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## PATENTS

## Post Prosecution Pilot: A Promising Patent Office Trial Program in Efforts to Improve After Final Practice



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The U.S. Patent and Trademark Office has expressed a desire to reduce the number of requests for continuing examination (RCEs) and appeals filed as well as the pendency of patent applications on appeal. See “USPTO 2014-2018 Strategic Plan,” pages 1, 9 and 15. However, there is a tension between these reductions and existing after final procedures, which limit an applicant’s options and tend to push the applicant to file an RCE or appeal.

Past and existing efforts by the office to address the number of RCEs and appeals filed and appeal pendency have included the Pre-Appeal Brief Request for Review (Pre-Appeal), the After Final Consideration Pilot (AFCP) program and the AFCP 2.0 program. The of-

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office's most recent experiment was the Post Prosecution Pilot (P3) program, which ran from July 11, 2016, to Jan. 12, 2017. See 81 Fed. Reg. 44,845 for P3 program rules.

The PTO has not yet indicated whether the P3 program will be reinstated. Based on our experience (we filed more than 50 P3 requests), the P3 program was a promising avenue to improve after final practice from the applicant's perspective as well as to reduce the number of RCEs and appeals filed. However, some modifications could make the P3 program even more effective. Below, we describe the P3 program, contrast the P3 program with current after final programs, and comment on possible modifications to the P3 program.

### After Final Practice and Procedure

After final practice and procedure is governed by 37 C.F.R. § 1.116. This section of the Patent Rules closes the prosecution of an application and limits an applicant's options for responding after a final rejection. Entry of amendments is limited and, because an examiner is less likely to reconsider his own position (for reduced/zero count), the most likely outcome of a response after final rejection is the issuance of an Advisory Action. According to data published by the office, over 65 percent of after final responses (including responses filed under the AFCP 2.0 program) filed between March 2016 and March 2017 resulted in the issuance of an Advisory Action, while just 30 percent of such responses resulted in the issuance of a Notice of Allowance or the reopening of prosecution. See <https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1011>. The PTO has not published data relating to the results of Pre-Appeal Brief filings.

During its pendency, the PTO tested the P3 program as an alternative after final procedure to the AFCP 2.0 program and the Pre-Appeal program. The chart below includes characteristic features of the AFCP 2.0 program, the Pre-Appeal program, and the P3 program.

	<b>AFCP 2.0 Program</b>	<b>Pre-Appeal Program</b>	<b>P3 Program</b>
<b>Filing Deadline</b>	None.	None.	Two-month date.
<b>Does Filing Stop Clock?</b>	No. Period of reply is not extended beyond six months.	Yes. Prosecution is stopped upon filing of Pre-Appeal Brief and Notice of Appeal.	No. Period for reply is not extended beyond six months.
<b>Cost</b>	None. Any EOT is calculated from the mailing date of Advisory Action (if rejection is upheld) if AFCP 2.0 request is filed by the two-month date.	Notice of Appeal fee.	None.
<b>Filing Requirements</b>	AFCP 2.0 request form. At least one independent claim must be amended in a way that does not broaden the claim in any aspect.	Must be filed with Notice of Appeal and Notice of Appeal fee, five-page limit for remarks, no claim amendments.	P3 request form. Five-page limit for remarks. Optional claim amendments may be filed for discussion purposes only.
<b>Examiner Interview</b>	The examiner contacts the applicant to schedule an interview when (i) the examiner determines that the claim amendments in the filed response require further search and/or consideration, (ii) the further search and/or consideration can be completed within the allotted time under the AFCP 2.0 program, and (iii) the claim amendments do not place the application in condition for allowance.	No interview/oral argument.	Panel conference is mandatory. Supervisory patent examiner (SPE) contacts applicant to schedule P3 conference. Panel of three examiners attend conference.
<b>Office Decision Form</b>	AFCP 2.0 Decision is mailed with Advisory Action or Notice of Allowance. Advisory Action may include limited comments.	Notice of Panel Decision. The Notice indicates whether (i) the request is improper, (ii) the application should proceed to appeal, (iii) the application is to be allowed, or (iv) the rejection is to be withdrawn. The Notice does not include comments.	Notice of Decision indicates whether (i) the rejection is upheld, (ii) the application is to be allowed, or (iii) the rejection is withdrawn. The Notice may include comments.

