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**Subject:** The PreAppeal Conference and P3 are Hopelessly Rigged Against the Applicant.

The USPTO announced their new Post-Prosecution Pilot Program, or P3 program for after-final review of a patent application. The P3 program is billed as being similar to the PreAppeal Conference but it adds an oral argument to the mix and - the Office promises - a meaningful explanation of the decision.

There is a twist, however, that can lead to a rigged board.

**Bottom line: the PreAppeal Conference is probably much better than P3.**

This writer has used the PreAppeal Conference with meaningful success over the years. I like the PreAppeal conference because under the right circumstances, the case is usually reopened. However, there are certain caveats.

**The PreAppeal Conference only works when you have a primary examiner.**

For junior examiners, a primary examiner or Supervisory Patent Examiner (SPE) is usually calling the shots. This varies from one SPE to the next, but when doing an interview with a junior examiner, you can usually get a sense of how controlling the SPE will be. If your interview is between you and the SPE, with the examiner holding their tongue the entire call, the SPE is in complete control and don't bother with a PreAppeal Conference. Plan on going straight to appeal, or doing the PreAppeal Conference only as a way to buy more time to write a complete Appeal Brief.

I always ask to have the SPE present in a telephone interview, but more times than not, junior examiners balk or are downright offended when I ask. At this point, the practitioner is really stuck. Do you risk completely alienating the examiner by demanding that the SPE is present, or give in and wind up with an interview where nothing gets decided because the examiner says "I will have to check with my boss" about anything substantial?

Every SPE I know says - unequivocally - that you can ALWAYS get a supervisor on the phone with a junior examiner, and that it is completely improper for the junior examiner to even hesitate and certainly to argue about it. My personal experience is that junior examiners want to have an interview without their supervisor at in at least 7 out of 10 cases. When this happens, the applicant must risk offending the junior examiner, which can greatly damage your chances of allowance.

With a junior examiner, the PreAppeal Conference is hopelessly stacked against you. The primary or SPE who calls the shots is not going to overrule themselves, and the junior examiner is not going to overrule the SPE. Starting out, the applicant has 2 votes against them.

**With a junior examiner, the PreAppeal Conference is hopelessly rigged. You are not going to win. Period.**

**On the flip side, when there is a primary examiner, the PreAppeal Conference can be remarkably effective.**

The SPE typically does not review the primary's actions, so they are not biased towards the position of the examiner. With a primary, it usually makes sense to give the SPE a quick call after an interview with the primary. I like to let the SPE know how well the interview went, and sometimes ask for their read on the situation. When this conversation goes well, the PreAppeal Conference is extremely successful, since the SPE will likely cast the deciding vote.

**Pro Tip: PreAppeal Conferences are better for legal issues with less about the technical ones.**

For technical issues, the other members of the board are not going to know the details of the invention, so they will defer to the examiner's view of the technical issues. Solid, well described legal arguments are much more powerful in this forum.

Another key: make sure you are really right. If you have a specious argument or half-baked reasoning, you are not going to move the needle and the PreAppeal Conference will result in going to the PTAB or making an amendment in an RCE.

Remember that you are presenting the examiner with a preview of what they will see on appeal. The examiner's calculus goes like this: is it better for the examiner to lose a little face at the PreAppeal Conference, or write an Examiner's Answer during the appeal phase?

**The P3 Program has a unique, unadvertised twist to the process that can kill your chances.**

The unadvertised feature is that the PreAppeal Conference board is assembled by an administrative assistant in the technology center, but the P3 board is assembled by the SPE. This is a critical difference.

With the P3 program, the Office is trying to address an internally perceived problem that they believe they have with the PreAppeal Conference, which is the technical knowledge of the third member of the board.

**The third member of the PreAppeal Conference is the first available examiner from any technology center and with any type of technical background. This person is essentially selected at random, and often has no technical competence in the area.**

**With the P3 program, the third person is picked by the SPE. This gives the SPE the ability to stack the deck in their favor, intentionally or not.**

By letting the SPE pick the board, the PTO was hoping that someone with technical expertise would be on the board to help decide the applicant's technical issues. The unintended consequence is that the SPE can stack the board - and probably does so unintentionally when it is not done deliberately.

