

The Post-Prosecution Pilot Program: To P3, or Not To P3

by Doreen Y. Trujillo and Michael G. Manas

On July 11, 2016, the United States Patent & Trademark Office (“USPTO”) announced the commencement of the Post-Prosecution Pilot Program (“P3”). The announcement was published in the Federal Register – 81 FR 44845 (July 11, 2016) (“Notice”). The P3 started July 11, 2016, and extends until January 12, 2017, or until 1,600 compliant requests are received, whichever occurs first. Each Technology Center is only allowed 200 requests in reaching the 1,600 total, however. Indeed, the USPTO website has a P3 webpage with a “counter” for showing how many requests have been filed per Technology Center. A snapshot of the counter as of August 15, 2016 is duplicated below:



Counter by Technology Center (updated as of August 15, 2016)

1600	9	1700	12	2100	35	2400	33
2600	23	2800	23	3600	38	3700	39

The P3 could close for a Technology Center(s) and remain open for others. Although the P3 has already begun, the Notice requests written comments on the P3 by November 14, 2016.

The P3 is the third program initiated by the USPTO to attempt to improve the after final practice in a little over a decade. The first program is the Pre-Appeal Brief Conference Program (“Pre-Appeal”), which was begun on July 12, 2005, and was extended indefinitely on February 7, 2006. The second program is the After Final Consideration Pilot Program (“AFCP”), now AFCP 2.0, which was begun on May 19, 2013, and is presently scheduled to end September 30, 2016. All three programs, thus, are running concurrently.

A chart comparing the three different programs is attached. As can be seen from the chart, and as was asserted in the Notice, the P3 combines features from both the Pre-Appeal and the AFCP 2.0. For example, like the AFCP 2.0, claim amendments are allowed in the P3. Notably, however, claim amendments are not required under the P3, nor are they restricted to independent claims. Like the Pre-Appeal, there is a page limit for the P3. While the total page number for the Pre-Appeal request is limited to five (5) or fewer pages, only the argument section of the P3 is limited to five (5) or fewer pages. Additionally, the P3 request can be single-spaced, and the signature block can appear on the sixth page. Like the Pre-Appeal, the decision is made by a panel of three examiners. In the case of the P3, however, the Applicant has an opportunity to appear in person before the panel, as well as by phone or video. In this regard, the P3 is more like the AFCP 2.0, which allows for an Examiner interview if the claim amendment(s) do not place the application in condition for allowance. Notably, the Applicant can use exhibits during the panel presentation for the P3, which are then placed in the file. The exhibits do **not** get counted toward the page limit, and do not appear to be limited to what was argued in the request, thus providing an opportunity for entering further arguments into the record. Finally, and perhaps most motivating to the Examiner, like the AFCP 2.0, non-production hours can be granted to the Examiner for processing the P3 request. Regarding the AFCP 2.0, up to three (3) hours of non-production time can be granted; for a P3 request, up to four (4) hours can be granted – usually three (3) hours are granted but, if there are claim amendments, an additional hour is granted.

Although all three programs are running concurrently, with the exception of perhaps being able to file a Pre-Appeal request after an AFCP 2.0 request, all three programs are mutually exclusive. Accordingly, if you choose one program, you are foregoing the other two. Each program provides different advantages and disadvantages.

In our experience, we have found the AFCP 2.0 program to result in an allowance much more frequently than the Pre-Appeal. Perhaps it is because the scope of the Pre-Appeal is so limited, i.e., clear factual or legal deficiencies must be shown. Or, perhaps it is because claim amendments are allowed, indeed required, for the AFCP 2.0, but not allowed for the Pre-Appeal. Often an amendment that would overcome the outstanding rejection(s) does not become clear until a final office action has issued. The patent rules, however, prevent amendments affecting the substance of claims after a final rejection unless good cause why the amendment is necessary and was not earlier presented is shown. Or, perhaps it is because non-production time is given for the AFCP 2.0, which encourages the Examiner to take a more careful look at the response than he or she normally would have. Or, and finally, perhaps it is because the Examiner has to interview the Applicant if the amendment does not place the application in condition for allowance under the AFCP 2.0; no interview is provided for under the Pre-Appeal. Although the patent rules do not prevent interviews after a final office action, the Manual of Patent Examining Procedure limits the scope of such interviews to placing the application in condition for allowance, or resolving issues prior to appeal. Further, the intended purpose and content of the interview must be presented to the Examiner beforehand, preferably in writing. An interview may be granted, but only if nominal further consideration is required.

