

# Patent Prosecution: 37 C.F.R. § 1.181 Petitions for a Complete Office Action

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A Practice Note discussing petitions under 37 C.F.R. § 1.181 for a complete US Patent and Trademark Office (USPTO) office action in a pending patent application. This Note examines the requirements for complete examination and office actions, the principles of compact USPTO prosecution, and the process of identifying and responding to an incomplete office action. It delves into patent examiners' procedural obligations, as outlined in 35 U.S.C. § 132(a) and MPEP § 707.07, emphasizing the necessity for examiners to provide comprehensive responses to all claims and arguments. It discusses the strategic considerations and benefits of challenging an incomplete office action by petition, including how to prepare, file, and monitor the petition to enhance the likelihood of success. The Note underscores the importance of timely filing petitions and managing examiner relationships to promote successful outcomes.

When examining a patent application, examiners are required to issue complete office actions that address all the issues. However, the US Patent and Trademark Office (USPTO) occasionally issues an incomplete office action that fails to examine all the claims or address all the applicant's patentability arguments or amendments. An incomplete office action leaves the applicant unable to respond effectively and can delay or preclude a fully argued patentability decision. In response, the applicant can file a petition under 37 C.F.R. § 1.181 requesting the USPTO replace the action with a new complete office action. A petition can promote prosecution quality and efficiency in the right situations.

This Note addresses petitions for a complete office action, including:

- Situations where a petition may be appropriate.
- The benefits, key considerations, and potential drawbacks of filing a petition.
- How to prepare and file a timely and successful petition.

## Complete Office Action Requirement and Compact Prosecution Goals

The Patent Act and USPTO regulations require patent examiners to state the reasons for their actions and provide the necessary supporting information and references (35 U.S.C. § 132(a)). Office actions must be complete as to the claimed invention's patentability and compliance with statutes, rules, and formalities (37 C.F.R. § 1.104(a)(1); MPEP § 707.07). Final actions have the same completeness requirement (37 C.F.R. § 1.113(b); MPEP §§ 706.07 and 707.07(g)). Consistent with these requirements, examiners are instructed to generally avoid piecemeal patent examination (MPEP § 707.07(g)).

A complete patent examiner's office action must:

- Be complete as to all substantive matters in the patent application (37 C.F.R. § 1.104(b); MPEP §§ 707.07 and 707.07(f)).
- Address all the claims (MPEP § 707.07(i)).

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- Identify any allowable subject matter (MPEP § 707.07(j)).

MPEP Section 707.07(f) details an examiner's duties when reviewing and acting on an applicant's office action response. For example:

- To provide a complete application file history and enhance the clarity of the prosecution history, an examiner must provide clear explanations of all actions taken during prosecution.
- Where the examiner's requirements are traversed, the examiner should:
  - make proper reference in their action on an amendment; and
  - if they repeat the rejection, take note of the applicant's argument and answer its substance (37 C.F.R. § 1.112).
- If a rejection of record is to be applied to a new or amended claim, the examiner should provide specific identification of that ground of rejection, such as by citing to the original rejection in the prior office action.
- If the examiner determines that asserted advantages are not sufficient to overcome the rejections of record, they should state the reasons for their position in the record, preferably in the action immediately following the assertion or argument relative to these advantages. By doing this, the applicant knows that the asserted advantages have actually been considered by the examiner, and if an appeal is made, the Patent Trial and Appeal Board (PTAB) is also advised.
- If the examiner withdraws a rejection, the next action must state the reasons why the previous rejection is withdrawn by referring to the relevant pages and lines of applicant's remarks.

(MPEP § 707.07(f).)

More specific requirements apply to particular rejection types including:

- Prior art rejections (37 C.F.R. § 1.104(c)(2); MPEP §§ 707 and 2143.03).
- Non-prior art rejections (MPEP § 706.03).

