

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

uspto

Post-Prosecution Pilot (P3)

PTC - Examiner Training 2016





Objectives

- Examiners will understand the purpose of the Post-Prosecution Pilot Program
- Examiners will know what to do when they receive a Post-Prosecution Pilot request



Background: Post-Prosecution Pilot

- The Post-Prosecution Pilot (P3) will provide an alternative vehicle to request consideration by a panel of an after-final submission prior to the filing of a Notice of Appeal
- The Post-Prosecution Pilot will be available only for utility applications under Final Rejection
- A maximum of 1600 total applications will be admitted into the Pilot over a six month time period, with an ideal level of participation at 200 applications per utility Technology Center. There will be a limit of one accepted request per round of prosecution.

Entry into the Pilot

- Timing of Request
 - A proper request for consideration under the P3 must be filed within **two (2) months** of the mailing date of a Final action and before the filing of a Notice of Appeal
- Notification
 - Once the request is accepted, an e-mail notification is sent to the SPE and Examiner, and the application is placed on the SPEs dashboard as a pending Pre-Appeal
 - The document code will be A.NE.PCP

Request for consideration under P3

- The request for consideration must:
 - Be filed within **two (2) months** of the mailing date of a Final action and before the filing of a Notice of Appeal
 - Include a transmittal form
 - The Office advises applicants use form PTO/SB/444 titled “Certification and Request for Consideration under the Post-Prosecution Pilot Program”
 - Include a response comprising no more than five pages of arguments (exclusive of any proposed amendment)
 - Include a conference participation statement
 - Applicant must commit to be available to meet within 10 days of an initial request by the Office to schedule the panel
- Optionally, if the response includes a proposed amendment, the amendment may not broaden the scope of the claim(s) in any aspect.



P3 Request Review

- The P3 TC POC reviews entry request into pilot for compliance
- If improper or not accepted, the P3 TC POC notifies the Examiner by email and places the application in the Examiner's Expedited Docket

If the Request is Improper or Not Accepted, the Response is Treated as an After Final amendment filed under 37 CFR 1.116

- Once the application is docketed the Examiner should treat the applicant's response like any other received after final
 - In addition to completing the Advisory Action, examiner will be provided language to include in the Advisory Action to notify the Applicant why the request was improper.
- Do not include a PTO-2324 form (P3 Decision Form)

Reason(s) for Improper Request

- The request was filed more than two (2) months from the mailing date of the final rejection
- The application does not contain an outstanding final rejection.
 - If a non-final rejection is outstanding, the request filed by applicant will be deemed a reply to the non-final rejection pursuant to 37 CFR 1.111. No further action is required by applicant at this time.
- A Request for Continued Examination (RCE), Notice of Appeal, or express abandonment has been filed
 - RCE: no further action is required by applicant at this time. Notice of Appeal: A brief in compliance with 37 CFR 41.37, or any other reply, must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)). Express abandonment: the case will be abandoned.



Reasons for Improper Request

- A Post-Prosecution Request (P3) was previously requested and accepted.
- The request comprises more than five (5) pages of arguments.
- The submitted claim amendment broadens the claim(s) scope.



If the Request is Proper a Panel Conference is Scheduled

- If proper, the P3 TC POC notifies the Examiner and SPE by email
- Conference
 - Coordinated by the SPE, assisted by the Examiner
 - SPE is the point of contact between Applicant and Office
 - Discussion of mutually agreeable panel members, dates and times

Panel Participants

- Examiner of record (and preferably the Primary if the Examiner of record is a Junior)
- SPE
- At least one other Primary Examiner
 - With expertise in the relevant technical and legal issues at hand
- Applicant
 - Applicant must commit to be available to meet within 10 days of an initial request by the Office to schedule the panel. If Applicant is unable to be available to meet within the specified time period the P3 request will be held defective and treated like a response under 37 CFR 1.116.



Non-Production Time

- The Examiner of record is granted up to three (3) hours to review Applicant's arguments, conduct the conference, complete the P3 Decision Form and the survey
- One (1) additional hour is granted if claim amendments are proposed
- Panelists will record the amount of time necessary to prepare for and participate in the conference
- Additional non-production time may be available on a case-by-case basis with SPE approval.



