

REPORT

NEW USPTO "AFTER-FINAL-REJECTION" PILOT PROGRAM

May 17, 2013

The United States Patent and Trademark Office ("USPTO") has formalized a program (the "After Final Consideration Pilot Program 2.0" or AFCP 2.0) to encourage examiners to act on more amendments after final rejection without the need for a Request for Continued Examination ("RCE"). AFCP 2.0 will be available from May 19, 2013 at least until September 30, 2013.

Currently, most USPTO examiners require applicants to file an RCE before the examiners will substantively consider an amendment after final rejection that narrows an independent claim or otherwise requires additional search or consideration. This is largely because the examiners do not receive any credit for their time spent in such after-final-rejection activities. The USPTO has been experimenting with programs to encourage examiners to be more flexible in this regard, by giving the examiners credit for more time spent at that stage.

Under AFCP 2.0, examiners will be given credit for additional time spent considering responses after final rejection and updating their searches. If the examiner's consideration of a proper AFCP 2.0 request and response results in a determination that all pending claims are in condition for allowance, the examiner will issue a Notice of Allowance. Otherwise, the examiner will request an interview with the applicant to try to avoid the need for an RCE.

I. Requirements For Participation in AFCP 2.0

To participate in AFCP 2.0, an application must: 1) be subject to a pending final rejection; and 2) be a utility, plant or design non-provisional application. Continuing (e.g., continuation, divisional and CIP) applications are eligible for participation. Reissue applications and reexamination proceedings are not eligible for participation.

An applicant must file a Request to participate in AFCP 2.0. The Request must include: 1) a transmittal that requests consideration under AFCP 2.0; 2) a response under 37 CFR §1.116, including an amendment to at least one independent claim that does not broaden the scope of the independent claims in any aspect; 3) a statement that the applicant is willing and available to participate in any interview initiated by the examiner concerning the response; and 4) any necessary extension, excess claim, or other fees. No additional fees are required in order to participate in AFCP 2.0.

Only one such Request may be filed in response to any final rejection. Subsequent requests in response to a same final rejection will be treated consistent with current practice concerning after-final responses.

May 17, 2013

II. Effect on Examination

If a submission under AFCP 2.0 includes all required items, the examiner will determine whether additional search and/or consideration would be required to determine whether the amendment would distinguish over the prior art, and whether such search and/or consideration would be possible within the extra time allotted under the AFCP 2.0 program. If any necessary additional search and/or consideration could not be completed within the allotted time, the examiner will mail an advisory action refusing entry of the response. In that case, an RCE may be filed to obtain entry of the response.

If the examiner determines that the amendment does not necessitate additional search and/or consideration, or if the examiner determines that any necessary additional search and/or consideration could be completed within the allotted time, then the examiner will consider whether the amendment places the application in condition for allowance (after completing the additional search and/or consideration, if required). If the examiner determines that the amendment places the application in condition for allowance, then the examiner will enter the amendment and issue a Notice of Allowance. If the examiner determines that the amendment does not place the application in condition for allowance, then the examiner will contact the applicant to schedule an interview to discuss the amendment.

Following the interview, the examiner will proceed according to current practice (e.g., allowing the claims, issuing an advisory action entering the amendment but maintaining the rejection, or issuing an advisory action refusing entry based on new issues being raised). If the applicant declines the interview, or is unable to schedule the interview to take place within ten calendar days after the date the examiner first

contacts the applicant, then the examiner may proceed with an appropriate response to the submission after final rejection according to current practice.

III. Recommendations

We recommend considering filing an AFCP 2.0 Request in applications with a pending final rejection whenever at least one independent claim will be amended without broadening the scope of the claim. The AFCP 2.0 program should result in many after-final amendments being entered and considered that would otherwise require the expense and delay of an RCE for entry and consideration.

We also generally recommend conducting an interview before filing the AFCP 2.0 Request and amendment. At this interview, we can present any proposed amendments to the examiner prior to filing the Request, and address any concerns the examiner may have. This can maximize the likelihood of allowance, or at least entry of the amendment without an RCE, by allowing us to tailor the amendment to the Examiner's concerns. Coupling such an interview with the AFCP 2.0 program further allows us to emphasize to the Examiner that he or she can receive credit for additional work under AFCP 2.0, and provide an opportunity for a follow-up interview if the amendment does not resolve all of the examiner's concerns.

We also recommend participating in interviews requested by an examiner subsequent to filing of a Request to participate in AFCP 2.0. Such an examiner-initiated interview will likely be relatively brief, especially if we have already established a dialog with the examiner in a prior interview. It may also enable us to convince the examiner that the claims are allowable without further amendment, or may allow us to present a

May 17, 2013

further amendment that will place the application in condition for allowance.

An examiner-initiated request for such an interview signals that the examiner may need further arguments or amendments before he or she will agree to allow the claims. Thus, we recommend preparing a backup strategy for possible further amendments or arguments to present at such an interview.

If consideration is being given to amending an independent claim after final rejection to make it broader in some aspects, even if it will be amended to be narrower in other aspects, then the AFCP 2.0 program will not be available. In such situations, we even more strongly recommend conducting an interview before filing the response, in order to try to convince the examiner to enter such an amendment without the need for an RCE.

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