

# REPORT

## **COST-SAVING MEASURES FOR AFTER-FINAL PRACTICE**

June 19, 2009

### **I. Introduction**

Extensions of time can significantly increase the cost of prosecuting a patent application. Frequently, Applicants incur extension fees between filing a response to a Final Rejection and filing a Notice of Appeal, Request for Continued Examination (RCE) or continuation application due to delays between the date the response is filed and the date the Examiner issues an Advisory Action. If the response is filed on or near the three-month response deadline, extension of time fees will mount while the Examiner decides whether to mail an Advisory Action. In addition, if an Advisory Action is mailed near the next month extension of time deadline, Applicants have very little time to formulate a response to the Advisory Action if additional extension fees are to be avoided.

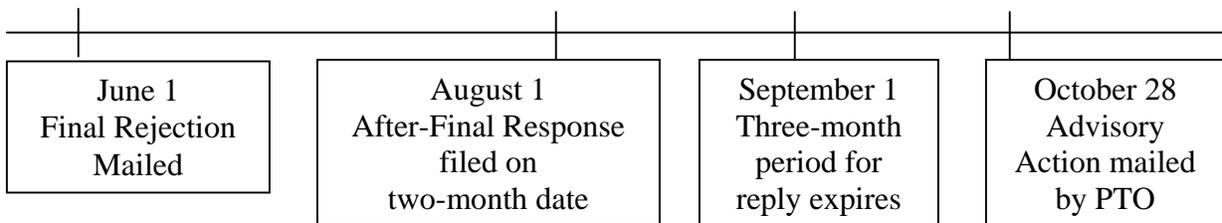
To avoid extension fees and increase Applicants' decision times, an Amendment After Final Rejection or Request for Reconsideration After Final Rejection (collectively "After-Final Response") should be filed within two months of the Final Rejection mailing date. If the After-Final Response is filed within this time period, and the PTO issues an Advisory Action after the three-month statutory period for reply, extensions of time and extension fees will be calculated from the date on which the Advisory Action is mailed rather than from the date of expiration of the normal three-month period for reply. Thus, Applicants are only subject to a one-month extension fee (\$130) and retain a full month to formulate a response to the Advisory Action. If the PTO issues an Advisory Action before the expiration of the three-month period for reply, Applicants can still respond to the Advisory Action without incurring extension fees, albeit with limited decision time.

June 19, 2009

## II. Examples

The following are examples that illustrate the advantages of filing an After-Final Response on or before the two-month date. In Example 1, an After-Final Response is filed within two months after the Final Rejection mailing date.

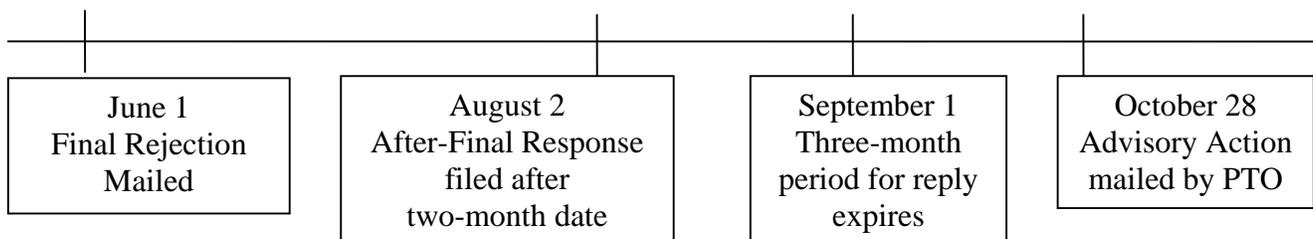
### Example 1



In Example 1, any Notice of Appeal, RCE, or continuation application filed in response to the Advisory Action would require only a petition for one-month extension of time and \$130 fee if filed between October 28 and November 28, or a petition for two-month extension of time and \$490 fee if filed between November 29 and December 1 (extensions beyond six months from the Final Rejection mailing date are not permitted).

In Comparative Example 2, in contrast to Example 1, an After-Final Response is filed only one day later, but more than two months after the Final Rejection mailing date.

### Comparative Example 2

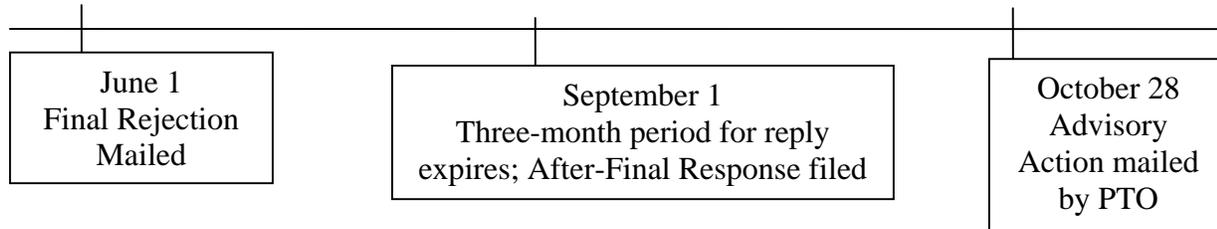


In Comparative Example 2, any Notice of Appeal, RCE, or continuation application filed in response to the Advisory Action would require a petition for two-month extension of time and \$490 fee if filed between October 28 and November 1, or a petition for three-month extension of time and \$1,110 fee if filed between November 2 and December 1. The single day difference in filing the After-Final Response between the two examples could thus cost several hundred dollars and reduce the available time for deciding how to respond to the Advisory Action from a full month to only a few days.

