After Final Practice and Request for Continued Examination (RCE)

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Objectives

You will become more familiar with patent examining procedure after a final rejection including:

• After final interviews
• After final replies
• Practice after final: Notice of appeal
• Practice after final: Examiner’s amendments
• Practice after final: How to handle a request for continued examination (RCE)
• After Final Consideration Pilot 2.0
• Quick Path IDS (QPIDS)
After final rejection: Interview practice

- 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).

  *MPEP 706.07(f)(III)*

- Normally, 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*
After final rejection: Interview practice (cont.)

Interviews (personal and telephone) must include an examiner who has negotiation authority, and who is familiar with the application.

*MPEP 713.05*
After Final Replies
Applicant’s options after final are limited

To avoid abandonment, applicant’s reply options are:

• Filing an after final reply (37 CFR 1.116)
• Appealing any rejections (37 CFR 41.31) or
• Filing an RCE (37 CFR 1.114)

MPEP 706.07 and 714.13(II)
After final rejection, applicant has no right to unrestricted further prosecution

• 37 CFR 1.116 applies to replies filed after final action and prior to appeal

• Once a proper final rejection has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution

MPEP 714.12

• Ordinarily, amendments filed after the final action are not entered unless approved by the examiner
Advisory actions

If the after final reply does not place the application in condition for allowance, an advisory action (PTOL-303) should be sent to the applicant stating the remaining period for reply. If no notice of appeal was filed:

- Normally, the reply period continues to run 3 months from the mailing date of the final rejection plus any extensions of time paid for

- However, if the advisory action is mailed more than 3 months after the mailing date of the final rejection in response to an after final reply filed within 2 months of the mailing date of the final rejection, the SSP ends on the mailing date of the advisory action consistent with the variable reply period conditions stated on the previous slide
6 month statutory reply period

The statutory period for reply will never expire later than six months.

For example, if applicant’s reply to the final rejection was filed 1.5 months after the mailing date of the final rejection and the examiner’s advisory action was mailed 3.5 months after the mailing date of the final rejection, the SSP will end on the 3.5 month date. (See the second bullet of the previous slide.) However, the applicant would only be able to extend the time period for reply by 2.5 months due to the 6 month statutory limit on the period for reply. In addition, if the applicant in that scenario filed, for example, a notice of appeal, an RCE, or a continuing application on the 6 month date, the applicant would be required to pay a full 3 months extension of time even though the extendable period was only 2.5 months.
“After final” amendments not entered as a matter of right

After final replies can include an after final amendment under 37 CFR 1.116

• 37 CFR 1.116 is much more restrictive than 37 CFR 1.111 which concerns replies to non-final office actions

• Applicant can present an amendment after final rejection to file a request for continued examination (RCE) under 37 CFR 1.114

• In rare instances, applicant can present an amendment after the mailing of an examiner’s answer and prior to the fee to forward an appeal to the Board:
  – To cancel all appealed claims and proceed to issue with claims previously indicated as allowable or
  – Where the examiner is convinced that some but not all of the previously rejected claims are in condition for allowance.
Purpose of an “After Final” amendment

The purpose of allowing applicant to present certain types of amendments after prosecution is closed is to reduce pendency

- The policy contemplates that within the statutory period for response, the case may be put in either:
  - *Condition for allowance*, or
  - *Better condition for appeal*
Amendments filed after final rejection

The types of after final amendments that may be entered are:

1) To cancel claims or comply with any requirement of form expressly set forth in a previous action

2) To present rejected claims in better form for consideration on appeal or

3) For an amendment touching the merits of the application upon a showing of **good and sufficient reasons** why the amendment is necessary and was not earlier presented

37 CFR 1.116(b)(1), (2), and (3) and MPEP 714.13(II)

Note: If an examiner can readily determine that a proposed amendment will place an application in condition for allowance, the final amendment may be entered
After final amendments are NOT entered in part

- Amendments after final are either “entered” or “not entered.” They are NOT “entered in part.”

- If part of the amendment would be acceptable, notify applicant as to which portions would be acceptable for placing some of the claims in better form for appeal, comply with objections or requirements as to form, or render certain claims allowable or make an examiner’s amendment.

MPEP 714.12, 714.13, and 714.20
Action by examiner: After final amendment Not entered

If the after final amendment or submission does not place the claims in condition for allowance or in better form for appeal, an advisory action - PTOL-303 should be sent out

MPEP 714.13(III), 706.07(f)
Action by examiner: After final amendment not entered (cont.)

