Patent Quality Chat
Using Petitions Effectively in Patent Prosecution

August 8, 2017
To send in questions or comments during the webinar, please email:

PatentQuality@uspto.gov
Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to our mission at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the Office of the Deputy Commissioner for Patent Quality, along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

Highlights

Patent Quality Chat
Tune into our next webinar on Tuesday, July 11, from noon - 1 p.m. ET on "Latest Updates in USPTO's Work Sharing Efforts".

Quality Metrics
See our new metrics approach, categorizing into product, process and perception indicators.

Stakeholder Training on Examination Practice and Procedure (STEPP)
Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.

Areas of Focus
Collaboration with our stakeholders has directed our focus within three areas, where we can best improve patent quality.

Email questions to PatentQuality@uspto.gov
### 2017 Chat Series

<table>
<thead>
<tr>
<th>Date</th>
<th>Topic</th>
<th>Speaker</th>
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</table>
| Tuesday, August 8, Noon-1 p.m. ET | Using Petitions Effectively in Patent Prosecution  
- Presentation Slides (coming soon)  
- Video (coming soon) | • Charles Kim  
Director, Office of Petitions  
• Namrata Boveja  
Acting Deputy Director, Office of Petitions |
| Tuesday, July 11, Noon-1 p.m. ET | Latest Updates in USPTO’s Work Sharing Efforts  
- Presentation Slides  
- Video | • Mark Powell  
Deputy Commissioner for International Patent Cooperation  
• Daniel Hunter  
Director for International Work Sharing, Planning and Implementation, Office of International Patent Cooperation |
| Tuesday, June 13, Noon-1 p.m. ET | Patent Quality Metrics  
- Presentation Slides  
- Video | • Greg Vidovich  
Associate Commissioner for Patent Quality  
• Jim Dwyer  
Director, Office of Patent Quality Assurance |
| Tuesday, May 9, Noon-1 p.m. ET | eCommerce Modernization (eMod) Update  
- Presentation Slides  
- Video | • Lisa Tran  
Communications Manager for eCommerce  
• Richard Fernandez  
eMod Project Manager |

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Patent Quality Chat
Using Petitions Effectively in Patent Prosecution

Charles Kim
Director, Office of Petitions

Namrata Boveja
Acting Deputy Director, Office of Petitions

Email questions to PatentQuality@uspto.gov
Office of Petitions

• Central repository for deciding most petitions, including those signed by the Commissioner or other top USPTO officials.

• Reviews and decides:
  – Over 45 types of petitions (see MPEP 1002.02(b))
  – Approximately 50,000 petitions per year

• Petitions Help Desk

• Inventor’s Assistance Center (IAC)

Email questions to PatentQuality@uspto.gov
Patents Petitions Timeline

Prior to Examination
- Abandonment Related
- Access
- Advancement of Examination
- Application Publications
- Assignee Related
- Conversion of Applications
- Correction of Inventorship
- Entity Status
- Expunging Papers
- Extensions of Time
- Filing Date Related
- Foreign Priority or Domestic Benefit Related
- General and Misc
- Public Use Related
- Retroactive Foreign Filing Licenses
- Specifically Related to International Applications
- Suspension or Waiver of Rules (not provided for in any statute)
- Withdrawal of Attorney Related

During Examination
- Abandonment Related
- Access
- Advancement of Examination
- Application Publications
- Assignee Related
- Conversion of Applications
- Correction of Inventorship

Email questions to PatentQuality@uspto.gov
**Patents Petitions Timeline (Cont.)**

Abandonment Related Petitions

**Generally Available**

<table>
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<tr>
<th>Petition Type</th>
<th>Avg. Days Pending of Decided Petitions</th>
<th>Grant Rate Percentage</th>
<th>Deciding Office</th>
<th>ePetition Option</th>
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<tbody>
<tr>
<td>502 - To Revive an Abandoned Application - Unintentional Delay (37 CFR 1.137(e))</td>
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<td>OPET</td>
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<td>525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - Failure to receive an Office Action</td>
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<td>525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - Reply Timely Filed</td>
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<td>536 - Under 37 CFR 1.137(f)</td>
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<td>561 - Revive Abandoned Application, Continuity Purposes Only</td>
<td>72</td>
<td>98%</td>
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</tbody>
</table>

Email questions to **PatentQuality@uspto.gov**
Overview
An ePetition is filed and immediately processed online through EFS-Web if all filing requirements are met. The USPTO offers 12 web-based ePetitions and two PDF-based ePetitions.

