



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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MEMORANDUM

DATE: October 25, 2023

TO: All Patent Office Professionals

FROM: Vaishali Udupa
Commissioner for Patents

SUBJECT: **Advance Notice of Change to MPEP § 706.07 and Form Paragraph 7.39.01**

To support access to the innovation ecosystem by all, the United States Patent and Trademark Office (USPTO) has collaborated with the Patent Trial and Appeal Board (PTAB) Bar Association to establish the PTAB Pro Bono Program which provides pro bono (free) legal services and advice for those who are under-resourced and considering an appeal. This advance notice will increase awareness of this valuable resource by changing the Ninth Edition, Revision 07.2022, of the Manual of Patent Examining Procedure (MPEP) to require examiners to notify pro se applicants of the PTAB Pro Bono Program in final rejections. Specifically, the paragraph in MPEP § 706.07 that occurs between the reproduction of form paragraphs 7.39 and 7.39.01 is revised to read:

Form paragraph 7.39.01 must be used when the last response was signed only by the applicant (pro se) who is not a patent practitioner ~~may be used~~ to notify applicant of options available after final rejection.

Also, form paragraph 7.39.01 in MPEP § 706.07 and the Form Paragraph Chapter is revised to read:

¶ **7.39.01 Final Rejection, Options for Applicant, Pro Se**

This action is a **final rejection** and closes the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited to an appeal to the Patent Trial and Appeal Board, an amendment complying with the requirements set forth below, or a request for continued examination (RCE) to reopen prosecution where permitted. Please note that the Office also offers initiatives that are available to applicants after the close of prosecution. See <https://www.uspto.gov/patents/initiatives/uspto-patent-applications-initiatives-timeline> for more information.

General information on the Patent Trial and Appeal Board is available at: www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab. The information at this page includes guidance on time limited options that may assist the applicant contemplating appealing an examiner's rejection. It also includes information on pro bono (free) legal services and advice available for those who are under-resourced and considering an appeal at: <https://www.uspto.gov/patents/patent-trial-and-appeal-board/patent-trial-and-appeal-board-pro-bono-program-independent>. The page is best reviewed promptly after applicant has received a final rejection or the claims have been twice rejected because some of the noted assistance must be requested within one month from the date of the latest rejection. See MPEP § 1204 for more information on filing a notice of appeal.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply. The Notice of Appeal must be accompanied by the fee required by 37 CFR 41.20(b)(1). The current fee amount is available at: www.uspto.gov/Fees.

If applicant should desire to file an after-final amendment, entry of the proposed amendment cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made in a previous Office action. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing of good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include cancellation of or appeal from the rejection of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds all of the claims to be in condition for allowance.

If applicant should desire to continue prosecution in a utility or plant application filed on or after May 29, 2000 and have the finality of this Office action withdrawn, an RCE under 37 CFR 1.114 may be filed within the period for reply. See MPEP § 706.07(h) for more information on the requirements for filing an RCE.

The application will become abandoned unless a Notice of Appeal, an after final reply that places the application in condition for allowance, or an RCE has been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b).

Examiner Note:

1. This form paragraph must be used when the last response was signed only by the applicant (pro se) who is not a patent practitioner.

2. This ~~The~~ form paragraph must be preceded by any one of form paragraphs 7.39, 7.40, 7.40.01, 7.40.02.aia, 7.40.02.fti, 7.41, 7.42.03.fti, or 7.42.09.

These changes to the MPEP are effective on issuance of this memo and supersede the content in the Ninth Edition, Revision 07.2022, of the MPEP. The MPEP will be revised to include these changes in due course.