

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**





# **Patent Quality Chat**

# **Using Petitions Effectively in**

# **Patent Prosecution**

August 8, 2017

UNITED STATES  
PATENT AND TRADEMARK OFFICE





**To send in questions or comments during the  
webinar, please email:**

**[PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)**

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# <http://www.uspto.gov/patentquality>

## Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to [our mission](#) at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the **Office of the Deputy Commissioner for Patent Quality**, along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

### Highlights



#### [Patent Quality Chat](#)

Tune into our next webinar on Tuesday, July 11, from noon - 1 p.m. ET, on "Latest Updates in USPTO's Work Sharing Efforts".

#### [Quality Metrics](#)

See our new metrics approach, categorizing into product, process and perception indicators.

#### [Stakeholder Training on Examination Practice and Procedure \(STEPP\)](#)

Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.

### Areas of Focus

Collaboration with our stakeholders has directed our focus within three areas, where we can best improve patent quality.

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# <http://www.uspto.gov/patent/initiatives/patent-quality-chat>

2017 Chat Series

Date	Topic	Speaker
Tuesday, August 8 Noon-1 p.m. ET	Using Petitions Effectively in Patent Prosecution <ul style="list-style-type: none"><li>• Presentation Slides (coming soon)</li><li>• Video (coming soon)</li></ul>	<ul style="list-style-type: none"><li>• <b>Charles Kim</b> Director, Office of Petitions</li><li>• <b>Namrata Boveja</b> Acting Deputy Director, Office of Petitions</li></ul>
Tuesday, July 11 Noon-1 p.m. ET	Latest Updates in USPTO's Work Sharing Efforts <ul style="list-style-type: none"><li>• <a href="#">Presentation Slides</a></li><li>• <a href="#">Video</a></li></ul>	<ul style="list-style-type: none"><li>• <b>Mark Powell</b> Deputy Commissioner for International Patent Cooperation</li><li>• <b>Daniel Hunter</b> Director for International Work Sharing, Planning and Implementation, Office of International Patent Cooperation</li></ul>
Tuesday, June 13 Noon-1 p.m. ET	Patent Quality Metrics <ul style="list-style-type: none"><li>• <a href="#">Presentation Slides</a></li><li>• <a href="#">Video</a></li></ul>	<ul style="list-style-type: none"><li>• <b>Greg Vidovich</b> Associate Commissioner for Patent Quality</li><li>• <b>Jim Dwyer</b> Director, Office of Patent Quality Assurance</li></ul>
Tuesday, May 9 Noon-1 p.m. ET	eCommerce Modernization (eMod) Update <ul style="list-style-type: none"><li>• <a href="#">Presentation Slides</a></li><li>• <a href="#">Video</a></li></ul>	<ul style="list-style-type: none"><li>• <b>Lisa Tran</b> Communications Manager for eCommerce</li><li>• <b>Richard Fernandez</b> eMod Project Manager</li></ul>

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# Patent Quality Chat

## Using Petitions Effectively in Patent Prosecution

**Charles Kim**

Director, Office of Petitions

**Namrata Boveja**

Acting Deputy Director, Office of Petitions

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)

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# Office of Petitions

- Central repository for deciding most petitions, including those signed by the Commissioner or other top USPTO officials.
- Reviews and decides:
  - Over 45 types of petitions (see MPEP 1002.02(b))
  - Approximately 50,000 petitions per year
- Petitions Help Desk
- Inventor's Assistance Center (IAC)

# Patents Petitions Timeline

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Patents Trademarks IP Policy Learning and Resources Quick Links

Home / Patents: Application Process / Petitions / Timeline / Patents Petitions Timeline

## Patents Petitions Timeline

The **Patents Petitions Timeline** provides applicants access to petitions that can be submitted during each stage of patent prosecution process and information related to each specific petition and deciding office. Also, the timeline provides information on both the historical grant rates and the pendency of decided petitions.