## Filing Deadlines and Timing of Programs

The Pre-Appeal program requires that claims of an application be twice rejected and that a Pre-Appeal Brief be filed concurrently with a Notice of Appeal. Thus, a Pre-Appeal Brief may be filed after a second Office Action, irrespective of finality. In contrast, the AFCP 2.0 program requires, and the P3 program required, that the claims be under final rejection.

A notable feature of the AFCP 2.0 program is that EOTs are calculated from the mailing of an Advisory Action if an AFCP 2.0 request is filed within two months of the mailing of the final rejection. Although the P3 program did not include this feature, the P3 program required that a P3 request be filed within two months of the mailing of the final rejection. This resulted in some P3 participants being left to pay for extensions of time (EOTs) when outstanding rejections were upheld.

When a Pre-Appeal Brief and Notice of Appeal are filed, the clock is stopped until the office issues a panel decision. In contrast to the Pre-Appeal program, the clock does not stop under the AFCP 2.0 program, and the period for reply is not extendable beyond six months. The P3 program had similar rules to the AFCP 2.0 program; the clock did not stop and the period for reply could not be extended beyond six months. As a result, it was possible under the P3 program for an appli-

cation to approach the non-extendable six-month deadline due to inaction or delay by the office.

## Filing Requirements and Cost

The AFCP 2.0 program and the Pre-Appeal program have distinctly different filing requirements. The AFCP 2.0 program requires the filing of an AFCP 2.0 request form and amendments to at least one independent claim that do not broaden the claim “in any aspect.” The Pre-Appeal program prohibits claim amendments and requires the filing of a Pre-Appeal Brief that includes a maximum of five pages of remarks. Additionally, the Pre-Appeal Brief must be filed concurrently with a Notice of Appeal and Notice of Appeal fee.

The P3 program aimed to combine features of the AFCP 2.0 program and the Pre-Appeal program. The P3 program required the filing of a P3 request form and a maximum of five pages of remarks. Additionally, the P3 program allowed the applicant to present optional proposed amendments to any pending claim, *independent or dependent*, provided that the amendments are “non-broadening.”

We note the distinction between the P3 program’s optional non-broadening amendments to “a claim” and the AFCP 2.0 program’s required non-broadening claim amendments to “at least one independent claim.” Our experience was that claim amendments were proposed,

by the attorney or the examiner, in about a quarter of the P3 requests we filed and that were considered by the office.

### Examiner Interview/P3 Conference

Under the AFCP 2.0 program, the applicant is not guaranteed an interview with the examiner. The AFCP 2.0 program requires that the examiner contact the applicant to schedule an interview when (i) the examiner determines that the claim amendments in the filed response require further search and/or consideration, (ii) the further search and/or consideration can be completed within the allotted time under the AFCP 2.0 program, and (iii) the claim amendments do not place the application in condition for allowance. Examiner interviews are not permitted under the Pre-Appeal program.

The P3 program required a “P3 conference.” The P3 conference was a mandatory interview between the applicant and a three-examiner panel and permitted the applicant to present remarks for a maximum of 20 minutes. Similar to a panel in the Pre-Appeal program, the P3 panel comprised the examiner of record, the examiner’s SPE, and another senior examiner knowledgeable in the art field.

Under the P3 program, the SPE was required to contact the applicant to schedule the P3 conference. We experienced an average of almost 23 days from the filing of a P3 request until we received a call from the SPE to schedule the P3 conference. We note that the 23-day average (to receive a scheduling call from the SPE) is consistent with the PTO’s 23-day average for an examiner to *enter a reply* to a response filed after final rejection. See <https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1011>.

In our experience, the PTO conducted P3 conferences for virtually all P3 requests that were considered. Some P3 requests were not considered by the office because the applicable art unit reached the P3 cap of 200 or due to office error, such as the improper consideration of a P3 filing under the AFCP 2.0 program. We conducted P3 conferences for all but one of the P3 requests that we filed and that were considered by the office. In the one instance in which the P3 conference was not held, the office issued a Notice of Allowance instead of scheduling the P3 conference.

While most standard examiner interviews (under the AFCP 2.0 program and otherwise) generally include constructive interaction between the applicant and the examiner, we experienced little-to-no examiner interaction during our P3 conferences. Instead, most P3 conferences we attended could be described as one-way presentations, with the attorney presenting information to a silent examiner panel.

