

1. How long will the Pilot run?

The Pilot Program will run for six (6) months from its effective date or until the USPTO accepts 1,600 proper requests, whichever occurs first.

2. What can applicant include as part of their submission?

The submission must contain no more than five (5) pages of arguments/evidence and may additionally contain proposed non-broadening claim amendments.

3. What if the non-broadening claim amendments are extensive or directed to limitations not previously considered which clearly raise issues requiring new consideration and/or rejections?

There is no right of entry of the after final amendment. The examiner will review the proposed amendment to the extent possible in the limited time provided to the examiner by this Pilot. Whether to enter the amendment or not will proceed under 1.116 practice. The examiner will indicate whether the amendment is to be entered and provide the necessary comments in the Notice of the Decision from P3 conference (PTO-2324 form).

4. Who is responsible for scheduling the conference?

The SPE, assisted by the examiner of record, will schedule the conference with applicant and a mutually agreed additional panel member, having primary examiner signatory authority.

5. Who are the required participants in the P3 Conference?

The applicant, the examiner of record, the SPE and a third primary examiner. If the examiner of record is a junior examiner, the signing primary examiner may optionally attend. If applicant is unable to participate in the conference, the P3 request is considered non-compliant and no conference will be held.

6. What can applicant present in the conference?

The applicant, or representative, will have the opportunity to present arguments to the panel, limited to 20 minutes. Arguments may be directed to the outstanding record (including evidence previously entered; as outlined in MPEP § 1209), or, if proposed amended claim(s) are presented, arguments may be directed to patentability of the amended claim(s).

7. What may be discussed during the conference?

Applicant may present arguments directed to the outstanding record and, if an amendment is proposed, to the patentability of the amended claim(s). Applicant will present to the panel of examiners in a manner similar to how an applicant presents an argument in an ex parte appeal before the PTAB.

8. If the request is received and accepted into the pilot, can the conference be held after the end of the pilot?

Yes. The request must be received and accepted before the pilot ends or the 1,600 cases limit is reached. Conferences may be scheduled after that time.

9. What are the possible P3 outcomes that would be communicated to applicant?

Possible outcomes are that the application is allowable, that the final rejection is upheld, or that prosecution is reopened.

10. What if an examiner receives a proper and accepted P3 request and determines, during preparation prior to the panel conference, that the application is allowable?

If an examiner determines during preparation prior to the panel conference that the application is allowable, the examiner should contact the attorney indicating that the application is in condition for allowance and query whether or not the attorney would still like to participate in the panel.

11. Can applicants file an after final amendment or Pre-Appeal request following a proper and accepted P3 request?

No. There will be a limit of one accepted request per outstanding final rejection (i.e. prior to filing of an RCE). If the panel decision is to uphold the final rejection, applicant's options will be limited to filing an Appeal Brief, abandonment or filing an RCE. Applicant's options do not include re-entry into current 37 C.F.R 1.116 practice.

12. What if applicant files an AFCP 2.0, Pre-Appeal request or an after final response under 1.116 after the filing and acceptance of a P3 request?

If the AFCP 2.0, Pre-Appeal request or any other after final amendment is filed after the filing and acceptance of a P3 request, an Advisory Action will be mailed indicating that the AFCP 2.0, Pre-Appeal or any other after final amendment under 1.116 is not being considered since applicants have participated in the P3 pilot.

13. What type of training will be available to examiners?

Just-in-time training will be available to examiners and will include training slides, a Quick Reference Guide and FAQs. Once the Pilot starts, training will be provided both in-person and via WebEx. Training materials and other P3-related documents are available on the P3 website (coming soon).