

UNITED STATES
PATENT AND TRADEMARK OFFICE



Overview of USPTO Patent Application Initiatives

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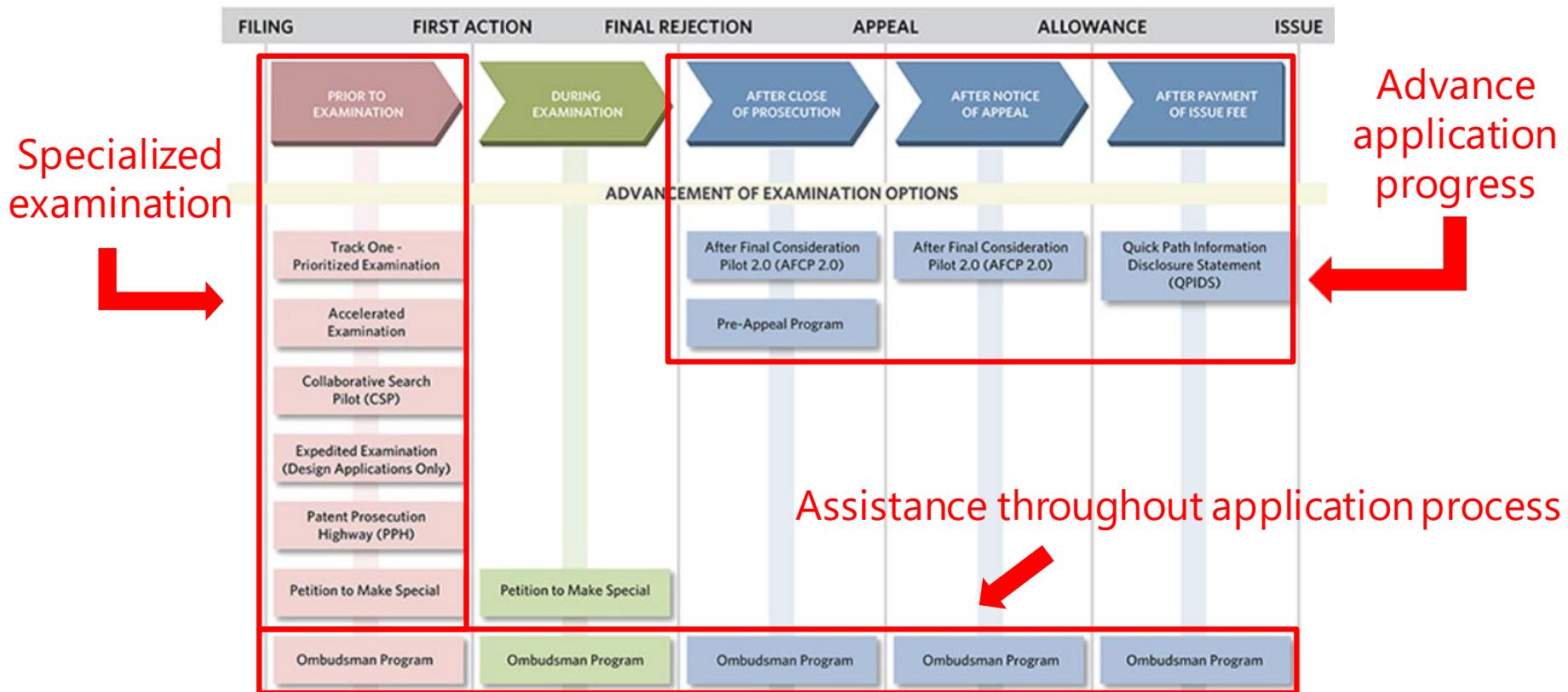


Today's topics

- Overview of patent application initiatives:
 - Prior to examination
 - During examination
 - After close of prosecution
- Each program is designed to advance the progress of a patent application and to provide applicant assistance.



Patents programs and examination timeline



For more information: <https://www.uspto.gov/patents/initiatives/uspto-patent-application-initiatives-timeline>

Prior to examination

Specialized examination programs

- Rule 37 C.F.R. 1.102 permits applications to be taken out of turn under certain circumstances (see also MPEP 708).
- Applicant may petition the Office for entry into a specialized examination program (fees may apply).