With all those seeming advantages for the AFCP 2.0, why would one ever choose the Pre-Appeal? We can think of at least two situations. The first would be if the Applicant does not wish to make any non-broadening amendments to an independent claim. The second is if the Applicant has already requested entry into AFCP 2.0, but has failed to overcome the final rejection. One does not have to file a notice of appeal to proceed with the AFCP 2.0. It is possible, thus, to file the Pre-Appeal request at the six-month deadline for responding to the final rejection with the notice of appeal. This strategy gives an Applicant a second bite at the apple.

But how does the P3 compare with the AFCP 2.0? The P3 provides for all the advantages of the AFCP 2.0 noted above. The P3, however, is not without limitations. One limitation with the P3 is that it must be filed very quickly, i.e., within two months of the mailing date of the final office action. That turnaround is quick for a document of such import. A second limitation is that the argument is limited to five (5) pages. Although the page limit excludes claim amendments, if an Applicant were to make any amendments, they would have to show support for the amendments in the argument section, thereby cutting into the page limitation. The first and second limitations are somewhat offset, however, by the ability to rely upon exhibits during the P3 conference, including PowerPoint® presentations. A third limitation is that the P3 only applies to utility applications; the AFCP 2.0 is applicable to utility, plant, **and** design applications. And, finally, a fourth limitation is that, currently, only 200 P3s are allowed per Technology Center. It is quite possible that the limit for a Technology Center can be reached well before the deadline of January 12, 2017.

Finally, how does the P3 compare to the Pre-Appeal? As noted above, the P3 must be filed within two months of the mailing date of the final office action; the Pre-Appeal can be filed at the six-month deadline if necessary, as long as it is filed with the Notice of Appeal. Again, only 200 P3s are allowed per Technology Center currently; at present, the Pre-Appeal extends indefinitely. Finally, the Pre-Appeal can be filed after the claims have been twice rejected, i.e., it does not need to be filed in response to a final rejection. If the Examiner protracts prosecution by levying new rejections each time an Applicant overcomes prior rejections, the Applicant can then file a Pre-Appeal to challenge the protraction. Unfortunately, if it does not result in an allowance, Applicant will have no guidance why, as there is no explanation provided. Contrastingly, a written explanation of the panel decision is provided under the P3. Further, unlike the Pre-Appeal, the P3 does not limit what arguments can be advanced, and allows for the presentation of additional arguments/exhibits at the conference.

Considering that this is the third attempt by the USPTO to address the “problem” of final rejections, perhaps a better solution might be for the Office to be less hasty with levying final rejections. Instead of making it the normal procedure to make the second office action be final (which is definitely our experience), why not allow Examin-

ers a third (or fourth) action to flush out the issues? The statute does not require that the second office action be final. Such a strategy will provide Applicants a second opportunity to amend the claims. As noted above, the appropriate amendment to make often does not become clear until after the second office action.

Until then, an Applicant has three different mechanisms to choose for trying to advance an application to allowance after receipt of a final rejection. The mechanism chosen will depend upon timing, whether or not claim amendments are desired, and whether or not an opportunity to present before a panel of Examiners is desired. Our advice to you is thus this – choose wisely.

