

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Special Programs for Patent Prosecution An Overview

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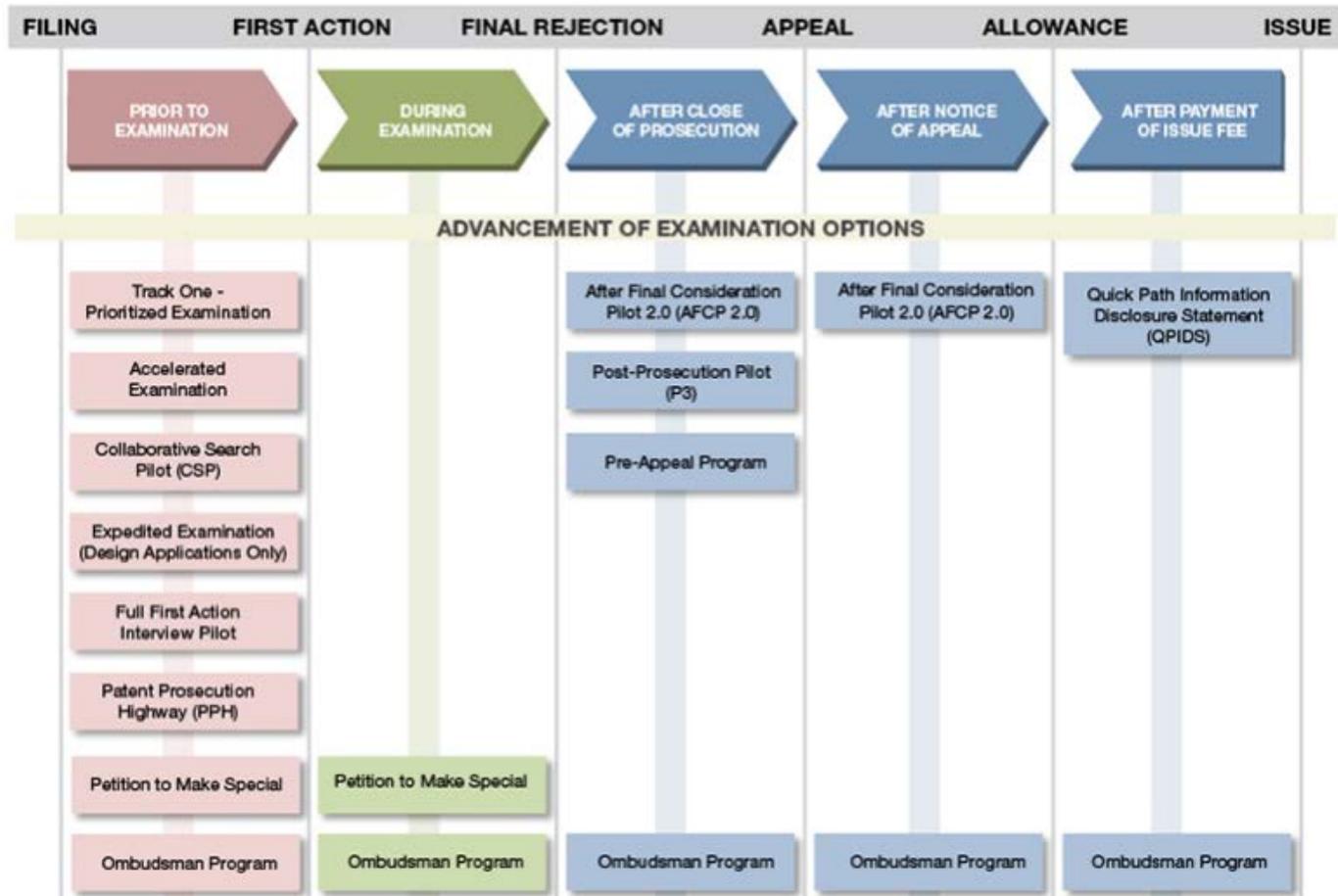
Supervisory Patent Examiner, TC 1600

BCP Meeting - 10/19/2016

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# Application Initiatives'- Timeline



