

Elevate Your Prosecution: Petitioning Examiner Errors After Final

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Myths about Petitioning Examiner Errors

- ▶ This will never work
- ▶ Petitions slow up prosecution
- ▶ Takes forever to get a decision
- ▶ Petitions are usually dismissed
- ▶ Petitions upset the Examiner
- ▶ Better try to stay on the Examiner's good side



Challenges After Final



Your After Final Toolbox

- ▶ Request an Interview MPEP 713.09
- ▶ File an After Final response/amendment
- ▶ Contact the Supervisor for advice or help
- ▶ File an AFCP2.0 Request
- ▶ Request a corrected Office action MPEP 710.06
- ▶ Request Examiner Withdraw Finality MPEP 706.07(c)
- ▶ Request a Pre-Appeal Conference MPEP 1204.02
- ▶ File a Notice of Appeal
- ▶ **Petition under 37 CFR 1.181**
- ▶ Throw in the towel, pay the fees, and file an RCE



USPTO Discourages After Final Petitions

After Close of Prosecution

Petition Type	Avg. Days Pending of Decided Petitions	Grant Rate Percentage	Deciding Office
611 - Relating to Prematureness of Final Rejection (37 CFR 1.181, MPEP 706.07c)	178	42%	TC

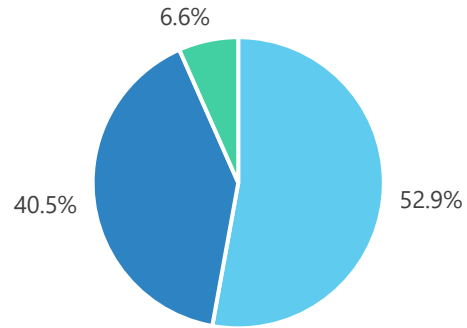
USPTO's 12-month rolling average as of July 6, 2021

Our analysis shows, for recently filed petitions, a pendency of ~60 days.

1.181 Decisions to Address Examiner Errors

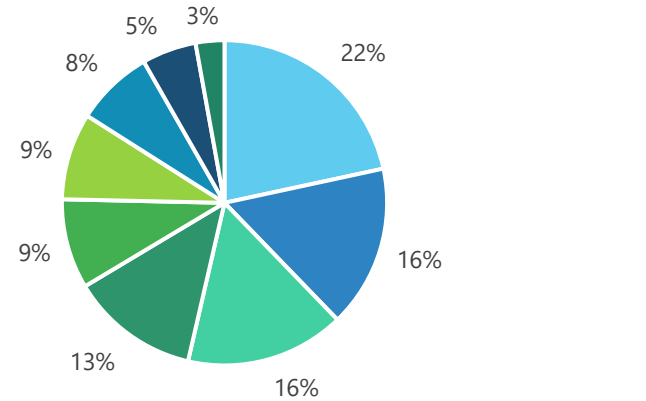
1.181 Decision Outcomes - Examiner Errors

