

Best Practices After Final Office Action

Presented at:

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You Received A Final Office Action: Now What?

Traditional Approach

1. File A Final Office Action Response
 - Rule 116 Amendments; Additional Arguments
2. File A Request For Continued Examination (RCE)
 - Substantial Amendments
3. Appeal
 - No New Arguments Or Claims

Post-Final Programs Proliferating at USPTO

- Inexperienced Examiners
- Quality Of Examination Has Declined
- Pendency As A Success Measure
- USPTO's Budget Is Fraction Of Fees

Prosecution With Experienced Examiner Begins at Final Office Action

- Goal Of Post-final Programs Is Examination QC
- Poor Examination Has Different Problems
- Post Final Programs Have Different Advantages

Patent Office Trends Away From Appeals

- Appeals Consume USPTO Resources
- Examiners Do Not Like Writing Briefs
- Applicants Dislike Cost And Delay
- Post Final Programs Cut Appeals And Encourage Collaboration



Examination By Telephone

- Designed To Speed Prosecution (Extra Office Action)
- Designed To Reduce Appeals (Proposed Amendments)
- Just Because We Report Them Does Not Mean We Agree With Them
- Claims Still Only *Need* To Be Amended When Not Novel

New Post-Final Programs

1. File a Final Office Action Response
2. File a Request for Continued Examination (RCE)
3. Appeal

4. After Final Consideration Program 2.0 (AFCP)
5. Post-Prosecution Pilot Program (P3)
6. Pre-Appeal Brief Program

Selecting Which After-Final Program To Use

- How Urgent Is Patent Issuance
- How Important Is Claim Breadth
- How Important Is Cost
- Utilize WHIPgroup's Experience Based On Your Prosecution Priority

WHIPGroup's After Final Experience

- "Thanks to everyone at WHIP for your efforts and near-perfect record before the PTAB in the past 12-month period."

--In-House Patent Counsel of European Client

- Visit @PTAB Blog www.whipgroup.com/ptab For Strategic Insight

Steps in Considering a Post-Final Program

- Is Office Action Properly Final?
- Are Claims Novel Without Amendment?
- Is There A Non-art Rejection That Is Easy To Correct?
- Is Disagreement About Language Or Translation?
- Is Disagreement About Scope Of Prior Art?

Novelty and Appeal

- If Case Is Important, You Should Still Appeal Once There Are No Non-art Rejections And Claims Are Novel
- 80% Of Appeals Never Reach The Board
- If Rejections Are Just 103; Rce Should Not Be Necessary

Post-Prosecution Pilot (P3) Program

- Must Be Filed By 2 Month Date.
- Amendments Are Optional, But Cannot Be Broadening.
- No Substantial Amendments
- Required Presentation (“P3 Conference”) To Examiner, Another Primary Examiner, And Supervisor
- WHIPgroup Has USPTO Video Conference Capability Onsite

