

In This Issue

Post-Prosecution Pilot ProgramPage 1-2

The USPTO Attempts to Improve Customer Service Experience..... Page 2

Nicholas Krob..... Page 3

"Stairway to Heaven" Holds on to Iconic Riff..... Page 4

We're There.....Page 4

POST-PROSECUTION PILOT PROGRAM

by Luke T. Mohrhauser

On July 11, 2016, the USPTO released a notice for a new test program titled Post-Prosecution Pilot Program, which is also referred to as the P3. The P3 is an attempt to provide a path for patent applicants and examiners to discuss an application with the hopes of avoiding and/or limiting the amount of patent appeals filed, as these have increased greatly. The P3 is scheduled to run between July 11, 2016 and January 12, 2017, or the date that the Patent Office accepts 1,600 compliant requests, whichever occurs first. Furthermore, each technology center is limited to 200 compliant requests. As of August 18, 2016, there have been a total of 212 accepted requests.

There is no fee for requesting the P3, but, of course, there are some requirements for being eligible for the P3. First, an application must contain an outstanding final rejection and be (i) an original utility non-provisional application filed under 35 U.S.C. 111(a), or (ii) an international utility application that has entered the national stage in compliance with 35 U.S.C. 371 (see 37 CFR 1.491). This includes continuation and divisional applications, but does not include design, reissue, or plant applications. Next, a P3 request must be filed within two months from the mailing date of a final rejection and prior to filing a notice of appeal. The request must include a transmittal form, a response, and a statement that the applicant is willing and available to participate in the conference with the panel of examiners. Optionally, a P3 request may include a proposed non-broadening amendment to a claim(s). Such an amendment should be focused on the issues with respect to a single independent claim in order to overcome the rejections as provided.

The Response

The response that accompanies a request for the P3 must comprise no more than five pages of arguments. Such arguments must be limited to appealable, not petitionable, matters. As mentioned, proposed amendments to the claims may also be provided, and these will not count towards the 5-page limit. However, any attachment in the form of affidavits or other evidence will count towards the five pages, and

therefore, it is recommended that the argument reference, via shorthand, any prior filing including any such declaration, affidavit, or other evidence. Finally, it is noted that the transmittal form is not considered part of the five pages.

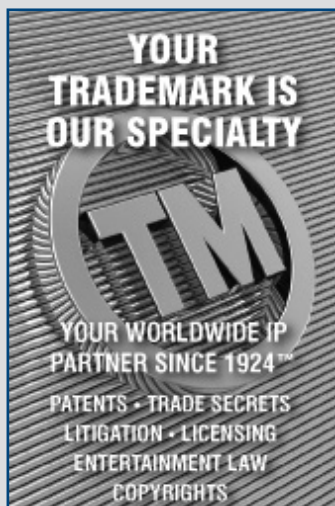
Conference Participation

The P3 request must include a statement by the applicant that the applicant is willing and available to participate in the conference with the panel of examiners. After confirming that the request form is timely and compliant, the USPTO will contact the applicant's representative to schedule a conference. There is a ten day period in which a conference is to be scheduled, or else the P3 request will be deemed improper. The conference can be in the form of in-person, by telephone, or by a video conferencing tool.

The presentation will take a form similar to an *ex parte* appeal before the Patent Trial and Appeal Board (PTAB), and the applicant will be given 20 minutes to present their case for overcoming the final rejection(s). The presentation can include materials (e.g., PowerPoint or other exhibits), and these will not count towards the 5-page limit. The panel hearing the presentation may include the examiner of record, the Supervisory Patent Examiner (SPE), and a primary examiner with the most expertise in the relevant technological and/or legal field based upon the issues. While this is the goal of the P3, the Patent Office acknowledges that this may not always be the case.

The Decision

After the conference, the panel will decide an outcome, which will be in the form of writing and sent to the applicant's representative. The decision will indicate one of the following: (a) Final rejection upheld; (b) allowable application; or (c) reopen prosecution. If (a), the decision will simply disclose the status and reasons for upholding the rejection. If a proposed amendment had been included with the P3 request, the status of the amendment will also be given (e.g., entered or not entered). Upon notice that the rejection is upheld, the applicant will be given further notice of a time period for taking



MVS

MCKEE, VOORHEES & SEASE, PLC
WWW.IPMVS.COM
(515) 288-3667

continued from page 1

any further action, such as filing an appeal or an RCE. If the outcome results in an allowable application, the decision will accompany a Notice of Allowance. Finally, if (c) is the outcome, the panel decision will be withdrawn the final rejection and a new Office Action will be mailed in due course.

