

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

**uspto**

# Patent Public Advisory Committee Quarterly Meeting

## Post Grant Outcomes

Jack Harvey

Assistant Deputy Commissioner for Patent Operations  
August 18, 2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Objectives of Post Grant Outcomes

The purpose of this program is to learn from all post grant proceedings and inform examiners of their outcomes

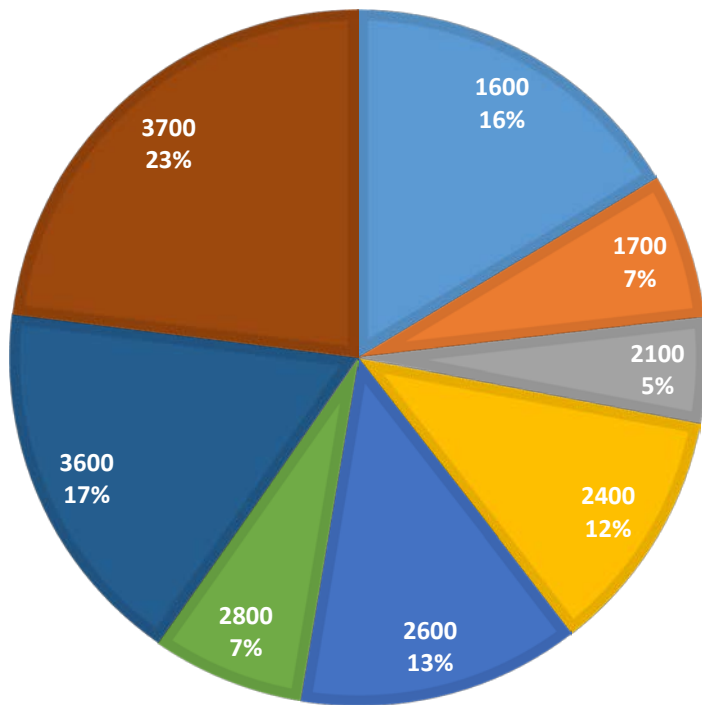
- Propose **three** objectives to accomplish this:
  - **Enhanced Patentability Determinations in Related Child Cases**
    - Provide examiners with prior art submitted during PTAB AIA trial proceedings
    - Other petition information, expert testimony, declarations, interpretations...
  - **Targeted Examiner Training**
    - Data collected from the prior art submitted and examiner behavior will provide a feedback loop on best practices
  - **Examining Corps Education**
    - Provide examiners a periodic review of post grant (and post examination) outcomes focusing on technology sectors

# Objective 1 - Enhanced Patentability Determinations in Related Child Cases

- A Pilot to:
  - Identify those patents being challenged at the PTAB under the AIA Trials that have pending related applications in the Patent Corps
  - Provide the examiners of those pending related applications access to the prior art submitted with the IPR petition

# Objective 1 – Pilot Statistics

DISTRIBUTION OF PILOT APPLICATIONS  
BY TECHNOLOGY CENTER: PP15-PP21

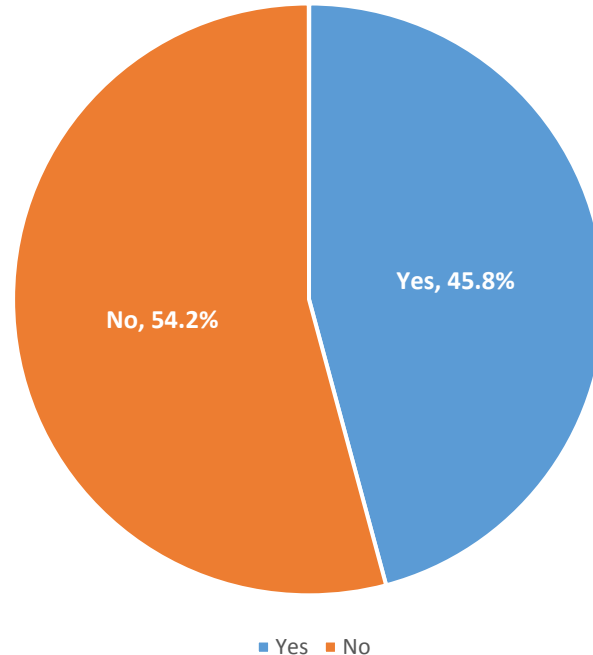


- 1600
- 1700
- 2100
- 2400
- 2600
- 2800
- 3600
- 3700

Technology Center	Number of Pilot Applications
1600	111
1700	46
2100	33
2400	78
2600	89
2800	48
3600	117
3700	156
<b>Grand Total</b>	<b>678</b>