- Track One Prioritized Examination

- Accelerated Examination

- Collaborative Search Pilot (CSP)

- Patent Prosecution Highway (PPH)

- Other Petitions to Make Special

Popular

For more information: <https://www.uspto.gov/patents-application-process/petitions>

Track One program highlights



- Prioritized examination of up to 15,000 requests per fiscal year
 - Gives application special status with fewer requirements than the current accelerated examination program and without having to perform a pre-examination search.
 - GOAL → Provide final disposition of application with about twelve (12) months from the date that the petition was granted.
 - A single request for prioritized examination may be granted for a request for continued examination RCE in a plant or utility application.

For more information: <https://www.uspto.gov/patent/initiatives/uspto-s-prioritized-patent-examination-program>



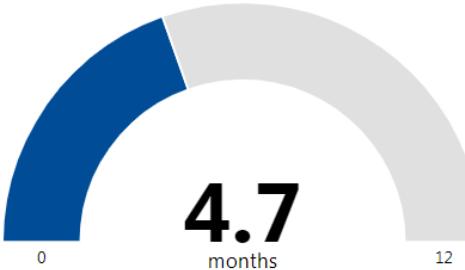
Track One statistics

- Cumulative FY 2022 statistics* → from petition grant to:



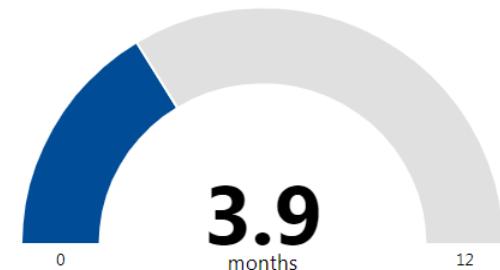
First Action

1.4 Months



Final Action

4.7 Months



Allowance

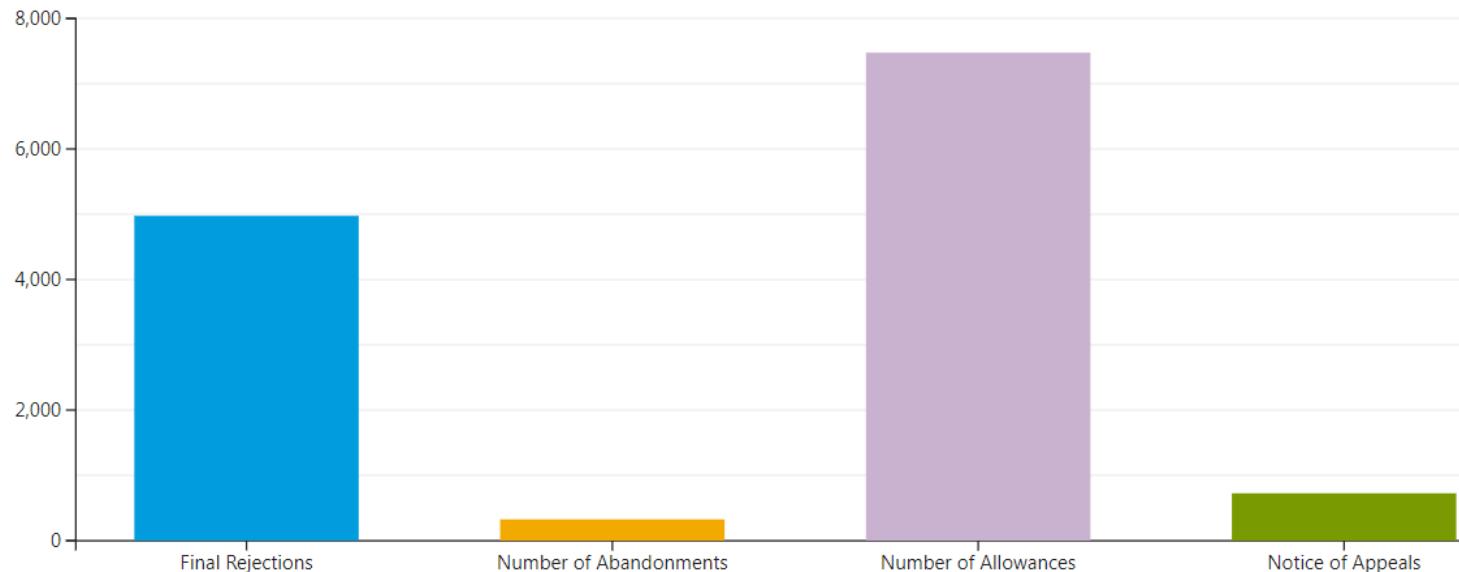
3.9 Months

*As of March 2022. Data available at: <https://www.uspto.gov/dashboard/patents/>



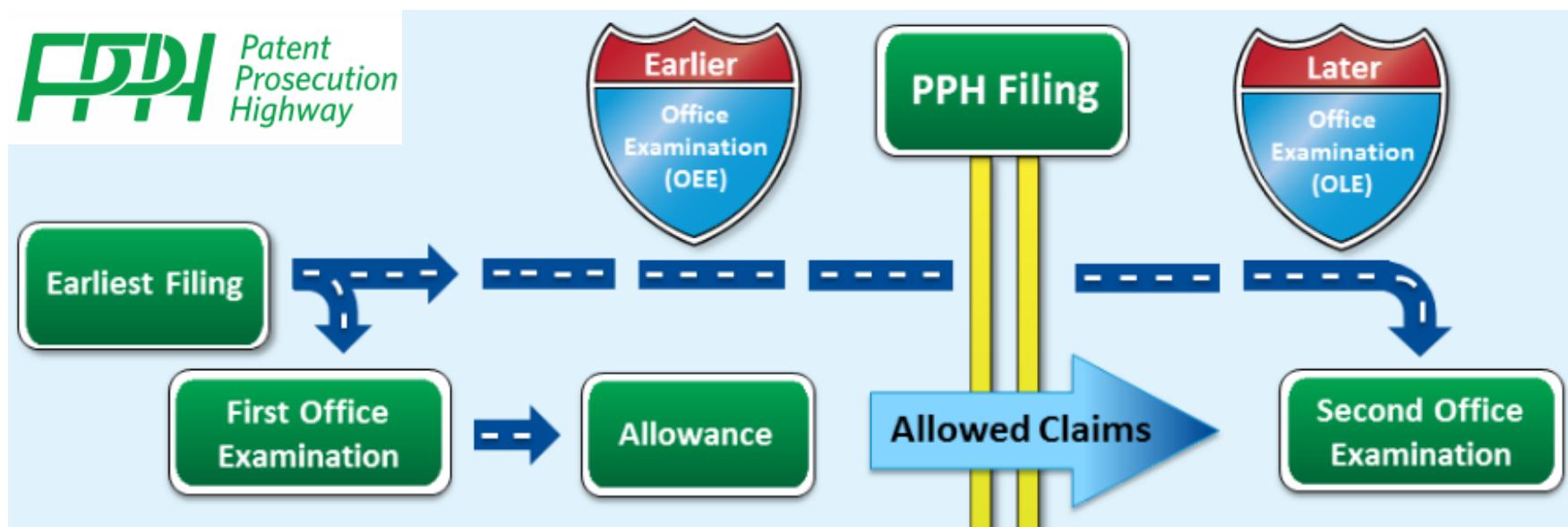
Track One totals in past 12 months

- Final dispositions in Track One applications in the past 12-months*:



*Data available at: <https://www.uspto.gov/dashboard/patents/>

Patent Prosecution Highway Program



For more information: <https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

PPH program highlights

