

From: Randall Vaas
Sent: Monday, November 14, 2016 10:07 AM
To: After Final Practice <afterfinalpractice@USPTO.GOV>
Cc: Suzanne Michel; Aeric Banks
Subject: Requests for Comments on P3 Program

Please find attached Google's response to the Request for Comments on P3 program (Docket No. PTO-P-2016-0012).

Sincerely,

Randall Vaas

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Before the
United States Patent and Trademark Office
Alexandria, VA 22313

In re:) Docket No. PTO-P-2016-0012
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Request for Comments on P3)
And Other Suggestions to Improve After)
Final Practice and Reduce the Number)
Of Appeals and Issues Taken Up to)
the PTAB and RCEs)

Comments of Google Inc.

I. INTRODUCTION

Google prosecutes thousands of applications each year before the USPTO. Last year, our inventors placed Google in the top five of patent recipients. Thus, Google’s experience with after-final practice is extensive and now includes over 31 pending and granted requests for conferences under the Post-Prosecution Pilot (P3) program. We appreciate this opportunity to offer input on improving the P3 program and making prosecution more efficient for both applicants and the Office.

Google supports the Office’s three stated goals for the P3 program: “(1) Increase the value of after final practice; (2) reduce the number of appeals and the issues to be taken on appeal to the PTAB and the number of RCEs; and (3) streamline the options available to an applicant during after final practice.” We agree that P3 will likely increase the value of current after-final practice “by (1) leveraging applicant input obtained through an oral presentation during a conference with a panel of examiners, and (2) also providing written explanation of the panel decision.” Accordingly, we encourage the Office to extend the P3 program and offer suggestions for improving the value of the program.

Google submits, however, that compact prosecution as currently implemented by the Office contributes to the inefficiencies that the P3 program seeks to address. Current rules and policies create a typical inefficient prosecution cycle of two full office actions, followed by limited after-final practice, followed by an RCE (requests for continued examination), which then promotes an additional two full office actions, or an appeal without full development of the issues. Thus, the burden of excessive RCEs and premature appeals is partially caused by the

rules and policies of compact prosecution. The Patent Office should therefore consider revising current practice to allow a higher number of amendments before finality and ensure that prosecution is fully developed before after-final practice begins.

II. P3 MODIFIED AS SUGGESTED WOULD IMPROVE CURRENT AFTER-FINAL PRACTICE

The Office has several after-final pilot programs intended to improve after-final practice and reduce RCEs, appeals, and issues appealed to the PTAB under compact prosecution. P3 is the latest of these programs and provides benefits over the other programs. The proposed examiner panel review at the completion of prosecution can help the Office reduce appeals and clarify issues, and the written explanation of the panel decision aids the applicant and brings clarity to the public record. Therefore, Google supports the P3 program generally and suggests that the following changes would enhance these benefits.

A. ORAL PRESENTATION TO PANEL

An engaged examiner panel hearing the applicant's position in view of the record at the end of prosecution can help achieve the Office's stated goals for P3. By actively engaging with the applicant, and responding on the record to the applicant's positions, a panel of experienced examiners can help to clarify allowable subject matter, reduce issues on appeal, and focus the issues in dispute. The panel of experienced examiners can also provide a quality check for the examination while helping to advance prosecution of the application.

Engagement by all the members of the review panel is important. This is particularly true where a junior examiner without signatory authority and her primary examiner make up 2 of the 3 panel members. Absent engagement of all the panel members, the oral presentation during a conference with a panel of examiners is similar to an interview between the applicant and the examiner of record.

1. PANEL COMPOSITION

The panel composition is important for the impact of the panel review. The panel should be made up of three experienced examiners having full signatory authority, even if a junior examiner of record remains on the panel. This will make the panel review a new review. An experienced panel of examiners can review the record, consider all the issues, and resolve issues that don't require the expertise of the PTAB.

2. COMPLETE RECORD

The Office should record or otherwise capture the full content of the applicant's presentation to the examiner panel so that the record is clear and all arguments made will be available to the public. Currently, the typical interview record is sparse and often obscures or minimizes what was discussed. This sabotages the goal of clarity, but the problem can be avoided in P3 by simply recording the applicant's presentation so that their content is available to the public. Otherwise, the presentations will become a private loophole in an otherwise public record.

B. WRITTEN EXPLANATION OF THE PANEL DECISION

Providing written explanation of the panel decision is very beneficial for both applicant and the public. For example, a summary explanation of the panel's interpretation of the prior art in view of applicant's conference submission assists the applicant in understanding the Office's position, decide whether to accept narrower allowable subject matter in a dependent claim, and avoid appeal or reduce the issues on appeal. The well written explanation of the panel's position further aids the public by providing clarity to the record.

C. MORE TIME TO FILE P3 REQUESTS

It is common for a final rejection to be based on a new art rejection made in response to an amendment filed by applicant. This often occurs in compact prosecution when a second office action is made final. Applicant does not have an opportunity to respond before the action is made final. After-final practices that allow insufficient time for the applicant to respond will not address this problem. Additionally, the 2-month time limit for filing P3 makes it difficult for the applicant and examiner to determine if prosecution is in fact complete (i.e., all the issues and positions are set forth, and the examiner and applicant have determined that they disagree) such that the application is ripe for appeal. As a consequence, the applicant risks filing a premature P3 if further prosecution is needed, or filing an RCE that was not necessary if prosecution is complete. The 2-month time limit should be extended to 3 months to allow applicant and examiner time to determine that prosecution is complete, for example through an interview, and that P3 is appropriate.

III. A REDESIGN OF COMPACT PROSECUTION WOULD PROMOTE THE GOALS OF THE P3 PROGRAM

Efficient examination that reaches finality in a timely manner is the goal of compact prosecution. The concept behind compact prosecution is that an examiner will thoroughly review every claim in the first office action, provide fully articulated rejections, and receive a fulsome response from

the applicant that will place the application in a condition for allowance or generate an abandonment or appeal. The combination of a thorough first office action and the potential of a final rejection limiting further prosecution is intended to crystallize the issues quickly and make examination efficient.

But in reality, prosecution operates under rules that have the opposite effect. Two office actions are often insufficient to resolve all the issues in a complex application. As a result, Applicants frequently engage in limited after-final practice and then, when unsatisfied, pursue repeated requests for continued examination (RCEs) to keep prosecution going in a two-full-steps / one half-step cycle or prematurely appeal a final rejection. This behavior, partially driven by the rules, creates the burden of excessive RCEs and premature appeals that the Office has identified.

To better reduce the number of RCEs and premature appeals, the Office should eliminate both final rejections and RCEs as they currently exist. It is inefficient for the conversation between the patent applicant and the examiner to be interrupted by these events. The Office should instead allow for multiple Office actions triggering increasing fees and a cap on how many are possible (perhaps four or five). After the applicant has reached the limit on Office actions, the Office should allow the applicant to bring the matter to a panel of examiners for further consideration, just as in the P3 program. The panel could issue a decision that maintains the rejection, finds the claims allowable, or (more rarely than in the current proposal) reopens prosecution. If no resolution is reached at that point, the applicant could then appeal to the Board, accept any subject matter indicated to be allowable, or abandon the application. This examination structure would reduce the caseload at the Board so that only well developed issues reach them, rather than issues that could have been more efficiently resolved by allowing examination to continue or involving additional patent examiners.