



# An Applicant's Perspective: Options for After-Final Practice

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# Overview

## Compact Prosecution and After-Final Practice

- Quick Path IDS (QPIDS)
- After Final Consideration Pilot 2.0 (AFCP 2.0)
- Post-Prosecution Pilot (P3)
- Pre-Appeal Request for Review

# Overview

## Sample Set

- Nearly 4500 events spanning the last five years
- Applications contained at least one event from the investigated list
- ~25% remain pending

# QPIDS

## Summary

### Effective Date:

- May 16, 2012

### Eligibility:

- Post Payment of Issue Fee

### Background:

- Duty of candor and the duty of disclosure, applies through to grant
- Rules do not permit submission of IDS post-payment of issue fee
- Consideration of IDS requires withdrawal from issuance and filing of RCE
- QPIDS permits submission of certain IDS following payment of issue fee

# QPIDS

## Requirements

- Transmittal form designating the submission as a QPIDS submission
- IDS with Fee
  - Payment via Deposit Account
- Certification statement under 1.97(e)(1) or 1.97(e)(2)
- ePetition to Withdraw from Issuance with Petition Fee
- RCE with Fee

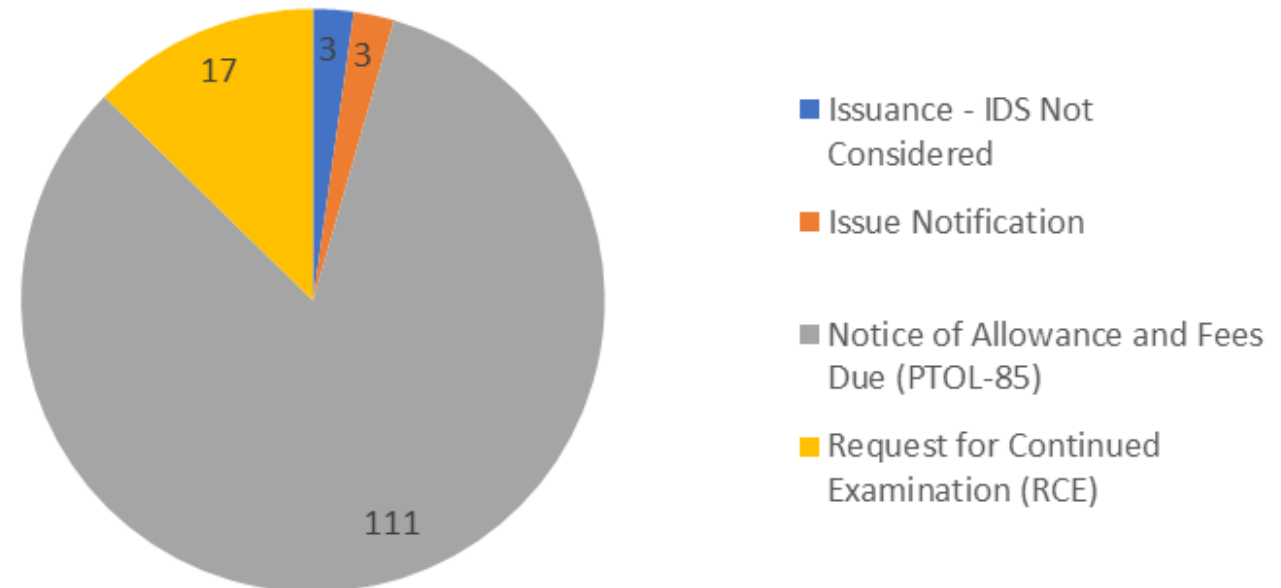
# QPIDS

## Five Year Statistics

Success Rate: 85%

Event	Count	Pct
Issuance - IDS Not Considered	3	2%
Issue Notification	3	2%
Notice of Allowance and Fees Due (PTOL-85)	111	83%
Request for Continued Examination (RCE)	17	13%
Grand Total	134	100%

QPIDS Outcome



# AFCP 2.0

## Summary

### Effective Date:

- May 19, 2013, extended through September 30, 2017

### Eligibility:

- After Final Rejection

### Background:

- After-Final amendments are not entered as of right
- Entry of amendments after final may require additional search
- Reduce the number of Requests for Continued Examination (RCE) and encourage increased collaboration between the applicant and the examiner to effectively advance the prosecution of the application