USPTO After Final Program Comparison Chart

	Pre-Appeal Brief Conference	After Final Consideration Pilot (AFCP) 2.0	Post-Prosecution Pilot Program (P3)
Program Duration	Started: July 12, 2005. Extended until further notice, effective February 7, 2006.	Started: May 19, 2013. Scheduled End: September 30, 2016.	Started: July 11, 2016. Scheduled End: January 12, 2017 or after a total of 1,600 compliant requests, <i>no more than 200 per Technology Center</i> , are received. The USPTO website has a “counter” for keeping track of the number of P3 requests per Technology Center.
Eligible Applications	Does not appear to be limited to utility applications only. Reexamination applications are not eligible.	Utility, plant, or design applications. Reissue and reexamination applications are not eligible.	Utility applications only. Reissue and reexamination applications are not eligible.
Time to File	Can be filed once an application has been twice rejected, i.e., the application does not have to be under final rejection. Must be filed with the Notice of Appeal.	Application must be under <i>final</i> rejection. Request must be filed prior to re-opening prosecution (e.g., through an RCE). Request must be filed within standard response window for responding to the final rejection, including any extensions of time.	Application must be under <i>final</i> rejection. Request must be filed within two (2) months of the mailing date of a Final Office Action and prior to filing a Notice of Appeal or re-opening of prosecution (e.g., through an RCE).
Requirements	Request must include: - a document entitled “Pre-Appeal Brief Request for Review,” PTO/SB/33; - a document comprising five (5) or fewer total pages of arguments accompanying the request; and - a Notice of Appeal.	Request must include: - a transmittal form (form PTO/SB/434) that identifies the submission as an AFCP 2.0 submission and requests consideration; - a response under 37 CFR § 1.116, which includes at least one independent claim amendment; and - a commitment by the Applicant to be available to speak within 10 days of an initial request by the Office to schedule an interview.	Request must include: - a transmittal form (form PTO/SB/444) titled “Certification and Request for Consideration under the Post-Prosecution Pilot Program”; - a response under 37 CFR § 1.116 comprising five (5) or fewer pages of argument (excluding signature page and claim amendments); and - a conference participation statement indicating that the Applicant is willing and available to meet within 10 days of an initial request by the Office to schedule the panel.
Page Limits	Whole request cannot be more than five (5) pages.	None.	Argument section cannot be more than five (5) pages, <i>single-spaced</i> .
Amendments	No claim amendments are allowed.	MUST include a non-broadening amendment to at least one <i>independent</i> claim.	Non-broadening amendments to any claims are allowed.

Fees	Not for the program, only whatever extension fees are due, and the Notice of Appeal fee.	Not for the program, only whatever extension fees are due.	None (has to be filed before extension fees would be due).
Compliance Review	Technology Center Art Unit Supervisor reviews for compliance. If non-compliant, the request can be dismissed; if compliant, the Technology Center Art Unit Supervisor designates a panel of Examiners to review the arguments and rejections.	The Examiner reviews the submission for compliance. If non-compliant, the request is processed as a standard after final amendment; if compliant, claim amendment(s) are reviewed.	Request is reviewed for compliance by Technology Center. If non-compliant, the request is entered as a standard after final amendment; if compliant, a panel conference is scheduled.
Argument Requirements	<ul style="list-style-type: none"> - Arguments should specify clear errors in the Examiner's rejections or the Examiner's omissions of one or more essential elements needed for a <i>prima facie</i> rejection. Should be based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings. For example, the request should concisely point out that a limitation is not met by a reference, or that the Examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103). Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. - Arguments must be limited to appealable matters, not petitionable matters. 	No limits on what can be argued.	<ul style="list-style-type: none"> - Arguments not as limited as for the Pre-Appeal Brief Conference. For example, patentability of any amended claims can be argued. - Affidavits may be included, but count against the page limit. - Can refer to arguments already of record. - Arguments must be limited to appealable matters, not petitionable matters.
Substantive Review	A panel of three Examiners, including at least one Supervisory Patent Examiner and the Examiner of record, will review the request.	Interviews will be conducted by the Examiner and, if the Examiner does not have signatory authority, a Primary Examiner or a Supervisory Patent Examiner.	A panel consisting of the Examiner of record (and their Primary if the Examiner is a Junior), the Supervisory Patent Examiner, and at least one other Primary Examiner will review the request.