- Once applicant has received an allowance of at least one claim at a participating patent office, applicant may request expedited examination of corresponding claim(s) in a corresponding application that is pending at a second patent office.
- Leverages fast-track examination procedures already in place among participating patent offices to allow applicants to reach final disposition of a patent application more quickly and efficiently than standard examination processing.
- There is no fee under the PPH programs.



Other petitions to make special

- List of grounds to make special (non-exhaustive) (see MPEP 708.02):
 - e.g., applicant's age is 65 or more; applicant's health may affect availability to assist in prosecution.
- Petitions are decided by the Office of Petitions or a designated Quality Assurance Specialist within each Technology Center.
- Applications will be treated as special throughout the entire prosecution within the USPTO.
- Applications placed on the examiner's expedited dockets for processing in accordance with the prescribed time period.

For more information: <https://www.uspto.gov/patents/apply/petitions>



COVID-19 Prioritized Examination Pilot

- USPTO is accepting requests for prioritized examination for certain applications that claim a product or process related to COVID-19 without the additional fees.
- The USPTO's goal is to provide a final disposition within six months of prioritized status being granted if applicants respond within 30 days to a notice from the USPTO.
- The limit of 500 qualifying patent applications only has been removed.
- The pilot will include all qualifying patent applications received by midnight ET on June 30, 2022.