n = 4,221



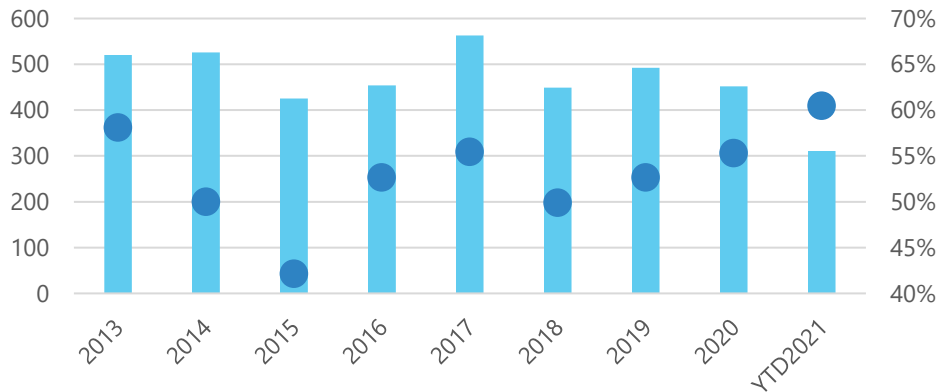
■ Granted ■ Dismissed ■ Denied

1.181 Decisions by TC - Examiner Errors



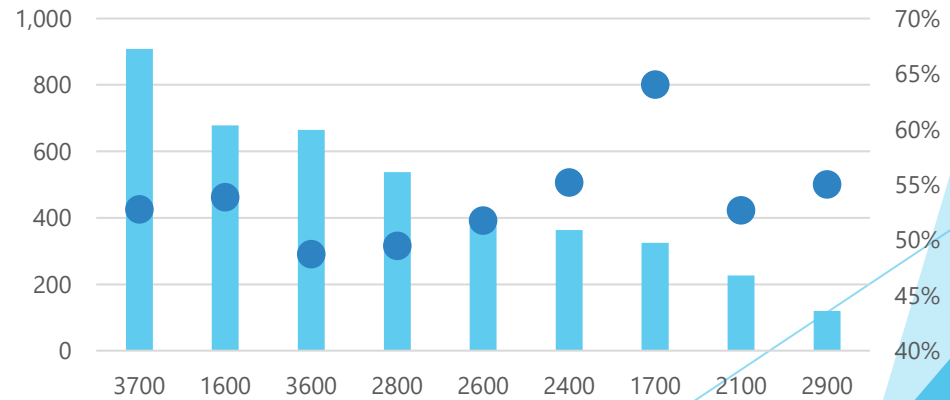
■ 3700 ■ 1600 ■ 3600 ■ 2800 ■ 2600 ■ 2400 ■ 1700 ■ 2100 ■ 2900

1.181 Decisions by Year - Examiner Errors



■ # of Decisions ● Grant Rate

1.181 Decisions by TC- Examiner Errors



■ # of Decisions ● Grant Rate

Petitioning Procedural Errors: An Unlikely Road to Allowance?



Petition or Appeal?

- ▶ A line of demarcation exists between:
 - ▶ Appealable matters for the Board and
 - ▶ Petitionable matters to the TC Group Directors
- ▶ Ordinarily, an objection is petitionable, and a rejection is appealable
- ▶ When the objection is "determinative of the rejection", the matter may be addressed by the Board
- ▶ See MPEP 1201, *In re Hengehold*, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971) and *Ex parte Frye*, 94 USPQ2d 1072, 1078 (Bd. Pat. App. & Int. 2010)(precedential)

Insider Tip

- ▶ Petitioning Examiner Errors gives USPTO management **the opportunity and the obligation** to review the entirety of an application file wrapper
- ▶ USPTO management includes
 - ▶ TC Group Directors
 - ▶ Quality Assurance Specialists (QAS)
 - ▶ Supervisory Patent Examiners (SPE)
- ▶ Often, this higher-level review is **NOT** limited to procedural, petitionable matters



Leverage Procedural Errors into Substantive Prosecution Progress

- ▶ Ensure review of the application by SPE, QAS and Group Director
- ▶ Obtain a new Office Action (OA)
- ▶ Have finality withdrawn
- ▶ Regain your right to have amendments & declarations entered
- ▶ Prompt higher level review of subsequent OAs
- ▶ Increase chance that next OA will move prosecution forward
- ▶ Petitions can ensure a clear and complete file record to maximize applicant's rights during prosecution and obtain a patent likely to survive litigation



Examples of Petitionable Examiner Errors

- ▶ Incomplete, incorrect Office Action
- ▶ Premature final rejection
- ▶ New grounds of rejection in a final Office action
- ▶ Refusal to enter amendments
- ▶ Refusal to enter declarations and affidavits
- ▶ Failure to acknowledge and address the substance of applicant's response
- ▶ Improper restriction requirements (37 CFR 1.144)

Some MPEP Guidance & Instructions

706.07	Applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.
706.07(a)	When finality is proper on second or subsequent action
706.07(b)	When finality is proper on first action in a RCE or Continuing application. Expanded to include a <i>patentably indistinct</i> legal standard in June 2020.
707.07(f)	Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.
707.07(i)	In every Office action, each pending claim should be mentioned by number, and its treatment or status given.
710.06	Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. (Emphasis added).

