Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

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What is the DSMER pilot program?

- Temporary program that allows participating applicants to deviate from traditional compact prosecution practice
  - Examiners will still mail actions containing all applicable rejections.
  - Participating applicants may defer responding to subject matter eligibility (SME) rejections under 35 U.S.C. 101 until later in prosecution.
  - USPTO will evaluate how this deferral affects examination efficiency and patent quality as compared to traditional practice.
How to participate

• Applications will be selected for invitations based on procedural and patentability-related criteria.
  – Invitation phase runs from February 1 through July 30, 2022.
  – Invitation will appear as a special form paragraph in the First Action on the Merits (FAOM).

• Invited applicant must formally accept invitation in order to participate.
Application criteria

- Utility non-provisional application that is a first filing;
- Must be on regular examination track; and
- FAOM contains at least one SME rejection, and at least one non-SME rejection.
  - “SME rejection” = Step 1 (not in statutory category) or Step 2B (judicial exception without significantly more) rejection.
  - “non-SME rejection” = rejection on any other statutory basis, e.g., anticipation, indefiniteness, utility, or written description.
Program procedure

- Participation provides a partial waiver of 37 CFR 1.111(b) with respect to SME rejection(s) only. Applicants must still respond to all non-SME rejections.
- Other than the waiver, participation in this program does not alter the normal prosecution process.
- Waiver is terminated by “final disposition” (e.g., allowance or final rejection), or by the withdrawal or obviation of all non-SME rejections.
Program timeline

*Projections are based on FY21 average timing data using the compact prosecution model
USPTO resources

  - Includes notice, flow chart, form, and more information
  - Includes links to public comments

- Eligibility webpage: www.uspto.gov/PatentEligibility
Thank you!

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