For more information: <https://www.uspto.gov/initiatives/covid-19-prioritized-examination-pilot>



COVID-19 Prioritized Examination Pilot requirements

Same as Track One, except:

- The prioritized examination fees are waived.
- Open to small and micro entities only.
- The application must be a non-continuing nonprovisional application or a continuing application claiming the benefit of one nonprovisional application or one prior international application designating the United States.
- Applicants must certify claim(s) of the application must cover a product or process subject to an applicable FDA approval for COVID-19 use.
- The request must include an Application Data Sheet (ADS).



Cancer Immunotherapy Pilot (Patents 4 Patients)

- Prioritized examination → methods of treating a cancer using immunotherapy.
- Part of National Cancer Moonshot initiative.
- Extended until June 30, 2022.
- GOAL → Provide final disposition of patent applications in the pilot in one year or less after it grants prioritized status.

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For more information: <https://www.uspto.gov/patent/initiatives/patent-application-initiatives/patents-4-patients>



Cancer Immunotherapy Pilot requirements

- Applications must contain one or more claims to a method of treating a cancer using immunotherapy. See Federal Register notice for comprehensive definitions (81 FR 42328).
- Applicants must file a grantable petition under this initiative using the USPTO patent electronic filing system (EFS-Web).
- Open to:
 - any application that has not received a first Office action,
 - any application where the petition is filed with a Request for Continued Examination (RCE), or
 - any application not under final rejection where the claimed cancer immunotherapy is the subject of an active Investigational New Drug (IND) application that has entered Phase II or Phase III (FDA) clinical trials.
- No additional fee is required to participate in the program.



During examination

Patents Ombudsman



- Provides assistance to applicants and attorneys throughout the application process including initial filing, patent examination, and post examination.
- Assists applicants when the normal processing has stalled, helping to get applications back on track.
- Can provide assistance on the merits where there is an issue with case prosecution concerns, such as:
 - Claim objections, after-final practice, claim rejections, restrictions
- Not intended to circumvent normal communication between applicants or their representatives and examiners or supervisory patent examiners (SPEs) or TC Directors.

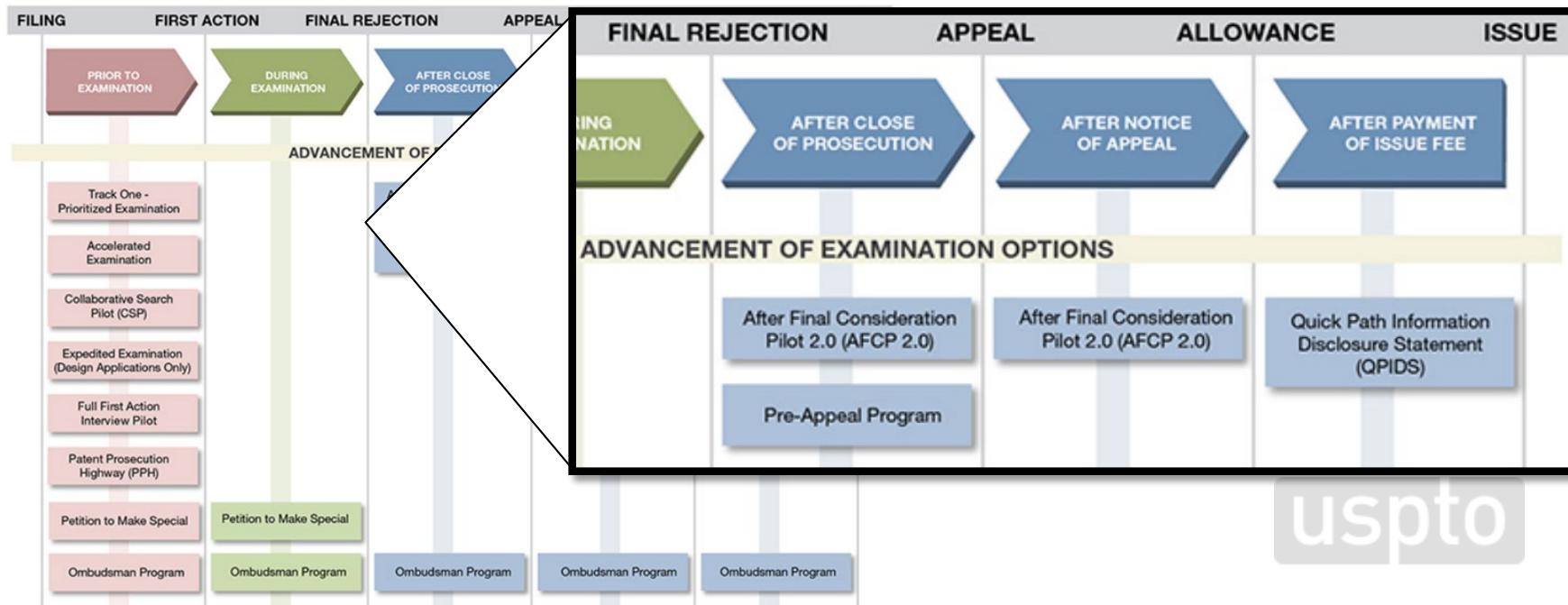
For more information: <https://www.uspto.gov/patent/ombudsman-program>