24 Extra-Successful After Final Petitions

- ▶ Using Petition.ai, we identified 24 extra-successful petitions challenging the finality of an Office action
 - ▶ Finality withdrawn
 - ▶ **AND** Application promptly allowed
- ▶ Decisions were:
 - ▶ Decided in 2018-2021
 - ▶ In 6 different Technology Centers
 - ▶ Drafted by 16 different Quality Assurance Specialists
 - ▶ Signed by 19 different Group Directors



24 Extra-Successful After Final Petitions

<u>Discipline</u>	<u>TC (#)</u>	<u>Grant Rate</u>	<u>Effective Grant Rate</u>	<u>Petition Filing Date to Decision Date</u>
Chemical	1600 (3)	66%	100%	50
Electrical	2100 (3)	33%	100%	64
Electrical	2400 (4)	75%	100%	25
Electrical	2800 (3)	100%	100%	31
Mechanical	3600 (4)	25%	100%	49
Mechanical	3700 (7)	57%	100%	21
Total		63%	100%	37
USPTO stats		42%		178

Chemical Example

- ▶ 2010 Application with a long prosecution history
 - ▶ 4 nonfinal OAs, 3 final OAs, 3 RCEs
 - ▶ Petitioned OA relied upon a rejection relying on new reference not cited on an IDS
- ▶ Petition to withdraw finality granted in **16 days**
- ▶ Finality withdrawn, which permitted applicant to file amendments and declarations
- ▶ Interview with SPE
- ▶ Next action: a Notice of Allowance signed by SPE

Mechanical Example

- ▶ 2014 Application with a long prosecution history
 - ▶ 4 nonfinal OAs, 2 final OAs, 2 RCEs, and 3 AFCP2.0 requests
 - ▶ Petitioned OA mixed up claims 4 and 5 of a reference patent in an ODP rejection
- ▶ Petition under 1.181 accompanied by a Pre-Appeal Conference Request
- ▶ Petition to withdraw finality granted in **7 days**
- ▶ Pre-Appeal Request moot in view of Petition Grant
- ▶ Notice of Allowance mailed **44 days** after petition was filed

Electrical Example

- ▶ 2016 Application
 - ▶ 1 nonfinal OA, 1 final OA
 - ▶ Petitioned OA included a new rejection on an independent claim which had not been amended using art not cited on an IDS.
- ▶ Petition accompanied by a AFCEP2.0 Request
- ▶ Notice of Allowance signed by SPE mailed in **44 days**
- ▶ Petition dismissed as moot in **49 days** in view of Notice of Allowance

Deciphering 'Dismissed as Moot'

Bad

When USPTO delays a decision so long that applicant is compelled to file an RCE.

Petition then ***dismissed as moot*** in view of the RCE. *Ouch!*



Good

When the USPTO fixes the problem being petitioned via a new OA, withdrawn finality, or Notice of Allowance.

Petition then ***dismissed as moot*** in view of the Office's corrective action.

Note these 'good' decisions are excluded from USPTO grant rate.

Extra-Successful Petitions- Often Coupled with Other After Final Requests

	<u>USPTO Personnel</u>	<u>USPTO processing time (days)</u>	<u>MPEP</u>
After final response +/- amendment	Assigned Examiner	11 average 30 max	714.13(III)
Request Withdraw of Premature Finality	Primary Examiner who signed final Office action	11 average 30 max	706.07(c)
AFCP2.0 Request	Examiner, SPE and another primary examiner	11 average 30 max	Pilot Program
Interview Request	Examiner and SPE (AIR form)	30	713.09
Pre-Appeal Conference	Examiner, SPE and another primary examiner	45	1204
1.181 Petition to withdrawn final Office action	Decision drafted by Quality Assurance Specialist, reviewed and signed by Group Director; their instructions sent to SPE	No clock set	1002.02(c)3

19

Where are these Extra-Successful Petitioners?