Our P3 conference experience is consistent with a literal interpretation of the PTO’s training materials relating to the P3 program. The office training materials dated July 5, 2016, stated, “After Applicant departs, the panelists will confer and make a recommendation to the Examiner.” See <https://www.uspto.gov/sites/default/files/documents/post-prosecution-pilot-training.pdf>. Despite the lack of examiner/attorney interaction, we note that the P3 conferences allowed us to “read the room” and to get a feel for how the examiners would process the filed remarks and the presented arguments.

### Office Decision

The P3 program required that the office mail a Notice of Decision after completion of the P3 conference and consideration by the examiner. The Notice of Decision combined features of the Pre-Appeal Decision and the AFCP 2.0 Decision. In particular, the Notice of Decision indicated whether (i) the rejection was upheld, (ii) the application was to be allowed, or (iii) the rejection was to be withdrawn. In some instances, the Notice of Decision included comments that explained the panel’s decision. In our experience, over 40 percent of the P3 requests that we filed resulted in either allowance or the re-opening of prosecution, which was a significantly greater percentage than the 30 percent of after final responses that result in allowance or the reopening of prosecution under current after final practice. See <https://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1011>.

### Suggestions for Improvement to the P3 Program

We believe that the P3 program was a step in the right direction for after final practice. However, should the PTO decide to reinstate the P3 program (or replace the Pre-Appeal and AFCP 2.0 programs with the P3 program), the office may want to consider the following modifications to the P3 program.

*Expedite P3 Program Timeline:* We experienced an average of almost 23 days from the filing of a P3 request until we received a scheduling call from the SPE. Moreover, we experienced a wide variance in the amount of time from the filing of a P3 request to the mailing of a Notice of Decision, ranging from a short 17 days to an excruciatingly long 155 days. If the P3 program is to be reinstated, scheduling the P3 conference will need to occur faster. We suggest requiring that the SPE contact the applicant to schedule the P3 conference within 10 days of the filing of the P3 request.

Expedition mailing of the Notice of Decision after the P3 conference is also necessary. We experienced an average of 46 days from the filing of a P3 request to the mailing of a Notice of Decision. With such an average, the filing of *at least one* EOT was required to continue prosecution when a final rejection was maintained. We suggest requiring the mailing of a Notice of Decision not more than 10 days after the P3 conference.

*Calculation of Extensions:* We suggest that the P3 program adopt an EOT policy that is similar to the current EOT policy under the AFCP 2.0 program. Because the P3 program required that the applicant wait for the office to schedule the P3 conference and then wait for the office to mail a Notice of Decision, large amounts of time could pass before the applicant received a Notice of Decision. We suggest calculating EOTs from the mailing of the Notice of Decision instead of the three-month date.

*Filing of a Formal Amendment:* Claim amendments filed under the P3 program were optional and for discussion purposes only. Under P3 program rules, EOTs could have been necessary for the applicant to file a supplemental response including claim amendments

that may have been discussed during the P3 conference. We suggest modifying the filing requirements of the P3 program so that claim amendments included in a P3 filing may be entered either by the examiner or by the applicant's filing of an RCE.

*Examiner Feedback During P3 Conference:* A literal reading of the P3 program rules allowed for examiners to provide little-to-no feedback to an applicant during a P3 conference. Our experience has been that, in general, examiner interviews are productive when both the examiner and the applicant discuss the merits of a case. To improve the P3 conference, we suggest modifying the PTO training materials for the P3 program to *permit and encourage* panel interaction during the P3 conference.

### **Summary**

The P3 program was a great effort to improve after final practice, as it included some of the best features of

the AFCP 2.0 program and the Pre-Appeal program. We believe that the P3 program was attractive because it afforded opportunities to applicants that were unavailable under traditional after final practice. Despite the positives, the P3 program included inherent flaws that limited its potential, such as little-to-no examiner interaction during P3 conferences and long delays.

It is our hope that the PTO institutes a permanent and modified version of the P3 program that provides an improved avenue for applicants after final rejection. Modifications to the P3 program to (i) expedite the P3 program's timeline by imposing deadlines for examiners, (ii) adopt the AFCP 2.0 program's EOT calculation policy, (iii) modify the formal filing requirements for the P3 program, and/or (iv) encourage examiner interaction and feedback during the P3 conference, would undoubtedly make the P3 program more attractive to applicants and could help the office meet its stated goal to reduce the number of RCEs and appeals filed and to reduce the pendency of applications on appeal.