# AFCP 2.0

## Requirements

- Transmittal form requesting consideration under AFCP 2.0
- After-Final response with narrowing amendment to rejected independent claim
- A statement that the applicant is willing and available to participate in any interview initiated by the examiner concerning the accompanying response

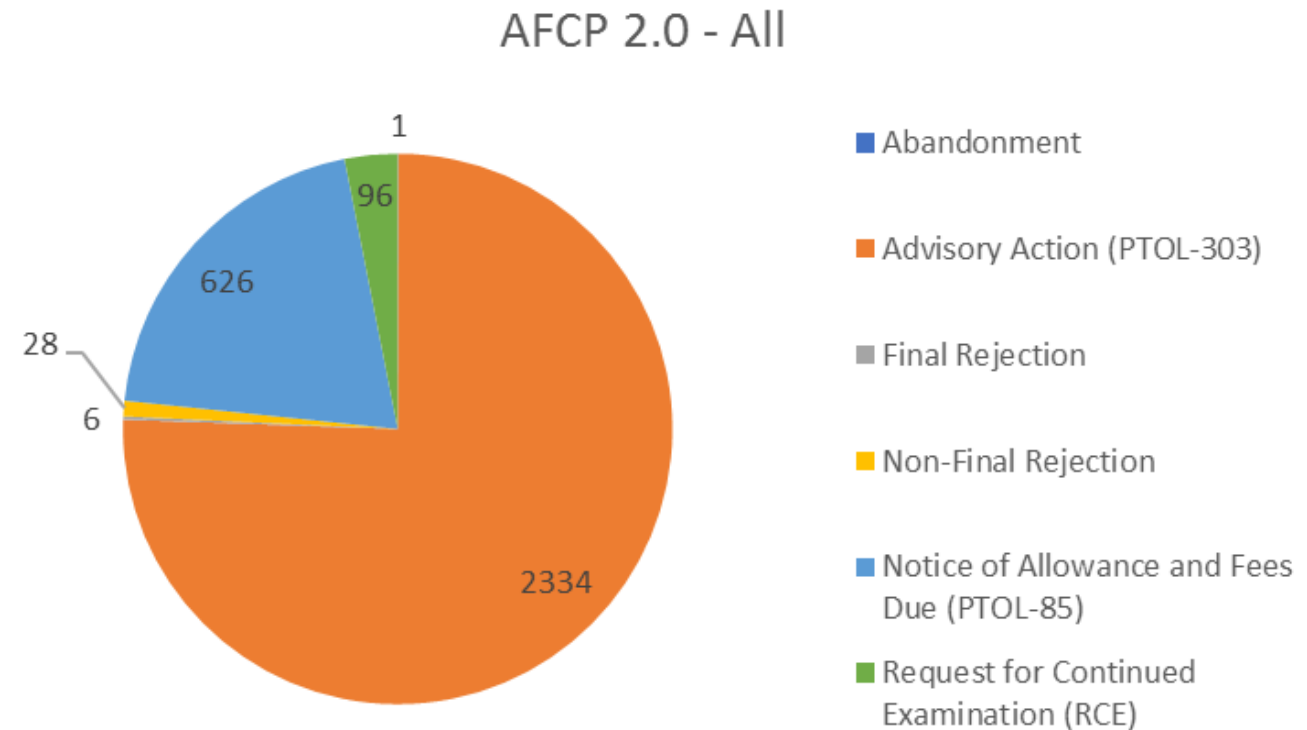


# AFCP 2.0

## Five Year Statistics

Success Rate: 21%

Event	Count	Pct
Advisory Action (PTOL-303)	2334	76%
Abandonment	1	0%
Final Rejection	6	0%
Non-Final Rejection	28	1%
Notice of Allowance and Fees Due (PTOL-85)	626	20%
Request for Continued Examination (RCE)	96	3%
Grand Total	3091	100%