Email questions to PatentQuality@uspto.gov
ePetitions Benefits

- Save Time
  Faster Petition Processing
  Filing an ePetition allows petitioners to directly input the requisite filing information into a secure Web interface and immediately receive an ePetition grant. Petitioners save time by avoiding delays associated with manually-processed petitions.

- Auto-Granting
  Immediate Petition Grant upon Submission
  Submitted ePetitions are auto-processed and immediately granted upon submission if all requirements are met. The auto-granting of submitted ePetitions is advantageous for time-sensitive petitions.

- Instant Feedback
  Instant Feedback on Requirements
  Feedback is immediately provided throughout the ePetition filing process to assist petitioners in meeting all filing requirements necessary for compliance with petition rules and to assure that fees will not be collected by the Office until the petition is acceptable for submission and grant.

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ePetitions: Get Immediate Decisions

Web-based ePetitions:

- Petitions for Revival
  - Petition to Accept Late Payment of Issue Fee - Unintentional Late Payment (37 CFR 1.137(a))
  - Petition for Revival of an Application based on Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))
  - Petition for Revival of an Application for Continuity Purposes Only (37 CFR 1.137(a))
  - Petition for Revival of an Abandoned Patent Application Abandoned Unintentionally (37 CFR 1.137(a)) (For Cases Abandoned After 1st Action and Prior to Notice of Allowance)

- Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2))
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2)
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3))
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2) with Assigned Patent Number)
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3) with Assigned Patent Number)

- Petition to Accept Unintentional Delayed Payment of the Maintenance Fee (37 CFR 1.378(b))

- Petition to Make Special Based on Age (37 CFR 1.102)

- Request for Withdrawal as Attorney or Agent of Record (37 CFR 1.36)

- Petition to Correct Assignee After Payment of Issue Fee (37 CFR 3.81(b))

Email questions to PatentQuality@uspto.gov
ePetitions Resource Page

The ePetitions Resource Page provides useful information and guidance regarding the submission, automatic processing, and immediate grant of ePetitions.

- **Secure Filing with Auto-Grant.** Filing an ePetition via EFS-Web automates the petition process and allows petitioners to directly input the requisite information into a secure Web interface and immediately receive an ePetition decision.
- **Saves Time when Immediate Petition Decisions are Important.** Time savings using ePetitions is especially advantageous for critical petitions where an automatic petition grant would reduce delays in restoration of patent rights, expedite withdrawal from representation and redirect Office correspondence to the new correspondence address, and initiate the revival of an abandoned application to save patent term adjustment time.
- **Increased accuracy** by providing immediate feedback to petitioners on the necessary filing requirements.
- **Current statistics** regarding the pendency and grant rate comparisons between filing an ePetition and non-ePetition are available on our Dashboard.

For questions regarding Patent e-Filing, or to suggest improvements to the online system, please send an email to **ePC@uspto.gov** or call the Patent Electronic Business Center at **1-866-217-9197** (toll free) or **571-272-4100** from 6 a.m. to 12 Midnight Eastern Time, Monday - Friday.

**ePetitions Computer Based Training (CBT)**

The CBT provides an overview of ePetitions and includes a step-by-step demonstration that illustrates how quick and easy it is to submit the Request for Withdrawal as Attorney or Agent of Record (37 CFR 1.36) via ePetition.

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Data Visualization Center

Email questions to PatentQuality@uspto.gov
# Frequently Filed Petitions

Email questions to PatentQuality@uspto.gov

## Frequently Filed Petitions in the Office of Petitions

<table>
<thead>
<tr>
<th>Petition Type</th>
<th>Avg Days Pending of Decided Petitions in the Past 12 Months</th>
<th>Grant Rate Percent of Total Petitions Decided in the Past 12 Months</th>
</tr>
</thead>
<tbody>
<tr>
<td>To Make Entity Status Large from Small</td>
<td>127</td>
<td>49%</td>
</tr>
<tr>
<td>To Join Track One (Prioritized Examination)</td>
<td>40</td>
<td>94%</td>
</tr>
<tr>
<td>To Join Patent Prosecution Highway (PPH)</td>
<td>75</td>
<td>79%</td>
</tr>
<tr>
<td>To Make Application Special on Grounds of Age or Health</td>
<td>69</td>
<td>93%</td>
</tr>
<tr>
<td>Revival Based on Unintentional Delay in Abandoned Application</td>
<td>166</td>
<td>78%</td>
</tr>
<tr>
<td>To Accept Unintentionally Delayed Claim for Priority</td>
<td>149</td>
<td>66%</td>
</tr>
<tr>
<td>Withdrawal of Attorney From Application</td>
<td>172</td>
<td>32%</td>
</tr>
<tr>
<td>Issue Patent in the Name of Assignee After the Issue fee is Paid</td>
<td>194</td>
<td>85%</td>
</tr>
<tr>
<td>To Accept Unintentional Delayed Payment of the Maintenance Fee</td>
<td>183</td>
<td>74%</td>
</tr>
<tr>
<td>Patent Term Adjustment After Patent Issued</td>
<td>226</td>
<td>52%</td>
</tr>
</tbody>
</table>
### E-Petitions and Non E-Petitions Data

