

# After Final Practice and Request for Continued Examination (RCE)

USPTO Patent Training Academy

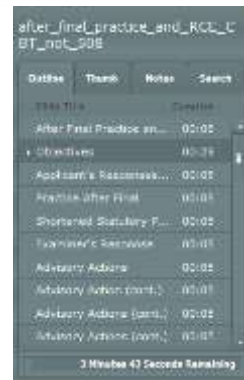
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## Presentation Navigation Notes

- Use bottom toolbar to control slides and voice recordings
- Use menu at right to navigate to slides out of order using either slide titles on the outline or thumbnail images
- Click on Notes tab at right to view transcript of voice recordings



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## Objectives

- You will become more familiar with the following:
  - Patent examining procedure After Final Rejection
  - Responses to Applicant's After Final Reply
  - Requests for Continued Examination (RCEs)

## Applicant's Responses After Final

- Responses after final may include:
  - After Final Reply
    - Amendment to the claims;
    - Request for Reconsideration, i.e. arguments or petitions; and/or
    - Additional evidence, e.g. 1.132 Affidavits
  - Request for Continued Examination (RCE)
  - Notice of Appeal and Appeal Fee
  - Appeal brief

## Practice After Final

- Replies After Final should be processed and considered promptly
  - 11 expected average days
- Replies After Final should NOT be considered by the examiner unless:
  - Filed within the Shortened Statutory Period (SSP); or
  - Accompanied by a petition for an extension of time and the appropriate fee

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## Shortened Statutory Period (SSP)

- Shortened Statutory Period (SSP):
  - 3 months from the date the final rejection is mailed
  - Can be extended up to additional 3 months with a petition and appropriate fee

MPEP 706.07(f), III

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## Examiner's Response

Examiner's response to an After Final Reply may include:

- Advisory Action
  - Enter the amendment and respond to arguments
  - Deny entry of the amendment and respond to arguments
- *Ex parte Quayle* action
- Allowance
  - Enter any amendments and allow the case
  - Interview to overcome objections and rejections
  - Examiner's Amendment

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## Advisory Actions

- When the After Final Reply does not place the application in condition for allowance:
  - An Advisory Action (PTOL-303) is sent to the Applicant
  - The advisory action informs applicant that the SSP for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later

MPEP 706.07(f), I

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## Advisory Action (cont.)

- Once a proper Final rejection has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution.
- Ordinarily, amendments filed after the final action are not entered unless approved by the examiner.

See 37 CFR 1.116 and MPEP 714.13

## Advisory Actions (cont.)

Amendment filed after a final Office action, but prior to the date of filing an Appeal Brief, may be entered if it:

- 1) Cancels claims or complies with any requirement expressly set forth in a previous action;
- 2) Presents rejected claims in better form for consideration on appeal;
- 3) Amends the specification or claims upon a showing of *good and sufficient reasons* why the amendment is necessary and was not earlier presented; or
- 4) Places the application in condition for allowance.

MPEP 714.13, II – Entry not a matter of right

## Advisory Actions (cont.)

Examiner **may refuse to enter** an After-Final amendment, if the amendments to the claims:

- 1) Would not avoid any of the rejections set forth in the last Office action, and thus, the amendment would not place the case in condition for allowance or in better condition for appeal;
- 2) Raises the issue of new matter;
- 3) Presents new issues requiring further consideration or search; and/or
- 4) Presents additional claims without canceling any finally rejected claims so as not to place the application in better condition for appeal.

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## Advisory Actions Processing

Annotate the first page of the amendment using the **Annotate** tab in eDAN

- If the amendment is **not entered**:
  - “DO NOT ENTER”
  - Initial and Date
- If the Amendment is **entered**:
  - “OK TO ENTER”
  - Initial and Date

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## Knowledge Check A

Once a final rejection that is not premature has been entered in an application, there is no right to unrestricted further prosecution.