These requirements dovetail with the USPTO's directive and policies toward efficient compact patent prosecution, which refers to reducing the number of actions in a patent application before its allowance or abandonment. For the USPTO,

compact prosecution is a procedural requirement defining the minimum information examiners must provide patent applicants during prosecution to facilitate prompt and complete examination (MPEP §§ 2103(l) and 2173.06). However, while the USPTO's examiner incentive structure (called the [count system](#)) is designed to motivate patent examiners to practice compact prosecution, it can result in reduced examination quality (see USPTO Examiner Performance Incentives Can Reduce Office Action Quality). Nevertheless, applicants can pursue compact and quality prosecution through certain procedural mechanisms (see Applicants' Role in Compact Patent Prosecution).

For information on patent prosecution and office action responses, see [Practice Notes, Patent Prosecution: Overview](#), [USPTO Patent Office Action Responses](#), and [Patent Prosecution: Final Rejections](#).

### USPTO Examiner Performance Incentives Can Reduce Office Action Quality

The USPTO's patent examiner count system sets metrics for evaluating examiner performance and affects everything from examiner pay to continued employment as the primary way to influence examiner behavior. The system considers examination quality balanced against factors like production rate and docket management. Under this system, examiners can increase the appearance of examination quality by focusing on issues more commonly reviewed by supervisors rather than the more difficult portions. These difficult portions also tend to be more substantive and are more likely to affect the ultimate enforceability of the patent. The system can also incentivize increased production at the expense of quality. For more on the count system, see Ryan Pool, *Compacting Prosecution and Petitions at the USPTO: Incredibly Useful and Incredibly Frustrating*, 51 AIPLA Q.J. 199, 204-06 (2023).

### Applicants' Role in Compact Patent Prosecution

Most patent applicants are inherently motivated to seek efficient and high-quality prosecution. The result is a clear and complete record with lower costs and fees. Applicants continually seek ways to achieve efficient compact prosecution such as by:

- Filing clear and complete responses, appropriate amendments, and arguments. For a collection of resources on preparing office action responses, see [USPTO Patent Office Action Response Toolkit](#).
- Seeking examiner interviews. For information on examiner interviews, see [Practice Note, Patent Prosecution: Examiner Interviews](#).
- Filing requests for continued examination (RCE) in appropriate situations. For information on RCEs and continuing applications, see [Request for Continued Examination \(RCE\) Checklist](#) and [Practice Note, Patent Prosecution: Continuing Patent Applications](#).
- Filing appeals when necessary (see [Practice Note, Patent Prosecution: PTAB Appeals](#)).
- Taking advantage of accelerated examination and other special USPTO procedures and initiatives (see [USPTO Initiatives](#); [Practice Note, Expediting Patent Prosecution](#)).

These applicant procedures are typically sufficient to receive a timely complete examination. An exception is an incomplete office action that fails to meet minimum requirements. Here too, applicants have some leverage to progress prosecution. For example, applicants can seek to cure an incomplete office action through an appropriate 37 C.F.R. § 1.181 petition, which the applicant can coordinate with an examiner interview.

### An Incomplete Office Action Is Petitionable

In general, a patent applicant can petition the USPTO Director or their designee from any non-appealable examiner action (37 C.F.R. § 1.181(a)(1); MPEP § 1002; see [Practice Note, Patent Prosecution: Petitions: Matters That Are Petitionable Rather Than Appealable](#)). This includes an incomplete office action, which:

- Is an action that is not complete as to all substantive matters (37 C.F.R. § 1.104(b); see Complete Office Action Requirement and Compact Prosecution Goals).
- Typically occurs when the office action ignores or completely fails to address the pending claims or fails to respond to all of the applicant's arguments and evidence (MPEP § 707.07(f)).
- Can be either a nonfinal or final action, although most commonly occurs as a second or subsequent

action that fails to address all the applicant's arguments or amendments traversing a rejection.

Before filing a petition, patent counsel should confirm that the office action is incomplete. Although examiner office actions naturally vary in quality, most office actions are not truly incomplete. An incomplete office action represents a breakdown in the exchange between examiner and applicant. Under these circumstances, the applicant is left unable to advance prosecution as to an issue because the action provides no new information to which they can respond. This type of petition is inappropriate if the examiner has examined all the claims and provides some substantive response to the applicant's arguments. In other words, a petition is inappropriate for resolving substantive disagreements with the examiner.

