

**From:** Chelstrom, Jeffrey A.  
**Sent:** Monday, November 14, 2016 10:20 AM  
**To:** After Final Practice <afterfinalpractice@USPTO.GOV>  
**Subject:** Comments to Post-Prosecution Pilot Program (P3)

Attention Paul Tamayo,

please see the attached comments of the Intellectual Property law Association of Chicago (“IPLAC”) on the Post-Prosecution pilot Program.”

Best Regards,

Jeff

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**HONIGMAN**

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November 14, 2016

**By electronic mail: [afterfinalpractice@uspto.gov](mailto:afterfinalpractice@uspto.gov)**

Mail Stop Comments—Patents  
Attn: Raul Tamayo  
Office of Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RE:** IPLAC Comments on Proposed USPTO Post-Prosecution Pilot Program  
81 Fed Reg. 132, 44845 (July 11, 2016)

Dear Mr. Tamayo:

The Intellectual Property Law Association of Chicago (“IPLAC”) appreciates the opportunity to provide comments to the US Patent and Trademark Office (“PTO”) regarding the notice and request for comment entitled “Post-Prosecution Pilot Program,” as published on July 11, 2016 in the Federal Register (81 Fed. Reg. 132, 44845).

Founded in 1884, IPLAC is the country’s oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal locus and forum for the nation’s authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association of over 1,000 members with interests in the areas of patents, trademarks, copyrights, and trade secrets, and the legal issues they present. Its members include attorneys in private and corporate practices before federal bars throughout the United States, as well as the U.S. Patent and Trademark Office and the U.S. Copyright Office. IPLAC offers the following comments and suggestions regarding the proposed changes to the rules of representation of others before the Patent and Trademark Office.

As an initial matter, IPLAC would like to commend the PTO on the Post-Prosecution Pilot Program (the “P3 Program”). IPLAC’s members believe there is great potential in the P3 Program and that the P3 Program might grow to be a valuable addition to the patent prosecution process.

That said, IPLAC has identified three areas worthy of specific feedback and invites the PTO to consider the following:

1. **PTO Response Deadline.** As read by IPLAC, it appears that the P3 Program, as currently proposed, does not have any deadline for the response by the PTO once the P3 Conference has occurred. This is problematic because of the requirement that the applicant either (1) provide a notice of appeal (NOA), or (2) file a request for continued examination (RCE) within the statutory six-month deadline after a final rejection to avoid abandonment of the application. Compounding this timing problem is the provision of the P3 Program that states that the filing of an NOA or an RCE “after the date of filing [of] a P3 request, but prior to a notice of decision from the panel of examiners, . . . will end [the P3 request] without a decision on the merits of the P3 request.” 81 Fed. Reg. at 44849. Thus, if an applicant has engaged in the P3 Program but has not yet received a decision

by the statutory six-month deadline, the applicant may feel compelled to terminate the P3 proceedings—not because of a desire to do so but out of necessity to avoid abandonment of the underlying application.

IPLAC has contemplated two possible methods to alleviate this concern. *First*, the PTO could impose a deadline on when a P3 decision must be communicated to the applicants such that applicants can be certain that they will receive a P3 decision prior to the expiration of the statutory 6-month response deadline (e.g., require a notice of decision no later than 5 months after the underlying final rejection or no later than 3 months after receipt of a P3 request). *Second*, alternatively, the PTO could modify the conditions that result in the termination of P3 proceedings such that an NOA or an RCE will only terminate a P3 proceeding if it is filed at a point in time sufficiently early in the P3 process. For example, the termination conditions of the P3 Program could be modified so that only an NOA or an RCE that is filed within the first 5 months after the final rejection—or within the first 3 months after the filing of the applicant’s P3 request—will terminate any underlying P3 proceedings. Any NOAs or RCEs filed after that time period would not terminate the P3 Program proceedings, absent an affirmative request from the applicant that it be terminated, so that the P3 process could continue despite the applicant’s later concurrent use of the RCE or NOA mechanisms, as is statutorily required to prevent abandonment.

2. Nature of the P3 Program Conferences. The P3 Program appears to contemplate a two-way dialog during the applicant’s P3 Program conference with the panel of examiners. (“The conference will permit the applicant to 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.” 81 Fed. Reg. at 44847.) We would strongly encourage such a two-way dialog. The primary value of the P3 Program conference, in IPLAC’s view, is an open and frank exchange of ideas, positions, and concerns between the applicant and the panel of examiners. If the conference is a one-way dialog, where the applicant merely restates the arguments already made in its opening statement and the applicant receives little or no feedback from the panel of examiners, the value of the conference—and the entire P3 Program—will be greatly diminished.
3. Removal of Pilot Limitations. Because, as previously stated, IPLAC believes this P3 Program has merit and is a worthy addition to a practitioner’s prosecution toolbox, IPLAC also requests that the limitations on the number of requests allowed by each technology center (200 requests) or by the PTO in total (1600 requests) either be raised, modified in a manner that will allow the P3 Program to continue indefinitely into the future, or simply removed entirely.

IPLAC thanks the Patent and Trademark Office for considering these comments and would welcome any further dialogue or opportunity to support the Patent and Trademark Office.