- 1 PRIOR TO EXAMINATION
- 2 DURING EXAMINATION
- 3 AFTER CLOSE OF PROSECUTION
- 4 ALLOWANCE/AFTER PAYMENT OF ISSUE FEE
- 5 POST ISSUANCE

## PRIOR TO EXAMINATION

- Abandonment Related
- Access
- Advancement of Examination
- Application Publications
- Assignee Related
- Conversion of Applications
- Correction of Inventorship
- Entity Status
- Expunging Papers
- Extensions of Time
- Filing Date Related
- Foreign Priority or Domestic Benefit Related
- General and Misc
- Public Use Related
- Retroactive Foreign Filing Licenses
- Specifically Related To International Applications
- Suspension or Waiver of Rules (not provided for in any Statute)
- Withdrawal of Attorney Related

## DURING EXAMINATION

- Abandonment Related
- Access
- Advancement of Examination
- Application Publications
- Assignee Related
- Conversion of Applications
- Correction of Inventorship
- Entity Status







# Patents Petitions Timeline (Cont.)



## Abandonment Related Petitions

IPLA – International Patent Legal Administrator  
 ODM – Office of Data Management  
 OPET – Office of Petitions  
 TC – Technology Center

### Generally Available

Petition Type	Avg. Days Pending of Decided Petitions	Grant Rate Percentage	Deciding Office	ePetition Option
502 - To Revive an Abandoned Application-Unintentional Delay (37 CFR 1.137(a))	147	82%	OPET	
510 - To Accept Late Payment of Issue Fee - Unintentional Late Payment (37 CFR 1.137(a))	115	81%	OPET	
525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - <b>Failure to receive an Office Action</b>	211	49%	OPET	
525 - To Withdraw a Holding of Abandonment (37 CFR 1.181) - <b>Reply Timely Filed</b>				
536 - Under 37 CFR 1.137(f)	76	90%	OPET	
561 - Revive Abandoned Application, Continuity Purposes Only	72	98%	OPET	

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# ePetitions

The logo for ePetitions, featuring a stylized lowercase 'e' in a dark blue circle followed by the word 'Petitions' in white, all set against a bright orange rectangular background.

**ePetitions**

GET IMMEDIATE DECISIONS

## Overview

An ePetition is filed and immediately processed online through EFS-Web if all filing requirements are met. The USPTO offers 12 web-based ePetitions and two PDF-based ePetitions.

The official logo for the United States Patent and Trademark Office (USPTO), consisting of the lowercase letters 'uspto' in a white, sans-serif font inside a light gray rounded rectangle.

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# ePetitions Benefits

## ePetitions Benefits

### Save Time

#### **Faster Petition Processing**

Filing an ePetition allows petitioners to directly input the requisite filing information into a secure Web interface and immediately receive an ePetition grant. Petitioners save time by avoiding delays associated with manually-processed petitions.

### Auto-Granting

#### **Immediate Petition Grant upon Submission**

Submitted ePetitions are auto-processed and immediately granted upon submission if all requirements are met. The auto-granting of submitted ePetitions is advantageous for time sensitive petitions.

### Instant Feedback

#### **Instant Feedback on Requirements**

Feedback is immediately provided throughout the ePetition filing process to assist petitioners in meeting all filing requirements necessary for compliance with petition rules and to assure that fees will not be collected by the Office until the petition is acceptable for submission and grant.

# ePetitions: Get Immediate Decisions

## Web-based ePetitions:

- ➔ • Petitions for Revival
  - Petition to Accept Late Payment of Issue Fee - Unintentional Late Payment (37 CFR 1.137(a))
  - Petition for Revival of an Application based on Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))
  - Petition for Revival of an Application for Continuity Purposes Only (37 CFR 1.137(a))
  - Petition for Revival of an Abandoned Patent Application Abandoned Unintentionally (37 CFR 1.137(a)) (For Cases Abandoned After 1st Action and Prior to Notice of Allowance)
- ➔ • Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2))
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2))
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3))
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2) with Assigned Patent Number)
  - Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(3) with Assigned Patent Number)
- ➔ • Petition to Accept Unintentional Delayed Payment of the Maintenance Fee (37 CFR 1.378(b))
- ➔ • Petition to Make Special Based on Age (37 CFR 1.102)
- ➔ • Request for Withdrawal as Attorney or Agent of Record (37 CFR 1.36)
- ➔ • Petition to Correct Assignee After Payment of Issue Fee (37 CFR 3.81(b))



# ePetitions Resource Page

The screenshot shows the top portion of the USPTO website. On the left is the 'uspto' logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO', along with a search bar containing 'Search uspto.gov'. Below this is a navigation bar with tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', and a 'Quick links' dropdown menu. At the bottom of the header is a breadcrumb trail: 'Home / Patents: Application Process / Filing Online / ePetition Resource Page', and 'Share' and 'Print' icons.