Most important, the office action challenged by petition must be procedurally incomplete because the examiner ignored at least one claim or at least one argument relevant to a maintained rejection. An office action that at least addresses all the applicant's claims and arguments is unlikely to be successfully petitioned and may anger the examiner, thereby placing the applicant in an unfavorable position.

On the other hand, selecting an office action that is truly incomplete for a petition can correct an unfavorable situation by spotlighting the application to the USPTO Technology Center Group Director for review to restore the applicant's right to complete examination. Patent counsel should reserve petitions for these clear cases. Even where petition success is considered likely, applicants should understand that the petition can nevertheless temporarily affect the applicant-examiner relationship. However, where allowance of the application may turn on the very argument the office action ignores, a petition may still be the best option.

### Petition Benefits and Strategic Considerations

Faced with an incomplete office action, applicants should consider:

- The benefits of a granted petition, namely a new office action (see Potential Benefits of Filing a Petition).
- Important considerations and additional coordinated strategies (see Additional Considerations and Strategy).

### Potential Benefits of Filing a Petition

A granted Rule 181 petition results in the examining Technology Center Group Director vacating the entire challenged incomplete office action with instructions to the examiner to issue a new replacement office action. The new office action has a new shortened statutory response time and effectively results in a reset. Compared to alternatives, such as a PTAB appeal or RCE and their associated fees, costs, and delays, this is a substantial win for the applicant. In an after-final situation, the new office action can be issued as a final or non-final action. In the case of a non-final action, a successful petition resulting in a new non-final action could help avoid a future final rejection of the application altogether. A successful petition is also likely to result in some amount of patent term adjustment (PTA).

### Additional Considerations and Strategy

Where patent counsel deems an office action incomplete, they should also consider:

- The overall predicted likelihood of success:
  - on the petition's merits (see *An Incomplete Office Action Is Petitionable*); and
  - accounting for petition timing and pendency, including extension of time fees necessary if the USPTO denies or fails to decide the petition (see *Petitions Outcomes Indicate Frequent Success but Low Usage*).
- Overall prosecution objectives and priorities. Most applicants would benefit from receiving a corrected office action with a new response timeline. Exceptions may include applicants seeking prosecution delay and who are not cost-sensitive.
- The practical impact of a granted petition on the application's progress toward allowance. For example, a granted petition's impact is higher where the challenged office action ignored a key dispositive issue.
- The applicant's intangible working relationship with the examiner (see *Interviews and Managing the Examiner Relationship*).
- The petition is easy to prepare and file and does not require a petition fee (see *Preparing and Filing the Petition*).

- Pairing the petition with an examiner interview or a request to withdraw an office action's finality (see *Interviews and Managing the Examiner Relationship*).
- The likely accrual of PTA days due to the USPTO's delay in issuing a complete office action on granting the petition. For relevant information on accruing PTA, see [Practice Note, Patent Term Adjustment: USPTO A-Delay](#).

### Petitions Outcomes Indicate Frequent Success but Low Usage

USPTO data for petitions seeking a complete office action indicate:

- Low overall usage of this type of petition.
- Petition decisions on the merits usually favor the applicant.
- Dismissals and denials resulting from:
  - statutory time running out for the applicant's response before the petition is decided; and
  - a merits determination that the challenged office action was not incomplete.

According to data collected from [Petition.ai](#) (represented in Figure 1 below), which has a searchable database of petition requests and decisions data mined from the USPTO's [Patent Center](#), patent applicants file petitions for a complete office action at a low rate.

From 2018 to 2022, there were fewer than 100 petitions based on an examiner's failure to issue a complete office action. Given the number of office actions issued over the five years studied and the assumption that examiner work product falls on a normal distribution, this number of petitions is considered low. Additionally of note was that only four different law firms filed any of this type of petition. It would be extraordinary if only a select few law firms were issued incomplete office actions.

