

## PATENT OFFICE PROPOUNDS NEW POST-PROSECUTION PILOT PROGRAM

Date: 15 July 2016

### IP Procurement and Portfolio Management Alert

By: Robert M. Barrett, Rebecca M. Cavin, Margaux L. Nair

On Monday, July 11, 2016, the U.S. Patent and Trademark Office (PTO) launched its new Post-Prosecution Pilot Program, or "the P3." The P3 is designed to test its impact on enhancing prosecution after a final office action but prior to an appeal, with the goal of reducing Requests for Continued Examination (RCEs), and reducing the number of appeals and issues on appeal to the Patent Trial and Appeal Board (PTAB).

The P3 is a part of the PTO's February 2015 Enhanced Patent Quality Initiative, and responds to stakeholder input requesting more applicant participation following a final office action. It expands the available after-final options, which previously included programs such as the 2005 Pre-Appeal Brief Conference Pilot Program (Pre-Appeal) and the 2013 After Final Consideration Pilot Program 2.0 (AFCP 2.0). The P3 blends popular features of these existing programs with new features. For instance, the P3 includes (1) an after-final response considered by a panel of examiners (Pre-Appeal); (2) an optional proposed amendment (AFCP 2.0); and (3) an oral presentation to the panel by the applicant (new).

To be eligible for the program, an application must have a pending final office action with no previously-filed Pre-Appeal or ACFP 2.0 request regarding the same pending final office action. The P3 cannot be used in re-issue, design, plant, or re-examination proceedings. If eligible, an applicant can enter the P3 program by filing, within two months from the mailing date of the final office action, (1) a transmittal form identifying the submission as part of, and requesting consideration under, the P3; (2) a response to the final office action with no more than five pages of argument on appealable issues (signature pages and proposed amendments do not count against the five pages); and (3) a statement that the applicant is willing and able to participate in a conference with the P3 panel of examiners. No fees are required.

Once an applicant has filed a timely and proper request for the P3, the PTO will coordinate an experienced panel and contact the applicant to schedule the conference. The conference must be scheduled within 10 calendar days of when the PTO contacts the applicant, and the conference can occur in-person, by telephone, or by video conference. The applicant's presentation may be performed in a manner similar to how an applicant presents an Argument in an *ex parte* appeal and may last up to 20 minutes, at which point the applicant will be excused. If the applicant uses any materials as a part of the presentation, such as a PowerPoint slide deck, those materials will be added to the prosecution file (but will not count against the five page limit on appealable arguments).

Following the conference with the panel, the panel will issue a written decision with three potential indications: (a) final rejection upheld (at which point the applicant must either abandon or file an RCE or appeal); (b) allowable application; or (c) reopen prosecution. The panel may also enter an Examiner's Amendment to place the application in condition for allowance at any time.

The PTO is accepting a total of 1,600 compliant requests (no more than 200 per technology center) through January 12, 2017. The PTO is also soliciting written comments on the P3 and other suggestions to improve after-final practice at the email address [afterfinalpractice@uspto.gov](mailto:afterfinalpractice@uspto.gov). Further details on the P3 are located in the Federal Register notice, available by clicking [here](#).

## KEY CONTACTS



**ROBERT M. BARRETT**  
PARTNER  
CHICAGO  
+1.312.807.4204  
[ROBERT.BARRETT@KLGATES.COM](mailto:ROBERT.BARRETT@KLGATES.COM)

---

This publication/newsletter is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer. Any views expressed herein are those of the author(s) and not necessarily those of the law firm's clients.