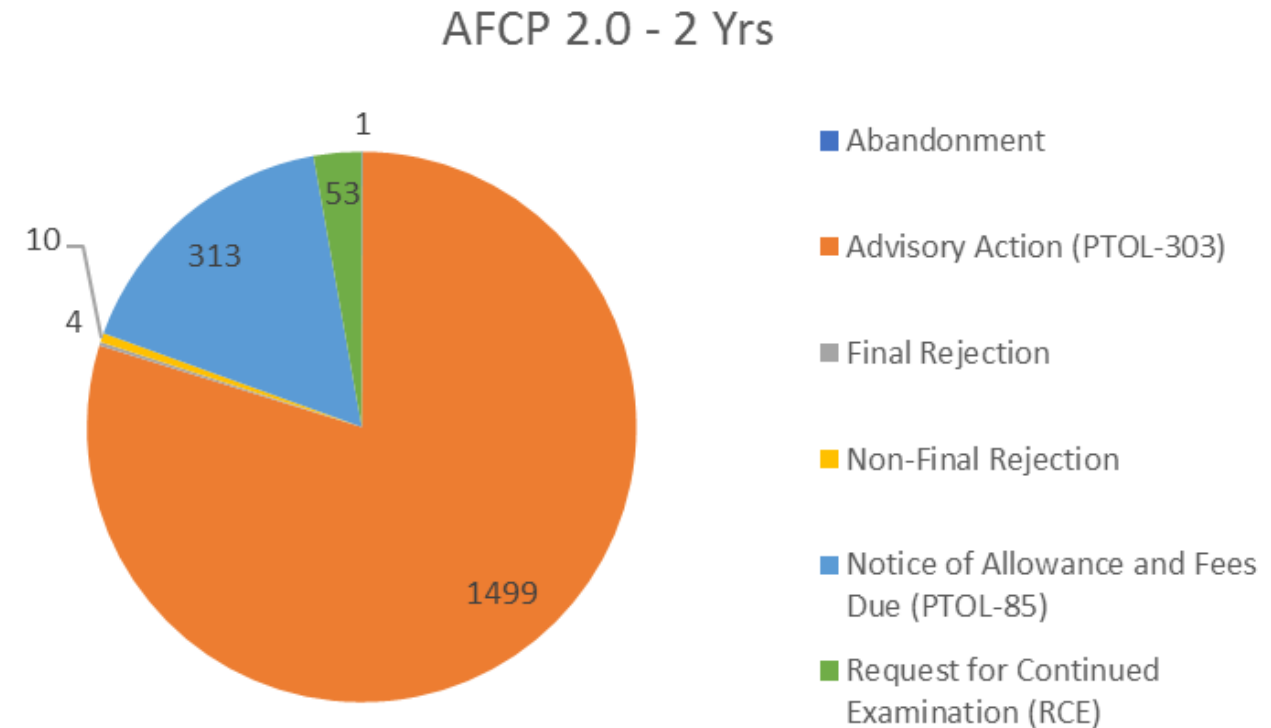


# AFCP 2.0

## Two Year Statistics

Success Rate: 17%

Event	Count	Pct
Abandonment	1	0%
Advisory Action (PTOL-303)	1499	80%
Final Rejection	4	0%
Non-Final Rejection	10	1%
Notice of Allowance and Fees Due (PTOL-85)	313	17%
Request for Continued Examination (RCE)	53	3%
Grand Total	1880	100%