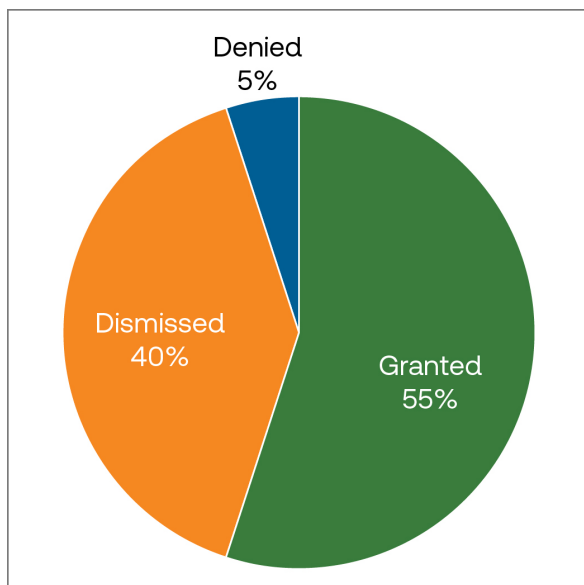
This underutilization is likely due to lack of applicant awareness. The data clearly shows that applicants are not petitioning incomplete office actions at an optimal rate. Properly filed petitions have a high grant rate and often save applicants substantial fees. These petitions also facilitate compact prosecution by advancing the contentious issues of patentability to allow an efficient determination of allowance or

abandonment. Patent counsel should at least be aware of the petition option for use in appropriate situations.

Attorney workflow could also be responsible for at least some petition underutilization. That is, clients and attorneys commonly wait until the three-month due date to prepare a response. Therefore, when a petitionable office action is identified, it is too late to file the petition. Prosecutors are encouraged to adapt their best practices to include early identification of office action incompleteness (see *Petition Timing and Pendency*).

The number of petition decisions issued from these requests is even less than the number of requests, presumably because some were dropped by the applicant or rendered moot by a notice of allowance. USPTO decisions on the merits are generally favorable to the applicant. In all the petition decisions over this time period, there were only a few instances of denial. However, while most decisions granted applicants' request for a new office action, about 40% were dismissed. A graphical representation is shown below in Figure 1.

Figure 1



The high dismissal rate can be attributed to two main reasons. The first is the petition officer's finding that applicants were petitioning for relief on a substantive issue rather than a petitionable issue. For example, an examiner's failure to respond

to an applicant's arguments is a valid ground for petition relief, but a disagreement between applicants and examiner on a particular issue must instead be appealed (see *Complete Office Action Requirement and Compact Prosecution Goals*). As another example, ignoring evidence of submitted unexpected results is petitionable, but finding that the evidence is not commensurate in scope with the claimed invention, even for ultimately incorrect reasons, is not. Applicants must appeal this issue.

The second reason for dismissal is the USPTO's failure to process petitions quickly enough against the challenged office action's response deadline (see *Petitions Pendency Data*), which forces the applicant to file a response. This failure appears pervasive throughout all petition types. Considering this, applicants should file early, well-supported petitions and be vigilant with USPTO follow-ups after filing.

### Preparing and Filing the Petition

Petitions for a complete office action are not discussed in the MPEP or the USPTO Patent Petitions web page. The petition should:

- Comply with formal requirements (see *Petition Requirements*).
- Focus on the challenged action's shortcomings and emphasize that the applicant is not challenging the rejection on the merits (see *Drafting the Petition*).

For general USPTO guidance on petitions, see the [USPTO Patent Petitions](#) page. For information on filing petitions, see [Practice Note, Patent Prosecution: Petitions](#).

### Petition Requirements

The petition for a complete office action:

- Must contain a statement of:
  - facts;
  - the points to be reviewed (argument); and
  - the action requested (request for relief).
- Must be filed within two months of the office action (see *Petition Timing and Pendency*).
- Does not require a fee.