Exemplary reasons for non-entry listed on Advisory Action Form:

• The amendment does not place the application in better form for appeal
• The claims, if amended as proposed, would raise the issue of new matter and the new matter should be identified
• The claims as amended present new issues requiring further consideration or search where reasons why the proposed amendment would raise new issues should be provided; and/or
• The amendment presents additional claims without canceling any finally rejected claims and is not considered as placing the application in better condition for appeal

MPEP 714.13(III), 706.07(f)
Affidavit filed after a final office action

An affidavit or other evidence may be admitted after final rejection upon a showing of good and sufficient reasons as to why:

• It is necessary, and
• It was not earlier presented

37 CFR 1.116(e) and MPEP 714.13
Special case – Entering amendment with proposed rejection(s)

MPEP 714.13 Amendments and Other Replies After Final Rejection or Action, Procedure Followed

FP 7.169 Advisory Action, Proposed Rejection of Claims, Before Appeal Brief

For purposes of appeal, the proposed amendment(s) will be entered, and the proposed rejection(s) detailed below will be included in the examiner’s answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal:

Claim(s) [1] would be rejected for the reasons set forth in [2] of the final office action mailed [3]
Practice after final: Notice of appeal
Filing of a notice of appeal after a final rejection

Remember, after a final rejection, applicant’s reply options are:

• Filing an after final reply (Rule 1.116)
• **Appeal of any rejections (Rule 41.31)** or
• Filing an RCE (Rule 1.114)
If the appeal is filed after a final rejection, the order of filing an after final amendment, notice of appeal, and appeal brief determines which of either 37 CFR 1.116 or 41.33 controls the entry of the after final amendment
Filing of a notice of appeal after a final rejection (cont.)

• An after final amendment filed before the appeal brief is treated under 37 CFR 1.116
• An amendment (regardless of finality) filed with or after the appeal brief is treated under 37 CFR 41.33(b) and may only be entered to:
  – Cancel claims, where the cancellation does not affect the scope of any other claim, or
  – Rewrite dependent claims into independent form
Filing of a notice of appeal after a final rejection (cont.)

However, if appellant files an after final amendment, a notice of appeal, and an appeal brief on the same date after the mailing of a final action, 37 CFR 1.116 applies.
Practice after final: Examiner’s amendments
Examiner initiated interviews

If the examiner is aware of claim amendments that would place the application in condition for allowance, there may be an opportunity for an examiner-initiated interview to expedite allowance and to facilitate compact prosecution.
Examiner's amendments

Typically used to cancel or amend claims, but also to make formal corrections to the application, including the drawings and the specification

• Must be signed by a primary examiner
• Must be authorized by applicant in a formal interview (personal or telephone)
• When an examiner’s amendment is made to the drawings, applicant still must provide replacement drawings reflecting the changes made by the examiner’s amendment

MPEP 1302
Examiner’s amendments: Extension of time

A complete first reply to a final office action filed within 2 months:

• An examiner’s amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner’s amendment is made more than 3 months from the date of the final office action.
  - However, an examiner’s amendment cannot be made after 6 months statutory time period.

MPEP 706.07(f)(II)
Examiner’s amendments: Extension of time (cont.)

A complete first reply to a final office action filed after 2 months:

• Applicant’s authorization to make an amendment to place the application in condition for allowance must be made either within the 3-month SSP or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a)
  – However, 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
Examiner’s amendments: Extension of time (cont.)

A complete first reply to a final office action filed after 2 months (cont.):

- Where an extension of time not to exceed 6 month statutory period is necessary to place an application in condition for allowance (e.g., 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)
Ex parte Quayle

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 may be required to be corrected in an Ex parte Quayle action if the application is otherwise in condition for allowance

• No extension fees would be required

• Consider instead of an Ex parte Quayle action an examiner’s amendment to resolve formal matters
Practice after final: RCE
Practice after final

After final rejection, applicant’s reply options are:

- Filing an after final amendment (Rule 1.116)
- Appeal of any rejections (Rule 41.31); or
- Filing an RCE (Rule 1.114)
RCE — What is It?

• A procedure set forth in 37 CFR 1.114 under which an applicant may obtain continued examination of an application in which prosecution is closed (i.e., the application is under 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

*MPEP 706.07(h)*
RCE — What is It? (cont.)

• An RCE is **not** the filing of a new application.