Practice Tips

- ▶ Promptly Review Office Actions for Errors
 - ▶ Many Office Actions contain Procedural Errors
 - ▶ Determine whether an Office Action is complete and correct prior to reporting it out to Client
 - ▶ Provide Client with options to seek redress, including windows to filing a request or a petition



Practice Tips

- ▶ Consider all Approaches for Remedy
 - ▶ Call Examiner and SPE
 - ▶ Request Interview
 - ▶ Ombudsman Request
 - ▶ Petition
- ▶ Try Several Options
 - ▶ In Turn
 - ▶ In Combination



Practice Tips

- ▶ Watch the Petition and Response Windows
 - ▶ One Month for Request under MPEP 710.06 to obtain a new Office action with restarted mail date
 - ▶ Two Months for Petition under 1.181
- ▶ **Filing a Petition does not stop the clock!**





Petitions: Both a Right...

The First Amendment

Congress shall make no law... abridging... the right of the people... to petition the Government for a redress of grievances.

...and when necessary, an Obligation: With Zeal in Advocacy

- ▶ 37 CFR 11.101 **Competence** – A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for representation.
- ▶ 37 CFR 11.103 **Diligence** – A practitioner shall act with reasonable diligence and promptness in representing a client.
- ▶ 37 CFR 11.302 **Expediting Proceedings** – A practitioner shall make reasonable efforts to expedite proceedings before a tribunal consistent with the interests of the client.
- ▶ ABA comments to Model Rule 1.3 – “A lawyer should ... take whatever lawful and ethical measures are required to **vindicate a client’s cause** or **endeavor**. A lawyer must also act with **commitment** and **dedication** to the interests of the client and with **zeal in advocacy** upon the client’s behalf.”

Our IPWatchdog Articles on After Final Petitions

1. *Newly Created First Action Final Rejection Policy Adds Needless Complications to Patent Prosecution* With Former APJ Bill Smith 9/22/20
2. *Analyzing Vastly Different First Action Final Rejection Outcomes Following Recent Policy Change* 9/25/20
3. *Late-Filed Petitions Dismissed as Untimely by USPTO: No Apparent Rhyme nor Reason* 10/18/20
4. *Petitions Filed After Final Dismissed as Moot: USPTO Runs Down the Clock* 11/18/20
5. *Successful After Final Petitions Can Help Advance Prosecution* 1/29/21
6. *USPTO After Final Petition Statistics – Are Things as Bad as They Appear?* 5/7/21
7. *USPTO Petition Process: Who Should Pay for the Burden of Inordinate Delays and ‘Mistakes’?* 7/26/21

PETITION.AI

Petition.ai Overview

- ▶ The first comprehensive searchable database of publicly available patent petition documents filed with the USPTO
- ▶ Easily and efficiently search 1,000,000 documents from 390,000 patent applications filed since 2013
 - ▶ Petitions, Requests for Reconsideration, and Petition Decisions
 - ▶ Users search using natural language queries
- ▶ Launched in June 2020

Petition Search

Q Retroactive Foreign Filing License

Search

[Search techniques](#)

SORT BY

+ Expand all Showing 1 - 10 of 1,023,914

Jump to:

