



American Intellectual Property Law Association

November 8, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Attn: Raul Tamayo

Via email: afterfinalpractice@uspto.gov

Re: Comments of the AIPLA on Post-Prosecution Pilot Program (P3) 81 Fed. Reg.44845
(July 11, 2016) Docket No. PTO-P-2016-0012

Dear Under Secretary Lee:

INTRODUCTION

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the proposed P3 pilot changes to after-final practice.

The American Intellectual Property Law Association is a national bar association of approximately 14,000 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

COMMENTS

We commend the Office for initiating the Post-Prosecution Pilot Program. Almost all of the comments we received expressed the belief that the program will improve patent prosecution. While we believe that P3 is an improvement, we have concerns about its implementation and suggestions on how it may be improved. Our comments are divided into two sections. The first addresses the P3 pilot as articulated by the Office. The second addresses possible future pilots or other programs in view of some of the concerns regarding P3.

Direct comments on the P3 pilot:

P3 submission under 37 C.F.R. 1.116

We are concerned with two related issues: the permitted length of the P3 submission and the treatment of submissions that are refused consideration.

In particular, we believe that the five-page limit is too short to adequately address the many issues that can arise in prosecution of a patent application. Most final Office Actions include multiple rejections. Applicants may only be able to address one or two of these rejections within the five-page limit. Furthermore, in some instances, applicants may not be able to fully present their positions even on the single ground due to the page limits. We suggest that the Office either increase the page limit, at least in applications having multiple rejections, or provide some mechanism, such as a petition reviewed within the group or a fee, whereby an applicant may be able to ask to submit more than a five-page response. For example, when the Office Action has multiple rejections covering the independent claims, the applicant may petition to be allowed five pages of argument for each such rejection.

We are also concerned about how these submissions will be treated once the patent issues. Applicants should not be prejudiced as to issues they were not able to address due to page limits. Either non-compliant submissions should not be entered in the record or Applicant should be allowed to expunge them from the record. Furthermore, because there is no page limit on a submission under 37 C.F.R. § 1.116, Applicants should be allowed to submit a supplementary response to a Final Rejection when the P3 submission does not resolve all of the issues.

Petitionable matters should be considered

The line between petitionable and appealable matters is unclear, especially with petitions to the Director under 37 C.F.R. §§ 1.181, 1.182 and 1.183. Depending on the examiner, the same basic issue may be phrased as a petitionable matter or an appealable one. Often, the merits of appealable issues depend on petitionable ones. Many times, Petitionable issue are amenable to some sort of interactive intervention by other Office personnel to persuade the examiner to suggest amendments. Accordingly, where review of a petition is required to adequately address an issue in a finally-rejected patent application, proceedings should be stayed until a decision on the petition is issued.

Amendments

The Office should clarify handling of possible amendments other than those formally proposed. We note, in particular, that form PTO-2324 does not seem set up to address the possibility of an examiner's amendment.

The Office should consider the allowing for "auxiliary requests" as in EP oral proceedings practice. Allowing for a limited number of alternative amendments, at least to the independent claims, may greatly facilitate the finding of common ground. If the Office does not formally allow proposal of alternative amendments, perhaps the Office should encourage applicants to achieve the same result by including the alternatives in their argument.

P3 interviews should allow for greater interaction

We are concerned that applicant's representatives are not allowed to ask questions during the P3 conferences. The limitation seems both difficult to enforce and unnecessarily limiting on the options for finding common ground such as allowable subject matter or an agreed upon claim construction that could advance the case. Any issues as to the amount of interaction allowed may be addressed by limiting the length of the conference. For example, many cases involve issues of interpretation of claim elements. There may be issues of what the examiner's interpretation is, whether that interpretation is reasonable, and whether a simple amendment could overcome a rejection based on such an interpretation. Because they were not involved in the prosecution, the other panel members may not be aware of these issues. Addressing these issues requires an interaction among applicant's representative and panel members. Our members have reported only a few preliminary experiences with P3. Based on these experiences, however, they believe that greater panel participation would be beneficial.

