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Portfolio Media, Inc. | 111 West 19th Street, 5th floor | New York, NY 10011 | www.law360.com  
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

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## Is The New USPTO Pilot Program An Improvement?

Law360, New York (July 18, 2016, 11:34 AM ET) -- On July 11, the U.S. Patent and Trademark Office announced the launch of a new Post-Prosecution Pilot ("P3") aimed at increasing collaboration between patent examiners and applicants. The P3 program was designed to combine the best features of two existing programs, the Pre-Appeal Brief Conference Pilot Program (Pre-Appeal) and the After Final Consideration Pilot Program 2.0 (AFCP 2.0). While the program sounds promising for applicants facing a final rejection, the question remains whether it will suffer from the same drawbacks of the Pre-Appeal and AFCP programs.



Lisa Adams

Under the current Pre-Appeal program, patent applicants have an opportunity to request review of a final rejection after the filing of a notice of appeal, but prior to filing an appeal brief for consideration by the Patent Trial and Appeal Board. The Pre-Appeal request must be filed with the notice of appeal and with pre-appeal brief comments that do not exceed more than five pages. The program is intended to be used only when applicant believes there is a clear legal or factual deficiency in the rejection(s). As such, the program tends to be more successful when appealing novelty rejections, where there is a missing element in the prior art, as compared to obviousness rejections where arguments often rely on reasons why the prior art references cannot be combined. Once the Pre-Appeal request and comments are submitted, the comments are reviewed by a panel of examiners that includes the examiner of record, and typically the examiner's supervisor as well as another supervisor, often from the same art unit.

While the Pre-Appeal program provides applicants with an opportunity to have a rejection reconsidered before proceeding with the filing of a costly appeal brief, many practitioners feel it has a low success rate. Since two members of the three member pre-appeal review panel consist of the examiner and their supervisor who issued the final rejection(s), it is unlikely that the rejection(s) will be withdrawn. As noted above, obviousness rejections, as compared to novelty rejections, are even more unlikely to be withdrawn due to the fact that the arguments are often not based on a clear factual deficiency. Accordingly, many practitioners feel it may more prudent to avoid the added expense of drafting a pre-appeal brief, and instead proceed with the preparation and filing of an appeal brief that will be reviewed by an entirely independent panel of judges at the PTAB. On the other hand, the costs of preparing Pre-Appeal comments is significantly lower than the costs of preparing an Appeal Brief, and the turn-around time is significantly faster. Thus, even considering the success rate of overcoming rejections through the Pre-Appeal program, the opportunity to avoid an appeal altogether may be worth the additional costs.

The AFCP 2.0 program has also received mixed reviews. Under the AFCP 2.0 program, an examiner is afforded additional time to search and/or consider an amendment submitted after a final rejection. The AFCP 2.0 request can be filed after a final rejection. There is no fee to participate, however an amendment must be made to at least one independent claim that does not broaden the scope of the independent claim in any aspect. Examiners are allotted up to three hours to consider the amendment and optionally to conduct an interview to discuss the amendments or to discuss new search results.

While the program is aimed at reducing the number of requests for continued examination filed, it seems most examiners continue to require an RCE in order to have an after-final amendment

considered. When asked whether the AFCP 2.0 will provide enough time to consider the amendment, examiners often claim that it will not. This may be due to the count system, which incentivizes an examiner to require an RCE as more counts are granted with the filing of an RCE as opposed to issuing an allowance in an application after a final rejection. Unfortunately, the examiner has sole discretion to decide whether the after-final amendment can be considered within the time allotted, and thus an examiner can choose to decline the AFCP 2.0 request and the applicant has no recourse. Regardless, applicants should always consider filing an AFCP 2.0 request with any amendment submitted in response to a final office action, since there is no cost to participate in the program and it at least provides the examiner with an option to consider the amendment and potentially allow the application after final.

While the new P3 program is said to combine the best features of the Pre-Appeal and AFCP 2.0 programs, many practitioners are skeptical that the combined program will simply suffer from the same aforementioned drawbacks. Under the P3 program, applicants can request that a panel of examiner's formally review the pending rejections before a notice of appeal is filed. The request must be filed within two months of the mailing date of the final office action, and it must include the P3 transmittal request form filed via EFS-Web, a response consisting of no more than five pages of argument, and a statement that the applicant is willing and available to participate in a conference with the panel of examiners. Unlike the Pre-Appeal program, which requires the filing of a notice of appeal and payment of the fee, under the P3 pilot the filing of a notice of appeal will terminate the P3 request. An amendment is also optional under the P3 program, unlike the AFCP 2.0 program where a nonbroadening amendment to at least one independent claim is required. Examiners are allotted a total of three hours under the P3 program where no amendments are made. Additional time will be given where amendments are submitted.

One difference that could lead to a higher success rate is that under the new P3 program, applicants are required to participate in a 20-minute conference with the review panel. Angela Sykes, USPTO director of Technology Center 3700, discussed the P3 program at a Technology Center 3600 and 3700 Customer Partnership Meeting on July 13, 2016. According to Director Sykes, the applicant or applicant's representative will be allotted 20 minutes to present to the panel. The panel may ask questions, however the applicant or applicant's representative will not be allowed to ask questions of the panel. The conference will thus be more similar to oral arguments, rather than an interview in which the applicant and the examiner engage in a discussion. The conference can be conducted in person, by telephone, or using video conferencing. Information on conducting video conferences can be found on the **USPTO website**. After the presentation, the applicant/applicant's representatives will leave the room, and the panel will discuss the merits of the case and make a decision as to patentability.

The incorporation of a brief oral presentation into the P3 process could be the distinguishing factor that renders the P3 program a success, as compared to the Pre-Appeal and AFCP 2.0 programs. Unlike the AFCP 2.0 and the Pre-Appeal programs, the P3 program allows applicants or their representatives to present oral arguments to the entire panel. At the very least, the P3 program provides some hope for applicants wishing to avoid a costly appeal.

To the extent applicants choose to utilize the new P3 program, they must bear in mind certain limits that the USPTO has placed on the program. In particular, the P3 program cannot be used in applications where a Pre-Appeal or AFCP 2.0 request was previously filed. Moreover, each individual technology center at the USPTO will accept no more than 200 compliant requests. A counter by technology center has been added to the **USPTO website** to indicate the number of P3 requests filed by technology center.

—By Lisa Adams, Mintz Levin Cohn Ferris Glovsky and Popeo PC

*Lisa Adams is a member in Mintz Levin's Boston office.*

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