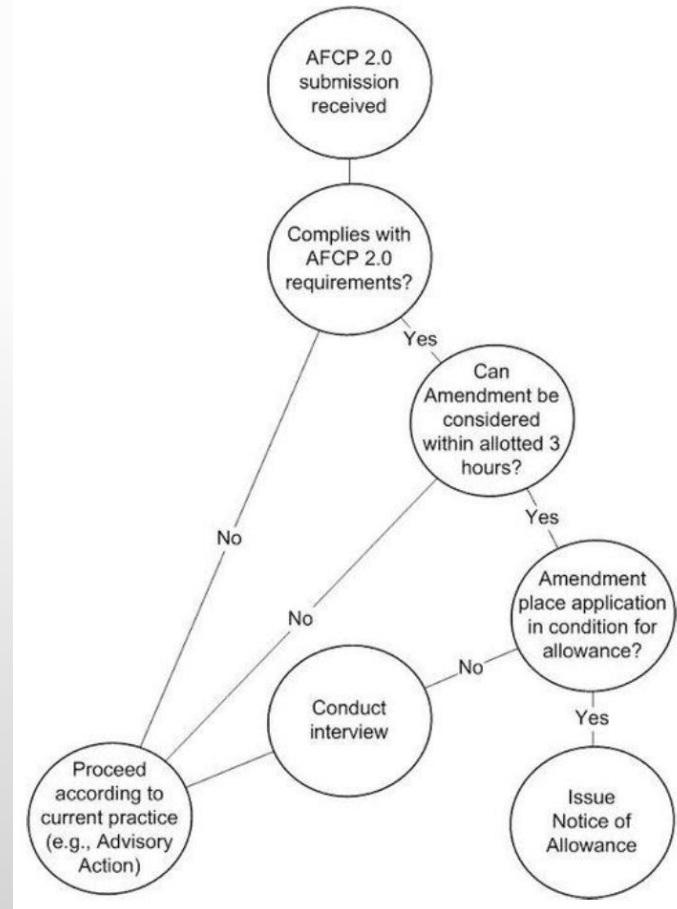


When to Request P3

- When You Believe Claims Are Novel
- Examiner Is Stubborn Or Underqualified
- If You Don't Want To Amend Claims And Therefore Cannot Do Afcpc
- Still A Pilot (Temporary) Program

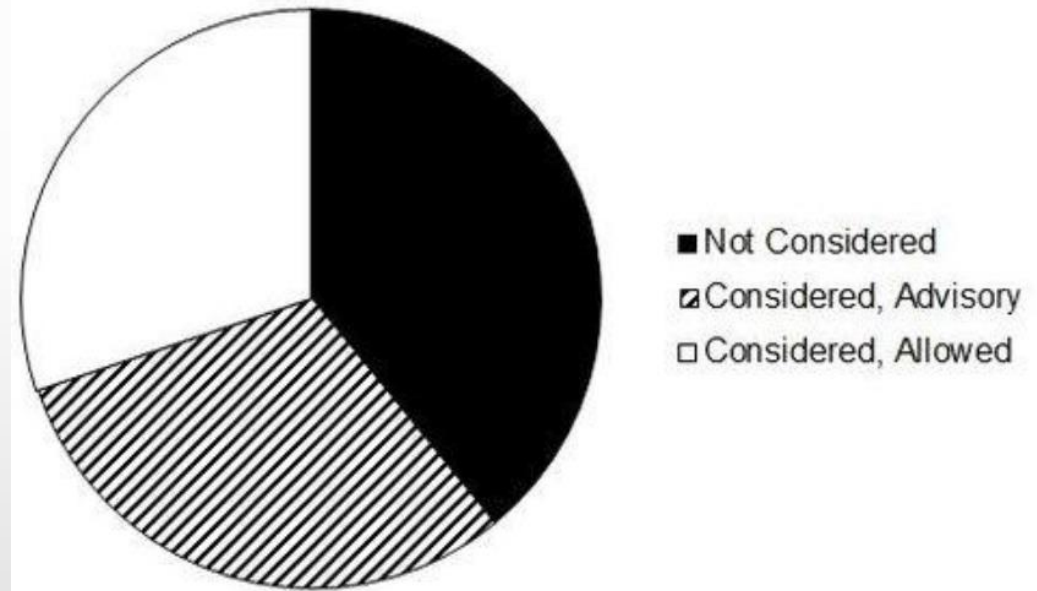
After Final Consideration Program (AFCP)

- Best If Filed Before 2 Month Date, But Can Be Filed After
- Required Amendment
- Interview With Examiner Upon Request