# Ombudsman Program

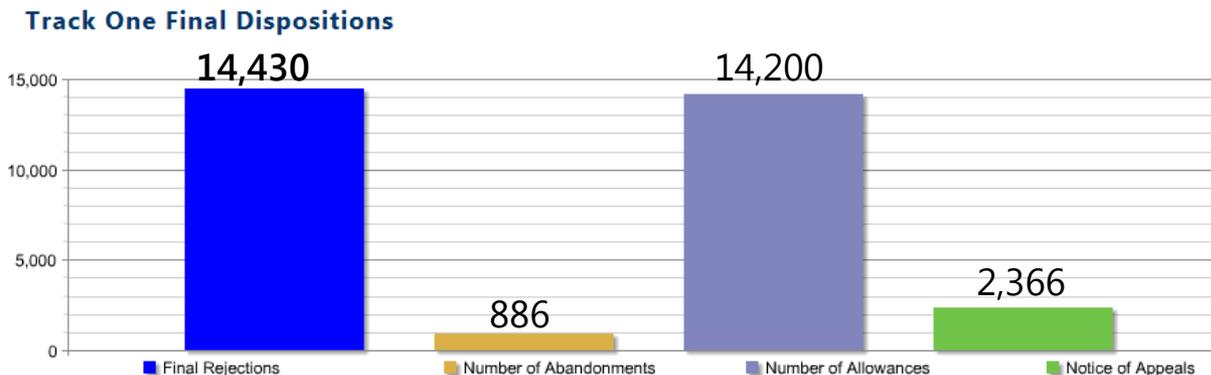


- ❖ Enhances the USPTO's ability to assist applicants with issues that arise during prosecution of an application
- ❖ Applicants contact the program by e-mail or telephone
- ❖ Top five inquiries: After Final; Customer Service; Petitions Certificates of Correction; Case Prosecution Problems
- ❖ Available at all stages of patent prosecution
  - ❖ Issues currently addressed within ~3 business days
  - ❖ Allows identification of training needs based on identified trends (complaint data)
- ❖ Ombudsman may address the complaint directly, or route to e.g. SPE or TC Director
- ❖ 14,623 inquiries from start of program (April 2010) to May 2015
- ❖ Annual survey results: 68% would recommend the program to others



# Track One (Prioritized Examination) 9/2011 (MPEP 708.02(b))

- ❖ First action in less than 5 months; final disposition within 12 months (on average)
  - Request must be via EFS web with fee at time of filing (CONS and RCEs eligible)
  - Limit of 10,000 Applications per fiscal year; Follows normal interview practice
  - Limited to no more than 30 total claims (maximum of 4 independent claims)
  - No special examination rules; Applicant cannot file an extension of time and remain in the Program

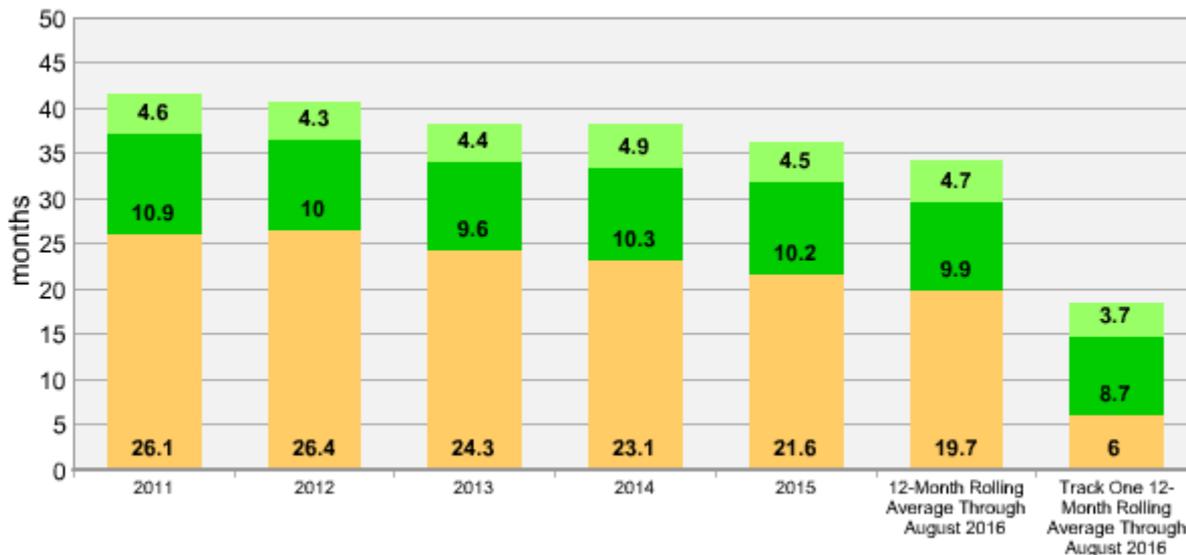


The Track One final disposition numbers displayed are broken out by final rejections, abandonments, allowances and notice of appeals. The totals are cumulative since inception of the program.

Cumulative Through  
August 2016



# Total Pendency Time Until Final Disposition (All Applications vs. Track One)



The data is cumulative for the year and breaks out time into three categories: prosecution time with the office, time awaiting first action, and prosecution time with the applicant.

