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After Final Practice in the USPTO with a Focus on Petitions and Patent Appeals

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Examiners can and do make mistakes. How to rectify these mistakes requires one to make effective use of the various after final options provided by current practice. However, too many practitioners narrowly view after final practice in the context of having an amendment after final entered by the examiner. The focus of this paper is to take a step back and view all of the options available after final to correct examiner mistakes. Thus, this paper presents an integrated overview of after final practice and how petitions and appeals must be considered in any strategy of responding to a final office action.

Petitions

Upon examining a patent application, the examiner may reject the claims or make objections and/or requirements.² It is important to determine which of these actions by an examiner are subject to an appeal to the PTAB and which must be addressed by way of petition. A rule of thumb is that a rejection of claims is to be appealed to the PTAB while objections and procedural requirements are subject to petition. This may seem anomalous in that the statute that defines the Board's duties states in relevant part that the Board "shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patent."³ However, the CCPA clarified that not:

all 'decisions,' which are made by examiners in the course of examination of applications from time of receipt to final disposition by allowance or abandonment and which might be termed 'adverse,' are perforce reviewable by the board of appeals. Such has not been the case, either before or after the passage of the 1952 Patent Act. There are a host of various kinds of decisions an examiner makes in the examination proceeding - mostly matters of a discretionary, procedural or non-substantive nature - which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections

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² 35 U.S.C. § 132(a)

³ 35 U.S.C. § 6(b)

of claims, but traditionally have been settled by petition to the Commissioner.⁴

Petitions are provided for in 37 CFR §§ 1.181, 182 and 183. Chapter 1000 of the *Manual of Patent Examination Procedure* (MPEP), Matters Decided by Various U.S. Patent and Trademark Office Officials, provides detailed guidance as to the specific USPTO officials who decide what issues. Further guidance in regard to petition practice is set forth on the web page of the Office of Petitions at the USPTO web site.⁵ As explained, a petition generally has five points:

- The petition must be in writing, 37 CFR § 1.2.
- The petition must contain a statement of facts involved, the point(s) to be reviewed and the action requested, 37 CFR 1.181(b).
- The petition must be accompanied by a fee, if required, in order to avoid the petition being summarily dismissed, 37 CFR 1.181(d).
- The petition must be timely filed, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.
- The petition must comply with any specific requirements as provided by statute, regulation or USPTO policy.

Common situations where a practitioner finds it necessary to file a petition to overturn an examiner's action include when an examiner makes a restriction requirement final or refuses to enter an amendment or an affidavit after a final rejection. Another situation that is subject to petition, not appeal, is when the examiner makes a premature final rejection.

Appeals

I. Introduction

The Patent Corps continues to hire large numbers of patent examiners in an effort to tackle the backlog of patent applications awaiting examination. As a result of this effort, the present body of patent examiners is relatively inexperienced. If your client's case has difficult legal and/or technical issues it is likely that the case will end up at the PTAB. Thus, for a patent practitioner to successfully win claims of appropriate scope to protect the client's technology, create an administrative record before the USPTO that contains

⁴ *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)

⁵ <http://www.uspto.gov/web/offices/pac/dapp/petitionsmain.html>

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