

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

uspto

Patent Public Advisory Committee Quarterly Meeting

Post Prosecution Pilot

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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

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

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 AfterFinalPractice@uspto.gov

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)

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

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 non-compliant;
 - 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.

P3 Pilot Process

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

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

C. Reopen Prosecution

All of the above outcomes will include an Explanation of Decision

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

For More Information on P3

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

Questions and Comments

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