



After Final Practice and Appeal

July 15, 2016

Steven M. Jensen, *Member*



Why is a Final Rejection Important?

- Substantive prosecution is closed
- Filing a response to a Final Office Action does not stop the time for responding
- Application will become abandoned at statutory deadline
- Co-pendency requirement for filing continuation applications



After Final Practice

- When is a Final Rejection proper?
- When to reply to a Final Rejection?
- Effect of reply on Statutory Period for Reply
- How to reply to a Final Rejection?
- Practice tips



When is a Final Rejection Proper?

- A Final Rejection is intended to close prosecution of the application
- On second or any subsequent examination or consideration by Examiner (37 C.F.R. §1.113(a)), unless:
 - Examiner introduces new ground of rejection that is
 - Not necessitated by amendment of claims OR
 - Not based on information submitted in Information Disclosure Statement (IDS) filed after non-final Office Action but before Final Office Action and accompanied by fee



When is a Final Rejection Proper?

- On first Office Action only if:
 - Application is continuation of or substitute for earlier application, or after filing a Request for Continued Examination (RCE), AND
 - All claims:
 - Are drawn to same invention claimed in earlier application AND
 - Would have been properly finally rejected on grounds or art of record in next Office Action if had been entered in earlier application



Request for Withdrawal of Premature Final Office Action

- A request for withdrawal of a premature Final Office Action can be filed if basis for finality is improper (i.e., “premature”)
- File while application still before Examiner
 - Not grounds for appeal
 - Not basis of complaint before Patent Trial and Appeal Board (PTAB)
- Request for withdrawal of finality is not a response to Final Office Action
 - If successful, Examiner will withdraw finality
 - If unsuccessful, must still file response within time for reply
 - Does not extend deadline for response



When to Reply to a Final Rejection?

- Three months from mailing date of Final Office Action – “Shortened Statutory Period” (SSP)
 - But SSP expires on mailing date of Advisory Action if:
 - Reply filed within two months of mailing date (expedited handling) of Final Office Action AND
 - Advisory Action not mailed until after end of three months from mailing date of Final Office Action
 - In this case, extension fees are calculated from the Advisory Action mailing date
 - BUT cannot extend past six months from Final Office Action mailing date



When to Reply to a Final Rejection?

- No later than six months from mailing date of Final Office Action – “Statutory Period” (SP)
 - Replies filed after expiration of SSP will require payment of extension fees
 - Period for reply cannot be extended beyond six months from mailing date under any circumstances
 - Application must be allowed, or a Notice of Appeal or Request for Continued Examination (RCE) must be filed, by the end of the statutory period
 - Filing only a response does not stop period for reply



Effect of Reply on Statutory Period for Replying to a Final Office Action

Replies that stop the running of the Statutory Period:

- Filing of a Notice of Appeal
 - Begins the period for filing an Appeal Brief
 - Can still file a response after filing of a Notice of Appeal
- Filing of a Request for Continued Examination (RCE)



Effect of Reply on Statutory Period for Replying to a Final Office Action

Filing of Response/Amendment After Final

- Does **NOT** stop running of the statutory period (SP) for reply even if Examiner verbally indicates that he/she will allow the application and has entered the amendment -- need a Notice of Allowance mailed before SP
- If Notice of Allowance expected but not received by the end of SP, file a Notice of Appeal
- **DOCKETING TIP** – Do not remove six month statutory period from docket until you filed a Notice of Appeal / Continuation Application / RCE or you have received a Notice of Allowance with a mailing date



How to Reply – Response/ Amendment

- File an Amendment After Final
 - (37 C.F.R. §1.116 (b))
- File a Request for Continued Examination (RCE)
 - (37 C.F.R. §1.114 (a))
- File a Notice of Appeal
- Other actions to consider
 - File Continuation Application
 - File Divisional Application
 - Discussed in Continuation Practice



How to Reply – Response/ Amendment

- File an Amendment After Final (37 C.F.R. § 1.116 (b))
 - Entry of proposed amendment is not a matter of right – Examiner’s discretion
 - 37 C.F.R. § 1.113(c)/1.116 (b)(1) – Amendments will likely be entered that put application in condition for allowance by:
 - Canceling each rejected claim AND/OR
 - Complying with any requirement or objection as to form of allowed claim(s)



How to Reply - Response/ Amendment

- 37 C.F.R. § 1.116 (b)(2) – Amendments will likely be entered that:
 - present rejected claims in better form for consideration on appeal
- 37 C.F.R. § 1.116 (b)(3) – Amendments touching merits may be admitted by showing of good and sufficient cause:
 - Why they are necessary
 - Why they were not earlier presented



How to Reply - After Final Consideration Pilot Program (AFCP 2.0)

- After Final Consideration Pilot Program (AFCP 2.0)
 - Because of AFCP 2.0, after receiving a Final Office Action, it is often advisable to file an Amendment **without** a Request for Continued Examination (RCE).
 - Current version of program (AFCP 2.0) available since 2013, now extended through **September 30, 2016**.
 - One-page form (PTO/SB/434) filed with After Final Amendment:
 - At least one independent claim is amended, but not broadened in any aspect;
 - Applicant must agree to an interview at the Examiner's request; and
 - No additional fee is required.
 - Under AFCP 2.0, in certain circumstances, an Examiner will perform a search based on the substantive amendment
 - USPTO's goal: reduce the number of RCEs, but USPTO has not released data as to effectiveness.