Preparing for the Panel Conference

Review Applicant's arguments and any proposed amendments

- If a claim amendment is filed, the Examiner of record should review the amendment(s) to the extent possible within the time allotted

Conducting the Panel Conference

- The scheduled Conference includes 20 minutes for a presentation by applicant.
- Applicant may present arguments directed to the outstanding record, or arguments may be directed to patentability of the amended claim(s) if presented.
- After Applicant departs, the panelists will confer and make a recommendation to the Examiner.
 - After considering the recommendation of the panel, the Examiner of record will prepare the decision form and post it to the SPE who will route the form to conferees for signature and then approve.

Panel Conference Discussion

- Decide whether Applicant's arguments overcome any outstanding rejection(s) or objection(s)
- Decision by Examiner on the entry of any proposed claim amendments
- Confer to reach a consensus on how to proceed:
 - Indication of allowable subject matter
 - Final rejection upheld
 - Re-open prosecution
- Recommendation to the Primary of record



Docketing of Request to Examiner

Once the conference is completed the SPE notifies a P3 TC POC to docket the P3 request to the Examiner's Expedited Docket.

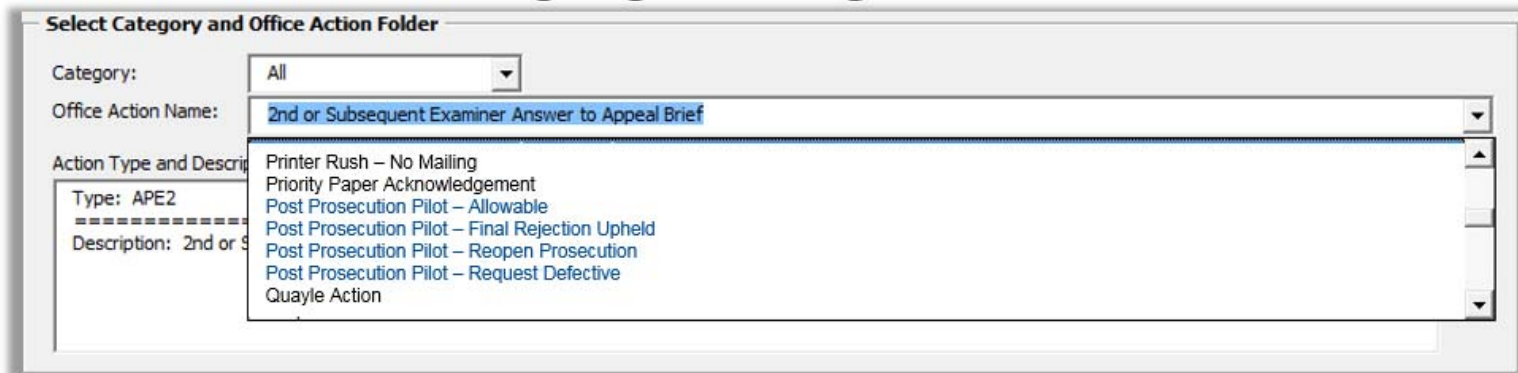
Notice of Decision from Post-Prosecution Conference

Responsible Parties

- A P3 Decision Form, form 2324, is completed by the Examiner of record
- Examiner of record will post the decision for credit to the SPE
- The SPE will route the decision form to panel members for their signature and approve the form for mailing

Titling the OACS Action

- When creating the action select the appropriate title that corresponds to the conference result
- Below is a snapshot of the options to name the actions, with P3 actions highlighted in green **(Include new screen shot)**





If you have a proper P3 request, a conference was held, and the application deemed allowable

- Docketed to Examiner's Expedited tab
- Complete Notice of Allowance
 - P3 Decision Form is included as an attachment to the Notice of Allowance (Form PTOL-37)
- Examiner of record will post for credit to SPE the Decision Form and completed Notice of Allowance
- The SPE will route the NoA to panel members for signature of the decision form and forward for mailing



If you have a proper request, conference held, Final rejection upheld

- Docketed to Examiner's Expedited tab
- Examiner of record will post for credit to SPE the completed Decision Form indicating that the final rejection is upheld
- The SPE will route the Decision Form to panel members for their signature and forward for mailing