By letting the SPE pick the board, the SPE is not likely to pick someone who will be disagreeable. Would the SPE reach out to anyone who would make the P3 board more confrontational and painful - or would the SPE reach out to someone agreeable and easy to manipulate?

I am not willing to take the risk that the SPE will avoid controversy and will unintentionally - or even intentionally - stack the deck against the applicant.

There are other reasons why PreAppeal Conferences are better than P3.

### **PreAppeal Conferences are a net lower cost - and less stressful - than P3.**

Another element of the P3 program is that is different from PreAppeal is that you do not pay the appeal fee (\$400 for small entity/\$800 large). The effect of the Notice of Appeal and appeal fee in the PreAppeal Conference is that it satisfies the statutory limit to respond to an Office action. However, with P3, the statutory limit to respond to an Office action is NOT stopped, so the Office has to hustle through the P3 process to give you an answer.

You could be faced with a three month extension of time (\$750 small/\$1500 large) if the process soaks up the entire time. Because the applicant does not have control over how fast the Office decides the case and the Office has no specific penalties for dragging its feet, you should plan on eating into your extension of time and the associated costs.

The Office appears to be very worried about the time frame and its ability to find the right examiners for the board, set up the phone/WebEx session between the applicant and three examiners, and get a decision. If there were no time constraints like with PreAppeal Conferences, I would suspect that there would be better, more thoughtful analysis and the results would be better. I would hate for the decisions to be rushed when they did not have to be. I pity the practitioner who tries to do this in August/September, when every examiner is trying to make quota (or earn a bonus) before the end of the fiscal year.

PreAppeal Conferences do not have the statutory time limit hanging over everyone's head, so the board can take as much time as necessary to reach a decision - and you have a fresh clock to respond once the decision is rendered. 3P forces the PTO and the applicant to make quick decisions with an (expensive) clock ticking all the time.

The Applicant must respond quickly during the P3 program. They must decide quickly, write their brief quickly, then pray that the PTO has their ducks in a line. The PTO could very well delay your case unnecessarily, pushing you to the end of your six month date. This can be stressful for the Applicant to make the appropriate decisions and respond quickly. It would be so much better to relieve the unnecessary schedule pressure and just file the Notice of Appeal.

### **Prosecution Tip: The positive effects of the P3 program can be had without the headaches.**

If you have a primary examiner on your case, I would prefer the PreAppeal Conference over the P3 program - hands down. When the final action comes out, have an interview with the primary and try out your arguments that you want to try in the PreAppeal. Then call the SPE and have the same conversation, but without the primary present, then file the PreAppeal Conference request.

The net effect is that you made your oral arguments with the two most important members of the board, which is essentially the same as making the oral arguments on a P3 case. The SPE does not have direct control over who is on the board, so you don't have that stacked against you. Also, the Notice of Appeal stops all of the unnecessary pushups to meet the statutory deadline. You were never going to win on a technical argument anyway, so it doesn't really matter that the third member of the board knew the art or not.

I would pick the PreAppeal Conference.

### **My wish list for the P3 program and PreAppeal Conference:**

One of the best ways to fix the problems with PreAppeal and P3 reviews would be to require three examiners with full signatory authority on the board. A primary and their SPE is OK, but a junior and their SPE should only count for one vote. When the examiner is a junior examiner, they should have a voice (since they did the heavy lifting and understand the technology) but they should not be able to vote - because they are not qualified to vote. There needs to be three examiners each with signatory authority on the board for the applicant to get a fair shake. Right now, PreAppeal Conferences are unfair when you are stuck with a junior examiner.

I would also like to see the P3 program to require the Notice of Appeal and Appeal fee. This would stop the time limit pressure and give the applicant - and the Office - more time to reach the best decision possible for the public. I don't see this as a huge financial cost, and in most cases, it will probably be a net cost savings.

In general, I like the PreAppeal Conference system. It works well (but only when you have a primary examiner) and is remarkably quick and efficient. I am not convinced that the P3 program fixes the main problems of the PreAppeal Conference.

It is interesting that the P3 program is launched in the last fiscal quarter of the year. Woe to the practitioner who attempts to get the Office to wrangle a review board, set up a conference, deliberate on a decision, then write up a meaningful explanation - all within the 4-6 week goal of the USPTO. We all know how well that will go.

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