**June 19, 2009**

In Comparative Example 3, an After-Final Response is filed on the three-month due date.

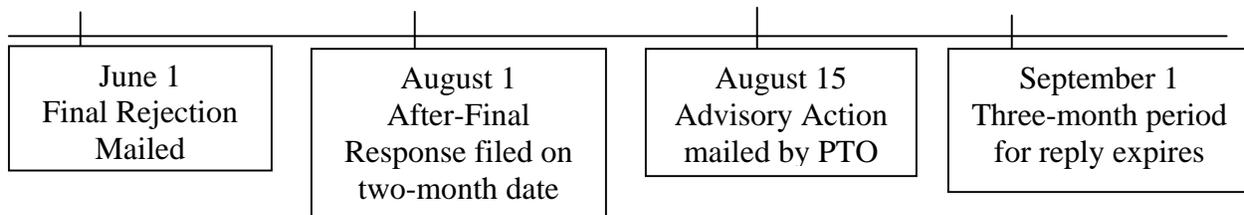
Comparative Example 3



Similar to Comparative Example 2, in Comparative Example 3, any Notice of Appeal, RCE, or continuation application filed in response to the Advisory Action would require a petition for two-month extension of time and \$490 fee if filed between October 28 and November 1, or a petition for three-month extension of time and \$1,110 fee if filed between November 2 and December 1. Again, the difference in the date of filing the After-Final Response increases the necessary extension fees and reduces the available time for deciding how to respond to the Advisory Action.

In Example 4, an After-Final Response is filed within two months of the Final Rejection mailing date, and the Examiner issues an Advisory Action within two weeks.

Example 4

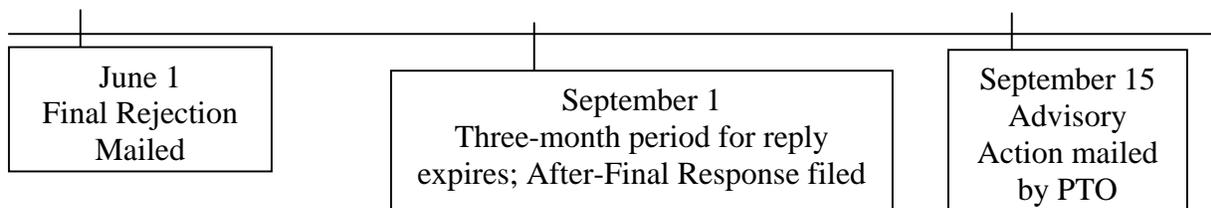


In Example 4, any Notice of Appeal, RCE, or continuation application filed in response to the Advisory Action would not require any extension fees if filed between August 15 and September 1, and would require only a petition for one-month extension of time and \$130 extension fee if filed between September 2 and October 1, a petition for two-month extension of time and \$490 fee if filed between October 2 and November 1, or a petition for three-month extension of time and \$1,110 fee if filed between November 2 and December 1. Thus, Applicant would have two weeks fee-free, or six weeks with a \$130 fee, to decide how to respond to the Advisory Action.

**June 19, 2009**

In Comparative Example 5, an Amendment After Final Rejection is filed on the three-month due date, and the Examiner issues an Advisory Action within two weeks.

Comparative Example 5



In Comparative Example 5, any Notice of Appeal, RCE, or continuation application filed in response to the Advisory Action would require a petition for one-month extension of time and \$130 fee if filed between September 15 and October 1, a petition for two-month extension of time and \$490 fee if filed between October 2 and November 1, or a petition for three-month extension of time and \$1,110 fee if filed between November 2 and December 1. By filing the After-Final Response one month later (as compared to Example 4), Applicants cannot avoid paying a \$130 extension fee when filing a response to the Advisory Action, and would have only two weeks to decide how to respond to the Advisory Action before additional extension fees are incurred.

**III. Recommendations**

In order to take advantage of the above procedure, Oliff & Berridge will carefully monitor the two-month date after a Final Rejection has been issued. If you instruct us to file an After-Final Response within the two-month period, even if you are silent as to the requested date of filing, we will endeavor to file the After-Final Response within the two-month period. In any case, we will press the Examiners for timely action on our After-Final Responses.

We recommend that you provide your instructions as early as possible after a Final Rejection has been issued, preferably in time that we may file an After-Final Response within two months of the Final Rejection mailing date. As illustrated in the above hypotheticals, Applicants can reduce expenses and increase the time available to respond to an Advisory Action when filing an After-Final Response within two months of the mailing date of the Final Rejection.

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*Oliff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.*

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