

## USPTO P3 Program: What You Need to Know

July 13, 2016

The US Patent and Trademark Office (USPTO) announced a new pilot program for responding to final rejections. This program, called the Post-Prosecution Pilot Program (P3), combines the three-examiner panel of the Pre-Appeal Brief Conference Pilot program (Pre-Appeal) with the submission of non-broadening amendments of the After Final Consideration Pilot Program 2.0 (AFCP 2.0), while also adding an opportunity for applicants to present arguments to the panel. The USPTO will accept P3 requests until January 12, 2017, or until it receives 1600 compliant requests, whichever occurs first. Each technology center in the USPTO may accept up to 200 requests.

**Key takeaway:** If you have a utility application that's been finally rejected, consider using the P3 to get feedback – and possibly an allowance – from a panel of examiners before filing an RCE or notice of appeal.

### Eligibility for P3

The P3 is open to continuation and divisional applications, but not to reissue, design, or plant applications. An applicant may not submit a P3 request after requesting participation in the Pre-Appeal or AFCP 2.0 programs in response to the same final rejection. Similarly, an applicant may not request participation in the Pre-Appeal or AFCP 2.0 programs after having a P3 request accepted in response to the same final rejection. (Pre-appeal and AFCP 2.0 requests can be properly submitted after another final action in same application.)

### The P3 submission

Under the P3, an applicant may respond to a final rejection in a utility application by filing:

1. A transmittal form, such as form [PTO/SB/444](#), that identifies the submission as a P3 submission and requests consideration under the P3;
2. A response under 37 CFR 1.116 with up to five pages of argument;
3. A statement that the applicant is able and willing to participate in a conference with a panel of three examiners; and
4. An optional non-broadening amendment to at least one claim.

Amended claims and signature pages don't count against the five-page limit on arguments, but definitions and affidavits do. The five-page limit is also cumulative, so an applicant may not file two separate papers with a total of more than five pages of argument. Arguments should address appealable matters (e.g., rejections), not petitionable matters (e.g., the finality of the office action).

There is no fee for making a P3 request, but the P3 request must be filed within two months of the notification date of the final office action.

## Evaluating P3 compliance

The USPTO will consider all P3 requests for timeliness and compliance with the program requirements. If a P3 request is timely and compliant, the application will enter the P3 process. If the P3 request is untimely or non-compliant, it will treat the P3 request as an ordinary after-final response. In its next communication, the USPTO will also tell the applicant why the P3 request was denied and issue a Notice of Allowance or Advisory Action in reply to the applicant's response under 37 CFR 1.116

## The P3 conference

If the USPTO accepts a P3 request, it will contact the applicant to schedule the P3 conference. If the applicant cannot arrange a conference within ten calendar days of the USPTO's initial contact, the application may be removed from the P3 program.

At the conference, the applicant will make a 20-minute presentation to a panel of three examiners, including the examiner of record, the Supervisory Patent Examiner (SPE), and a primary examiner, either in person or via phone, video, or web conferencing. If the applicant uses slides or any other materials, these materials will be placed in the file. (Presentation materials won't count against the five-page limit on arguments.) The presentation should focus on the outstanding record or the patentability of the proposed amended claim(s). After the presentation, the applicant will be excused from the conference.

## Notice of decision

The USPTO will inform the applicant of the panel's decision in writing via a [Notice of Decision from Post-Prosecution Pilot Program \(P3\) Conference](#) (PTO-2324). This Notice of Decision will indicate one of three outcomes: (1) final rejection upheld; (2) allowable application; or (3) reopen prosecution. If the final rejection is upheld, the applicant must file a notice of appeal or Request for Continued Examination (RCE) within six months of the mail date of the final rejection. If the application is allowable, the USPTO will mail a Notice of Allowance with the Notice of Decision. And if the USPTO reopens prosecution, it will withdraw the final rejection and issue a new Office action.

The decision is not petitionable, and the USPTO will not grant a petition seeking reconsideration of a panel decision upholding a final rejection.

## Termination of the P3 process

The applicant can terminate the P3 process before receiving the Notice of Decision by filing a notice of appeal, RCE, express abandonment under [37 CFR 1.138](#), request for the declaration of interference, or petition requesting the institution of a derivation proceeding.

## Final thoughts

By giving the applicant an opportunity to address patentability with a panel of examiners, the USPTO hopes to reduce the number of appeals to the Patent Trial and Appeal Board. The Patent Office is currently accepting public feedback on the pilot program. Comments can be sent to [afterfinalpractice@uspto.gov](mailto:afterfinalpractice@uspto.gov).

[Read more about the pilot program](#) 

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## Key Contacts

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