



Greenblum & Bernstein, P.L.C.  
**CLIENT ADVISORY**  
Recent Changes in Rules and Procedures

April 12, 2012

**New USPTO Pilot Program for Consideration of  
Amendments Filed After Issuance of Final Rejection**

Dear Clients:

The Patent and Trademark Office has recently announced a new pilot program dealing with consideration of amendments filed after issuance of a final rejection. The intent of the program is to eliminate "unnecessary" filings of a Request for Continued Examination (RCE) in those situations where the application can be disposed of (i.e. placed in condition for allowance) with a relatively small amount of additional Examiner resources (i.e. time).

Entry into the pilot program is at the discretion of the Examiner, so this aspect is not within our control. Further, while there appears to be some doubt about the effectiveness of the program in significantly reducing the number of "unnecessary" RCEs being filed, the existence and availability of the program should be considered, of course together with other factors, in deciding how to file respond to a final rejection.

In accordance with the provisions of the pilot program, a number of situations are enumerated where, after a full and complete review by the Examiner (which includes any additional search required to determine whether or not proposed amendments distinguish over the prior art) a response after final rejection should be entered. The most common and therefore the most relevant such situation is where the amendment "can be determined to place the application in condition for allowance by adding new limitations which require only a limited amount of further consideration or search". Examiners are instructed to review responses filed under 37 CFR 1.116(b) and to use their professional judgment to decide whether the nature and extent of the amendments or arguments presented in the response can be fully considered within the limited amount of time authorized by the pilot program. If the Examiner determines that the response can be fully considered, including any required additional consideration (i.e. search and/or interview), within three hours, the Examiner will then be given three hours of additional time within which to attempt to resolve all the outstanding issues and place the application in condition for allowance. If not, the Examiners are instructed to treat the response according to current practice (e.g. issuing an advisory action).

As noted, entry into the above noted pilot program is solely at the discretion of the Examiner and accordingly it will not be possible for us to easily or accurately gauge the success of this program in reducing the need to file RCEs. However, the existence of this program, which applies only when a reply to a final rejection is filed, and the possibility that it might reduce the need to file an RCE, should be considered when determining whether or not to file a response after final or to directly file an RCE. The term of the pilot program is the 3<sup>rd</sup> quarter of fiscal year 2012.

If appropriate, we will provide you with further information about this pilot program as it becomes available. Of course, should you have any questions or require any further information regarding this program, please feel free to contact us.

Best regards,

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