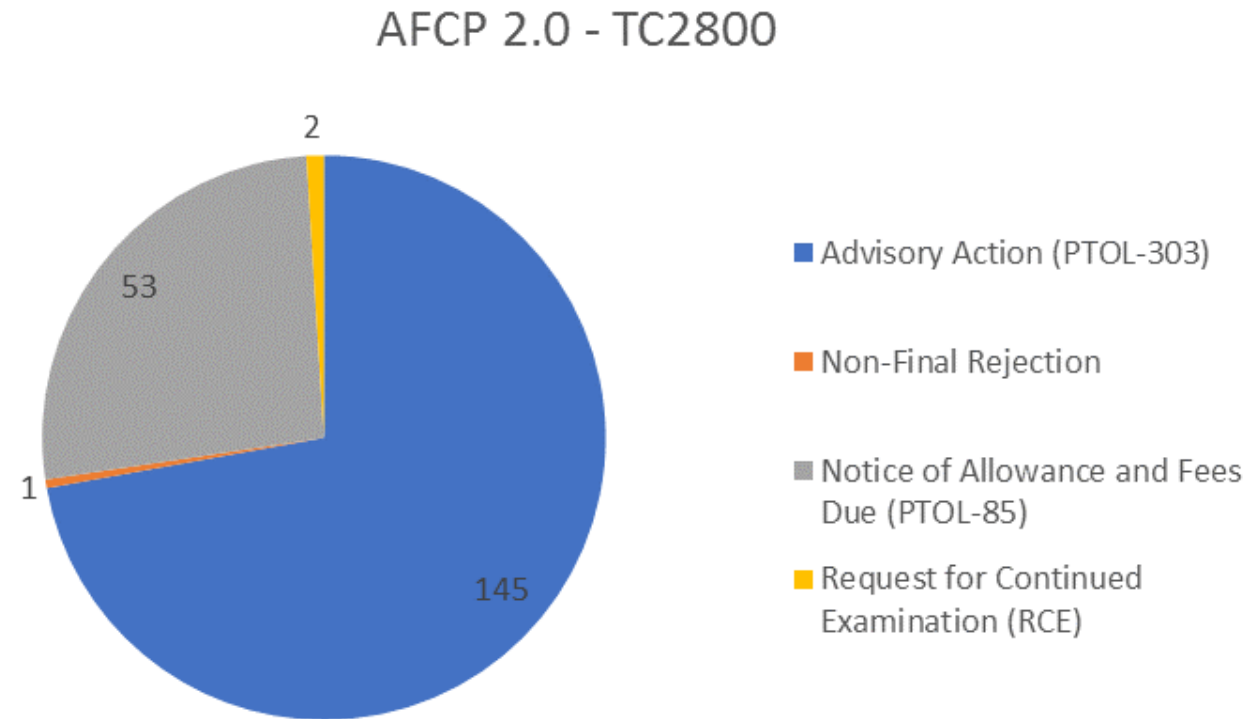


# AFCP 2.0

## Five Year TC2800 Statistics

Success Rate: 27%

Event	Count	Pct
Advisory Action (PTOL-303)	145	72%
Non-Final Rejection	1	0%
Notice of Allowance and Fees Due (PTOL-85)	53	26%
Request for Continued Examination (RCE)	2	1%
Grand Total	201	100%



# Pre-Appeal Request For Review

## Summary

### Effective Date:

- July 12, 2005, extended until further notice

### Eligibility:

- At time of filing of Notice of Appeal

### Background:

- Appeal process is lengthy and costly for both the applicant and the USPTO
- Program offers applicants an opportunity to request a review of matters on appeal by panel of experienced prior to the filing of an appeal brief
  - Based upon a clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings

# Pre-Appeal Request For Review

## Requirements

- File a Notice of Appeal
- File a request and accompanying arguments in a separate paper entitled, “Pre-Appeal Brief Request for Review”
  - Arguments may not exceed 5 pages
  - May not include amendments
  - Must be filed prior to filing of Appeal Brief

