

The Docketing Excellence Webinar Series



Best Practices for Docketing Optional US Prosecution Procedures



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Best Practices for Docketing Optional US Prosecution Procedures

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Topics

- Prioritized Examination (Track 1)
- Patent Prosecution Highway (PPH)
- Special Interview and Appeal Procedures
 - First Action Interview Pilot Program
 - After Final Consideration (AFCP) 2.0
 - Pre-Appeal Conference
 - Patent Prosecution Pilot (P3)

Prioritized Examination (Track 1)

- Track 1 is a procedure for expedited review of a patent application for an additional fee.
- The USPTO's goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted.

Maintaining Track 1 Status

- The Track 1 program grants special status until one of the following occurs:
 - i. Applicant files a petition for extension of time to extend the time period for filing a reply.
 - ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
 - iii. Applicant files a request for continued examination (RCE).
 - iv. Applicant files a notice of appeal.

Maintaining Track 1 Status

- v. Applicant files a request for suspension of action.
 - vi. A notice of allowance is mailed.
 - vii. A final Office action is mailed.
 - viii. The application is abandoned.
 - ix. Examination is completed as defined in 37 CFR 41.102.
- https://www.uspto.gov/patents/init_events/track1_FAQS.jsp

Docketing Tips for Track 1

- To avoid a loss of prioritized status, it's important to docket any response to a Non-Final action to avoid an extension of time that would result in a loss of Track 1 status.
- Docketing the action as non-extendable and not permitting a response to be filed after the first statutory deadline will lessen the chance that a Track 1 case will lose its prioritized status and be tossed into regular examination proceedings.

Patent Prosecution Highway (PPH)

- PPH speeds up the examination process for corresponding applications filed in participating intellectual property offices.
- Under PPH, participating patent offices have agreed that when at least one claim is allowed, the applicant may request fast track examination of corresponding claim(s) in a corresponding patent application that is pending in another patent office.

PPH

- In order to have your application considered for PPH you must meet all the criteria and submit a PPH Request Form.
- The PPH program does not require the request to be filed at the time of filing of the application.
- If the PPH request is granted, the examiner will generally examine the application within 2 to 3 months from the grant of the PPH request provided the application has completed all its pre-exam processing and is ready for examination.

Docketing Tips for PPH

- Upon receiving an indication of allowable subject matter of any application in an international family of cases, docketing for review of existing PPH opportunities in co-pending cases that share a common earliest priority.
- Typically, examination cannot have begun in the co-pending cases that share priority in order to be eligible for PPH.
- A list of PPH participants/programs can be found here: <https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

Special Interview and Appeal Procedures

- First Action Interview Pilot Program: <https://www.uspto.gov/patents-application-process/applying-online/full-first-action-interview-pilot-program>
- AFCP: <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>
- Pre-Appeal: <https://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>
- P3: <https://www.uspto.gov/patent/initiatives/post-prosecution-pilot>

First Action Interview (FAI) Pilot:

- First Action Interview (FAI) Pilot Program: <https://www.uspto.gov/patents-application-process/applying-online/full-first-action-interview-pilot-program>
- Under FAI, an applicant is entitled to a first action interview, upon request, prior to the first Office action on the merits. The examiner will conduct a prior art search and provide applicant with a condensed pre-interview communication citing relevant prior art and identifying proposed rejections or objections.
- Within 30 days of receipt, applicant schedules an interview and submits proposed amendments and/or arguments. At the interview, the relevant prior art, proposed rejections, amendments and arguments will be discussed.
- If agreement is not reached, the applicant will receive a first action interview Office action that includes an interview summary that constitutes a first Office action on the merits under 35 USC 132.

Docketing Tips for FAI

- Check PAIR for expected first action date and docket date for filing FAI Request.
- Application must be a non-reissue, non-provisional with three or fewer independent claims and twenty or fewer total claims.
- After filing request, Office will issue a Pre-Interview Communication (PTOL-413FP). Docket 30 day deadline, extendable up to one month, to request or decline interview.
- Applicant Initiated Interview Request form (PTOL-413A) along with a proposed amendment and/or arguments must be filed via EFS-Web within 60 days.

After Final Consideration (AFCP) 2.0

- AFCP 2.0 Pilot:
<https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>
- AFCP 2.0 authorizes additional time for examiners to search and/or consider responses after final rejection.
- Under AFCP 2.0, examiners will also use the additional time to schedule and conduct an interview to discuss the results of their search and/or consideration with you, if your response does not place the application in condition for allowance.

Docketing Tips for AFCP

- Can be filed at any time after a Final Office Action is received in eligible non-provisional applications.
- After final response deadlines apply, including available extensions of time.
- If the applicant declines the interview, or is unable to schedule the interview within ten (10) calendar days from 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.

Pre-Appeal Conference

- Pre-Appeal Brief Conference Program (Pre-Appeal):
<https://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>
- Offers applicants an opportunity to request a review of identified matters on appeal prior to the filing of an appeal brief.
- Goals: (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a prima facie rejection.

Docketing Tips for Pre-Appeal Conference

- The request must be filed with the filing of a notice of appeal and before the filing of the appeal brief. No extensions of time are available for filing the request for review after filing the notice of appeal.
- The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable.

Post-Prosecution Pilot (P3)

- P3 combines the AFCP 2.0 program and the Pre-Appeal Brief Conference Pilot program:
<https://www.uspto.gov/patent/initiatives/post-prosecution-pilot>
- P3 is open to nonprovisional and international, utility applications filed under [35 USC 111\(a\)](#) or [35 USC 371](#) that are under final rejection.
- P3 will run for six (6) months from its effective date (July 11, 2016) or until the USPTO accepts 1,600 proper requests, whichever occurs first.

Docketing Tips for P3

- Request Form (SB/444) must be filed within two (2) months from the mailing date of the final rejection and prior to filing a notice of appeal
- If applicant is unable to schedule the conference within ten (10) calendar days from the date the Office first contacts applicant, the request will be deemed improper.
- Statutory deadlines still apply and are not waived as a result of acceptance into P3 pilot