# Objective 1 – Pilot Statistics cont.

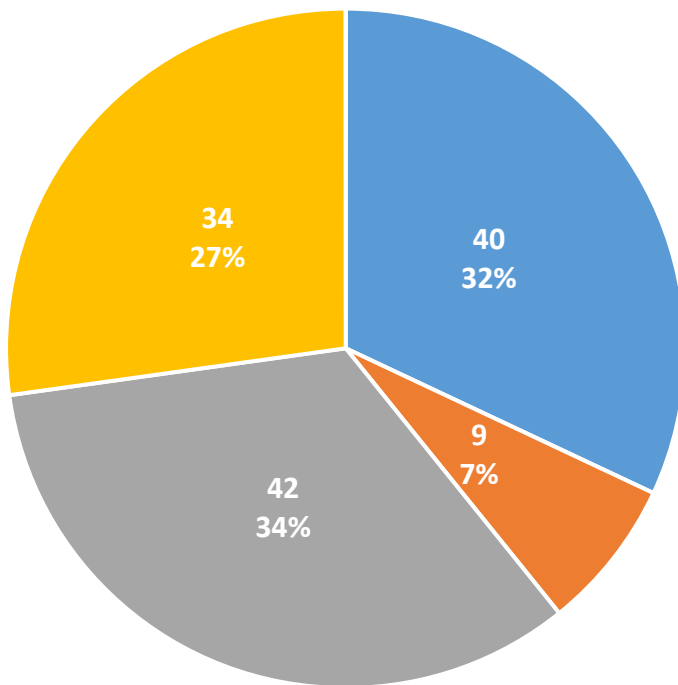
In the Office Action of the child case, did the examiner refer to any of the references cited in the AIA trial petition of the parent case?



Based on 201 survey responses

# Objective 1 – Pilot Statistics cont.

If the examiner did not use any references cited in the AIA Trial Petition, why?

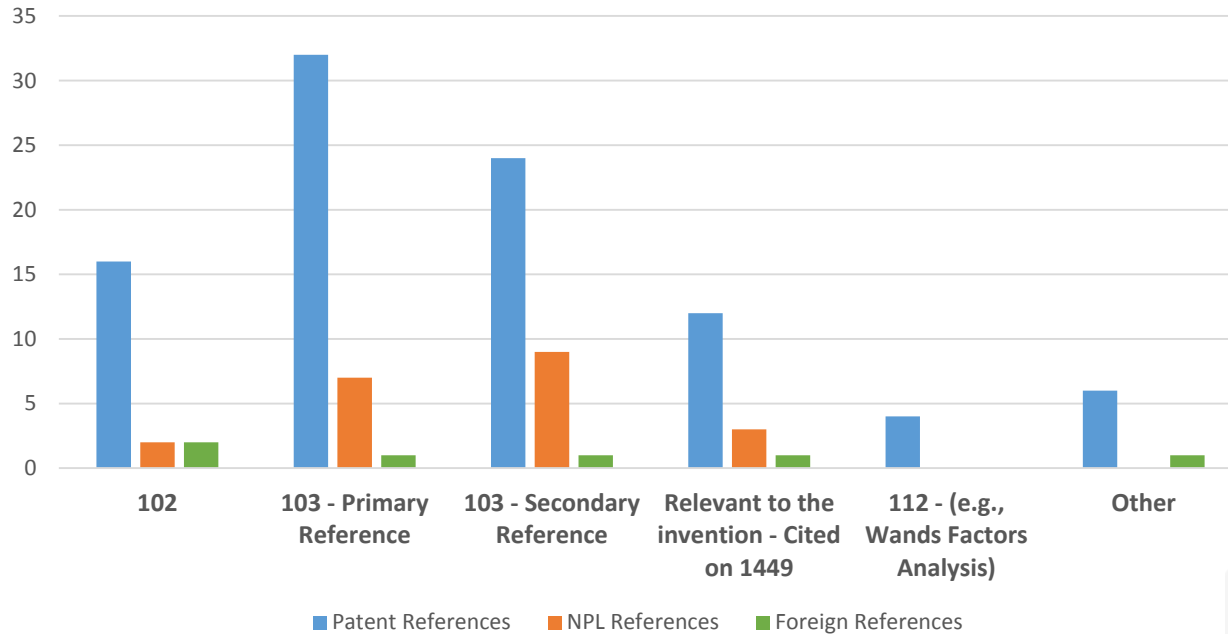


- The claims in my pilot case were substantially different from the parent case.
- I disagreed with the petitioner's analysis of the prior art and/or claims.
- I was able to find better art on my own.
- Other