**Petition Type** | **Total E-Petitions Decided/Filed in Past 12 Months** | **Average Days Pending of E-Petitions** | **Grant Rate Percent of Total E-Petitions Decided in the Past 12 Months** | **Total Non-E-Petitions Decided in the Past 12 Months** | **Average Days Pending of Non-E-Petitions Decided in the Past 12 Months** | **Grant Rate Percent of Total Non-E-Petitions Decided in the Past 12 Months**
--- | --- | --- | --- | --- | --- | ---
To Make Application Special on Grounds of Age or Health | 1,666 | 0 | 100% | 1,427 | 69 | 93%
Revive Abandoned Application for Failure to Notify the USPTO of Foreign Filing | 1068 | 0 | 100% | 5,981 | 166 | 78%
Revive Patent Application for Continuity Purposes Only When Abandoned Unintentionally | 109 | 0 | 100% | 61 | 165 | 77%
Withdrawal of Attorney From Application | 91 | 0 | 100% | 81 | 128 | 94%
Withdraw Application From Issue After Issue Fee is Paid | 1,711 | 0 | 100% | 1910 | 172 | 32%
Revive Patent Application for Unintentional Late Payment of the Issue Fee | 2,262 | 0 | 100% | 194 | 6 | 84%
Withdraw From Issue Patent Application With Patent Number Assigned | 642 | 0 | 100% | 2025 | 349 | 75%
Withdraw Patent Application From Issue to Expressly Abandon | 2,974 | 0 | 100% | 258 | 3 | 90%
Withdraw Patent Application From Issue In the Name of Assignee 163 | 17 | 0 | 100% | 15 | 26 | 67%
After the Issue Fee is Paid | 6 | 0 | 100% | 519 | 194 | 85%
To Accept Unintentional Delayed Payment of the Maintenance Fee | 1,587 | 0 | 100% | 861 | 183 | 74%

Email questions to **PatentQuality@uspto.gov**
Helpful Tips
Helpful Tips: Document Codes

Document Codes

• Petitions that are filed without the proper document code can result in delays in processing the petition
  – Use of ‘letter’ or ‘miscellaneous’ codes can cause delays unless someone reviews and identifies these papers as a petition and notifies the appropriate office of the petition
  – “PET.OP” is the most frequently used document code for most petitions handled by the Office of Petitions

Email questions to PatentQuality@uspto.gov
Helpful Tips: Petitions are NOT a Response

Reminder: Petitions Are Not A Response To An Office Action

• Petitions do not stop the time running against an applicant for filing a response to an Office action.

• Even if applicant is asking for review of the decision by the Office of Petitions, a response must be filed before the period for reply expires or the application will become abandoned.

Email questions to PatentQuality@uspto.gov
Helpful Tips: To Avoid Abandonment

Avoid Abandonment

• **Terminal Disclaimers including eTerminal Disclaimers**
  – If the only remaining rejection in an Office action is an obviousness-type rejection, a complete response is either a reply by the applicant showing that the claims subject to the rejection are patentably distinct from the reference claims or filing of a terminal disclaimer in accordance with 37 CFR 1.321 in the pending application(s) with a reply to the Office action
  – Filing a terminal disclaimer by itself does not obviate the need to respond under 37 CFR 1.111

• **Notice of Allowance**
  – Should review it carefully to ensure there are no outstanding requirements
  – For example, if the box is checked on the Notice of Allowance form indicating that corrected drawings (as “replacement sheets”) must be submitted, the Applicant needs to send in a response

Email questions to PatentQuality@uspto.gov
Helpful Tips: To Avoid Abandonment (Cont.)