• If applicant timely files a submission and fee, the office will **withdraw the finality** of any office action and the submission will be entered and considered.

*37 CFR 1.114*
RCE — Availability

Applies to:

• **Utility or Plant Applications** filed under 35 U.S.C. 111(a) on or after June 8, 1995; or

• **International Applications** filed under 35 U.S.C. 363 on or after June 8, 1995 (that comply with 35 U.S.C. 371)
RCE — Availability (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, or an international application that does not comply with 35 U.S.C. 371

D. An application for a design patent

E. An international design application; or

F. A patent under reexamination
RCE — Conditions

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 challenging an affirrmance by the Patent Trial and Appeal Board (PTAB) (unless the appeal or civil action is terminated)
RCE - First action final (cont.)

Claims of an RCE application may be finally rejected in the action immediately subsequent to the filing of the RCE where all the claims in the application after the entry of the submission:

- Are either identical to or patentably indistinct from the claims in the application prior to the entry of the submission, and

- Would have been properly finally rejected on the grounds and art of record in the next office action if they had been entered in the application prior to the filing of the RCE

MPEP 706.07(b)
If applicant filed a submission under Rule 1.116:

• It would not be proper to make final a first office action in an RCE where that application contains material presented after final rejection but was denied entry because:
  
  – New issues were raised that required further consideration and/or search, or
  – The issue of new matter was raised

MPEP 706.07(b)
Additionally, it would **not** be proper to make final a first office action immediately after the filing of an RCE **if** the first office action includes a new ground of rejection.

*MPEP 706.07(h)(VIII)*
RCE — Submission requirement

• 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)

• Mere request for RCE and payment of the fee – not sufficient to avoid abandonment of the application

• Submission can be:
  – An amendment to the written description, claims, or drawings
  – New arguments
  – New evidence in support of patentability, or
  – An information disclosure statement in an application subject to a notice of allowance under 35 U.S.C. 151, but not in an application where the last office action is a final rejection or an office action under *Ex parte Quayle*
RCE – Submission not a *bona fide* reply

Examples:

a) A reply to a final office action includes the submission of IDS only

b) An amendment that would cancel all of the claims in an application and without any new or substitute claims
RCE — *Bona fide* reply but not fully responsive

Examples:

1) Non-compliant amendment: an amendment that is not in compliance with 37 CFR 1.121

2) Presentation of claims for different invention (*i.e.*, applicant cannot switch inventions) - *e.g.*, an RCE filed with an amendment canceling all claims drawn to the elected invention, and presenting only claims drawn to a non-elected invention
RCE — After allowance or Ex parte Quayle

• 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

*MPEP 706.07(h)(II)*
RCE – After appeal, before decision by the board

• Must include a reply to the final rejection. (May consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief)

• **Filing of an RCE** will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner, regardless of whether the RCE is proper or improper

  37 CFR 1.114(d) and MPEP 706.07(h)(X)
RCE – After appeal, before decision by the board (cont.)

For Improper RCE filed after appeal:

- If no claim is allowed, application is abandoned
- Claims that are allowed except for their dependency from rejected claims will be treated as if they were rejected
- If at least one allowed claim, application should be passed to issue on the allowed claim(s)
- If at least one claim is allowed but formal matters are outstanding, applicant should be given two months to correct the formal matters. (FP 7.42.10-7.42.14)

MPEP 706.07(h)(X)(B)
RCE – After decision by the board

• Within sixty-three days of the decision by the board (MPEP 706.07(h)(XI)), but before filing of a notice of appeal to the Court of Appeals for the Federal Circuit (CAFC) or the commencement of a civil action in federal district court:
  – For a proper RCE: Appeal is withdrawn and prosecution is reopened.
  – For an improper RCE: Send PTOL-90 with FP 07.42.16

• After appeal to the CAFC or civil action, the filing of an RCE is not available unless the appeal or civil action is terminated and the application is still pending. The examiner should consult their SPE or QAS. MPEP 706.07(h)(XII)
After Final Consideration Pilot 2.0 (AFCP 2.0)
AFCP 2.0

• At the time of submitting an after final amendment under 37 CFR 1.116, applicant may additionally request additional consideration under the after final consideration pilot

• Examiner can get up to 3 hours non-production time to perform additional examination to determine allowability
Purpose of AFCP 2.0

• The purpose of the AFCP 2.0 is to reduce pendency by increasing the number of applications that are allowed after final and/or reducing the number of RCEs

• Applicant applies by submitting a request (Form PTO/SB/434 or equivalent)

• Only one AFCP 2.0 request may be filed in response to an outstanding final rejection
AFCP 2.0 (cont.)

