners other than the examiner that finally rejected the application. This program, from a practitioner centric point of view may not seem very effective. But that may not be its point. The point may be that it shines a light on poor examinations potential in the sense that it allows the applicant to make their case, live, to two other examiners. The existence of this program and the possibility that it may be used to shine a light on bad examinations, may act to avoid bad examinations in the first instance.

Another potential benefit is that the exhibits presented during a P3 conference are made of record. Presumably, those exhibits could subsequently be used in an appeal to make a case. Just like demonstrative exhibits are used in inter partes Board hearings, but with reference to them in the appellant's principle brief.

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