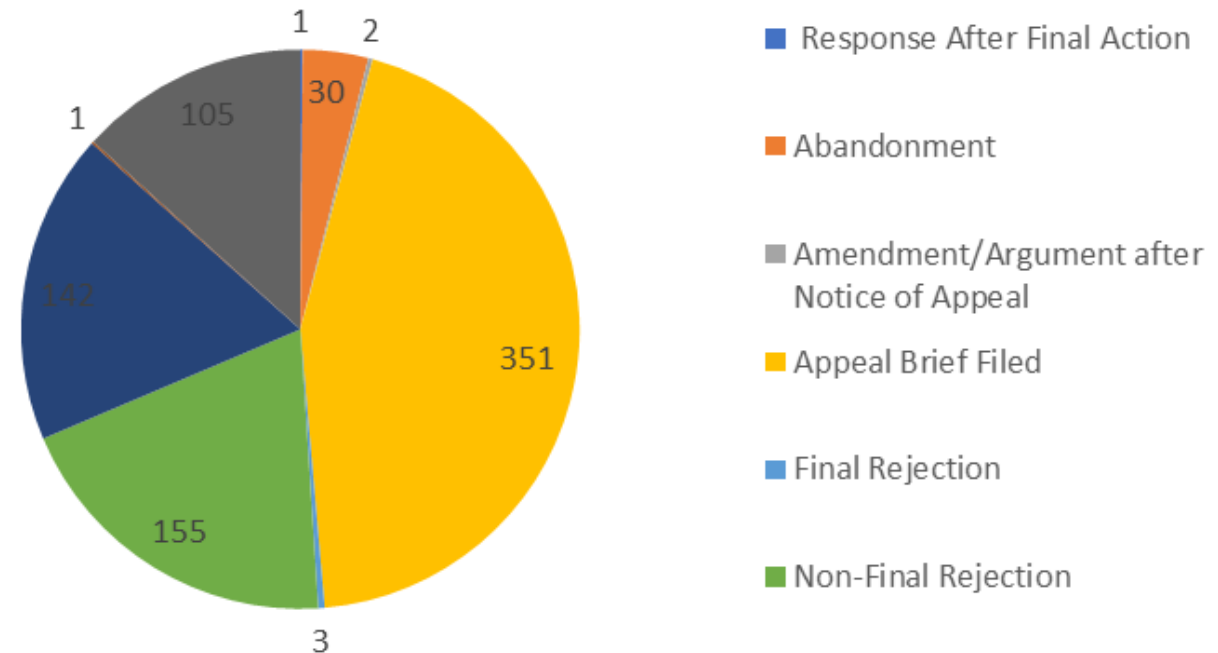
# Pre-Appeal Request For Review

## Five Year Statistics

Success Rate: 38%

Event	Count	Pct
Response After Final Action	1	0%
Abandonment	30	4%
Amendment/Argument after Notice of Appeal	2	0%
Appeal Brief Filed	351	44%
Final Rejection	3	0%
Non-Final Rejection	155	20%
Notice of Allowance and Fees Due (PTOL-85)	142	18%
Notice-Defective Pre-Brief Appeal	1	0%
Request for Continued Examination (RCE)	105	13%
Grand Total	790	100%