- Prosecution Time With Office
- Prosecution Time With Applicant
- Time Awaiting First Action

- ❖ Track One pendency from petition grant to first Office action is 2.1 months
- ❖ Average pendency to first Office action in TC 1600 is 12.6 months vs. 19.7 for the corps.
- ❖ Total pendency in TC 1600 is 24.8 months vs. 33.3 for the corps.



# Accelerated Examination

## 8/2006 (MPEP 708.02(a))



- ❖ Upon grant to make Special, provides a final disposition within twelve months
  - Except based on PPH Program, Applicant's age or health
- ❖ Requires EFS-Web filing: Limited to three independent claims and no more than 20 total claims
- ❖ Must file for a single invention or agree to elect without traverse a single invention
- ❖ Requires preexamination search documents and an examination support document (IDS), with claimed limitations mapped to the cited references
- ❖ Examiner interview required before issuing an Office Action (within 2 weeks of contact)
- ❖ Continuations are eligible for the program; No limit on number of applications admitted to the program per year
- ❖ Applicant agrees not to separately argue patentability of any dependent claim if an Appeal Brief is filed

# Patent Prosecution Highway (PPH) (Global and IP5 – 1/2014 – MPEP 708.02(c))



- ❖ Currently 21 countries (and EPO) participating
  - No claim number limit; No fee
  - Entry based upon at least one allowable claim in counterpart foreign application (whether PCT or national work product)
  - All the eligible countries can use a single request form
  - Fast-track accelerated examination (Special)
  - Follows normal restriction and interview practice
  - CONs are eligible for the program (before first action is issued)
  - No limit on number of applications admitted to the program per year
  - As of July 31, 2016 33,796 petitions have been granted
  - Higher allowance rates



# Collaborative Search Pilot (CSP) (JPO – 8/2015; KPO – 9/2015)

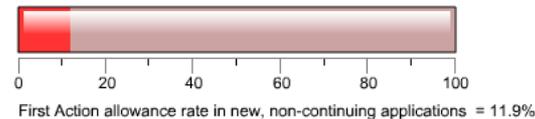
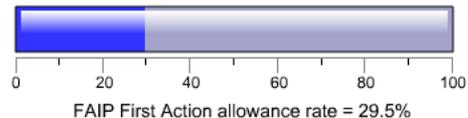
- ❖ Allows an applicant with a corresponding application in either Japan or Korea to request a collaborative serial (JPO) or parallel (KIPO) search prior to entering the full first action interview pilot Program
  - JPO-USPTO Pilot – 200 per year, each (effective 8/15-7/17)
  - KIPO-USPTO Pilot – 400 per year, each (effective 9/15-8/17)
- ❖ Application requirements:
  - Claim limits – 3 Independent/20 Total
  - Claims must correspond between Offices
  - Directed to a single invention
- ❖ Potential benefits to Applicants:
  - Free
  - Greater consistency in examination across Offices leading to more certainty of IP rights
  - Application is taken out of turn resulting in expedited search and final disposition

uspto

# Full First Action Interview Pilot (10/2009)



- ❖ Open to all technology areas (all utility applications)
  - Limited to three independent claims and no more than 20 total claims
  - Must claim only a single invention
- ❖ Follows current restriction practice
- ❖ If not allowable, a Pre-interview Communication is issued, citing relevant prior art and identifying proposed rejections and objections; setting a 30 day time period to request or deny an interview
- ❖ Following interview, proceeds in accordance with current examination procedures



August 2016

# Petition to Make Special (MPEP 708.02)



- ❖ Fast-track review of Applications out of turn based on:
  - Health or age ( $\geq 65$ ); with evidence
  - Subject matter:
    - e.g. Invention will materially enhance the environment; Contribute to the development or conservation of energy resources; or Contribute to countering terrorism;
    - Cancer Immunotherapy Pilot Program (National Cancer Moonshot)
      - Claimed method must be subject of an active IND application at the FDA, that has entered phase II or phase II clinical trials
      - No more than three independent and twenty dependent claims
  
- ❖ No petition fee

# After Final Consideration 2.0 (AFCP 2.0) Pilot (5/2013 – 9/2017)



- ❖ Applicant must file a response under 37 CFR §1.116, and a non-broadening amendment to at least one independent claim.
  - Examiners are allotted an extra 3 hours to search and/or consider amendments and conduct an interview.
  - Applicant benefits from the additional search and consideration, even when the results do not lead to allowance.
- ❖ Potential outcomes:
  - Final rejection(s) maintained – Advisory
  - Allowance
- ❖ Applicant options (if rejection maintained):
  - Appeal
  - RCE
  - Abandon

# After Final Consideration 2.0 (AFCP 2.0) Results



- ❖ Since inception through Sept. 9, 2016, 187,790 requests filed
  - Approximately 40% of AFCP 2.0 requests are provided additional consideration by examiners
  - Resulting in 48,721 allowances (26%)
  - Appeal briefs subsequently filed in only 3% of applications; compared to 6.8% for traditional After Final submissions