After close of prosecution

Programs to advance application process

- After-Final Consideration Pilot 2.0 (AFCP)
- Pre-Appeal Conference
- Quick Path Information Disclosure Statement (QPIDS)



After-Final Consideration Pilot (AFCP) 2.0

- Specialized after-final response designed to enhance communication between the Office and applicant.
- EXTENDED through September 30, 2022.
- Authorizes additional time for examiners to search and/or consider responses after final rejection.
- If a response considered under AFCP 2.0 does not place the application in condition for allowance, examiners will also use the additional time to schedule and conduct an interview to discuss the results of their search and/or consideration.

For more information: <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>



AFCP 2.0 requirements

- Key requirements (not exhaustive):
 - Response filed under 37 CFR §1.116
 - Request for consideration under the pilot (Form PTO/SB/434 or equivalent)
 - At least one non-broadening amendment to an independent claim
- Examiners use their professional judgment to decide whether the response can be fully considered under AFCP 2.0.
- Submissions not accepted in AFCP 2.0 will be treated under pre-pilot procedures.
- If you believe an after-final response will lead to allowance with only limited further searching and/or consideration, consider requesting consideration of the response under AFCP 2.0.



AFCP 2.0 FAQs

- Can I file an AFCP 2.0 request after having previously filed a non-pilot after final amendment?

Yes, the prior filing of a non-pilot after final amendment does not affect applicant's ability to submit an AFCP 2.0 request. Note that only one AFCP 2.0 request may be filed in response to an outstanding final rejection.

- Can I file an AFCP 2.0 request after having previously filed a notice of appeal?

Yes, the prior (or concurrent) filing of a notice of appeal does not affect applicant's ability to submit an AFCP 2.0 request, as long as applicant has not yet filed an appeal brief or a Pre-Appeal Brief Conference Request.

AFCP 2.0 FAQs continued

- Can I file an AFCP 2.0 request form in an effort to transform a previously filed non-pilot after final amendment into a proper AFCP 2.0 submission?

Synchronizing between USPTO databases is corrupted when the PTO/SB/434 request form is not filed concurrently with the remainder of the after final amendment materials. For this reason, applicants are requested to always file the AFCP 2.0 request form concurrently with a proposed amendment that is compliant with AFCP 2.0. A previously filed non-pilot after final amendment may be processed consistent with current non-pilot practice, e.g., by mailing an advisory action, notwithstanding a subsequently filed AFCP 2.0 request form.



Not recommended!

- Are there any fees associated with filing an AFCP 2.0 request?

There are no fees unique to an AFCP 2.0 request. Do note, however, that applicants will be required to pay any applicable non-pilot fee, e.g., the fee for an extension of time, concurrently at the time of filing the AFCP 2.0 request.

Pre-Appeal Brief Conference Program

- Request for review of outstanding rejections prior to filing of an appeal brief (see MPEP 1204.02).
- Upon receipt of a properly filed request, a supervisor will designate a panel of appropriate reviewers to review the appellant's remarks and the examiner's rejections.
- After the review is complete, the USPTO will mail a decision on the status of the application, stating one of the following:
 - (A) The application remains under appeal because there is at least one actual issue for appeal.
 - (B) Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).
 - (C) The application is allowed on the existing claims and prosecution remains closed.
 - (D) The request fails to comply with the submission requirements and is dismissed.



Pre-Appeal Brief Conference Program requirements

- Key requirements (not exhaustive) (see MPEP 1204.02):
 - Must file a notice of appeal in compliance with 37 CFR 41.31.
 - Request for pre-appeal brief review must be filed with (on the same day as) the filing of the notice of appeal and before the filing of an appeal brief. (Form PTO/AIA/33)
 - Request may not exceed five (5) total pages and should provide a succinct, concise and focused set of arguments for which the review is being requested
- The time period for filing an appeal brief will be reset to be one month from the mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever greater; the time period for filing of the appeal brief is extendible under [37 CFR 1.136](#).