Pre-Appeal Brief Conference Outcomes - All



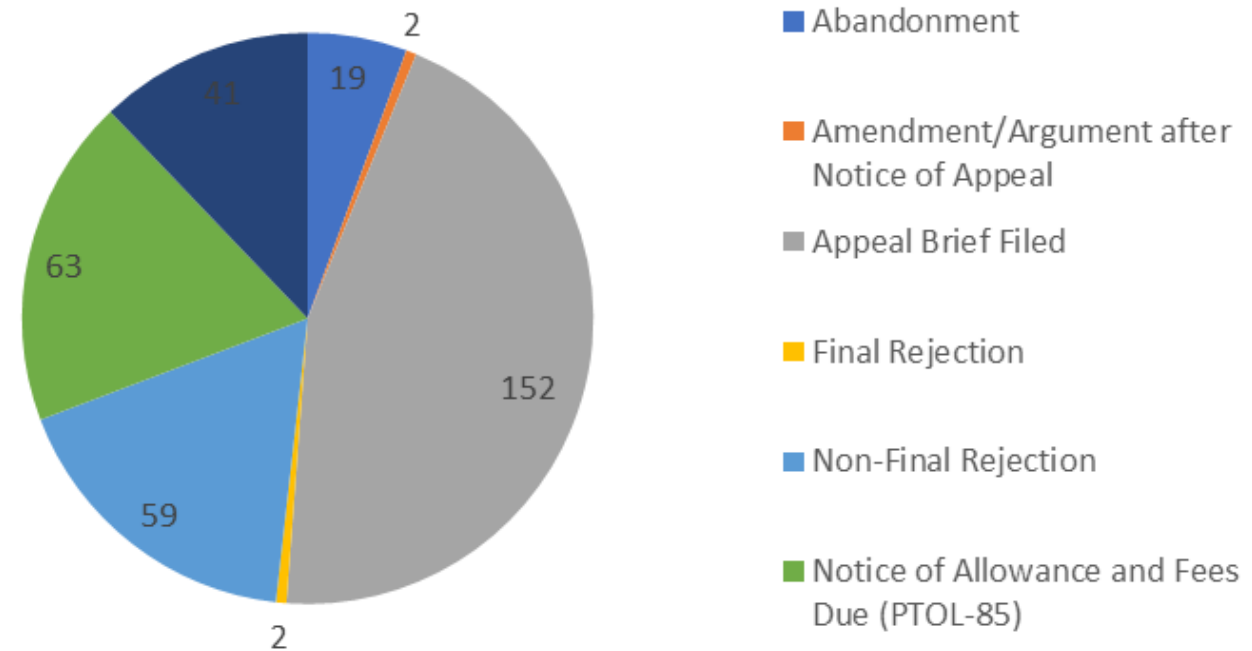
# Pre-Appeal Request For Review

## Two Year Statistics

Success Rate: 36%

Event	Count	Pct
Abandonment	19	6%
Amendment/Argument after Notice of Appeal	2	1%
Appeal Brief Filed	152	45%
Final Rejection	2	1%
Non-Final Rejection	59	17%
Notice of Allowance and Fees Due (PTOL-85)	63	19%
Request for Continued Examination (RCE)	41	12%
Grand Total	338	100%

Pre-Appeal Brief Conference Outcomes - 2 Yrs



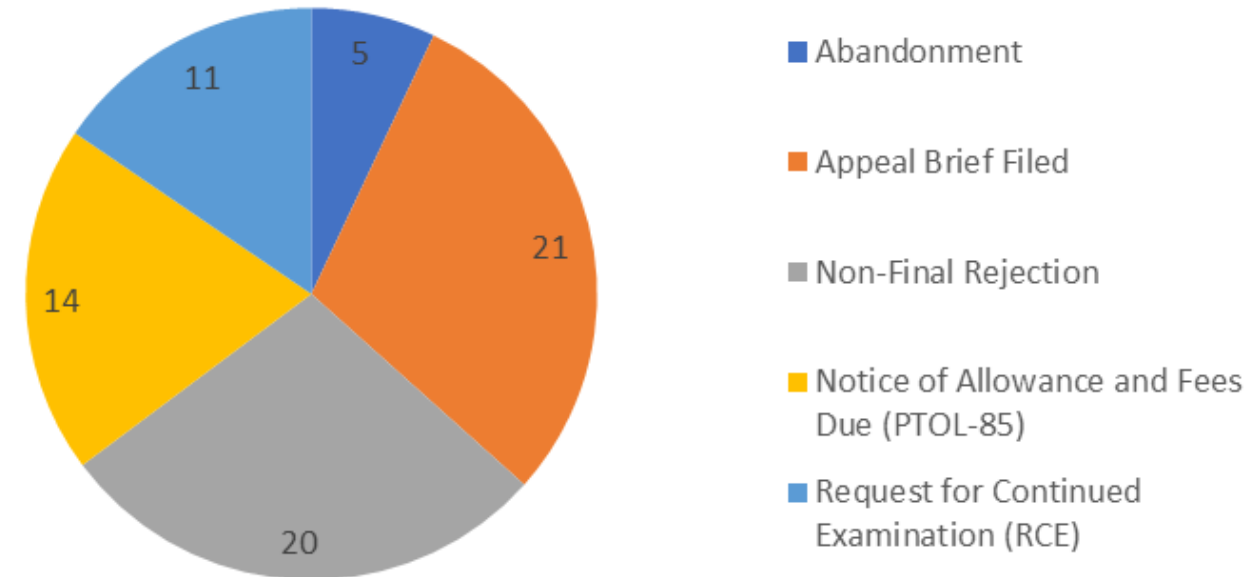
# Pre-Appeal Request For Review

## Five Year TC2800 Statistics

Success Rate: 48%

Pre-Appeal Brief Conference - TC2800

Event	Count	Pct
Abandonment	5	7%
Appeal Brief Filed	21	30%
Non-Final Rejection	20	28%
Notice of Allowance and Fees Due (PTOL-85)	14	20%
Request for Continued Examination (RCE)	11	15%
Grand Total	71	100%





# Post-Prosecution Pilot (P3)

## Summary

### Effective Date:

- July 11, 2016 until January 12, 2017 or once the technology center has accepted 200 compliant requests