Based on 102 survey responses

# Objective 1 – Pilot Statistics cont.

How did the examiner apply the AIA Trial reference(s) in the pilot application?



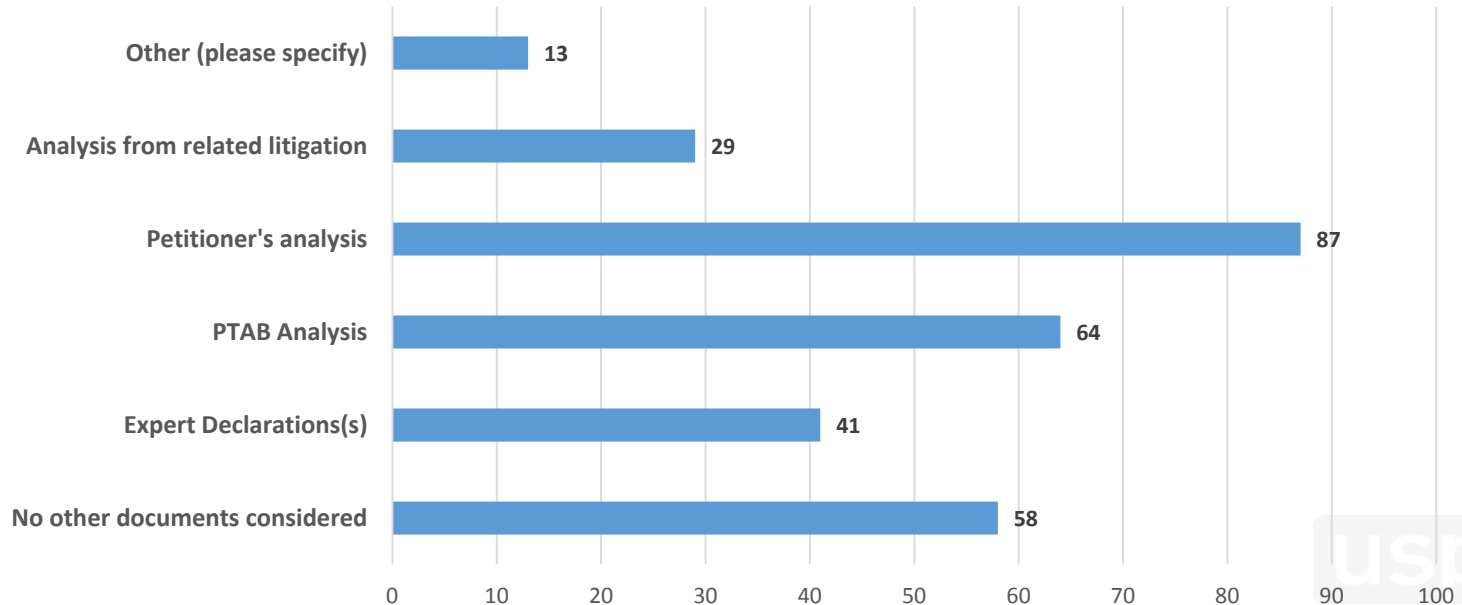
Based on 79 survey responses





# Objective 1 – Pilot Statistics cont.

Did the examiner consider any other documents submitted with the petition, e.g., expert declarations, PTAB analysis?



Based on 174 survey responses.