Application must:

• Have an outstanding final rejection.
• Have been filed under either 35 U.S.C. 111(a) or 371(c).
• Have a request for AFCP 2.0
• Amend at least one independent claim that does not broaden the scope of that claim in any aspect.
• Include a statement that applicant is willing and available to participate in an examiner initiated interview concerning the response
Applicant submits request for AFCP 2.0

Examiner reviews the AFCP 2.0 request to ensure it is a proper request*

Proper Request

Review Amendment

Pre-Pilot Practice or AFCP 2.0?

AFCP 2.0

Improper Request

Mail appropriate response under pre-pilot practice

Pre-Pilot Practice

Top Half
AFCP 2.0 (cont.)

- If submission is incomplete, or request is improper, examiner should process the after final submission under 37 CFR 1.116 (pre-pilot practice)

- If request qualifies for AFCP 2.0, examiner reviews amendment and determines:
  - If additional search and/or additional consideration would be required and is NOT possible within time allotted by AFCP 2.0, the process response under 37 CFR 1.116 (pre-pilot practice)
Some factors (not exhaustive) that might require more time to search and consider the amendment than is provided for in AFCP 2.0:

- Claims added
- Complexity of the amendment
- At least one added claim is directed to a different invention (possible restriction).
- Prior after final interviews or traditional after final submissions
AFCP 2.0 (cont.)

If the examiner determines:

1) No additional search/consideration is needed, or
2) Additional search/consideration required could be completed within time allotted,

then after completing any search and/or additional consideration, the examiner will consider whether the amendment places the application into condition for allowance.
AFCP 2.0 flow chart: Bottom half

- **Mail Allowance**
  - YES: Case Allowable?
  - NO: Examiner-initiated interview conducted ≤ 10 days?
    - NO: Mail Advisory Action
    - YES: Case Allowable?
AFCP 2.0 (cont.)

If the examiner determines the amendment places the application in condition for allowance, the examiner will:

• Enter the amendment, and
• Mail out the notice of allowance
AFCP 2.0 (cont.)

If the examiner determines the amendment does NOT place the application in condition for allowance, the examiner will request an interview with the applicant.
Quick Path IDS (QPIDS)
QPIDS

• QPIDS is designed to allow applicant submissions of prior art after a final office action, after the mailing of a notice of allowance, and even after the payment of the issue fee

• If the QPIDS is submitted after payment of the issue fee, an RCE must be filed with the QPIDS but will not be processed unless the art necessitates reopening prosecution
3 paths for QPIDS

- **Path 0**: IDS filed after a final rejection and prior to disposal, requires:
  - IDS, IDS fee, Certification under 37 CFR 1.97(e)

- **Path 1**: IDS filed after the mailing of a notice of allowance and prior to or with payment of the issue fee, requires:
  - IDS, IDS fee, Certification under 37 CFR 1.97(e)

- **Path 2**: IDS filed after the payment of the issue fee, requires:
  - PTO/SB/09 Form (“QPIDS.REC” in IFW),
  - IDS, IDS fee, Certification under 37 CFR 1.97(e),
  - Web ePetition to withdraw from issue and petition fee,
  - RCE (PTO/SB/30) and RCE fee, and
  - Authorization to charge all fees associated with the QPIDS to a USPTO deposit account (included on PTO/SB/09 Form)
Summary

You should now be more familiar with the following:

- After final interviews
- After final replies
- Practice after final: Notice of appeal
- Practice after final: Examiner’s amendments
- Practice after final: How to handle a request for continued examination (RCE)
- After Final Consideration Pilot 2.0
- Quick Path IDS (QPIDS)
Other resources

After Final Consideration Pilot 2.0 (AFCP 2.0):
Examiner Link: http://ptoweb.uspto.gov/patents/pai/afcp.html
External Stakeholders Link: www.uspto.gov/patents/init_events/afcp.jsp

Quick Path Information Disclosure Statement (QPIDS):
Examiner Link: http://ptoweb.uspto.gov/patents/pai/qpids.html
External Stakeholders Link: www.uspto.gov/patents/init_events/qpids.jsp

Examiner Interview Resources:
http://ptoweb.uspto.gov/patents/interview-resource/training.html