- A) True
- B) False

Correct - Click anywhere to continue

Incorrect - The answer is True. Once a proper Final rejection has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. 37 CFR 1.116

Click anywhere to continue

Your answer:

You did not answer this question completely

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## Advisory Actions: PTOL-303

- If the Reply is filed after 2 months from the date of the final Office action, check box 1a)
- The SSP is 3 months from the mailing of the final rejection or up to the month(s) the extension fee has been paid

<b>Advisory Action Before the Filing of an Appeal Brief</b>		Application No.	Applicant(s)
		Examiner	Art Unit
<p>—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —</p> <p>THE REPLY FILED <del>HEREIN</del> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p><b>NO NOTICE OF APPEAL FILED</b></p>			
<p>1 <input checked="" type="checkbox"/> The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:</p> <p>(a) <input checked="" type="checkbox"/> The period for reply expires <b>3</b> months from the mailing date of the final rejection.</p> <p>(b) <input type="checkbox"/> The period for reply expires on (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>(c) <input type="checkbox"/> A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires <b>3</b> months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.</p> <p><small>Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 796.07(f).</small></p>			

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## Advisory Actions: PTOL-303

- If the Reply is filed **within 2 months** from the date of the final Office action, check box 1b)

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	Examiner	Art Unit
<p align="center">-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -</p> <p>THE REPLY FILED <del>timely</del> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.  <b>NO NOTICE OF APPEAL FILED</b></p> <p><input checked="" type="checkbox"/> 1 The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires <input type="text"/> months from the mailing date of the final rejection.</p> <p>b) <input checked="" type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>c) <input type="checkbox"/> A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires <input type="text"/> months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.</p> <p><small>Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).</small></p>		

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## Second Advisory Action: PTOL-303

- If no Notice of Appeal was filed, and a 2<sup>nd</sup> (or subsequent) Advisory Action mailed responsive to applicant's 2<sup>nd</sup> (or subsequent) after-final reply is necessary:
  - If box #1a) was selected in the 1<sup>st</sup> Advisory Action:
    - Check box #1a) in the 2<sup>nd</sup> Advisory Action
  - If box #1b) was selected in the 1<sup>st</sup> Advisory Action **AND** the 1<sup>st</sup> Advisory Action was mailed within 3 months of the date of the final rejection:
    - Check box #1a) in the 2<sup>nd</sup> Advisory Action to set for the time period for reply including extensions of time.
- Note that box #1b) should *never* be selected in a 2<sup>nd</sup> (or subsequent) Advisory Action following the same final rejection

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## Second Advisory Action: PTOL-303 (cont.)

- If all of the following conditions apply, select box #1c) on your 2<sup>nd</sup> Advisory Action:
  - No Notice of Appeal was filed subsequent to the final rejection
  - A 1<sup>st</sup> Advisory Action was issued in response to applicant's 1<sup>st</sup> after-final reply in which item 1, box #1b) was selected
  - Subsequent to the 1<sup>st</sup> Advisory Action, applicant timely filed a 2<sup>nd</sup> after-final reply in response to the same final rejection
  - The 1<sup>st</sup> Advisory Action was mailed more than 3 months after the mailing date of the final rejection
- If box #1c) is checked in the 2<sup>nd</sup> (or subsequent) Advisory Action, enter the number of months paid for by applicant's extension of time

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## Second Advisory Action: PTOL-303

<b>Advisory Action Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)
	Examiner	Art Unit
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- THE REPLY FILED <del>IMMEDIATELY</del> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE (A) NOTICE OF APPEAL FILED		
<p><input checked="" type="checkbox"/> The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance;</p> <p>(2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires _____ months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>c) <input checked="" type="checkbox"/> A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires _____ months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.</p> <p style="font-size: small;">Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).</p>		

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# Advisory Actions: PTOL-303