# Survey Comments

- All documents have been submitted in the IDS. Therefore, I did not need the access to the AIA data.
- The petition as a source of relevant art is a great use of information that the PTO had access to already- would love for other such relevant sources to be flagged for examiners (re-exam art? other programs?).
- The trial documents were not helpful in my case because the claims were so different, but I can see how the pilot could be very helpful if the claims were similar. So I think the pilot is generally a good idea.
- It's helpful to have the art/arguments when working on a sibling case of the application under petition... especially if it gets overturned.
- This is an excellent program and should absolutely continue.
- I felt important for the first time in years. I wish you guys would reinstitute the annual Legal Lectures that were a great sampling of court cases relevant to patents, so us examiners can keep up with legal precedence.
- The particular petition was related to 35 USC 101 rejection and nothing of prior art. This petition did not have to be referred to me because it did not help me finding any prior arts than what was already available to me from the parent application patent prosecutions.
- The number of documents submitted for analysis by the Examiner should be restricted to a reasonable number. In the present case, the IDS includes over 1000 pages for analysis. On top of that, the Examiner should consider the documents submitted by this Pilot. No time left for instant invention.
- I think it is an excellent tool for allowing the Examiner to see what is involved in litigation of a patent. I learned a lot from the filing and exhibits, e.g. having the terms of claim language be argued by the petitioners not just deciding whether the scope of patent claims overlaps. It was really eye-opening and great experience.

# Objective 2 – Targeted Examiner Training

- Data collected from the prior art submitted, resulting examiner behavior and the survey, will provide a feedback loop on best practices
- Potential to educate examiners on:
  - Prior art search techniques
  - Sources of prior art beyond what is currently available
  - Claim interpretation
  - PTAB proceedings and how it relates to child applications

# Objective 3 – Examining Corps Education

- Leverage results of all post grant proceedings (and post examination) to educate examiners on the process and results
  - Provide examiners a periodic review of post grant outcomes focusing on technology sectors
  - Utilize the proceedings to give examining corps a fuller appreciation for the process
  - Collecting Ex Parte PTAB decisions by technology to recognize trends for examiner education

# Post Grant Outcomes Summary

- Learn from the results of post grant proceedings
- Shine a spotlight on highly relevant prior art uncovered in post grant proceedings
- Enhance patentability of determination of related child cases
- Build a bridge between PTAB and the examining corps

# Next Steps

- Develop training and best practices gleaned from pilot and implement corps-wide
- Send your feedback to:  
[WorldClassPatentQuality@uspto.gov](mailto:WorldClassPatentQuality@uspto.gov)
- More information at the PGO Pilot home page:  
<http://www.uspto.gov/patent/initiatives/post-grant-outcomes-pilot>

# Questions and Comments

**Jack Harvey**

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# Patent Public Advisory Committee Quarterly Meeting

## Post Prosecution Pilot

Jerry Lorengo

Director, Technology Center 1600  
August 18, 2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE





# Introduction to the Post-Prosecution Pilot (P3)

- Advanced as a program of the Enhanced Patent Quality Initiative (EPQI) under Pillar 3, Excellence in Customer Service
- Developed to test its impact on enhancing patent practice during the period subsequent to final rejection and prior to the filing of a notice of appeal

# Overview of the Post-Prosecution Pilot (P3)

- Retains popular features of the Pre-appeal Brief Conference Pilot and After Final Consideration Pilot (AFCP) 2.0 programs:
  - Consideration of 5-pages of arguments after final
  - Consideration of non-broadening claim amendments after final
- Adds requested features:
  - Presentation of arguments to a panel of examiners
  - Explanation of the panel's recommendation in a written decision after the panel confers

# Post-Prosecution Pilot (P3) Begins

- Federal Register Notice (81 FR 44845) July 2016
- Pilot began July 11, 2016
- Runs six (6) months or upon receipt of 1,600 compliant requests, whichever occurs first
  - 200 per Technology Center
- Formal comments about P3 will be received through November 14, 2016 at [AfterFinalPractice@uspto.gov](mailto:AfterFinalPractice@uspto.gov)



# P3 Pilot Participation

Open to nonprovisional and international utility applications filed under 35 USC 111(a) or 35 USC 371 that are under final rejection.

The following are required for pilot entry:

- A **request**, such as in **PTO/SB/444**, must be filed via EFS-Web
  - within 2 months of the mail date of the final rejection and prior to filing notice of appeal
- A **statement** that applicant is willing and available to participate in P3 conference with the panel of examiners
- A **response** comprising no more than five (5) page of arguments under 37 CFR 1.116 to the outstanding final rejection, exclusive of any amendments
- Optionally, a proposed non-broadening amendment to one (1) or more claim(s)

# P3 Pilot Requirements

- No fee to participate
- No previously filed proper request to participate in the Pre-Appeal or AFCP 2.0 programs to the same outstanding final rejection
- Once a P3 request has been accepted:
  - no additional response(s) under 37 CFR 1.116 will be entered unless requested by examiner
  - impermissible to request participation in Pre-Appeal or AFCP 2.0 programs once a P3 request has been accepted

# P3 Pilot Compliance

For requests considered timely and compliant, the Office will enter the application into the pilot process.