Central Reexamination Unit (CRU) panel interviews for reexaminations and reissues seem like a good guidepost on which to model the P3 panels. In CRU panels, there often can be a lively give-and-take between the applicant's attorney and the panel that facilitates a better exploration of the case and issues. At least a small portion of Applicant's presentation should be able to be reserved for an exchange between the applicant's representative and the panel members. For example, applicant's representative may be allowed to reserve the final 10 minutes of the presentation for an exchange of questions, ideas and opinions. Regardless of whether the CRU panel model is used, the P3 conferences should be documented in the same way as CRU panel interviews to ensure that the reasons for any decision made during the conference is on the record.

Effectiveness of P3

We are also concerned about the effectiveness of P3. We note that many of our members reported good results with AFCP 2.0 when it was first introduced. They now find diminishing returns from the use of the program and fear that P3 will suffer the same fate. The problems with AFCP 2.0 may be a result of the limited amount of time granted to the

examiner to consider an AFCP submission. Thus, we suggest that the Office review the performance of the P3 panels with an eye to allowing greater interaction and more time for the panel members to consider the merits of the application.

Furthermore, we are concerned about the selection of conferees. Limits should be placed on the discretion of the SPE selecting the panel to ensure the presence of at least one person whose position relative to the examiner or other conferees allows for objective and meaningful input. This might involve at least one other SPE, SPRE, QAS or primary examiner familiar with the technology but not involved in the prosecution of the application and not in a supervisory relationship with the examiner. Moreover, this person should not be selected by the other conferees but should be independently selected, perhaps by the Technology Center Director.

To save time, the examiner in charge of the application should be encouraged to meet with the other conferees before scheduling the presentation to determine whether the P3 submission puts the application in condition for allowance. When it is determined that the submission is sufficient for allowance, the examiner should contact the applicant to notify the applicant that the application will be allowed possibly with an examiner's amendment.

Scheduling of P3 interviews

There should be a specified, limited period following the filing of the P3 request for the Office to contact the applicant to schedule the conference. We note that there seems to be an inconsistency on when the interview must occur. The AIPLA concurs with the body of the notice in that the agreement on interview timing (not the interview itself) must occur within ten days of contact.(81 FR 44848, col. 2). The discussion at <https://www.uspto.gov/patent/initiatives/post-prosecution-pilot> however states:

Pilot Process

1. The Office will contact the applicant to schedule the P3 conference. Such contact should result in a P3 conference within ten calendar days of the initial contact with the applicant or the P3 Request could be considered improper at that time.

The reference to the interview (rather than the scheduling) occurring within ten days and the permissive “should” are confusing.

Additional comments relative to future pilots and other practice changes:

We suggest the following be taken into consideration to improve the patent process.

1. Consider a Fast Track Appeal somewhat similar to Track I prosecution where the appellant could pay an increased appeal fee to accelerate the appeal. Alternatively, an applicant may be allowed to pay more for a P3 conference to obtain more time for a presentation or to be able to present more than five-pages of argument.

2. While the P3 conferences may improve after final practice, our members continue to believe that the decline in after final practice over the last two decades has made the current Compact Prosecution model less compact than it should be. Long ago, prior to AIA, AIPA, and The Uruguay Round, there was meaningful after-final practice. Somewhat like practice before the European Patent Office. Finality imposed a deadline to come to agreement with the examiner. Examiners were more than willing to propose, not merely consider, even substantive after-final amendments to obtain allowance. Now, examiners will often refuse to enter even minor amendments. This behavior may have resulted from the law of unintended consequences. The evolution from Continuing Prosecution Applications (CPAs) to File Wrapper Continuations (FWC's) to Requests for Continued Examination (RCEs) have made it procedurally easier to continue prosecution. Appreciating this, examiners have cut back on after-final practice.

Similarly, it appears that AFCP 2.0 has had unintended consequences. An examiner seeing that an Applicant is willing to put the effort into an AFCP 2.0 request and interview may infer that the Applicant is also willing to file an RCE. Some form of encouragement is needed for examiners to engage in meaningful after-final practice, particularly on interpretational issues.

CONCLUSION

AIPLA acknowledges the effort by the USPTO to improve after final practice. These comments have been provided in the spirit of making proposed changes in a way that is compatible with the needs of our members. Thank you for allowing AIPLA the opportunity to provide comments on the proposed P3 pilot.

Sincerely,

A handwritten signature in dark ink, reading "Mark L. Whitaker". The signature is fluid and cursive, with the first name "Mark" being the most prominent.

Mark L. Whitaker
President
American Intellectual Property Law
Association