### Eligibility:

- After Final, but prior to filing a Notice of Appeal

### Background:

- Applicants may submit amendments for consideration after Final under AFCP 2.0
- Applicants may have a panel review the basis of an Examiner's rejections prior to filing an Appeal Brief by filing a Pre-Appeal Brief Request for Review
- P3 program combines the two opportunities with an opportunity for Applicant participation in the conference
- Reduce the number of appeals and reduce the number of RCEs

# P3

## Requirements

- Transmittal form requesting P3
  - Within two-months from the mailing date of a Final rejection and prior to filing a Notice of Appeal
  - Include a statement that the applicant is willing and available to participate in the conference with the panel of examiners
- Response After Final with no greater than 5 pages of argument
- Optionally include non-broadening amendments

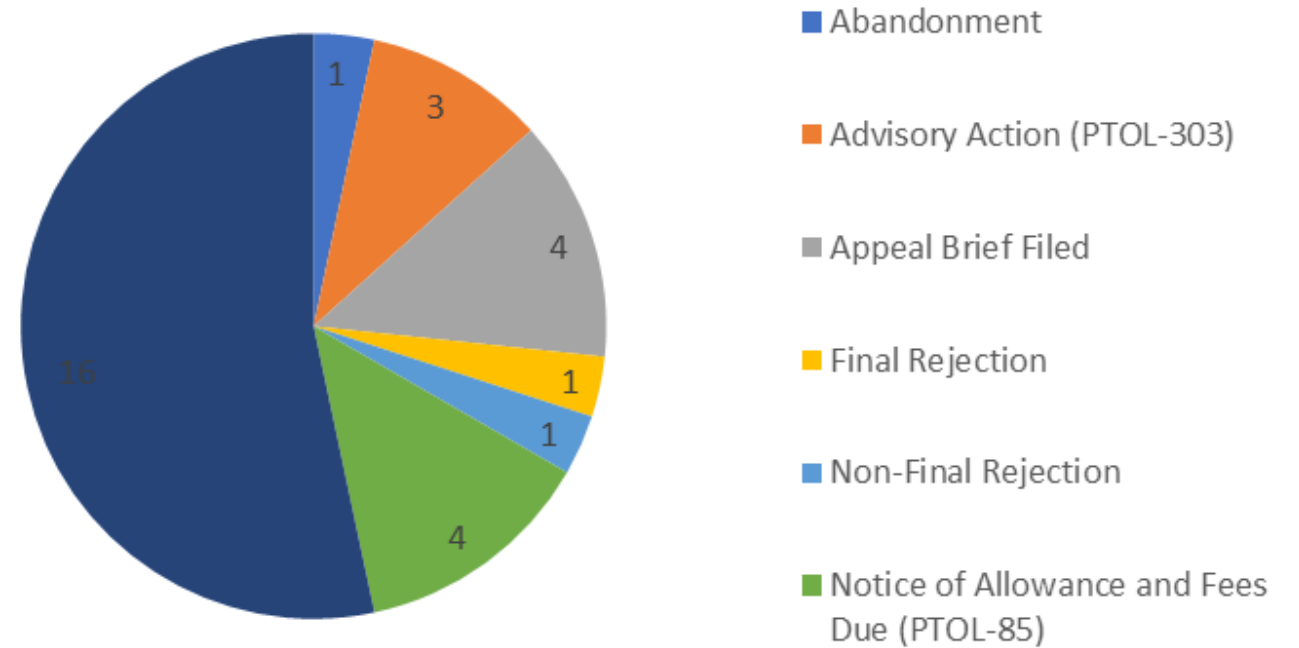
# P3

## Statistics

Success Rate: 20%

Event	Count	Pct
Abandonment	1	3%
Advisory Action (PTOL-303)	3	10%
Appeal Brief Filed	4	13%
Final Rejection	1	3%
Non-Final Rejection	1	3%
Notice of Allowance and Fees Due (PTOL-85)	4	13%
Request for Continued Examination (RCE)	16	53%
Grand Total	30	100%

P3 Outcome



# Conclusion

- USPTO provides numerous options for efficiently prosecuting applications
- Each of the options provides a significant opportunity for reducing pendency and associated prosecution costs
- Rates of success experienced in sample set warrant ongoing consideration of each option at the appropriate stage of prosecution

# Thank you

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