Avoid Abandonment

• Interview Summaries
  – All business with the U.S. Patent and Trademark Office should be transacted in writing under 37 CFR 1.2
  – Verbal agreements do not constitute a formal response
  – For example, if an examiner indicates a new Office action will be mailed out or that the replacement drawings satisfy a previously raised objection in an interview, this needs to be indicated in writing in the record

• Notice to File Missing Parts
  – Common mistakes that lead to Notice to File Missing Parts
    • Specification Format - 37 CFR 1.52, 37 CFR 1.71-1.75, 1.77, and 1.121(b) & (c)
    • Drawing Format - 37 CFR 1.84 and 1.121(d)
    • Application Data Sheet (ADS) - 37 CFR 1.76
    • Signatures - 37 CFR 1.4
    • Micro Entity Certification - 37 CFR 1.29

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Helpful Tips: Notice to File Missing Parts

Mail date: Date Mailed: 01/28/2015

Response period: Items Required To Avoid Abandonment

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).
Helpful Tips: Last-Minute Filings

Last-Minute Filings

• Oath/Declaration
  – Applicant can now defer filing until the Notice of Allowance is issued. However, an application goes abandoned by law if an oath/declaration is not filed by the time the issue fee is paid
    • It may become difficult to obtain all the necessary signatures (e.g., inventor may refuse to sign)
    • May need to file a request to accept oath/declaration without all signatures

Email questions to PatentQuality@uspto.gov
Helpful Tips: Last-Minute Filings (Cont.)

Last-Minute Filings (Cont.)
- Benefit/Priority Claims
  - Ensure benefit/priority information is properly listed in the application data sheet (ADS)
  - Using Web-based/Corrected Web-based ADS can help ensure that benefit/priority information is correctly entered into the ADS and changes are properly marked-up
  - Promptly review the filing receipt to verify accuracy of benefit/priority information
  - Avoid petitions for unintentionally delayed benefit/priority claims, which can be costly and can cause prosecution delays

Email questions to PatentQuality@uspto.gov
Helpful Tips: Filing Receipt Example

Domestic Benefit Data

Foreign Priority Data

Email questions to PatentQuality@uspto.gov
Helpful Tips: Petition Submission

Getting your Petition to the Office of Petitions

- ePetition -
- EFS-Web
- Mail to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- Central Fax – (571) 273-8300
- Deliver to Customer Service Window at Randolph Building
- ONLY FOR PETITIONS TO WITHDRAW FROM ISSUE (in addition to the options listed above, you have the option to)
  - fax to (571) 273-0025 Office of Petitions
  - hand carry to security gate in Madison West lobby (600 Dulany Street, Alexandria, VA); guard will call Office of Petitions and a staff member will meet you in the lobby with log book and date stamp.


Email questions to PatentQuality@uspto.gov
Helpful Hints: Call Centers

- Office of Petitions Help Desk
  (571) 272-3282
- Inventor Assistance Center (IAC)
  1–800 –786 –9199 OR (571) 272 - 1000
- IPLA (PCT Legal) Help Desk
  (571) 272-4300
- Pro Se Assistance
  (1866) 767-3848
- Fee Assistance
  (1800) 786-9199
- Other Support Numbers
  [Link](http://www.uspto.gov/patent/contact-patents)

Email questions to PatentQuality@uspto.gov
Helpful Tips: Online Resources

- Petitions Timeline: https://www.uspto.gov/patents-application-process/petitions/timeline/patents-petitions-timeline
- Patents Dashboard: https://www.uspto.gov/dashboards/patents/main.dashxml
- Web-Based ADS: https://www.uspto.gov/patents/process/file/efs/guidance/WebADS_QSG.pdf
- ADS Information Page: https://www.uspto.gov/patent/forms/important-information-completing-application-data-sheet-ads
- Patent Form Finder: https://my.uspto.gov/patent-form-finder

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Let’s Chat about
Using Petitions Effectively in Patent Prosecution

Charles Kim  
Director, Office of Petitions

Namrata Boveja  
Acting Deputy Director, Office of Petitions

Email questions to PatentQuality@uspto.gov
Next Patent Quality Chat
Patents Ombudsman Program and Pro Se Assistance Program

September 12, 2017
Other Patent Quality-Related Events
https://www.uspto.gov/about-us/events

<table>
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<tr>
<th>Date</th>
<th>Event Description</th>
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<tr>
<td>August 11-12</td>
<td>Invention-Con 2017</td>
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<td>August 17</td>
<td><strong>Inventor Info Chat</strong> “Office of Policy and International Affairs – Basic Overview of Copyright Law”</td>
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<td>August 22</td>
<td>Technology Center 2800 Semiconductor Customer Partnership Meeting</td>
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Thank you for joining us today!

Patent Quality Chat
Webinar Series 2017
August 8, 2017