(37 C.F.R. § 1.181(b); MPEP § 1002.)



The applicant should file the petition as soon as possible and not later than two months after the office action date (see Petition Timing and Pendency). The papers should direct the petition to the relevant USPTO Technology Center Group Director (37 C.F.R. § 1.181(g)). Patent Center is the best filing method, although it does not include an ePetition form for this type of petition.

### Drafting the Petition

A petition for a complete office action should focus on showing that the challenged office action is facially incomplete while emphasizing that the petition does not seek substantive review. It should include a short Introduction followed by sections directed to the Facts, Argument (points to be reviewed), and a Request for Relief (37 C.F.R. § 1.181(b); see Complete Office Action Requirement and Compact Prosecution Goals).

#### The Introduction

The Introduction should request the Group Director find the challenged office action incomplete and instruct the examiner to issue a new complete office action that responds to the applicant's filing. It should also state that the petition does not seek review of any of the examiner's findings or determinations and is limited to seeking a complete office action to allow prosecution to advance efficiently.

To set up the argument that the challenged office action is incomplete, the Facts section should briefly summarize the relevant parts of:

- The applicant's most recent filing.
- The challenged office action that should have addressed the applicant's amendments, arguments, or evidence.

This section should identify the applicant's arguments on each substantive issue and any relevant claim amendments with page citations. The office action summary should identify the applicant's arguments and claims the office action ignored.

#### The Argument

The Argument section should set out the relevant statute, regulation, and MPEP authorities requiring complete examination and examiner office actions (see Complete Office Action Requirement

and Compact Prosecution Goals). For example, MPEP § 707.07(f) is a key section requiring the examiner provide a substantive response to all of applicant's arguments challenging a rejection.

This section can also argue that the completeness requirements are necessary for efficient compact prosecution that produces a clear prosecution record. For example, the applicant can argue that the examiner is preventing efficient prosecution, thereby failing to meet the USPTO's compact prosecution goals. The USPTO acknowledges that not providing this compact prosecution can lead to unnecessary delays in the prosecution of the application.

The Argument should then apply the office action completeness requirements and policies to the office action's demonstrated omissions to show it violates the requirements and prevents effective prosecution.

#### The Request for Relief

The Request for Relief section should ask that the current office action be withdrawn and that the Group Director instruct the examiner to issue a new complete office action that examines all the claims and fully addresses all the applicant's remarks and arguments.

Examples of successful petitions for a complete office action include petitions filed:

- December 17, 2020 in [Appl. No. 15/868,357](#) (US Pat. Pub. No. 2019/0209471 A1).
- August 10, 2022 in [Appl. No. 16/494,113](#) (US Pat. Pub. No. 2020/0373612 A1).

### Petition Timing and Pendency

A petition for a complete office action:

- Must be filed no more than two months after the office action date because petitions filed later are typically dismissed.
- Does not toll the time period for response to the office action.

(37 C.F.R. § 1.181(f); MPEP § 1002.)

These provisions, coupled with USPTO petitions processing practices (see Petitions Pendency Data), put applicants in a difficult position. The no-tolling

provision means that if a decision on the petition is not issued by the final statutory response due date, the applicant is forced to file an RCE or a notice of appeal to keep the application alive. Ironically, these applicant filings done to save the application can trigger the petition's dismissal.

To maximize the likelihood of a timely petition decision, patent counsel should:

- Review office actions to identify incomplete office actions early.
- Seek to file the petition as soon as possible within the two-month requirement.
- Track the petition after filing (see Managing the Petition).

## Petitions Pendency Data

Figure 2 shows the pendency breakdown of 388,000 petition decisions issued from January 2013 to November 2021. This chart shows all petition types and their processing time broken into roughly month-long groups.

