Evaluating When USPTO Actions Should Be Made Final

IP Law Bulletin
 on 05.20.2014 | Posted in Patents

As patent practitioners are well aware, U.S. patent examiners will issue a first action on the merits of a patent application as non-final and typically issue a second action on the merits as final. The finality of second actions is so universal that the finality of an action may be accepted as proper by a patent applicant when, in fact, the action was improperly deemed final. It therefore behooves applicants to always evaluate whether a final action on the merits was properly made final to have improper final actions withdrawn before the applicant incurs unnecessary costs and/or delays in prosecution.

Section 706 of the Manual of Patent Examining Procedure (MPEP) outlines the handling of final actions by the U.S. Patent and Trademark Office (USPTO). Under general USPTO practice, second or subsequent actions on the merits can be made final. Additionally, first actions on the merits after the filing of a Request for Continued Examination (RCE) can be made final. These general rules have important exceptions that can guide an applicant in determining the appropriateness of an action’s finality. For instance, applicants can ask themselves the following questions after receipt of a final action:

1. Was any claim that was not amended in the immediately prior response rejected on new grounds?

If not, then the action’s finality is likely proper. However, if the amendment was minor, such as correcting a typographical error or clarifying antecedent basis to address a 35 U.S.C. § 112 rejection, the action’s finality is likely improper if the amendment did not necessitate the new ground(s) of rejection. Note that MPEP § 706.07(a) specifies that if any claim that was not amended in the immediately prior response is rejected on new grounds in a final action, the finality may be improper even if one or more other claims were amended so as to necessitate a rejection on new grounds.

2. Was any claim rejected over reference(s) submitted in an Information Disclosure Statement (IDS) filed after the mailing date of the preceding action?

If so, then the action’s finality is likely proper regardless of whether or not the rejected claim(s) were amended in the immediately preceding filed response.

3. Was an applicant submission made satisfying the joint research agreement prior art exclusion under 35 U.S.C. § 103(c)?

If so, and the final action includes a new double patenting rejection in view of the satisfied requirements, then the action’s finality is likely proper.

4. If the action immediately follows the filing of an RCE, could the action’s rejections have been made prior to filing the RCE?
In other words, would finality have been proper prior to the filing of the RCE had the amendments been entered? If so, then the action’s finality is likely proper. It is important to note, however, that finality is not proper when the application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised." MPEP § 706.07(b).

5. If the application is undergoing reexamination, does the final action include a rejection, on prior art not of record, of any claim amended to include limitations that the examiner should reasonably have been expected to be claimed?

If so, the finality of the action is likely improper. MPEP § 706.07(a) notes that this situation of improper finality arises in “very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. § 112, second paragraph).”

6. If the application is undergoing reexamination, does the final action include a new ground of rejection necessitated by the amendments to 35 U.S.C. § 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002?

In other words, is the new ground of rejection based on art available under (pre-AIA) § 102(e), namely art that was not published until after the U.S. filing date of the application? If so, then the action should not be final unless the new ground of rejection was necessitated by the applicant’s amendment of the claims or by reference(s) submitted in an IDS filed after the mailing date of the preceding action.

If an action appears to have been improperly issued as a final action, an applicant can address the error in a variety of ways:

- An informal approach involves directly contacting the examiner by telephone, explaining the error, and requesting that the action be withdrawn and reissued as a non-final action.

- A less informal approach involves submitting a formal written response to the USPTO explaining the action’s improper finality and requesting withdrawal of the action. This approach may expedite prosecution by allowing the examiner to consider any arguments and/or amendments also submitted in the written reply and to address the arguments and/or amendments as necessary in a newly issued action. However, if the applicant’s arguments are not persuasive and the examiner maintains the action’s finality, the applicant may be required to pay extension fees with a Notice of Appeal or an RCE to avoid abandonment of the application.

- If neither of these approaches is successful or is not desirable for an applicant to attempt for any reason, an applicant can formally petition the action’s finality under 37 CFR § 1.181. The petition process does not, however, toll the period for reply to the action and may necessitate payment of extension fees if the petition is denied and the final action is not withdrawn. Additionally, the petition is not guaranteed to be reviewed and acted upon within the six month period set for reply to a final action.
In reply to a final action, the application must be placed in final disposition (typically a Notice of Allowance, RCE, or a Notice of Appeal), which can incur considerable applicant expense and/or delay in prosecution. Applicants can thus be well served by evaluating the appropriateness of a final action to avoid these adverse outcomes if an action is improperly made final.

This update was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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