Filing online

EFS-Web Announcements

FAQS

First Action Interview

New Users

**ePetitions**

eTerminal Disclaimer

## ePetition Resource Page

The ePetitions Resource Page provides useful information and guidance regarding the submission, automatic processing, and immediate grant of ePetitions.



- **Secure Filing with Auto-Grant.** Filing an ePetition via EFS-Web automates the petition process and allows petitioners to directly input the requisite information into a secure Web interface and immediately receive an ePetition decision.
- **Saves Time when Immediate Petition Decisions are Important.** Time savings using ePetitions is especially advantageous for critical petitions where an automatic petition grant would reduce delays in restoration of patent rights, expedite withdrawal from representation and redirect Office correspondence to the new correspondence address, and initiate the revival of an abandoned application to save patent term adjustment time.
- **Increased accuracy** by providing immediate feedback to petitioners on the necessary filing requirements.
- **Current statistics** regarding the pendency and grant rate comparisons between filing an ePetition and non-ePetition are available on our [Dashboard](#).

For questions regarding Patent e-Filing, or to suggest improvements to the online system, please send an email to [ebc@uspto.gov](mailto:ebc@uspto.gov) or call the Patent Electronic Business Center at **1-866-217-9197** (toll free) or **571-272-4100** from 6 a.m. to 12 Midnight Eastern Time, Monday - Friday.

## ePetitions Computer Based Training (CBT)

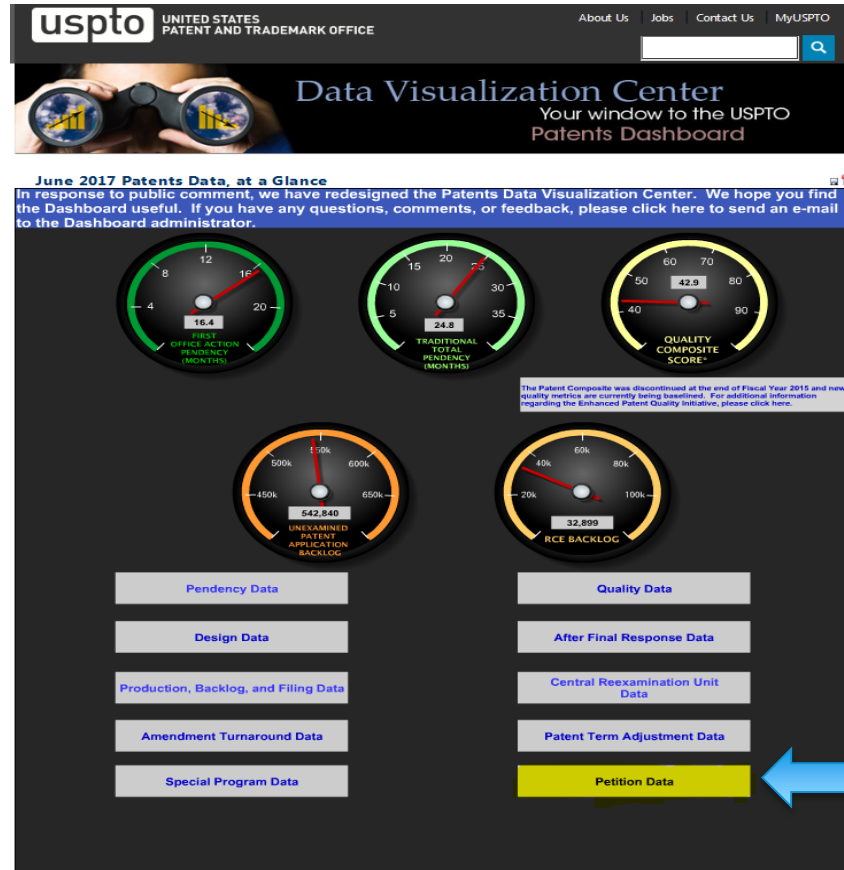
The CBT provides an overview of ePetitions and includes a step-by-step demonstration that illustrates how quick and easy it is to submit the Request for Withdrawal as Attorney or Agent of Record (37 CFR 1.36) via ePetition.



Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



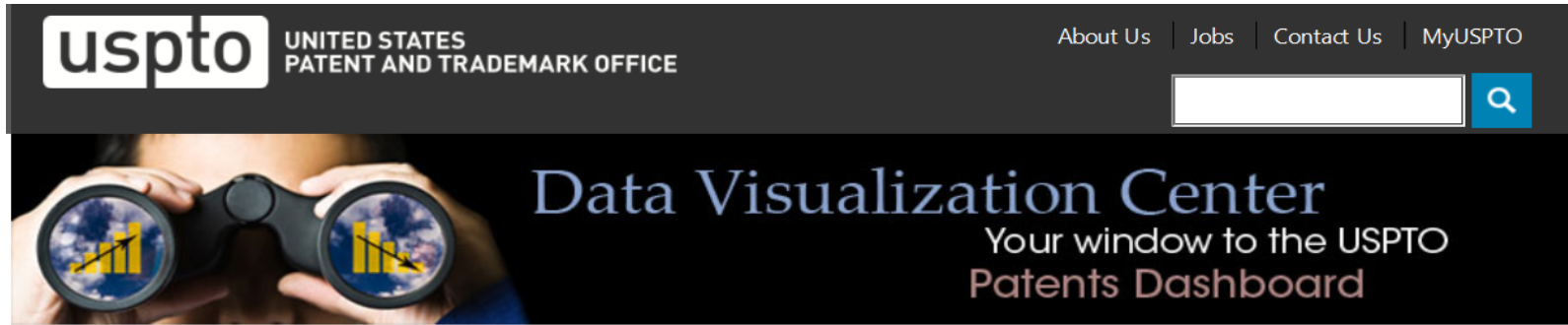
# Data Visualization Center



Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# Frequently Filed Petitions



The banner features the USPTO logo on the left, navigation links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO' on the right, and a search bar. Below the navigation is a large image of a person's hands holding binoculars. The lenses of the binoculars show a bar chart with an upward trend. To the right of the binoculars, the text reads 'Data Visualization Center' in a large, serif font, followed by 'Your window to the USPTO Patents Dashboard' in a smaller, sans-serif font.

## Frequently Filed Petitions in the Office of Petitions

Petition Type	Avg Days Pending of Decided Petitions in the Past 12 Months	Grant Rate Percent of Total Petitions Decided in the Past 12 Months
To Make Entity Status Large from Small	127	49%
To Join Track One (Prioritized Examination)	40	94%
To Join Patent Prosecution Highway (PPH)	75	79%
To Make Application Special on Grounds of Age or Health	69	93%
Revival Based on Unintentional Delay in Abandoned Application	166	78%
To Accept Unintentionally Delayed Claim for Priority	149	66%
Withdrawal of Attorney From Application	172	32%
Issue Patent in the Name of Assignee After the Issue fee is Paid	194	85%
To Accept Unintentional Delayed Payment of the Maintenance Fee	183	74%
Patent Term Adjustment After Patent Issued	226	52%

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# E-Petitions and Non E-Petitions Data



## E-Petitions and Non-E-Petitions Data

Petition Type	Total E-Petitions Decided/Filed in Past 12 Months	Average Days Pending of E-Petitions	Grant Rate Percent of Total E-Petitions Decided in the Past 12 Months	Total Non-E-Petitions Decided in the Past 12 Months	Average Days Pending of Non-E-Petitions Decided in the Past 12 Months	Grant Rate Percent of Total Non-E-Petitions Decided in the Past 12 Months
To Make Application Special on Grounds of Age or Health	1,665	0	100%	1,427	69	93%
Revival based on Unintentional delay in abandoned application	1068	0	100%	5,981	166	78%
Revive Abandoned Application for Failure to Notify the USPTO of Foreign Filing	109	0	100%	61	165	77%
Revive a Patent Application for Continuity Purposes Only When Abandoned Unintentionally	91	0	100%	81	128	94%
Withdrawal of Attorney From Application	1,711	0	100%	1,910	172	32%
Withdraw Application From Issue After Issue Fee is Paid	2,262	0	100%	194	6	84%
Revive Patent Application for Unintentional Late Payment of the Issue Fee	642	0	100%	2,025	149	75%
Withdraw From Issue Patent Application With Patent Number Assigned	2,974	0	100%	258	3	90%
Withdraw Patent Application From Issue to Expressly Abandon	17	0	100%	15	26	67%
Issue Patent in the Name of Assignee After the Issue Fee is Paid	163	0	100%	519	194	85%
To Accept Unintentional Delayed Payment of the Maintenance Fee	1,587	0	100%	861	183	74%