Figure 2

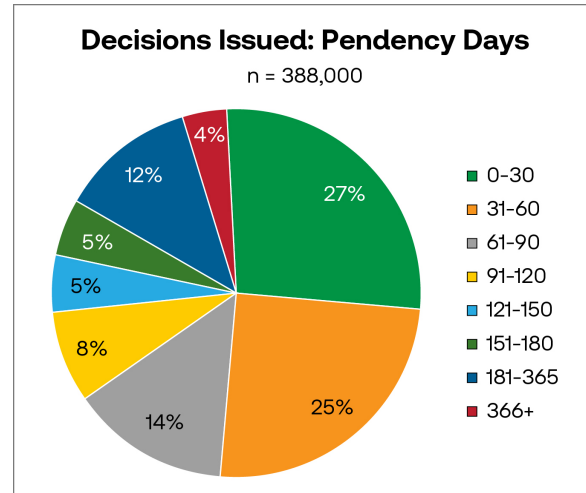
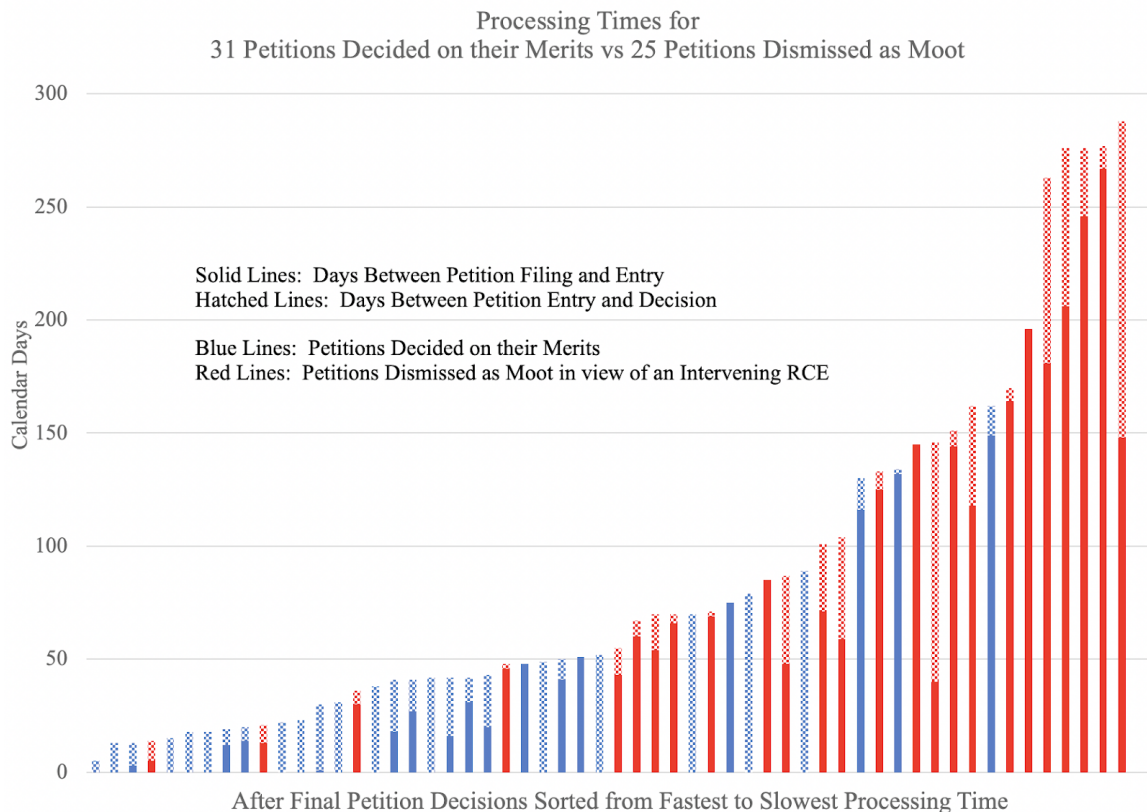


Figure 3 focuses on processing times for after-final action petitions, showing 25 petitions dismissed as moot and 31 petitions decided on the merits, from the fastest (left) to the slowest (right) processing time.