# Pre-Appeal Brief Conference Pilot Program (Pilot 7/2005-present)



- ❖ Allows applicants to request that a panel of examiners formally review the legal and factual basis of the rejections prior to the filing of an appeal brief
  - Applicant must file a request, together with a Notice of Appeal, and a five-page or less set of arguments
  - Only fee required is for the Notice of Appeal
  - Panel includes at least a supervisor and the examiner of record. May include an additional examiner or supervisor
- ❖ Panel decisions:
  - Proceed to the Board
  - Reopen Prosecution
  - Allowance
  - Defective Request

# Post-Prosecution Pilot (P3)



- ❖ Developed to test its impact on enhancing patent practice during the period subsequent to final rejection and prior to filing of a notice of appeal by
  - Incorporating the effective features of AFCP 2.0 and Pre-Appeal Brief Conference Pilot programs and providing Applicants an opportunity to present oral arguments to a panel of at least three, that includes the examiner of record and a SPE
  - Request must be filed within two months of the mailing of a Final rejection; No fee is required
  - Applicant's submission is limited to five pages of arguments, exclusive of any optional non-broadening claim amendments, but inclusive of any evidence
- ❖ Panel decision includes an explanation for the following outcomes:
  - Final Rejection Upheld
  - Allowable Application
  - Reopen Prosecution

# Post-Prosecution Pilot (P3) Decision Form



<b>Notice of Decision from Post-Prosecution Pilot Program (P3) Conference</b>	Application Number	Applicant(s)	
	Examiner	Art Unit	AIA Status

This is in response to the P3 request filed \_\_\_\_\_. A conference has been held.

1.  **Final Rejection Upheld:**

The status of claims has been determined as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

The following rejections have been withdrawn:

\_\_\_\_\_

\_\_\_\_\_

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.

For purposes of appeal, the proposed amendment:  (a) will be entered, or  (b) will not be entered (**see box 4 below**).

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.**

2.  **Allowable Application:** The rejection(s) is/are withdrawn, and this Notice of Decision is being mailed concurrently with a Notice of Allowance.

3.  **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.

4.  **Explanation of Decision for Boxes 1-3:** \_\_\_\_\_

5.  **Attachments:** \_\_\_\_\_

List of Participants:

(1) \_\_\_\_\_ (3) \_\_\_\_\_

(2) \_\_\_\_\_ (4) \_\_\_\_\_

# Post-Prosecution Pilot (P3)



## Comparison of various features of the AFCP 2.0, Pre-Appeal Brief and P3 Pilot programs

	AFCP 2.0	Pre-Appeal	P3
Argument Page Limit	None	Five	Five
Amendments to Claim(s)	Required	No	Optional
Notice of Appeal	No	Required	No
Fee	No	Notice of Appeal Only	No
Interview/Oral Presentation	Sometimes	No	Oral Presentation
3 Member Panel	No	Yes	Yes
Explanation of Decision	Yes	No	Yes



# Patent Application Resources



Links:

<http://www.uspto.gov>

USPTO Patent Application initiatives:

<https://www.uspto.gov/patent/initiatives/uspto-patent-application-initiatives-timeline>

Patent Quality Chat; Special Programs:

[http://www.uspto.gov/sites/default/files/documents/Q%20Chat%20final%20for%20posting%2010\\_13\\_2015.pdf](http://www.uspto.gov/sites/default/files/documents/Q%20Chat%20final%20for%20posting%2010_13_2015.pdf)

Data Visualization Center:

<https://www.uspto.gov/dashboards/patents/main.dashxml>

Ombudsman Program:

<https://www.uspto.gov/patent/ombudsman-program>

Track One:

<http://www.uspto.gov/patent/initiatives/usptos-prioritized-patent-examination-program>

Accelerated Examination:

<https://www.uspto.gov/patent/initiatives/accelerated-examination>

Full First Action Interview Pilot:

<http://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program>

Prioritized Examination Comparisons:

[http://www.uspto.gov/sites/default/files/aia\\_implementation/fast\\_exam\\_table20130912.pdf](http://www.uspto.gov/sites/default/files/aia_implementation/fast_exam_table20130912.pdf)



# Patent Application Resources Contd.



Links:

CSP:

<https://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>

PPH:

<https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

AFCP 2.0:

<https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>

Pre-Appeal Brief Conference Pilot:

<https://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>

P3:

<http://www.uspto.gov/patent/initiatives/post-prosecution-pilot>

2016 Patent Quality Chats:

<http://www.uspto.gov/patent/initiatives/2016-patent-quality-chats>