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# Helpful Tips

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# Helpful Tips: Document Codes

## Document Codes

- Petitions that are filed without the proper document code can result in delays in processing the petition
  - Use of 'letter' or 'miscellaneous' codes can cause delays unless someone reviews and identifies these papers as a petition and notifies the appropriate office of the petition
  - "PET.OP" is the most frequently used document code for most petitions handled by the Office of Petitions

# Helpful Tips: Petitions are NOT a Response

## Reminder: Petitions Are Not A Response To An Office Action

- Petitions do not stop the time running against an applicant for filing a response to an Office action
- Even if applicant is asking for review of the decision by the Office of Petitions, a response must be filed before the period for reply expires or the application will become abandoned

# Helpful Tips: To Avoid Abandonment

## Avoid Abandonment

- **Terminal Disclaimers including eTerminal Disclaimers**
  - If the only remaining rejection in an Office action is an obviousness-type rejection, a complete response is either a reply by the applicant showing that the claims subject to the rejection are patentably distinct from the reference claims or filing of a terminal disclaimer in accordance with 37 CFR 1.321 in the pending application(s) with a reply to the Office action
  - Filing a terminal disclaimer by itself does not obviate the need to respond under 37 CFR 1.111
- **Notice of Allowance**
  - Should review it carefully to ensure there are no outstanding requirements
  - For example, if the box is checked on the Notice of Allowance form indicating that corrected drawings (as “replacement sheets”) must be submitted, the Applicant needs to send in a response

# Helpful Tips: To Avoid Abandonment (Cont.)

## Avoid Abandonment


- **Interview Summaries**

- All business with the U.S. Patent and Trademark Office should be transacted in writing under 37 CFR 1.2
- Verbal agreements do not constitute a formal response
- For example, if an examiner indicates a new Office action will be mailed out or that the replacement drawings satisfy a previously raised objection in an interview, this needs to be indicated in writing in the record

- **Notice to File Missing Parts**

- Common mistakes that lead to Notice to File Missing Parts
  - Specification Format - 37 CFR 1.52, 37 CFR 1.71-1.75, 1.77, and 1.121(b) & (c)
  - Drawing Format - 37 CFR 1.84 and 1.121(d)
  - Application Data Sheet (ADS) - 37 CFR 1.76
  - Signatures - 37 CFR 1.4
  - Micro Entity Certification - 37 CFR 1.29

# Helpful Tips: Notice to File Missing Parts




UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
--------------------	-----------------------	-----------------------	------------------------

CONFIRMATION NO.  
FORMALITIES LETTER



Mail date → Date Mailed: 01/28/2015

**NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION**

FILED UNDER 37 CFR 1.53(b)  
*Filing Date Granted*

**Response period**

**Items Required To Avoid Abandonment**

An application number and filing date have been recorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

# Helpful Tips: Last-Minute Filings

## Last-Minute Filings

- Oath/Declaration
  - Applicant can now defer filing until the Notice of Allowance is issued. However, an application goes abandoned by law if an oath/declaration is not filed by the time the issue fee is paid
    - It may become difficult to obtain all the necessary signatures (e.g., inventor may refuse to sign)
    - May need to file a request to accept oath/declaration without all signatures

# Helpful Tips: Last-Minute Filings (Cont.)

## Last-Minute Filings (Cont.)

- Benefit/Priority Claims
  - Ensure benefit/priority information is properly listed in the application data sheet (ADS)
  - Using Web-based/Corrected Web-based ADS can help ensure that benefit/priority information is correctly entered into the ADS and changes are properly marked-up
  - Promptly review the filing receipt to verify accuracy of benefit/priority information
  - Avoid petitions for unintentionally delayed benefit/priority claims, which can be costly and can cause prosecution delays




