



NINE STRATEGIES FOR RESPONDING TO A FINAL OFFICE ACTION

1

Response After Final

Effective only when Office Action is clearly deficient and time permits it. Also useful for when the Attorney expects to file an appeal and has sufficient time. Watch the 6-month clock.

2

Amendment After Final

Typically will not be entered as requiring new search and consideration.

3

AFCP 2.0

One of the best strategies. No additional fees to the Applicant and gives the Examiner an opportunity to allow a non-broadening amendment. Also provides a telephone interview if amendment does not overcome art.

4

Pre-Appeal Brief Conference Request

Useful for resolving improper rejections due to errors in fact, clear error in law, or to missing elements. Must file Notice of Appeal fee.

5

Appeal Brief

Applicant must file an appeal brief within two months of receipt of the notice of appeal by the PTO. Claim must be twice-rejected. Use sparingly.

6

P3

Combines features of AFCP 2.0 and Pre-Appeal Conference Pilot Program. Present five pages of arguments and participate in conference with panel of Examiners. Program has concluded, but may be reinstated.

7

Examiner's Interview

Examiner is not obligated to grant an interview, but most do. Discuss the options before the Applicant and suggest an AFCP 2.0 if some minor amendment seems acceptable to both parties.

8

RCE

File a Request with Continued Examination, but add new claims or make an amendment to avoid a First Action Final.

9

Kitchen Sink

Conduct at least one Examiner's interviews in addition to an interview that is granted under AFCP 2.0, and combine with Pre-Appeal Brief Conference Request or Appeal Brief as necessary.

This infographic is informational and does not constitute legal advice.

Visit www.patentspace.net for more information.

©2017 BY PATENTSPACE. ALL RIGHTS RESERVED.