

RICK NEIFELD

From: RICK NEIFELD
Sent: Saturday, July 09, 2016 11:12 PM
To: afterfinalpractice@uspto.gov
Cc: RICK NEIFELD
Subject: Comments regarding the Post-Prosecution Pilot Program (P3 Program)

I am a patent attorney, and I run a small IP boutique law firm. I am active in a variety of patent bar organizations and frequently comment and write on PTO related matters.

These comments are my own. I respond to your request for comments on the Notice and request for comment, "Post-Prosecution Pilot Program", Docket No. PTO-P-2016-0012, 81 FR 44845 (7/11/2016). I refer to this program as the P3 program, herein below.

COMMENTS:

1. The Notice states that "Finally, at any point during the processing of a P3 request, the examiner may enter an Examiner's Amendment placing the application in condition for allowance." You should revise the P3 program by clarifying that the examiner's amendment must be authorized by the applicant for patent.
2. The Notice states that "If a notice of decision indicates "final rejection upheld," the time period for taking further action in response to the final rejection expires on (1) the mailing date of the notice of decision; or (2) the date set forth in the final rejection, whichever is later." I point out that the time period for taking further action in response to the final rejection expiring on the mailing date of the notice provides no relief from delays due to the conference and decision thereupon that result in delay past 3 months from the date of the final rejection. Consequently, this provision provides no relief from the burden and cost of requesting extensions pursuant to 37 CFR 1.136(a) in case of a decision on the P3 request upholding the final rejection. Given that the PTO cannot guarantee a date certain for the communication to the applicant of a "Notice of Decision from Post-Prosecution Pilot Conference" (form PTO-2324), this unforgiving provision is a substantial disincentive to use of the P3 program. You should provide a time for the applicant to act without incurring a 37 CFR 1.136(a) penalty.
3. The Notice states that "entry of the affidavit or other evidence will be governed by 37 CFR 1.116." However, under 37 CFR 1.116(e), admission of any evidence into an application that is finally rejected requires "a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." Consequently, the argument section of a P3 request requires both a showing why the application is allowable, and, a separate argument providing "good and sufficient reasons why the affidavit or other evidence is necessary and also why it was not earlier presented". That is a distinct disincentive to using the P3 program because it raises two additional hurdles to a P3 request being granted that are unrelated to patentability. This is particularly true given that all arguments must be crammed into 5 pages. You should amend the P3 program by expressly waiving the requirement to provide good and sufficient reasons why the affidavit or other evidence is necessary and also why it was not earlier presented.
4. The Notice states that "Entry of any proposed amendment after a final Office action is governed by 37 CFR 1.116." However, 37 CFR 1.116(a)(3), states that an amendment touching the merits of the application "may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented." Consequently, the argument section of a P3 request requires both a showing why the proposed amendment makes the application allowable, and, a separate showing providing "good and sufficient reasons why the amendment is necessary and was not earlier presented". That is a distinct disincentive to using the P3 program because it raises an additional hurdles to a P3 request being granted that are unrelated to patentability and to whether an applicant will pursue an appeal. This is particularly true given that all arguments must be crammed into 5 pages. You

should amend the P3 program by expressly waiving the requirement to provide good and sufficient reasons why the amendment was not earlier presented.

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