1

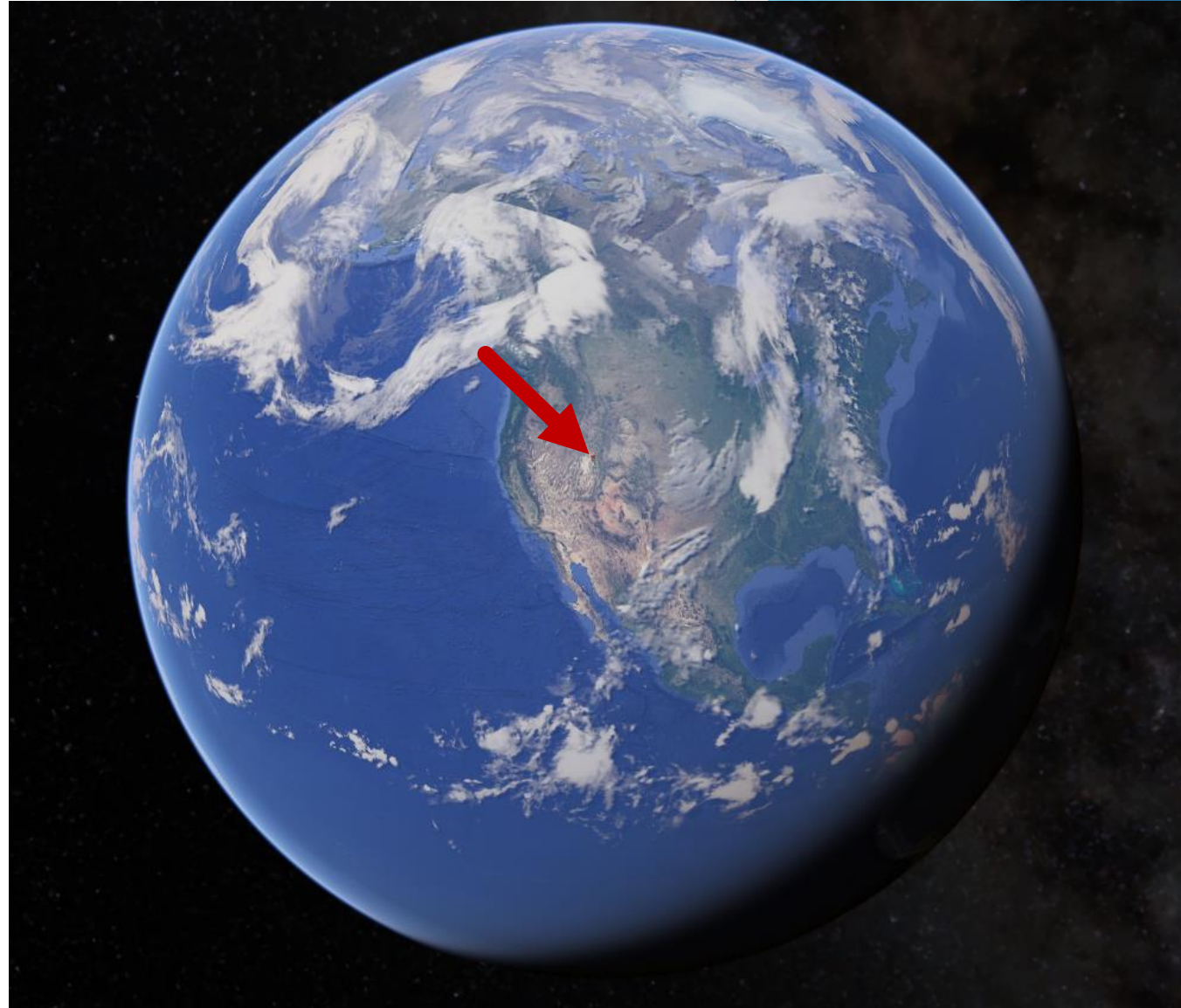
Show

10



Great Salt Lake vs. All Water on Earth

- ▶ Prior to Petition.ai, petition documents have NOT been transparent or obtainable
- ▶ Now patent practitioners can quickly research the **>99%** of petition documents not in their internal document database
 - ▶ *Why limit your search to just the Great Salt Lake when Petition.ai can quickly search ALL the water on Earth?*



Benefits of Using Petition.ai's Database



▶ Saves time and effort

- ▶ Like a magic magnifying glass for finding a needle in a haystack, you can rapidly identify petition documents with similar issues and/or fact patterns
- ▶ No need to reinvent the wheel when filing petitions in unusual situations

▶ Acts as a **valuable resource** for patent practitioners and support teams

- ▶ Research what information is needed to file a grantable petition
- ▶ Identify Deciding Official – ask questions, notify them petition was filed, obtain status information
- ▶ Provide realistic pendency data and likely success rate
- ▶ Unusual situation isn't so unusual – 490 Granted Retroactive Foreign Filing Licenses
- ▶ Analyze grant rates for: Petition Types, Deciding Officials, TCs and Art Units

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Increased Likelihood of Petition Granted on 1st Attempt

Benefits of Using Petition.ai's Database (cont'd)

▶ **Enhances your firm's patent prosecution**

- ▶ Allows patent practitioners to see what is possible and how it can be achieved in a simple, easy way
- ▶ Advocate for additional client rights – accelerate examination, withdraw improper Office actions, expunge material from file, adjust patent terms (PTAs and PTEs), correct errors made by examiner or practitioner during prosecution, etc.
- ▶ Determine if/when filing a petition might be appropriate
- ▶ Teach your patent practitioners about petitions
 - ▶ Practitioners are so good at not making mistakes, they may not have experience of what to do when a mistake happens