How to Reply - After Final Consideration Pilot Program (AFCP 2.0)

- Form (PTO-2323) issued in response to filing of AFCP 2.0 request:
 - Search cannot be conducted within guidelines of program
 - Examiner cannot search within allotted time (3 hours for utility application)
 - Amendment After Final treated under normal practice
 - All rejections are overcome, and Notice of Allowance issued
 - Amendment After Final would not overcome all issues, and Advisory Action issued
 - Amendment After Final raises new issues(s), and Advisory Action issued
- Interview Summary – to be included in all cases in which an interview is conducted.
 - Interview provides opportunity to present arguments, and may help advance prosecution – even if Amendment After Final is not entered.



How to Reply - After Final Consideration Pilot Program (AFCP 2.0)

- Benefits/Practice Tips

- No additional cost, and can be filed with any Amendment After Final (if claims are amended without broadening)
- Requires Examiner to consider amendments/arguments without immediately filing a Request for Continued Examination (RCE)
 - Interview provides another opportunity to discuss case, and may help advance prosecution
 - In some cases, interview can result in further amendment(s) to avoid filing of RCE
- In most cases, an RCE must be filed subsequently, but claims may be crafted based on the PTO-2323, Advisory Action and/or Interview Summary, thus advancing prosecution.



How to Reply - After Final Consideration Pilot Program (AFCP 2.0)

- Summary
 - AFCP 2.0 is a cost-effective tool for responding to a Final Office Action
 - Even a minor amendment to one or more independent claim(s) is sufficient to file an AFCP 2.0 request
 - Interview can be used to explain the claimed invention, and distinguish over cited references
 - Even if interview does not result in allowance, can be helpful to advance prosecution



How to Reply – RCE: RCE – When to File

- RCE can only be filed when prosecution has been closed
- EXAMPLES:
 - Final Office Action
 - Application under Appeal (before or after an Appeal Brief is filed or a decision on appeal is rendered)
 - Notice of Allowance issued
 - Other action closing prosecution (e.g., Ex Parte Quayle Office Action)



How to Reply – RCE RCE – When to File

RCE must be filed before:

- Abandonment
- Before payment of the issue fee
 - Unless a petition to withdraw the application from issue is granted
- Filing a Notice of Appeal to the Court of Appeals for the Federal Circuit
- Commencing a civil action under 35 USC §§ 145, 146 (District court)



How to Reply – RCE: RCE – Requirements of Submission

- An RCE submission can be
 - IDS
 - Amendment to the application
 - Specification, claims or drawings
 - New arguments
 - New evidence (including Declarations)
 - NOTE: If an Office Action is outstanding, the RCE submission must meet the requirements of 37 CFR §1.111 (for a complete reply to the Office Action)



How to Reply – RCE: RCE – USPTO Action

- An RCE can be filed in response to a Final Office Action and before payment of the Issue Fee
 - If the RCE and submission are timely filed, the USPTO will withdraw finality of the Action and enter the submission
 - Note that a first Office Action after an RCE can be a Final Office Action
 - An improper RCE:
 - Filing of an RCE request and payment of the fee does not stop the period for response to the Final Office Action
 - Unless the RCE is used to enter a previously-filed response
 - If there is no submission with an RCE before the end of the period to reply (or pay the Issue fee after a Notice of Allowance), the application will be abandoned



How to Reply – RCE: RCE - USPTO Action

- If an Amendment is submitted with an RCE, canceling pending claims and introducing new claims directed to a different invention:
 - USPTO will treat the RCE as proper BUT
 - USPTO will not enter the amendment
 - A Notice will be sent requiring a proper amendment
 - RCE is not a substitute for filing a divisional application



RCE WHEN APPEAL PENDING: USPTO Action When RCE Proper

- Appeal pending
 - Before a PTAB decision
 - A proper RCE will include an RCE Request, with fee and a submission
 - The submission should include arguments or amendments to avoid a new Final Office [MPEP-706.079(h), Para XI.A]
 - USPTO treats the RCE as a request to withdraw the appeal
 - » The submission will be entered and prosecution will be re-opened
 - The PTAB should be notified of the RCE filing
 - » If the PTAB renders a Decision on the Appeal after the RCE is filed, the PTAB may refuse to vacate that Decision if the USPTO did not recognize the RCE filing in time