If you have a proper request, conference held, need to re-open prosecution

- Docketed to Examiner's Expedited Tab
- Examiner of record will post for credit to SPE the completed Decision Form indicating that the prosecution will be re-opened
- The SPE will route the Decision Form to panel members for their signature and forward for mailing
- Once the Decision Form is mailed, the application will be forwarded to the Examiner's Amended Docket

Decision Form Overview

Notice of Decision from Post-Prosecution Pilot Program (P3) Conference	Application Number	Applicant(s)	
	Examiner	Art Unit	AIA Status
<p>This is in response to the P3 request filed [redacted]. A conference has been held.</p> <p>1. <input type="checkbox"/> Final Rejection Upheld:</p> <p><input type="checkbox"/> The status of claims has been determined as follows:</p> <p>Claim(s) allowed: [redacted]</p> <p>Claim(s) objected to: [redacted]</p> <p>Claim(s) rejected: [redacted]</p> <p>Claim(s) withdrawn from consideration: [redacted]</p> <p><input type="checkbox"/> The following rejections have been withdrawn:</p> <p>[redacted]</p> <p><input type="checkbox"/> The proposed amendment would overcome all outstanding rejections in the outstanding final Office action. A determination of allowability, however, could not be made within the guidelines of the pilot program.</p> <p>For purposes of appeal, the proposed amendment: <input type="checkbox"/> (a) will be entered, or <input type="checkbox"/> (b) will not be entered (<i>see box 4 below</i>).</p> <p>The time period for filing a response expires on (1) the mailing date of this decision; or (2) the date set forth in the final rejection, whichever is later. Extensions of time may be obtained under 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than six (6) months from the mailing date of the final rejection.</p> <p>2. <input type="checkbox"/> Allowable Application: The rejection(s) is/are withdrawn, and this Notice of Decision is being mailed concurrently with a Notice of Allowance.</p> <p>3. <input type="checkbox"/> Reopen Prosecution: The rejection(s) is/are withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.</p> <p>4. <input type="checkbox"/> Explanation of Decision for Boxes 1-3: [redacted]</p> <p>5. <input type="checkbox"/> Attachments: [redacted]</p> <p>List of Participants:</p> <p>(1) [redacted] (3) [redacted]</p> <p>(2) [redacted] (4) [redacted]</p>			
<p>U.S. Patent and Trademark Office PTO-2324 (Rev. 06-16)</p> <p style="text-align: right;">Notice of Decision from Post-Prosecution Pilot Program (P3) Conference</p>			

Docket Management Considerations

- Upon completion of the conference, TC DM POCs will be notified, by the SPE, to docket the case to the Examiner's Expedited Docket
- Upon docketing, a standard 14 day average / 28 day ceiling clock will be started for P3 requests
- Posting the P3 Decision Form to the SPE will stop the clock
- If the result of the conference is re-opening prosecution, upon mailing of the P3 Decision Form, the case will be moved to the Examiner's Amended Docket

Review of Key Points

- If applicant submits a proper P3 request that is accepted, they give up the option to participate in AFCP and Pre-appeal
 - No additional response under 37 CFR 1.116 to the same final rejection will be entered, unless the Examiner has requested the additional response because the Examiner agrees that it would place the application in condition for allowance
- The Examiner of record involved in a conference receives up to three (3) hours of other time
 - The Examiner of record receives one (1) additional hour of other time if the response includes a claim amendment
- If the P3 request is proper and accepted, the DM clock does not start until the P3 conference is completed
- If the P3 request is improper, or the applicant cannot attend the conference, the response should be treated as a response after final under 37 C.F.R. 1.116

Resources/Points of Contact

- Online resources:
 - [<Internal Website link here>](#)
 - PostProsecutionPilot@uspto.gov
- Points of contact
 - 1600: Fereydoun Sajjadi | Bethany Barham
 - 1700: Jennifer Michener | Mike Marcheschi
 - 2100: Kamini Shah | Emerson Puente
 - 2400: Ben Bruckart | Brian Gillis | Jeff Rutkowski
 - 2600: Will Boddie | Greg Tryder
 - 2800: Laura Martin | Alex Sofocleous
 - 3600: Joe Rocca | Rob Wu
 - 3700: Tricia Bianco | Jeff Hoekstra



Timecode and Survey?