For requests considered untimely or otherwise non-compliant (or if filed after the technology center has reached its limit):

- The Office will treat the request as in the same manner it would treat any after final response absent the P3 request.
  - No conference will be held.
- The next communication issued by the Office will indicate:
  - the reason why the P3 request was found to be untimely or otherwise non-compliant;
  - the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment; and
  - the time period for the applicant to take further action.

# P3 Pilot Process

1. The Office will contact the applicant to schedule the P3 conference.
2. The applicant will make an oral presentation to the panel of examiners with such participating being limited to 20 minutes.
3. The applicant will be informed of the panel's decision, in writing, following complete consideration of the P3 request.

# P3 Pilot Notice of Decision

Applicant will be informed, in writing via a Notice of Decision from Post-Prosecution Pilot Program (P3) Conference (PTO-2324), as to the outcome of the conference.

Three possible outcomes are:

A. Final Rejection Upheld

- The status of any proposed amendment(s) will be communicated
- The time period for taking further action will be noted

B. Allowable Application

C. Reopen Prosecution

All of the above outcomes will include an Explanation of Decision



# P3 Pilot – Looking Ahead

- ❖ Consider:
  - Internal and external survey results
  - Formal Comments from FR Notice
  - Stakeholder feedback about the program from other sources
- ❖ Decide:
  - Whether or not to continue the program, optionally with modifications

# For More Information on P3

- Visit our website:  
<http://www.uspto.gov/patent/initiatives/post-prosecution-pilot>
  - Program details and forms
  - Examiner training materials
  - FAQs
- Contact us by email:  
[PostProsecutionPilot@uspto.gov](mailto:PostProsecutionPilot@uspto.gov)

# Questions and Comments

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# Patent Public Advisory Committee Quarterly Meeting

## Stakeholder Training on Examination Practice and Procedures (STEPP)

Gary Jones

Director, Office of Patent Training  
August 18, 2016

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Stakeholder Training on Examination Practice and Procedure (STEPP) – Goals

- To further the USPTO's mission of delivering intellectual property information and education to external customers.
- To improve the customer experience throughout the patent process
- To increase transparency with respect to how an application is examined at the USPTO

# STEPP Program

- 3-day training program that focuses on the life of an application from docketing to allowance
- Training materials were derived from training delivered to patent examiners and other USPTO employees
- Training delivered by USPTO trainers

# STEPP: 3-Day Training Program

## Day 1: Courses

The Role of a Patent Examiner

Reading and Understanding an Application

Claim Interpretation

Wrap Up Q&A

35 USC 101, 112(a), and 112(b)

# STEPP: 3-Day Training Program

## Day 2: Courses

Planning a Search

Mapping Art to Claims

Overview of 35 U.S.C. 102 and 102

Q&A



# STEPP: 3-Day Training Program

## Day 3: Courses

Writing an Office Action and  
Responding to Applicant

Patent Trial and Appeal Board (PTAB)

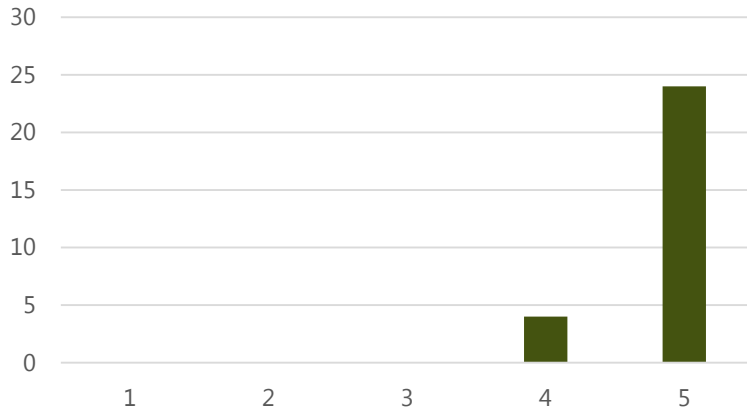
Double Patenting and Restrictions

Central Reexam Unit (CRU)

