

Cantor Colburn Client Alert: Post Prosecution Pilot Program – The P3

In Summary

On July 11, 2016, the U.S. Patent and Trademark Office initiated a Post-Prosecution Pilot Program (P3) to increase the interaction between applicants and the USPTO. The P3 offers a new alternative for responding to a final rejection and requires no additional fees. The P3 Program may, under the right circumstances, facilitate subsequent prosecution at a lower cost than the filing of a Request for Continued Examination (RCE).

P3 – Implications for your Intellectual Property

On July 11, 2016, the U.S. Patent and Trademark Office (USPTO) initiated a Post-Prosecution Pilot Program (P3) to increase the interaction between applicants and the USPTO. The P3 combines elements of (1) the After Final Consideration Pilot Program (AFCP) 2.0 and (2) the Pre-Appeal Brief Conference Pilot Program and provides a 20-minute conference to present arguments to a panel of examiners.

Initially, the P3 will run for six months from July 11, 2016, or when 1,600 requests have been accepted into the Pilot, whichever comes first. Each Technology Center will accept no more than 200 requests, meaning that P3 may close in one Technology Center sooner than another. There is no USPTO fee for the P3. The P3 is only available for nonprovisional and PCT utility applications. Reissue, design, and plant applications, as well as reexamination proceedings, are not eligible for P3 participation. A P3 request is available if there has not yet been a request for a Pre-Appeal or AFCP 2.0 program for the same final rejection. Once a P3 is initiated, an applicant may not request entry into either the Pre-Appeal or AFCP 2.0 programs. Filing a notice of appeal terminates the P3.

A P3 request must be filed within two months of a final rejection and prior to filing a notice of appeal. A P3 request must include a response with no more than five pages of arguments, which is similar to the Pre-Appeal program. A P3 request may optionally include a non-broadening amendment to one or more claims. In contrast, the AFCP 2.0 program requires a proposed non-broadening amendment to at least one independent claim. Like the AFCP 2.0, the P3 provides Examiners with additional time for searching, including more time if there are amendments. The P3 also provides a conference - in person, by phone, or by video - with three Examiners: the Primary Examiner; the Supervisory Examiner; and a third (likely Supervisory) Examiner. Thus the P3 may allow for formal review of a final rejection while avoiding a more costly appeal.

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However, the P3 may suffer similar drawbacks as the AFCP 2.0 and Pre-Appeal programs. First, the Examiners remain the only decision-makers with respect to whether a review can be accomplished within the allotted time or if an RCE is required. Due to the count system, Examiners may still have an incentive to require an RCE. Second, the panel includes the same primary and supervisory examiners as those that issued the final rejection. Thus, unless new evidence, amendments or arguments are provided, there is a low probability that they will change their minds.

The P3 may offer an opportunity to test new amendments and/or arguments prior to filing an RCE. Like the AFCP 2.0 and After-Final programs, the P3 may facilitate subsequent prosecution and provide for expedited allowance.

For Further Information and Assistance

Cantor Colburn's attorneys are prepared to answer any questions you may have about P3 and its implications for your intellectual property.

Please do not hesitate to contact us if we can be of further assistance:
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Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.