<p>Logistics</p>	<ul style="list-style-type: none"> - Review occurs without further participation of the Applicant. - The panel will review the rejection(s), the arguments, and evidence and determine if an issue for appeal is present in the record and make a decision accordingly. - A one-page decision will issue – PTO-2297 – usually within 45 days, summarizing the status of the pending claims. - No new grounds of rejection will be made. - No explanation of the decision is provided. 	<ul style="list-style-type: none"> - Must be filed electronically. - Only one AFCP request may be filed per final rejection. - An interview may be conducted with the Examiner. - For utility applications, up to three (3) hours non-production time is granted; for design applications, up to one (1) hour non-production time is granted. - If the claim amendments would require additional searches or considerations to determine whether the amendment would distinguish over the prior art, and such a search would not be possible in the allotted time, the submission is processed as a standard after final amendment and an advisory action is issued. - If the amendment does not require additional extensive searching or consideration, and the amendment puts the application in a state of allowance, then a Notice of Allowance is issued. - If the amendment does not place the application in a state of allowance, then the Examiner will contact the Applicant to schedule an interview. - After the interview, a decision will be made following standard practice after a final rejection. 	<ul style="list-style-type: none"> - Must be filed electronically. - Only one P3 request may be filed per <i>round of prosecution</i>. - Applicant can participate in conference in person, by phone, or by video conference (set up by the Office). - The conference includes 20 minutes for a presentation by the Applicant. The presentation is apparently not limited to what was argued in the request, and demonstrative exhibits may be used, e.g., PowerPoint® presentations. Such exhibits will be placed in the file and do not count against the five-page limit. - The Examiner of record is granted up to three (3) hours of non-production time to review the request, conduct the conference, complete the P3 decision form –PTO-2324 – and complete the survey. An additional hour is granted if claim amendments are proposed. - Additional non-production time may be available. - Panelists are to record the amount of time it takes to prepare for and participate in the conference. - After the conference, the panelists will confer and make a recommendation to the Examiner. - No new grounds of rejection will be made. - A written <i>explanation</i> of the panel decision will be provided.
<p>Potential Outcomes</p>	<ul style="list-style-type: none"> - Allowable subject matter is found; proceed to issue a Notice of Allowance. - The application remains under appeal because there is at least one actual issue for appeal. - Re-open prosecution. 	<ul style="list-style-type: none"> - Allowable subject matter is found; proceed to issue a Notice of Allowance. - Uphold Final rejection, an Advisory Action will issue. 	<ul style="list-style-type: none"> - Allowable subject matter is found; proceed to issue a Notice of Allowance. - Uphold Final rejection. - Re-open prosecution.

Effect on Response Deadline	Time for filing the appeal brief is either the balance of two months from the filing of the Notice of Appeal, or one month from the date of the decision, whichever is greater. Extensions of time under 37 CFR 1.136 are available.	Time for responding to the final rejection is not extended.	Time for responding to the final rejection is not extended. Cannot file a Notice of Appeal to extend the deadline, either, as the filing of a Notice of Appeal will end the P3 request.
Effect on Other After Final Programs	Cannot file a P3 request or an AFCP request after a <i>proper</i> Pre-Appeal Brief Conference request has been <i>filed</i> in response to the same final rejection.	Cannot file a P3 request after a proper AFCP request has been <i>filed</i> in response to the <i>same</i> final rejection. Pre-appeal Brief Conference request probably not precluded.	Cannot file a Pre-Appeal Brief Conference request or an AFCP request after a P3 request has been <i>accepted</i> in response to the <i>same</i> final rejection.

Written by Doreen Y. Trujillo, a partner in Saul Ewing's Intellectual Property and Patent Services practices, and Michael G. Manas, a Saul Ewing Patent Agent.

Doreen can be reached at 610.251.5092 or dtrujillo@saul.com. Michael can be reached at 215.972.7745 or mmanas@saul.com.

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