

From: Jeffrey Grayzel

Sent: Monday, November 14, 2016 11:13 PM

To: Post Prosecution Pilot <PostProsecutionPilot@USPTO.GOV>

Cc: After Final Practice <afterfinalpractice@USPTO.GOV>; Tamayo, Raul <Raul.Tamayo@USPTO.GOV>

Subject: Public Comment on the Post prosecution Pilot (P3) Program

To: USPTO Office of After Final Practice

RE: Public Comment on the Post prosecution Pilot (P3) Program

We would like to provide the USPTO with the following three comments:

1. The P3 program attempts to consolidate-and-combine the After-Final Consideration Pilot (AFCP) and the Pre-Appeal Brief Conference. The P3 panel is inherently biased, as the three members of the P3 Panel include the Examiner and the related Supervisor; only the third member comes to the P3 proceedings with no prior opinions on the application being reviewed. The P3 panel, like the PTAB, should be composed of three persons who are freshly exposed to the matters being considered. At a minimum, two of the three P3 panel members should be independent and unbiased, and be allowed to overrule the Examiner.

2. The P3 program provides the Applicant an opportunity to submit an amended claim set. However, whether amended claims are submitted or not, the Applicant is limited to five pages of arguments. Our submission included three amended claims, and in order to ensure that the reasoning behind our claim amendments was to be reasonably understood by the panel we utilized 25% of our 5-page limit to discuss the claim amendments. However, by doing so we had to limit our arguments related to the rejections to just 75% of the 5-page limit. In the end we felt neither our arguments or claim amendments received enough space to be as thorough as we would have preferred. Thus, we suggest that an Applicant submitting claim amendments be given additional pages (beyond the 5 pages) to explain those amendments thoroughly. This would allow the basic 5-page limit to be used for arguments solely focused on the rejection.

3. We have had prior experience in prosecuting an Appeal before the PTAB. The written decision received from the PTAB was detailed and explanatory as to why they were ruling the way they did. The written response received recently from the P3 panel was less detailed and less explanatory than that which we had previously received from the PTAB. We suggest that a standard be implemented that requires the P3 panel to provide more reasoning and a detailed basis to the statements they make in their decision.

Respectfully submitted,
Jeffrey Grayzel & Joseph Grayzel