If the applicant files any of the following after the date of filing a P3 request, but prior to a notice of decision from the panel of examiners, processing of the P3 request will end without a decision on the merits of the P3 request: a notice of appeal; a RCE; an express abandonment under 37 CFR 1.138; a request for the declaration of interference; or a petition requesting the institution of a derivation proceeding.

Therefore, the P3 provides a new tool in which an Applicant can provide arguments to a panel of more than just the examiner of record, with the hopes that the additional examiners will provide greater insight into the application. The goal is to reduce the number of appeals filed and to provide a path for advancing the prosecution of an application via a cost-efficient program for inventors and/or other applicants.

If you have any questions or if you would like to learn more about this and any other program to help patent your innovations, please contact an MVS attorney.

THE USPTO ATTEMPTS TO IMPROVE CUSTOMER SERVICE EXPERIENCE

The USPTO has been making an effort to improve its customer service experience for patent applicants and their representatives. As part of this effort the USPTO has started and continued its Ombudsman Pilot Program since 2010 and more recently has implemented a Stakeholder Training on Examination Practice and Procedure. These programs offer different approaches to customer service.

The Ombudsman Program

The Ombudsman Pilot Program is intended to assist patent applicants and their representatives with issues or concerns that may arise during prosecution. The USPTO maintains that such issues should first be addressed with Examiners and their Supervisory Patent Examiners (SPEs), it recognizes that in some instances irregularities in prosecution can occur. In such an instance, the Ombudsman program may be a place to go. Specifically the Ombudsman program is to assist in “situations [where] patent applicants, attorneys, and agents have felt that examination has stalled and that their efforts to move their applications forward through the normal channels have not been effective.” The Ombudsman Pilot Program was started in 2010 for a one year period. Due to the Ombudsman Program’s success it has been continued for the past six years.

Requests to the Ombudsman Program are tracked so that trends in prosecution can be analyzed and for recordkeeping purposes to ensure items raised are being addressed. The Ombudsman Program is designed for *pro se* applicants (inventors who filed the application and are prosecuting it on their own) or an applicant’s patent attorney or agent, as the person involved in an Ombudsman procedure must have authority to represent the applicant. The Ombudsman Program provides a simple form online followed by a phone call to the representative typically within one business day. The complaint is then assessed by the Ombudsman’s office and forwarded on to the appropriate person to address the issue. While contacting the Ombudsman’s Office may not

necessarily result in a Notice of Allowance, it may certainly insure that proper examining procedure is being followed.

Stakeholder Training on Examination Practice and Procedure

The Stakeholder Training on Examination Practice and Procedure (STEPP) follows a different approach to customer service. Where the Ombudsman Program provides the Applicant an avenue to voice concerns to the USPTO regarding prosecution procedure, STEPP provides the patent office the ability further educate applicants and the interested public in examination procedure. The intention is that by learning more about examination procedure, Applicants understand prosecution issues better, timing of prosecution better, and be better prepared in their for an office action or their next patent application.

STEPP is a three-day course on patent examination procedure. Many of the materials used for training examiners are used in the course. Additionally, the course is largely taught by the USPTO trainers, who also train patent examiners. Each of the three days addresses different issues. Day 1 focuses on patent eligibility (35 U.S.C. § 101), claim interpretation, and formal claiming elements (35 U.S.C. § 112). Day 2 focuses on searching the prior art and mapping the prior art for novelty (35 U.S.C. § 102) and obviousness (35 U.S.C. § 103) rejections. Day 3 focuses on writing office actions, restriction requirements, and procedures before the Patent Trial and Appeal Board. The STEPP courses will be offered at the USPTO headquarters in Alexandria, Virginia (November 15-17, 2016 and July 2017) at the Regional Offices in Dallas, Texas (January 2017), San Jose, California (March 2017), Denver, Colorado (May 2017), and Detroit, Michigan (September 2017). Additional information, including information regarding signing up is available at <http://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp>.

NICHOLAS KROB

Educational Background

I have undergraduate degrees in Philosophy, Sociology, and Criminology and a minor in Politics and Law from the University of Northern Iowa, where I graduated *summa cum laude* in 2012. For law school, I attended Drake University as a Dwight D. Opperman Scholar. I graduated in 2015 with high honors, also earning certificates in Global Intellectual Property and Public Service.

What IP specialties do you enjoy working in?

The entire field of intellectual property fascinates me. It is a unique and complex area of law that I truly love exploring. Of its subsets, trademark law is what I enjoy the most. It is a critically important and often-overlooked area of law.

How has your educational background prepared you for a career at MVS?

Going back to my undergraduate education, I would say that the diversity of study prepared me for a career in intellectual property, where every case is unique and presents new issues.

Having three different majors and a minor taught me to adapt my study to new and varying topics quickly and efficiently. I am now able to quickly adapt to new scenarios and feel confident and comfortable when presented with new legal issues.