Figure 3



These data indicate that about 121 days of processing time, or about four months, is the threshold for unreasonable USPTO delay. Even when paying for all available extensions of time, applicants have at most six months to respond to an office action. Petitions must be filed by two months after the challenged office action's date. Therefore, when the USPTO delays a timely-filed petition decision by more than about 121 days, the six-month statutory response clock will likely run out.

Figure 3 illustrates this effect. Nearly all petitions delayed more than 121 days are dismissed as moot. The reason is almost certainly that applicants were forced to take action to preserve the application that rendered their petitions moot. Effectively, USPTO delay is forcing RCEs and subsequent petition dismissals on petitioning applicants.

Referring back to Figure 2, 26% of all petitions are delayed more than 121 days. Figure 2 includes all petitions filed, including those that are automatically granted without substantive review. This largely explains the 27% segment at 0 to 30 days. Taken together, and after removing this segment from consideration, petitions requiring substantive review are likely unreasonably delayed in about one-third of cases.

"Justice delayed is justice denied" is a legal maxim that applies to the USPTO Office of Petitions. Based on the data described above, the USPTO is failing to process one in every three substantive petitions it receives in a timely manner. Additionally, the USPTO offers no mechanism to require a timely petition decision or remedy for applicants when the office action response clock runs out. By delaying a decision and then dismissing the petition, the USPTO disposes of the petition without addressing the merits. For the Office of Petitions to work effectively, it must do so in a timely manner. Without this, applicants face additional fees and delayed final determinations of allowance or abandonment. Delays effectively deny applicants an opportunity to be heard. As a result, patent quality suffers, harming both patent applicants and the public.

### Managing the Petition

After filing the petition, patent counsel should docket and follow up with the USPTO examination group to maximize the likelihood of a timely petition decision. Counsel should call the Petitions Office two months

after filing a petition. In most cases, this is sufficient action to get the USPTO to issue a Petition Decision. If the USPTO has not decided the petition within three months, counsel should call a USPTO Ombudsman to request a petition decision be issued before the six-month deadline to prevent the USPTO from running the clock out.

Counsel should also consider:

- Requesting an examiner interview.
- Seeking reconsideration after a dismissed petition. Unfortunately, this option may be effectively foreclosed where the statutory response deadline is approaching.
- Filing a request to withdraw a final office action's finality concurrently with a petition for a complete office action. This generally does not add significant additional work to the preparation of the petition, and if successful, the combination can have the same effect as an RCE without any of the costs.

### Interviews and Managing the Examiner Relationship

An intangible consideration is patent counsel's rapport or working relationship with the examiner. Filing a petition puts a spotlight on the application. The examiner's supervisor will be alerted to the petition and in some cases the Group Director will be alerted. The examiner may receive negative attention from their managers. On one hand, this will likely motivate the examiner to focus on the application. Counsel's future applications may also receive greater attention from that examiner. This is especially true if the applicant's petition is granted. Unfortunately, some examiners may blame counsel for any negative attention, resulting in a negative impact that can continue after the petition procedure is completed.

A side effect of the negative attention that a petition can bring an examiner is that they may be motivated to resolve the applicant's challenge so that the petition will be dismissed. For this reason, counsel may consider pairing the petition with an interview. Requests for an interview should be granted when reasonable (MPEP § 713.01). Interviews paired with a strong petition tend to be high-quality, productive interviews where the examiner has fully reviewed the application and is motivated to cooperate find a path to allowance. For information on examiner interviews, see [Practice Note, Patent Prosecution: Examiner Interviews](#).



### Acting on a Denied Petition

Most applicants who file the petition early and follow up as necessary receive a merits decision on their petition. If the petition is granted, the examiner issues a new office action with a new response time period (see Potential Benefits of Filing a Petition). If the USPTO denies a petition, patent counsel:

- Must file an office action response by the original six-month statutory deadline.
- May file a request for reconsideration of the petition. However, at this stage, there may be little time left before the six-month deadline for the action response. To expedite the request, patent counsel should call the USPTO official who signed the petition decision.
- In theory, may file a petition for writ of mandamus. However, this tactic is impractical due to timing and cost.

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