When to Use AFCP

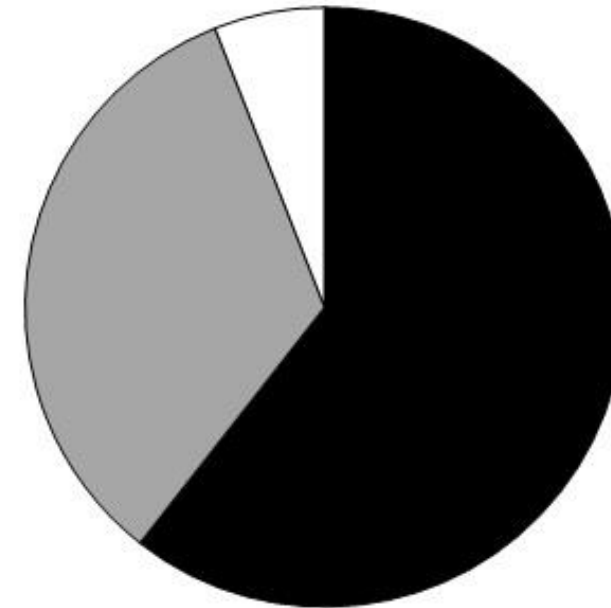
- When Minor Amendments Are Enough To Overcome Rejection
- Former Rule 116 Amendment
- Believe Current Examiner Can Be Convinced



Distribution of corp-wide outcomes of valid AFCP 2.0 requests.

Pre-Appeal Brief

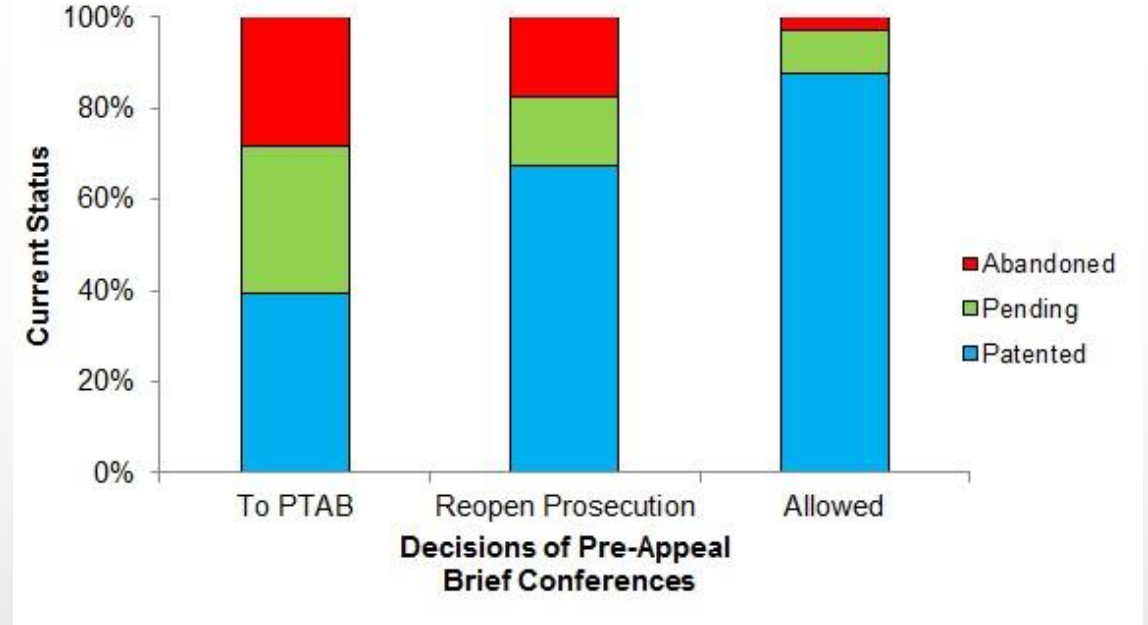
- File Anytime Before Abandonment
- Amendments And Interviews Not Allowed
- Must Pay USPTO Notice Of Appeal Fee