▶ **Provides insights** into your law firm's or your competitor's current patent petition usage/non-usage

Simple Pricing

- ▶ Three pricing options
 - ▶ Enterprise
 - ▶ Annual: \$1,500-\$7,500 per year
 - ▶ Pricing is based on the number of U.S. utility patents issued
 - ▶ Unlimited number of users, searches and downloads
 - ▶ Automated billing code tracking
 - ▶ Individual
 - ▶ Monthly: \$75 per month (\$900 per year) (*cancel any time*)
 - ▶ Annual: \$50 per month (\$600 per year)
 - ▶ Unlimited searches and downloads

Features

The screenshot shows a patent application decision interface. At the top, it displays the application number '14/858,368' with a 'Copy' link (callout 1). To the right, there are status buttons: 'Decision' (callout 2) and 'Granted' (callout 3), along with the 'DECISION DATE: 01-14-2020'. The main text describes the decision on a request for patent term adjustment. Below this, it identifies the 'DECIDING OFFICIAL: Charles Steven Brantley' (callout 9) and the 'PENDENCY: 173 days' (callout 4). At the bottom, there is a '+ Expand' link (callout 10), a 'Bookmark' button (callout 7), an 'Open PDF' button (callout 6), and a menu icon (callout 5). A red arrow (callout 8) points to the main text area.

- ▶ 1 – Easily see all petition documents related to a patent application
- ▶ 2, 3 – Quickly see if search result is Request/Decision and Granted/Dismissed/Denied
- ▶ 5 – Links search result directly to the corresponding application in Patent Center
- ▶ 6 – One-click access to the original petition document filed with the USPTO
- ▶ 10 – Expand a specific document to read and search the text

Filters

PETITION

- | | |
|-----------------------------------|---------|
| <input type="checkbox"/> Request | 519,955 |
| <input type="checkbox"/> Decision | 498,767 |

PETITION DECISION

- | | |
|------------------------------------|---------|
| <input type="checkbox"/> Granted | 370,177 |
| <input type="checkbox"/> Dismissed | 72,356 |
| <input type="checkbox"/> Accepted | 19,513 |
| <input type="checkbox"/> Approved | 14,506 |
| <input type="checkbox"/> Denied | 12,628 |

[+ More](#)

PETITION TYPE

Filter Petition Type

- | | |
|---|--------|
| <input type="checkbox"/> Track One Request | 68,991 |
| <input type="checkbox"/> Make Special - Patent Prosecution Highway (PPH) | 60,210 |
| <input type="checkbox"/> Revive Abandoned Application - Unintentional Delay - 37 CFR 1.137(B) | 35,765 |
| <input type="checkbox"/> Withdraw from Issue After Payment of Issue Fee with Assigned Patent Number - 37 CFR 1.313(C)(1) or (2) | 24,049 |
| <input type="checkbox"/> Make Special - Age / Health - 37 CFR 1.102, MPEP 708.02 | 20,792 |

[+ More](#)

TECHNOLOGY CENTER

- | | |
|-------------------------------|---------|
| <input type="checkbox"/> 3700 | 175,833 |
| <input type="checkbox"/> 3600 | 151,849 |
| <input type="checkbox"/> 2800 | 147,150 |
| <input type="checkbox"/> 1600 | 136,639 |
| <input type="checkbox"/> 1700 | 116,672 |

[+ More](#)

PETITION/DECISION YEAR

- | | |
|-------------------------------|---------|
| <input type="checkbox"/> 2021 | 33,954 |
| <input type="checkbox"/> 2020 | 111,756 |
| <input type="checkbox"/> 2019 | 120,179 |
| <input type="checkbox"/> 2018 | 112,873 |
| <input type="checkbox"/> 2017 | 122,139 |

[+ More](#)

Petition.ai Petition Resource Webpage

- ▶ Petition.ai created a Petition Resource Page
 - ▶ USPTO Petition Guidance and Information
 - ▶ USPTO Petition Points of Contact
- ▶ Visit petition.ai/resources

Questions?

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