Course Wrap Up and Q&A

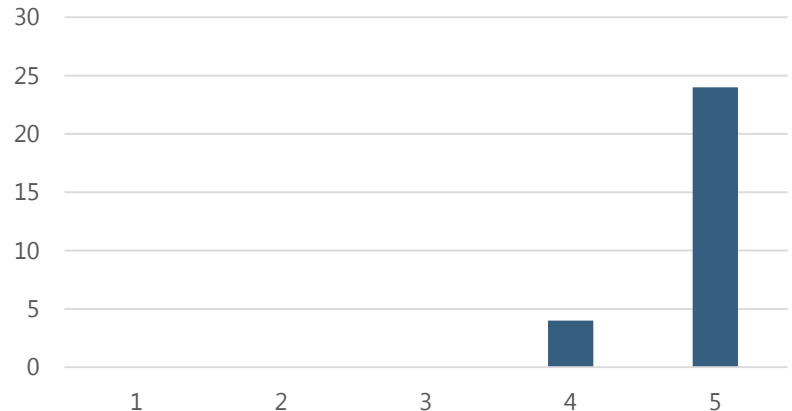
# Course Ratings

My knowledge and skills increased as a result of this course.



■ My knowledge and skills increased as a result of this course.

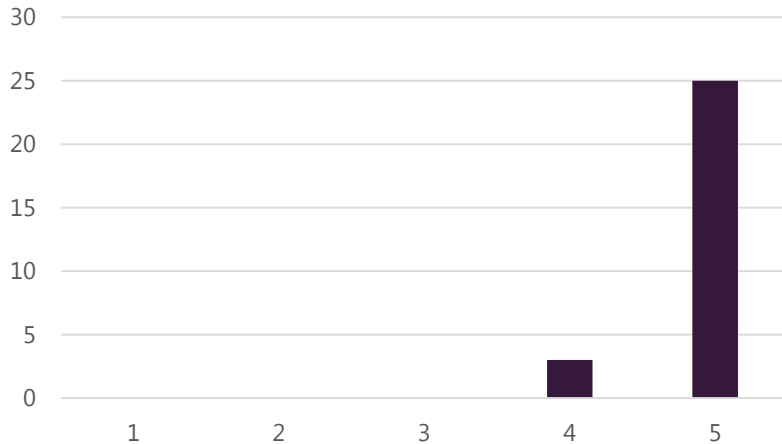
I would recommend this course to someone else.



■ I would recommend this course to someone else.

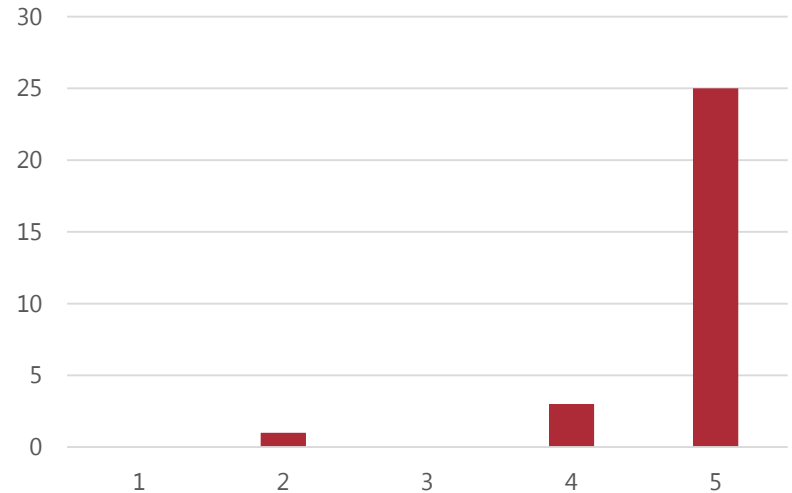
# Course Ratings

I plan to apply the knowledge and skills learned in this course.



■ I plan to apply the knowledge and skills learned in this course.