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/123,456	Applicant(s) BYLUND ET AL.
	Examiner Bao-Thuy L. Nguyen	Art Unit 4193
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
THE REPLY FILED <input type="checkbox"/> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. NO NOTICE OF APPEAL FILED		
<p>1 <input type="checkbox"/> The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance, (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.37, or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires <input type="text"/> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>c) <input type="checkbox"/> A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires <input type="text"/> months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.</p> <p>Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).</p> <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action, or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
<p>NOTICE OF APPEAL</p> <p>2 <input type="checkbox"/> The Notice of Appeal was filed on <input type="text"/>. A brief in compliance with 37 CFR 41.37 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)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>		

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# Advisory Actions: PTOL-303

<p><b>AMENDMENTS</b></p> <p>3 <input checked="" type="checkbox"/> The proposed amendments, filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because:</p> <p>a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>b) <input checked="" type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: <input type="text"/> (See 37 CFR 1.116 and 41.33(a)).</p> <p>4 <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5 <input type="checkbox"/> Applicant's reply has overcome the following rejection(s) <input type="text"/>.</p> <p>6 <input type="checkbox"/> Newly proposed or amended claim(s) <input type="text"/> would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7 <input type="checkbox"/> For purposes of appeal, the proposed amendment(s) (a) <input type="checkbox"/> will not be entered, or (b) <input type="checkbox"/> will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p><b>AFFIDAVIT OR OTHER EVIDENCE</b></p> <p>8 <input type="checkbox"/> The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9 <input type="checkbox"/> The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10 <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p> <p><b>REQUEST FOR RECONSIDERATION/OTHER</b></p> <p>11 <input type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because <input type="text"/>.</p> <p>12 <input type="checkbox"/> Note the attached Information Disclosure Statement(s) (PTO/SB-08) Paper No(s) <input type="text"/>.</p> <p>13 <input type="checkbox"/> Other: <input type="text"/>.</p> <p><b>STATUS OF CLAIMS</b></p> <p>14 The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: <input type="text"/></p> <p>Claim(s) objected to: <input type="text"/></p> <p>Claim(s) rejected: <input type="text"/></p> <p>Claim(s) withdrawn from consideration: <input type="text"/></p>	
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# Advisory Actions: PTOL-303

<b>Advisory Action Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)
	Examiner	Art Unit

**AFFIDAVIT OR OTHER EVIDENCE**

- 8.  The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
  - 9.  The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
  - 10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.
- REQUEST FOR RECONSIDERATION/OTHER**
- 11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because \_\_\_\_\_
  - 12.  Note the attached Information Disclosure Statement(s). (PTO/SB/06) Paper No(s) \_\_\_\_\_
  - 13.  Other: \_\_\_\_\_

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## Knowledge Check B

The shortened statutory period for reply always expires on the mailing date of the advisory action.

- A) True
- B) False

Correct - Click anywhere to continue

Incorrect - The answer is FALSE. The advisory action should inform applicant that the SSP for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later. See MPEP 706.07(f).

Click anywhere to continue

Your answer:

You did not answer this question completely

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## ***Ex parte Quayle Action***

An *Ex parte Quayle* action may be issued when the After Final Reply places the application in condition for allowance except for formal matters which are identified for the first time after a reply is made to a Final Office action and which require action by applicant to correct.

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## ***Ex parte Quayle Action (cont.)***

- Extension of time fees are not required
- Consider Examiner's Amendment to resolve formal matters when possible

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## Interviews

- Interviews may be conducted after the expiration of SSP for reply to a final Office Action but within the 6-month statutory period for reply (without the payment of an extension fee).
  - One interview after final rejection may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. MPEP §713.09
- Interviews (personal and telephone) must include an examiner who has negotiation authority, and who is familiar with the application.

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## Allowance: Examiner's Amendment

- At the time of allowance, changes made by the Examiner may be done by Examiner's Amendment
- An Examiner's Amendment is typically used to cancel or amend claims, but also to make formal corrections to the application, including the drawings and the specification (e.g., abstract)

MPEP 714.03

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## Allowance: Examiner's Amendment (cont.)

