



THINK FORWARD

Post Prosecution Pilot Program (P3)

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On July 11, 2016, the United States Patent and Trademark Office (Office) announced a new Post-Prosecution Pilot Program (P3) as part of the Enhanced Patent Quality Initiative. P3 offers a new alternative for responding to a final rejection and requires no additional fees. Initially, P3 is set to run for six months with a limit of 200 compliant requests per tech center for a total of 1,600 requests. This may be extended or made permanent depending on P3's success. The Office designed P3 to combine the effective features of the existing Pre-Appeal program and the After Final Consideration Pilot Program 2.0 (AFCP 2.0). P3 allows a response under 37 CFR §116 along with an optional, non-broadening amendment. A Panel of Examiners reviews the response and the Applicant is allowed a 20-minute presentation as part of the review. The Panel of Examiners returns a Notice of Decision with a brief written summary.

P3 should be useful for applications in which no agreement is expected with the examiner. Compared to AFCP 2.0 in which the Examiner of Record conducts the review, P3 allows the applicant to present their arguments to a Panel of Examiners. It is advantageous as compared to a Pre-Appeal conference, as P3 requires no fee, allows non-broadening amendments, and allows for an applicant presentation. One potential downside to the P3 program is the shortened response deadline of two months from the mailing date of the final action, which is not extendable.

To participate in P3, the application must be an original utility non-provisional application filed under 35 U.S.C. 111(a), or an international utility application that has entered the national stage in compliance with 35 U.S.C. 371, and the application must have an outstanding final rejection. In order for a response to be considered under P3, it must be submitted electronically and include: (1) a transmittal form that identifies the submission as a P3 submission and requests consideration under P3; (2) a response having no more than five pages of argument; and (3) a statement that the applicant is willing and available to participate in the conference with the Panel of Examiners. The Office has published a standard form, PTO/SB/444, that fulfills requirements (1) and (3) when submitted with the response.

The P3 request must be filed within two months of the mailing date of the final rejection and prior to the filing of a notice of appeal. The P3 request cannot be filed in addition to a AFCP 2.0 request, Request for Continued Examination, or a notice of appeal in the same application. Doing so will result in the P3 request being determined to be untimely.

After receiving a P3 request, the relevant technology center will verify its compliance and contact the applicant to schedule a conference. If the P3 request is not compliant, no conference will be held. The conference begins with presentation by the applicant, which is limited to 20 minutes. Any materials used by the applicant during the presentation are placed in the file and do not count against the five-page limit on arguments. The applicant is informed of the panel's decision in writing and will indicate one of

the following: (a) final rejection upheld; (b) allowable application; or (c) reopen prosecution.

Given the opportunity for panel review, the opportunity to make a presentation, and the lack of any accompanying USPTO fee, Applicants should give serious consideration to making a P3 request if they are within the two-month window.

Contact Us

If you have any questions or wish to discuss how this decision impacts your business, please contact one of our [Brinks Attorneys](#).