Law school tailored my focus, allowing me specialize in intellectual property. While at Drake Law School, I was able to study under wonderful professors who taught the law thoroughly and pragmatically. I served as a research assistant for two intellectual property professors and even published my own student note regarding trademarks and keyword advertising in the *Drake Law Review*. Additionally, the school's practical approach to legal education, together with my work experience while in school, allowed me to see the law in practice, working with clients, other attorneys, and judicial personnel.

What three qualities do people use to describe you?

Loyal, hard-working, and kind.

What's the best piece of advice you've received?

"Stay hungry, stay free, and do the best that you can." I suppose the advice wasn't directed at me personally as it is a lyric from a song, but I take a lot from the music I listen to. This line in particular reminds me to always maintain ambition and commit to all endeavors.

What challenges do you see the IP industry facing in the next 5-10 years?

Perhaps a concern not limited to 5-10 years from now, but it seems the field of intellectual property, unlike most other areas of law, is experiencing increased problems regarding public perception. Recent studies have shown that popular conceptions regarding intellectual property rights do not accord with actual intellectual property laws. This is problematic, as it undermines both the legitimacy and effectiveness of intellectual property law. Considering the fast-changing landscape of fields involving intellectual property, it will be extremely important in the coming years for those within the intellectual property field to be vigilant in educating about the law and its importance.

What is your favorite sports team?

Manchester United.

What is your favorite hobby?

I enjoy music, art, and traveling.

Where did you grow up?

I grew up in Iowa City.



“STAIRWAY TO HEAVEN” HOLDS ON TO ICONIC RIFF

by Caitlin M Andersen

One of the most iconic rock songs of the 20th Century came under fire earlier this summer for allegations of copyright infringement. The estate of Randy Wolfe, guitarist for Spirit on the song “Taurus,” brought a copyright suit against Led Zeppelin, frontman Robert Plant, and guitarist Jimmy Page alleging infringement of a guitar riff that opens the iconic classic “Stairway to Heaven.”

The jury heard testimony from Page that while he owned a copy of “Taurus,” he had never listened to the song during the time “Stairway to Heaven” was written and that he had not actually heard the song until very recently. The six-day trial ended with a jury instruction that correctly stated that while songs and riffs may be copyrighted, common musical elements such as chord progressions are not eligible for protection. This nuance in the instruction likely prompted the jury’s finding that while there was a chance Plant and Page head “Taurus,” no infringement occurred because the songs were not objectively

similar. Wolfe’s estate filed an appeal to the Ninth Circuit on July 23rd in the wake of a claim for nearly \$800,000 attorneys’ fees and costs because the claims were based on songs written 45 years ago and the estate’s conduct throughout the case amounted to “continued and gross misconduct.” However, this claim was denied on August 8, as the case was not “frivolous or objectively unreasonable.” This was one of the first requests for fees filed after the Supreme Court ruling in *Kirtsaeng v. John Wiley & Sons Inc.*, which concluded that fees should be awarded to successful copyright litigants. Per the rule, the court must consider if the case was objectively reasonable and then utilize its discretion to weigh other circumstances.

The tension between common, uncopyrightable chord progressions and copyrightable expressions of these chord progressions creates a question of whether songs which are built around such common elements are sufficiently original to be copyrighted.

WE’RE THERE

August 8, 2016

Luke Mohrhauser, Greg Woods and Marcus Smetka attended the Whirlpool Community Charity Golf Event in Benton Harbor, MI.

August 21-25, 2016

Jonathan L. Kennedy attended the American Chemical Society (ACS) National Meeting and Exposition in Philadelphia, PA.

September 12-14, 2016

Heidi S. Nebel and Jill N. Link attended the Ag Innovation Showcase at Danforth Plant Center in St. Louis, MO.

September 28-29, 2016

Heidi S. Nebel and Jill N. Link will attend the AUTM Partnering Forum for Agriculture in Saskatchewan. MVS is also a sponsor for this event.

October 4-5, 2016

Heidi S. Nebel, Jill N. Link, and Caitlin M. Andersen will attend Iowa’s Creative Corridor Biotech Spotlight Series in Cedar Rapids, Iowa.

October 11, 2016

Jonathan L. Kennedy will attend the South Dakota Innovation Expo in Rapid City, SD.

November 10-12, 2016

Kirk M. Hartung will attend the fall LEGUS meeting in Hoboken, NJ.

**If you would like to receive the BRIEFS newsletter electronically,
please subscribe to briefs@ipmvs.com**

BRIEFS is published periodically and is intended as an information source for the clients of McKee, Voorhees & Sease, PLC. Its contents should not be considered legal advice and no reader should act upon any of the information contained in this publication without professional counsel.