### Requirements for an Examiner's Amendment:

- Must be signed by a primary examiner
- Must be authorized by applicant in a formal interview (personal or telephone)
  - Include an Interview Summary as appropriate
- When an Examiner's Amendment is made to the drawings, the applicant still must provide replacement drawings reflecting the changes made by the Examiner's Amendment

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## Allowance: Examiner's Amendment (cont.)

- When a complete first reply to a Final Office action is filed **within** 2 months of the date of the final Office action:
  - An examiner's amendment may be made **without** the payment of extension of time fees even if the examiner's amendment is made more than 3 months from the date of the Final Office Action
  - However, examiner's amendment cannot be made after the 6-month statutory time period

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## Allowance: Examiner's Amendment (*cont.*)

- When a complete first reply is filed **after 2 months** from the date of the final Office action:
  - Applicant's authorization to make an amendment to the application must be made:
    - Within the 3-month SSP; or
    - Within an extended period for reply that has been petitioned and paid for by applicant

MPEP 706.07(f), II and 37 CFR 1.136(a)

## Allowance: Examiner's Amendment (*cont.*)

- An examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a Final Office action would not require any extension fee
- When an examiner's amendment is necessary after the SSP for reply has expired, applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account (use FP 13.02.02).



## Knowledge Check C

Which of the following are true about an Examiner's Amendment? (Check all that apply.)

- A) Must be signed by a primary examiner
- B) Must be authorized by applicant
- C) May be made after the 6-month statutory time period
- D) Is typically used to cancel or amend claims
- E) Cannot be used to make changes to the drawings

Correct - A, B, and D are true.

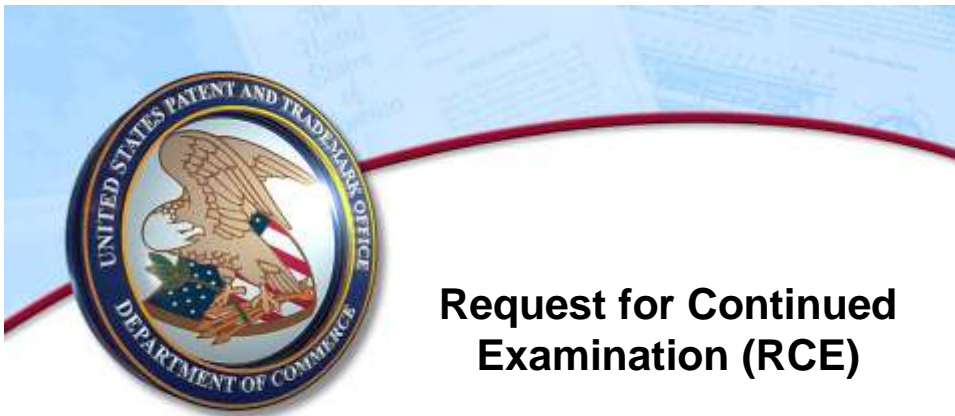
C is false because an examiner's amendment cannot be made after the 6-month statutory time period (MPEP 706.07 (f), II).

E is false because an Examiner's Amendment may be used to make changes to the drawings; however, the applicant still must provide replacement drawings reflecting the changes made by the Examiner's Amendment (MPEP 1302.04).

Incorrect – Please try again

You did not answer this question completely

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## Request for Continued Examination (RCE)

MPEP §706.07(h)

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## Request for Continued Examination (RCE)

What is it? 37 CFR 1.114 (a)

- A procedure under which an applicant may obtain continued examination of an application in which prosecution is closed, meaning the application is under:
  - A final rejection or appeal
  - A notice of allowance, or
  - An action that otherwise closes prosecution in the application (such as *Ex parte Quayle*)
- An RCE is not the filing of a new application

## RCE: Conditions for Filing

Applies to:

- Utility or plant applications filed under 35 U.S.C. §111(a) on or after June 8, 1995
- International applications filed under 35 U.S.C. §363 on or after June 8, 1995 (national stage only)

## RCE: Conditions for Filing (*cont.*)

Does **not** apply to:

- (A) a provisional application;
- (B) an application for a utility or plant patent filed under 35 U.S.C. §111(a) before June 8, 1995;
- (C) an international application filed under 35 U.S.C. §363 before June 8, 1995;
- (D) an application for a design patent; or
- (E) a patent under reexamination.