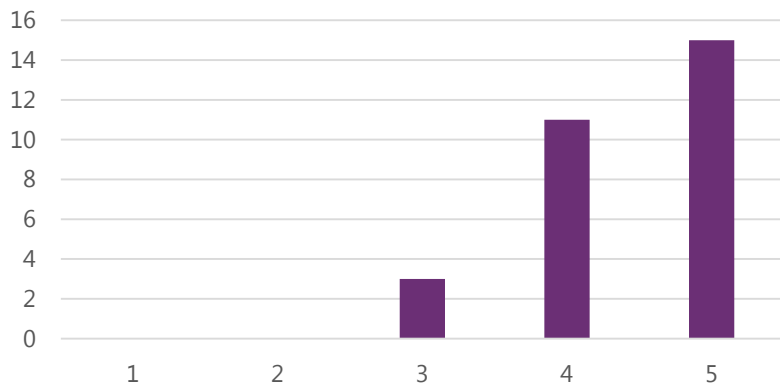
I understood the learning objectives



■ I understood the learning objectives

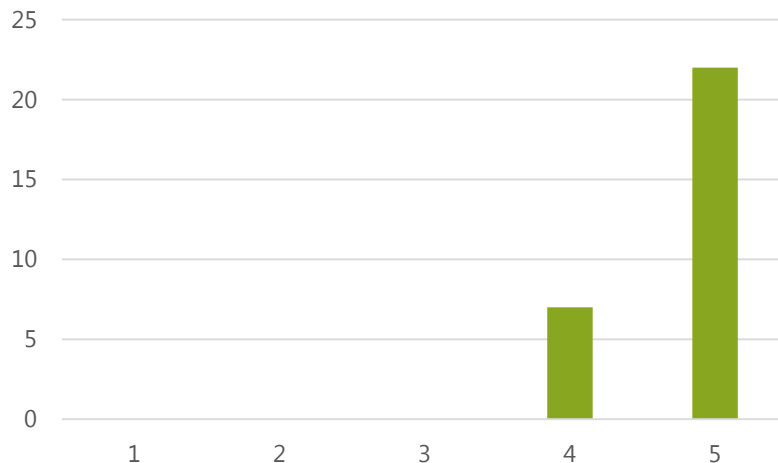
# Course Ratings

There was a sufficient amount of time for me to understand the content.



■ There was a sufficient amount of time for me to understand the content.

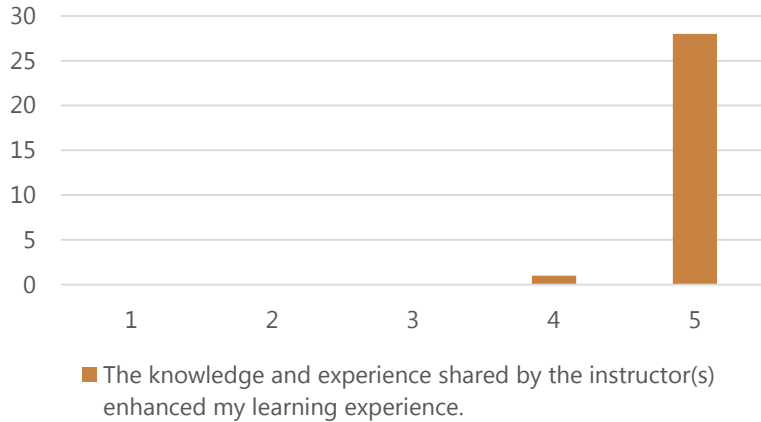
This course was easy to follow.



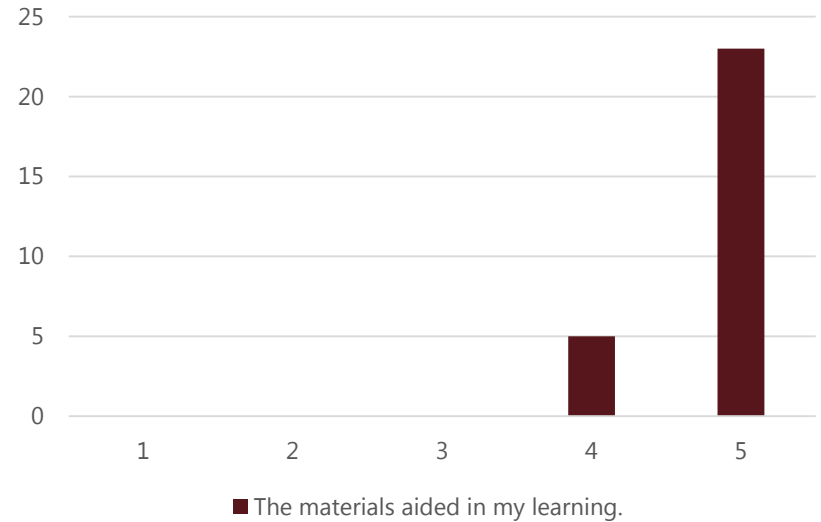
■ This course was easy to follow.