# Helpful Tips: Filing Receipt Example

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY DOCKET NO	TOT CLAIMS	IND CLAIMS
59-956,507	02/03/2014	3773	1260	45456-0102	12	1

CONFIRMATION NO. 7285

12346

FILING RECEIPT



\*OC0000057605684

Inventor(s)  
Charles Jordan, Sr. Brooklyn, NY  
Alexander Robert Thompson, New York, NY  
Kwan Jian Pak Seoul, KOREA, REPUBLIC OF,

Applicant(s)  
VICTOR PEST CONTROL COMPANY  
Assignment For Published Patent Application  
VICTOR PEST CONTROL COMPANY

Power of Attorney: The patent practitioners associated with Customer Number 12346.

Domestic Priority data as claimed by applicant  
NONE


Foreign Applications for which priority is claimed (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <http://www.uspto.gov> for more information.)  
REPUBLIC OF KOREA 12-2013-004567892 10/2/2013  
*Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.*

Domestic Benefit  
Data

Foreign Priority  
Data

# Helpful Tips: Petition Submission

## Getting your Petition to the Office of Petitions

- ePetition -  GET IMMEDIATE DECISIONS
- EFS-Web
- Mail to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- Central Fax – (571) 273-8300
- Deliver to Customer Service Window at Randolph Building
- ONLY FOR PETITIONS TO WITHDRAW FROM ISSUE (in addition to the options listed above, you have the option to)
  - fax to (571) 273-0025 Office of Petitions
  - hand carry to security gate in Madison West lobby (600 Dulany Street, Alexandria, VA); guard will call Office of Petitions and a staff member will meet you in the lobby with log book and date stamp.
- See Office of Petitions website for further information on various petitions handled by Office Petitions and other useful information <http://www.uspto.gov/patents-application-process/petitions>

# Helpful Hints: Call Centers

- Office of Petitions Help Desk  
(571) 272-3282
- Inventor Assistance Center (IAC)  
1-800 -786 -9199 OR (571) 272 - 1000
- IPLA (PCT Legal) Help Desk  
(571) 272-4300
- Pro Se Assistance  
(1866) 767-3848
- Fee Assistance  
(1800) 786-9199
- Other Support Numbers

<http://www.uspto.gov/patent/contact-patents>

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)



# Helpful Tips: Online Resources

- ePetition Resource Page: <https://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page>
- Petitions Timeline: <https://www.uspto.gov/patents-application-process/petitions/timeline/patents-petitions-timeline>
- Patents Dashboard: <https://www.uspto.gov/dashboards/patents/main.dashxml>
- Web-Based ADS:  
[https://www.uspto.gov/patents/process/file/efs/guidance/WebADS\\_QSG.pdf](https://www.uspto.gov/patents/process/file/efs/guidance/WebADS_QSG.pdf)
- Corrected Web-Based ADS:  
<https://www.uspto.gov/sites/default/files/documents/Corrected-WebADS-QSG.pdf>
- ADS Information Page: <https://www.uspto.gov/patent/forms/important-information-completing-application-data-sheet-ads>
- Patent Form Finder: <https://my.uspto.gov/patent-form-finder>

# Let's Chat about Using Petitions Effectively in Patent Prosecution

**Charles Kim**

Director, Office of Petitions

**Namrata Boveja**

Acting Deputy Director, Office of Petitions

Email questions to [PatentQuality@uspto.gov](mailto:PatentQuality@uspto.gov)

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The background of the slide is a light gray technical drawing or patent illustration. It features various mechanical components, lines, and callouts with numbers such as 18, 34, 32, 52, 84, and 86. The drawing is partially obscured by the dark blue header and footer.

# **Next Patent Quality Chat**

## **Patents Ombudsman Program and Pro Se Assistance Program**

September 12, 2017

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# Other Patent Quality-Related Events

<https://www.uspto.gov/about-us/events>

<b>August 11-12</b>	<b>Invention-Con 2017</b>
<b>August 17</b>	<b>Inventor Info Chat</b> "Office of Policy and International Affairs – Basic Overview of Copyright Law"
<b>August 22</b>	Technology Center 2800 Semiconductor <b>Customer Partnership Meeting</b>

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# Thank you for joining us today!

Patent Quality Chat  
Webinar Series 2017  
August 8, 2017

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