Quick Path IDS (QPIDs) program

- Part of the USPTO's on-going efforts towards compact prosecution and pendency reduction.
- Now PERMANENT.
- Eliminates the requirement for processing of a RCE with an IDS filed after payment of the issue fee in order for the IDS to be considered by the examiner.
- Where the examiner determines that no item of information in the IDS necessitates reopening prosecution, the USPTO will issue a corrected notice of allowability (NOA).

*For more information: <https://www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids>



Prosecution Timeline & Filing Requirements

Filed <u>after</u> final rejection & <u>prior to</u> disposal	Filed <u>on/after</u> allowance & <u>prior to/same day</u> issue fee payment	Filed <u>after</u> issue fee payment & <u>prior to</u> issue
<p>Required:</p> <ul style="list-style-type: none"> • CFR 1.17(p) fee • CFR 1.97(e) statement • IDS MUST comply with CFR 1.98 	<p>Required:</p> <ul style="list-style-type: none"> • CFR 1.17(p) fee • CFR 1.97(e) statement • IDS MUST comply with CFR 1.98 	<p>Required:</p> <ul style="list-style-type: none"> • QPIDS.REQ form (or equivalent) • ePetition to withdraw from issue • RCE w/ CFR 1.17(e) fee* • CFR 1.17(p) fee • CFR 1.97(e) statement • IDS MUST comply with CFR 1.98



- Outcomes: Applicant will receive an annotated IDS and either: a PTO-2300 form and subsequent Office action that reopens prosecution (necessitated by IDS reference); or a Corrected NOA.

*Treated as “provisional” RCE until examiner makes decision to reopen prosecution.



QPIDS FAQs

- What if I cannot make either of the timeliness statements within 37 CFR 1.97(e)?

You cannot file a QPIDS submission to have the IDS considered. You must follow the current process for having an IDS considered after payment of the issue fee of either filing (i) a petition under 37 CFR 1.313(c)(2) to withdraw the application from issue in order to permit entry of an RCE and have the accompanying IDS considered by the examiner or (ii) a petition under 37 CFR 1.313(c)(3) to withdraw the application from issue for express abandonment in favor of a continuing application.

- May I still file a QPIDS submission after having received an Issue Notification?

Yes, as long as the date of the QPIDS submission is before the date the patent issues. When filing a QPIDS submission after a patent number has been assigned to the application, be sure to select the “Petition to Withdraw from Issue after Payment of the Issue Fee (37 CFR 1.313(c)(1) or (2) with Assigned Patent Number)” option at the Web-based ePetitions interface. Information regarding submission of Web-based ePetitions is available at <http://www.uspto.gov/patents/process/file/efs/guidance/epetition-info.jsp>.

QPIDS FAQs continued

- Must a QPIDS submission include a RCE fee?

Yes, a QPIDS submission must include the RCE fee under 37 CFR 1.17(e). If the examiner determines that no item of information in the IDS necessitates reopening prosecution, the RCE fee will be automatically returned.

- Will the petition fee under 37 CFR 1.17(h) be returned if the examiner determines that no item of information in the IDS necessitates reopening prosecution?

No, the petition fee under 37 CFR 1.17(h) will not be returned, regardless of the examiner's determination with respect to reopening prosecution.

QPIDS FAQs continued

- May a QPIDS submission contain an amendment?

No, inclusion of an amendment will result in automatic entry and treatment of the “conditional” RCE as a RCE under 37 CFR 1.114.

- If I filed a QPIDS submission in an application, can I file a second or subsequent QPIDS submission in the same application?

Yes, but applicant must wait until after the Office issues a corrected notice of allowability (form PTOL-37) indicating that the examiner considered the prior QPIDS submission. The issuance of the PTOL-37 puts the application back into the issue queue, and at that point applicant may file another QPIDS submission. If, however, the Office issues a form PTO-2300 in response to the prior QPIDS submission, indicating that the examiner reopened prosecution, applicant can make another IDS submission in accordance with 37 CFR 1.97 (there would be no need to use the QPIDS program). If subsequent to the Office’s issuance of a PTO-2300, the application is again allowed, and the issue fee is again paid (or applicant requests that the previously submitted issue fee be applied toward payment of the issue fee), applicant may file another QPIDS submission.

Question and answer



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