

Guidelines for Consideration of Responses After Final Rejection under 37 CFR 1.116(b) under the After Final Consideration Pilot (AFCP)

To advance the goal of compact prosecution, the following guidance is provided to highlight situations when entry of an Amendment After Final Rejection under 37 CFR 1.116(b) may lead to earlier allowance of the application without undue burden on the examiner or applicant. Once a final rejection that is not premature has been entered in an application, there is no right to unrestricted further prosecution. In limited situations further amendments or arguments may be considered. Many of the difficulties encountered in the prosecution of a patent application after final rejection may be alleviated if the application includes, preferably at the time of filing, or before a first action by the examiner, claims varying from the broadest to which the applicant believes he or she is entitled, to the most detailed that he or she is willing to accept. See MPEP 714.12. Examiners should conduct an initial search which is as complete as possible, in keeping with the scope of the claims as well as disclosed features and subject matter which the examiner reasonably anticipates might be incorporated into the claims.

Situations where after a full and complete review, a response after final rejection should be entered:

1. The amendment places the application in condition for allowance by canceling claims or complying with formal requirement(s) in response to objection(s) made in the final office action.
2. The amendment places the application in condition for allowance by rewriting objected-to claims in independent form.
3. The amendment places the application in condition for allowance by incorporating limitations from objected-to claims into independent claims, if the new claim can be determined to be allowable with only a limited amount of further consideration or search.
4. The amendment can be determined to place the application in condition for allowance with only a limited amount of further search or consideration, even if new claims are added without cancelling a corresponding number of finally rejected claims.
5. The amendment can be determined to place the application in condition for allowance by adding new limitation(s) which require only a limited amount of further consideration or search.
6. The response comprises a perfected 37 CFR 1.131 or 37 CFR 1.132 affidavit or declaration (i.e. a new declaration which corrects formal defects noted in a prior affidavit or declaration) which can be determined to place the application in condition for allowance with only a limited amount of further search or consideration

A full and complete review of a response includes any additional search required to determine whether or not proposed amendments distinguish over the prior art. Examiners should review responses under 37 CFR 1.116(b) and 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 After Final Consideration Pilot. If not, examiners should treat the response according to current practice, without non-production time authorized.

If the examiner determines that the response can be fully considered, including any additional search required, within 3 hours for plant and utility applications or 1 hour for design applications, that amount of non-production time is available whether or not the consideration of the amendment results in allowance of the application, subject to the following limitations:

- In the situations described in items 1 and 2 above, no non-production time will be authorized since such amendments will normally be entered according to current practice.
- If an interview is conducted as a result of consideration of the after final response, the non-production time authorized by this pilot should be recorded under two separate time codes. For utility and plant applications, 2 hours should be charged to a pilot consideration code, and 1 hour should be charged to an interview code. For design applications, 1 hour should be charged to the pilot consideration code and the time attributed to the interview should be charged to the interview code.