RCE WHEN APPEAL PENDING: USPTO Action When RCE Improper

- Appeal pending

- Before PTAB Decision

- An improper RCE – RCE without fee and/or proper submission [MPEP-706.079(h), Para X.B]
 - USPTO treats the RCE as a request to withdraw the appeal, even if the RCE is improper under 37 CFR §1.114(d)
 - USPTO will issue a Notice of Abandonment unless allowed claims are pending in the application
 - » If allowed claims are pending, the appeal is withdrawn, the rejected claims will be cancelled, and the application will be passed to issue
 - » Note that objected-to claims with allowable subject matter will be treated as rejected claims



RCE AFTER APPEAL DECISION: USPTO Action

- Appeal pending

- After PTAB Decision

- A proper RCE includes the RCE Request, fee, and a submission [MPEP-706.079(h), Para XI.A]
 - USPTO will enter the submission and re-open prosecution
 - » But the PTAB Decision will be “law of the case”
 - An improper RCE – missing the Request, fee, or submission [MPEP-706.079(h), Para XI.B]
 - USPTO will notify the Applicant of the improper RCE filing
 - A Notice of Abandonment (or Allowance, if allowable claims are pending) will be issued if the time period for seeking Federal Court review has expired.



RCE – Procedure After Allowance

- RCE filing after allowance, before payment of the issue fee
 - RCE process can be used by Applicant to re-open prosecution
 - To consider additional prior art citations
 - To further amend claims



RCE – Procedure After Issue Fee Payment

- After Allowance and after payment of the issue fee
 - RCE and petition requesting withdrawal of application from issue must be filed (MPEP- 1308/ 37 CFR §1.313)
 - If petition to withdraw from issue is granted, the application will be withdrawn from issue
 - The RCE and submission will be entered and prosecution will be re-opened
 - Note that the QPIDS procedure may avoid the need for an RCE to enter an IDS in some circumstances



RCE – What to do: Examples

EXAMPLE 1

FACTS:

- Amendment in response to Final Office Action has been filed with USPTO
- Advisory Action received, refusing to enter amendments and indicating that further search and consideration would be required

TO DO:

- File Request for Continued Examination (RCE) to force entry of the Amendment



RCE – What to do: Examples

EXAMPLE 2

FACTS:

- Amendment in response to Final Office Action prepared but not filed
- Extensive amendments to claims in draft Amendment After Final

To do:

- OPTION 1 – File Amendment After Final with an AFCP 2.0 request
 - If Advisory Action is received, proceed as in Example 1
- OPTION 2 – File RCE with response to Final Office Action



RCE – What to do: Examples

EXAMPLE 3

FACTS:

- Final Office Action Response filed in USPTO
- Advisory Action received
- Notice of Appeal filed with Pre-Appeal Brief Request for Review (no re-opening of prosecution or allowance of claims)

To do:

- OPTION 1 – Continue with Appeal
- OPTION 2 – File RCE with Response to Final Office Action
- OPTION 3 – File RCE with a further or supplemental amendment



After Final Office Action: How to Reply

- Appeal after Final Rejection
 - Pre-Appeal Brief Request for Review
 - Appeal



How to Reply – Appeal/Pre-Response/Amendment after Final

- Generally – Applicant should consider need to file a Response/Amendment after Final Rejection
 - To put case in better condition for appeal
 - Eliminate objections as to form
 - Recycle arguments in pre-appeal conference submission or in appeal brief



How to Reply – Appeal/Pre-Appeal Additional Factors to Consider

- State of the Prosecution: Is case ready for Appeal?
 - Technical vs. Legal Issues
 - Technical issues – may need additional prosecution
 - Legal issues – may fare better on appeal
 - Available evidence
 - If previously entered, case may be ripe for appeal
 - If not yet entered, case may need additional prosecution
 - Client goals



How to Reply – Appeal/Pre-Appeal Appeal Pre-Appeal Brief Conference

- “A clear legal or factual deficiency in the rejections rather than an interpretation of the claims or prior art teachings”
- Applicant must file:
 - Notice of Appeal – with required fee
 - Pre-Appeal Brief Request for Review
 - Five-page limit
 - “Succinct, concise and focused set of arguments”
 - Specific reference to previous arguments
 - Applicant must specify:
 - Clear errors in Examiner’s rejections
 - Examiner’s omission of one or more essential elements for a prima facie case



How to Reply – Appeal/Pre-Appeal Appeal Pre-Appeal Brief Conference (cont'd)

