

Tactical approach to deal with Final Rejection from the USPTO

Introduction

The USPTO while examining a patent application may issue an office action rejecting one or more claims. The rejection of the claims may be non-final or final. A final rejection is typically issued during second or subsequent examination of the pending patent application. A patent applicant will generally have three months or six months time (with extension fee) from the mailing date of the final rejection to send in an appropriate reply. If the applicant fails to respond within the stipulated period, the application will be abandoned.

The final rejection is intended to close prosecution of the pending patent application. However, several options exist to pursue the patent application even after receiving the final rejection.

Options

The options that are available to the applicant after receiving final rejection are listed below:

1. Amendment
2. Appeal to the Patent Trial and Appeal Board
3. Interview
4. After Final Consideration Pilot 2.0 (AFCP 2.0)
5. Request for Continued Examination (RCE)
6. File a continuation application
7. Abandon the application

Amendment

The applicant may respond to the office action by making amendments. An amendment may be made by canceling claims or complying with any requirement of form expressly set forth in the office action. An amendment touching the merits of the application may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Advisory action will be issued by the USPTO if the response to the final office action fails to overcome the rejections of the final office action. On the other hand, if the response to the office action overcomes the rejections in the final office action, a notice of allowance will be issued by the USPTO.

Appeal to the Patent Trial and Appeal Board



An applicant whose patent application claims have been rejected twice may appeal from the examiner's decision to the Patent Trial and Appeal Board by filing a notice of appeal. The notice of appeal should be filed within a maximum period of six months from the final rejection, unless a shortened period is expressly specified in the office action. Further, the appellant should file an appeal brief within two months from the date of filing the notice of appeal. Failure to file the appeal brief will result in the appeal being dismissed.

Interview

The examiner after issuing the final rejection may grant one interview to the applicant in order to place the application in condition for allowance or to resolve issues prior to appeal. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing by the applicant. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

After Final Consideration Pilot 2.0 (AFCP 2.0)

AFCP is one of the ongoing efforts by the USPTO towards enhancing communication between the Office and the applicant, thereby resulting in compact prosecution.

The applicant should submit a request for consideration of the application under AFCP. The applicant should also submit a response which includes an amendment to at least one independent claim, and the amendment should not broaden the scope of the independent claim in any aspect. The applicant can submit the request even after receiving an advisory action and filing a notice of appeal. Only one AFCP 2.0 request may be filed in response to an outstanding final rejection.

If the amendment necessitates the examiner to conduct additional search and/or consideration is required but cannot be completed within the allotted time, the examiner may issue an advisory action. If the amendment does not necessitate the examiner to conduct additional search and/or consideration or if additional search and/or consideration could be completed within allotted time, then the examiner determines whether the amendment places the application in condition for allowance. If the examiner determines that the amendment does not place the application in condition for allowance, then the examiner will contact the applicant and request an interview.



From a survey, it has been found that AFCP 2.0 program was effective in advancing prosecution and reduced the likelihood of filing an RCE.

Request for Continued Examination (RCE)

An RCE is a request filed by the applicant for continued prosecution of the application after receiving a final rejection from the USPTO. Request for an RCE should be filed before abandonment of the application. The last office action (final rejection) is withdrawn upon filing of a RCE. The RCE may be accompanied by new arguments or amendments.

File a continuation application

A continuation application is an application which has the same content as in the pending patent application, but with claims of varying scope or rejected claims of the pending patent application. Continuation application does not get abandoned when the pending patent application is abandoned. Therefore, claims of varying scope may be filed through a continuation application which will undergo new examination. However, if claims that are rejected in the pending patent application are presented as it is in the continuation application, then the first office action will be a final rejection.

Abandon the application

Not responding within the time as set forth in the final office action (final rejection) or within such extended period will result in abandonment of the application.

Conclusion

As illustrated above, several options exist after a final rejection is issued. Some options are more expensive than the other. Further, each option allows the applicant to practically do different things to pursue a patent grant. Hence, an applicant has to carefully evaluate his position during patent prosecution and choose one or more options that best serves his interest.

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