■ To PTAB ■ Reopen Prosecution □ Allowed

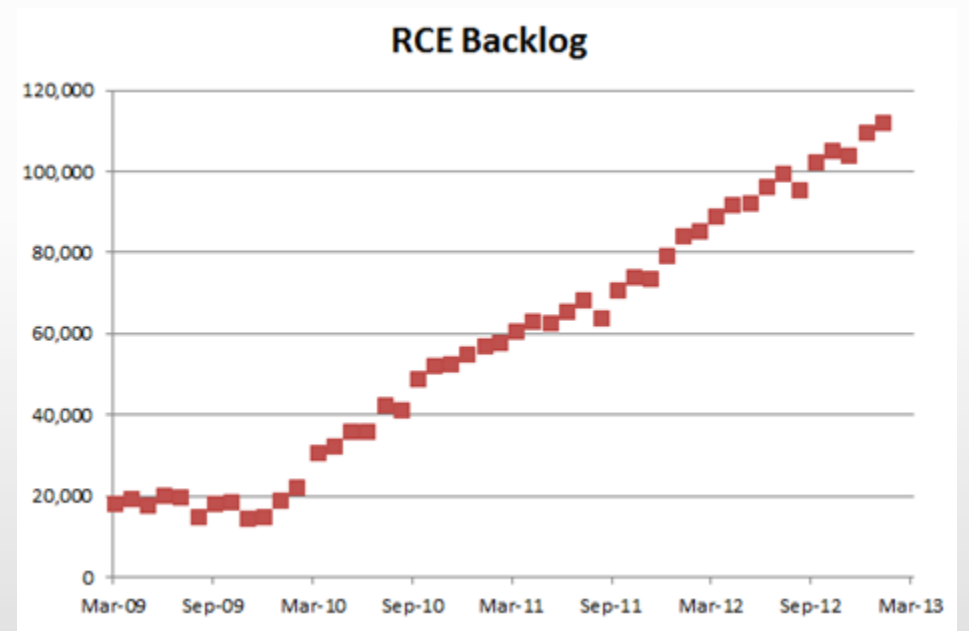
When to File a Pre-Appeal Brief

- When At Stalemate With Examiner And Applicant's Arguments Are Clear Winners And Simply Need Review By Other Examiners
- P3 Not Available By Date/Quota
- Should Exhaust Cheaper Options First



Request for Continued Examination (RCE)

- Re-enters The Application Into The Examination Process
- Any Time Before Abandonment
- Significant Amendments Allowed
- Substantial USPTO Fee

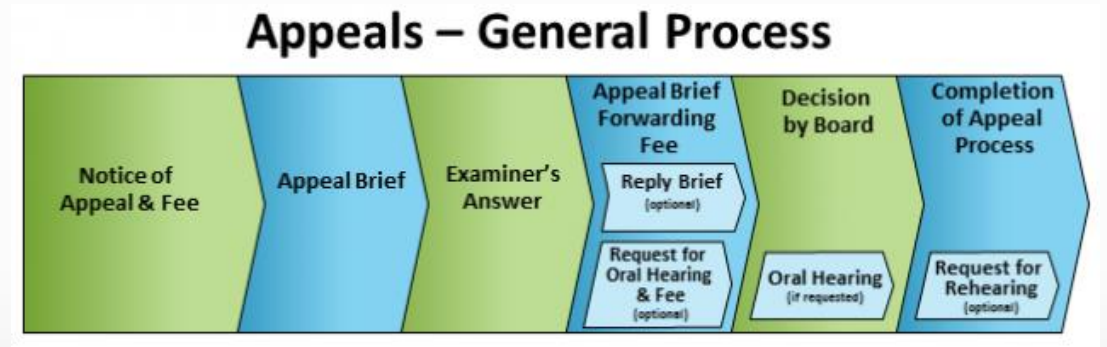


When to File RCE

- Examiner Won't Enter Amendment Needed For Novelty (Rule 116 Or AFCP Failed)
- If Significant Amendments Desired
- Arguments For Novelty Not Strong Enough For An Appeal

Appeal to PTAB

- Anytime Before Abandonment
- Amendments And Interviews Not Allowed (Nothing Done By Telephone)
- Substantial USPTO Fees For Notice Of Appeal, Forwarding Fee, And Oral Hearing
- WHIPgroup Has PTAB Video Conference Capability Onsite





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