## RCE: Time for Filing

An applicant may obtain continued examination of an application by filing a **request** for continued examination (PTO/SB/30), a **submission** and the **fee** set forth in 37 CFR 1.17(e) prior to the earliest of:

- (A) payment of the issue fee (unless a petition under 37 CFR 1.313 is granted);
- (B) abandonment of the application; or
- (C) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or the commencement of a civil action (unless the appeal or civil action is terminated).

## RCE: Submission Required

- Mere request for RCE and payment of the fee is not sufficient to avoid abandonment of the application
  - Submissions include, but are not limited to: an IDS; an amendment to the written description, claims, or drawings; new arguments; or new evidence in support of patentability
  - Must include a reply to the final rejection that meets the reply requirements of 37 CFR 1.111 (e.g., an amendment filed with the RCE or a previously filed After Final amendment)

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## RCE: Submission Not Fully Responsive

If the submission is not a bona fide attempt to provide a complete reply:

- Treat as an improper RCE that does not stop the period for reply
- “Notice of Improper Request for Continued Examination” (Form PTO-2051) is prepared and mailed by the technical support personnel

### Examples:

- a) A reply to a final Office action includes the submission of IDS only
- b) An amendment that cancels all of the claims in an application without any new or substitute claims

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## RCE: Submission Not Fully Responsive (cont.)

If the submission is a bona fide attempt to provide a complete reply:

- Inform applicant, state the reasons why, and give a new shortened statutory period of one month or 30 days (whichever is longer) to complete the reply - Use FP 7.42.08

### Examples:

- a) Non-compliant amendment: an amendment that is not in compliance with 37 CFR 1.121
- b) Presentation of claims for different invention (i.e., applicant cannot switch inventions) – e.g., an amendment presenting only claims drawn to a non-elected invention

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## RCE and Application Status

- After *Ex Parte Quayle* action:
  - Must include a reply to the *Ex Parte Quayle* action
- After Allowance:
  - Includes, but not limited to, an IDS, amendment, new arguments, or new evidence
- After Appeal:
  - Must include a reply under 37 CFR 1.111 to the final rejection (May consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief)

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After Final Practice and RCE

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## RCE: After Appeal

- Before decision by the Board:
  - Treated as a request to withdraw the appeal and to reopen prosecution, regardless of whether the RCE is proper or improper
  - For Improper RCE:
    - No claim is allowed: the application is abandoned
    - At least one allowed claim: application is passed to issue on the allowed claim(s)
    - At least one claim is allowed but formal matters are outstanding, applicant has 1 month or 30 days to correct the formal matters (see FP 7.42.01-7.42.14)

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## RCE: After Appeal (cont.)

- Within 2 months of the decision by the Board, but before filing of a Notice of Appeal to the CAFC or commencement of civil action:
  - For proper RCE: appeal is withdrawn and prosecution is reopened
  - For Improper RCE: send PTOL-90 with FP 07.42.16

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## RCE: After Appeal (*cont.*)

For RCE filed After Appeal to the CAFC or civil action:

- Consult your SPE

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### Knowledge Check D

In an RCE, an amendment presenting only claims drawn to a non-elected invention is considered fully responsive.

- A) True  
 B) False

Incorrect - The correct answer is FALSE. Applicants cannot file an RCE on the basis of claims that are independent and distinct from the claims previously examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145 and MPEP 706.07(h)VI(B).

Click anywhere to continue

Correct - Click anywhere to continue

Your answer:

You did not answer this question completely

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## Summary

You should now be more familiar with the following:

- Patent examining procedure after Final Rejection
- Applicant's Responses After Final and the Associated actions required of the Examiner
- Policies regarding Examiner's Amendments, Advisory Actions, and Requests for Continued Examination (RCEs)

## Questions?

**Thank you**