

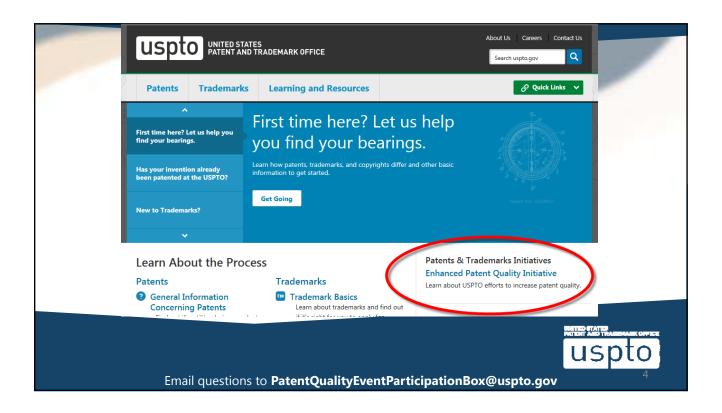
## **Patent Quality Chat:**

# The Post-Prosecution Pilot: A New After Final Collaboration Program

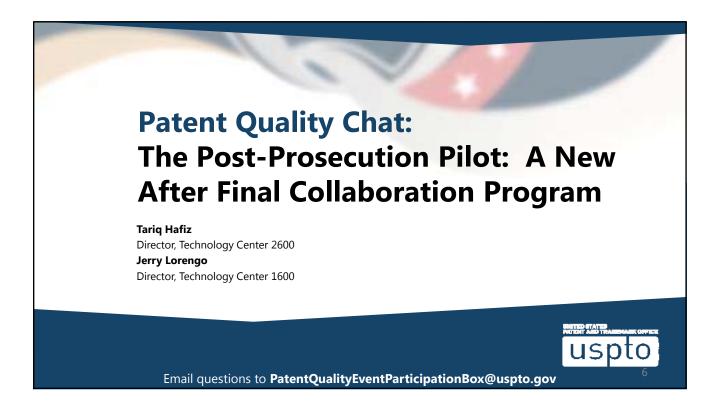
Patent Quality Chat Webinar Series 2016 (9 of 11) August 9, 2016











## Introduction to the Post-Prosecution Pilot (P3)



- Advanced as a program of the Enhanced Patent Quality Initiative (EPQI) under Pillar 3, Excellence in Customer Service
- Developed to test its impact on enhancing patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal



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## Overview of the Post-Prosecution Pilot (P3)

- Retains popular features of the Pre-appeal Brief Conference Pilot and After Final Consideration Pilot (AFCP) 2.0 programs:
  - > Consideration of 5-pages of arguments after final
  - Consideration of non-broadening claim amendments after final
- Adds requested features:
  - > Presentation of arguments to a panel of examiners
  - Explanation of the panel's recommendation in a written decision after the panel confers

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## Post-Prosecution Pilot (P3) Begins

- Federal Register Notice (81 FR 44845) July 2016
- Pilot began July 11, 2016
- Runs six (6) months or upon receipt of 1,600 compliant requests, whichever occurs first
  - 200 per Technology Center

 Formal comments about P3 will be received through November 14, 2016 at <u>AfterFinalPractice@uspto.gov</u>

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## **P3 Pilot Participation**

Open to nonprovisional and international utility applications filed under 35 USC 111(a) or 35 USC 371 that are under final rejection.

The following are required for pilot entry:

- A request, such as in PTO/SB/444, must be filed via EFS-Web
  - within 2 months of the mail date of the final rejection and prior to filing notice of appeal
- A statement that applicant is willing and available to participate in P3 conference with the panel of examiners
- A response comprising no more than five (5) page of arguments under 37 CFR 1.116 to the outstanding final rejection, exclusive of any amendments
- Optionally, a proposed non-broadening amendment to one (1) or more claim(s)

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## **P3 Pilot Requirements**

- No fee to participate
- No previously filed proper request to participate in the Pre-Appeal or AFCP 2.0 programs to the same outstanding final rejection
- Once a P3 request has been accepted:
  - no additional response(s) under 37 CFR 1.116 will be entered unless requested by examiner
    - impermissible to request participation in Pre-Appeal or AFCP 2.0 programs once a P3 request has been accepted



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## **P3 Pilot Compliance**

For requests considered timely and compliant, the Office will enter the application into the pilot process.

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

- The Office will treat the request as in the same manner it would treat any after final response absent the P3 request.
  - No conference will be held.
- The next communication issued by the Office will indicate:
  - the reason why the P3 request was found to be untimely or otherwise noncompliant;
  - the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment; and
  - the time period for the applicant to take further action.

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#### **P3 Pilot Process**

- The Office will contact the applicant to schedule the P3 1. conference.
- The applicant will make an oral presentation to the panel of examiners with such participating being limited to 20 minutes.
- The applicant will be informed of the panel's decision, in writing, following complete consideration of the P3 request.





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#### **P3 Pilot Notice of Decision**

Applicant will be informed, in writing via a Notice of Decision from Post-Prosecution Pilot Program (P3) Conference (PTO-2324), as to the outcome of the conference.

Three possible outcomes are:

- A. Final Rejection Upheld
  - The status of any proposed amendment(s) will be communicated
  - The time period for taking further action will be noted
- B. Allowable Application
- **Reopen Prosecution**

All of the above outcomes will include an Explanation 15010



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## P3 Pilot – Looking Ahead

- Consider:
  - Internal and external survey results
  - Formal Comments from FR Notice
  - Stakeholder feedback about the program from other sources
- Decide:



Whether or not to continue the program, optionally with modifications



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### For More Information on P3

- Visit our website: <u>http://www.uspto.gov/patent/initiatives/post-prosecution-pilot</u>
  - Program details and forms
  - Examiner training materials
  - FAQs
- Contact us by email: PostProsecutionPilot@uspto.gov



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## Let's Chat about the Post-Prosecution Pilot (P3) Program

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 $\label{prop:linear} \textbf{Email questions to } \textbf{PatentQualityEventParticipationBox@uspto.gov}$ 

## Thank you for joining us today!

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### **Next Patent Quality Chat:**

Tuesday, September 13<sup>th</sup>
Future Information Disclosure Practice in a
Global Dossier Environment