# Course Ratings

The knowledge and experience shared by the instructor(s) enhanced my learning experience.

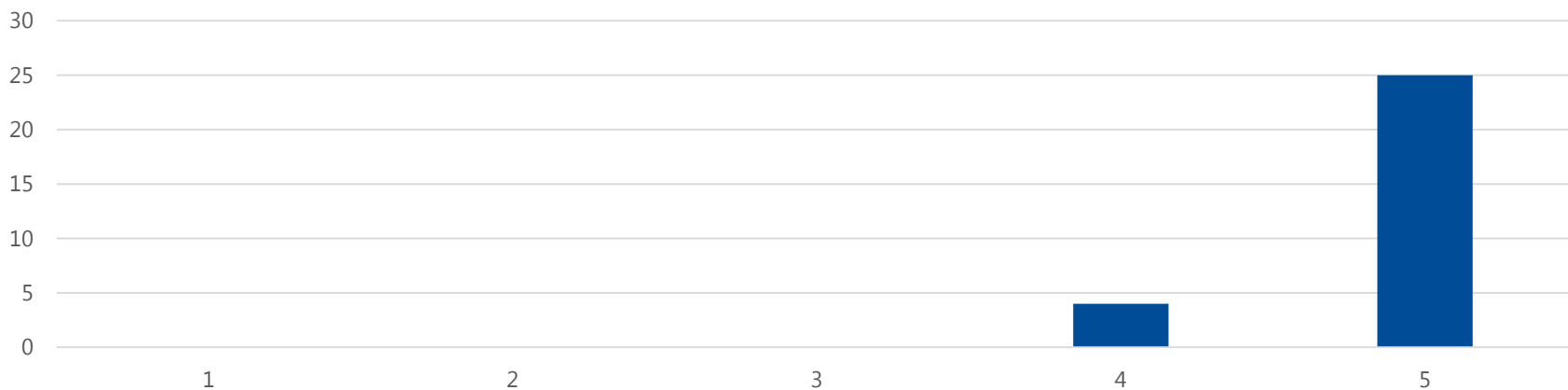


The materials aided in my learning.



# Course Ratings

I was given ample opportunity to discuss and ask questions about the course material.



■ I was given ample opportunity to discuss and ask questions about the course material.

# Course Ratings

Do you have any additional comments regarding the STEPP Program?

- "Overall, I think this is a very beneficial program. I learned a lot of useful information that I can use in my practice"
- "The program was beyond my expectations and the approachability of the staff made this 3 day program a delight. I hope that future programs continue as this makes the USPTO seem more transparent and willing to assist the public and practitioners get strong valid patents"
- "I can't thank you enough! This was tremendous for my clients, my practice, my career, and my optimism about the US continuing as a leader of innovation! My commitment to fostering innovation is reinvigorated. Keep offering these types of training to the public!"

# Course Ratings

- "Fantastic course. As someone who is transitioning into IP Law this was invaluable. The instructors were well prepared and accessible. The course materials were well developed. Truly amazing. Would definitely recommend this course to any practitioner, whether experienced or a novice practitioner"
- "Great program with tons of information, presented with clear resources, knowledgeable speakers and great organization. Everyone was very engaging"



# Course Ratings

What was the best part of this course?

- "By far the hands on exercises were the most informative and impactful"
- "Information about the office's emphasis on 'compact prosecution' shed new light on the back and forth"

What recommendations do you have for improving this course?

- "Much less lecture and much more hands on. Possibly make lecture slides/videos available before the start of the program and jumping into the hands on exercises after brief lectures."

# Next Steps

- Deliver STEPP workshops in each of the four regional offices over the next four quarters.
- Provide additional STEPP workshops in Alexandria. (frequency to be determined)
- Increase workshop size somewhat, while maintaining the ability to maintain the hands-on and answer questions.

# Questions and Comments

**Gary Jones**

Director, Office of Patent Training

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