- NOT Permitted:
 - After Final or Proposed Amendments
 - Petitionable matters
 - Interpretations of the prior art
 - Interpretations of the scope of the claims
- Unclear what constitutes appropriate subject matter
- No Supplemental Requests
- No interviews during Pre-Appeal Review period



How to Reply – Appeal/Pre-Appeal Appeal Pre-Appeal Brief Conference (cont'd)

- Generally – If uncertainty, then Pre-Appeal Brief Request should be considered
 - Less expensive than Appeal
 - Shorter review period
 - If unsuccessful, arguments can be developed further for subsequent Appeal



How to Reply – Appeal/Pre-Appeal Appeal Pre-Appeal Brief Conference (cont'd)

- Review:
 - Panel of experienced examiners including:
 - Examiner of record
 - Examiner's Supervisor
 - Applicant's representative not present
- Decision mailed within 45 days of Request



How to Reply – Appeal/Pre-Appeal Appeal Pre-Appeal Brief Conference (cont'd)

- Possible findings/results:
 - Application remains under appeal (at least 1 issue is unresolved)
 - Prosecution reopened and new Office Action follows
 - Application allowed and prosecution closes
 - Request dismissed for failure to comply with requirements



How to Reply – Appeal/Pre-Appeal Appeal – Filing

- Can file Appeal after any claim rejected twice
 - Last Office Action need not be final
 - Need not be twice in the same application
- Cannot file Appeal concurrently with RCE
- Filing of RCE withdraws any previously filed Appeal
- Notice of Appeal due within period for reply to last Office Action
- File Notice of Appeal
- Pay Appeal Fee when filing Notice
- May be accompanied by an After Final Amendment



How to Reply – Appeal/Pre-Appeal Appeal – Appeal Brief

- Appeal Brief
- Due later of:
 - One month from mailing date of Decision of Pre-Appeal Conference OR
 - Two months from the receipt by USPTO of the Notice of Appeal
- Brief may not incorporate arguments by reference



How to Reply – Appeal/Pre-Appeal Appeal – Appeal Brief (cont'd)

- Appeal Brief (content/elements):
 - Identification of the real party of interest
 - Related appeals and interferences
 - The status of the claims
 - The status of any amendments
 - A summary of claimed subject matter
 - The grounds of rejection to be reviewed on appeal (each in a separate section)
 - The argument
 - The claims appendix
 - The evidence appendix
 - A related proceedings appendix



How to Reply – Appeal/Pre-Appeal Appeal – Amendment

- Amendments filed with or after Brief entered at Examiner's discretion only:
 - To cancel claims
 - To re-write dependent claims in independent form
- Other amendments and affidavits not usually admitted



How to Reply – Appeal/Pre-Appeal Appeal – Post Appeal Brief Filing

- After Appeal Brief filed, Examiner may:
 - Re-open prosecution for new rejection or action
 - Withdraw Final Rejection and allow case
 - Maintain appeal and draft Examiner's Answer at Appeal Conference with Supervisor and another experienced Examiner
 - Includes Response to arguments
 - May include new ground of rejection



How to Reply – Appeal/Pre-Appeal Appeal – Post Appeal Brief Filing (cont'd)

- If new grounds of rejection, Applicant must request re-opening of prosecution or file Reply Brief in two months
- Additional rounds of Answer and Reply Briefs possible
- Appeal may be decided on briefs or Applicant may file Request for Oral Hearing
 - Decision by Patent Trial and Appeal Board



How to Reply – Appeal/Pre-Appeal Appeal – Post Board Decision

- Judicial review of Decision either by
 - Appeal to U.S. Court of Appeals for the Federal Circuit
 - Civil action in U.S. District Court for the District of Columbia



How to Reply – Appeal/Pre-Appeal Practice Tips

- Anticipate Final Office Action Early
 - Plan for response after Final Office Action during consideration of first Office Action
 - Be cordial and respectful of Examiner
 - Seize on indications of allowable or potentially allowable subject matter
 - Structure claim matrix to facilitate allowance of claims after Final
 - Clearly delineate claims that will most likely be allowable so questionable claims can be easily cancelled



How to Reply – Appeal/Pre-Appeal Practice Tips (cont'd)

- Act Early After Receipt of Final Office Action
 - Take advantage of expedited processing guidelines
 - Plan on filing response (utilizing the AFCP 2.0 program, if appropriate) within two months of mailing date of Final Office Action – Examiner will provide Advisory Action on expedited basis
 - Could reduce extension fees
 - Schedule Telephonic Interview with Examiner to occur well before lapse of two-month period to discuss possible allowable subject matter
 - Monitor consideration of any After Final Amendment, to consider appropriate action (e.g., filing of a Request for Continued Examination (RCE), Notice of Appeal, or further Amendment) by the three-month due date



Thank you!

Please contact me if you have any further questions.

Email: smjensen@mintz.com