

FREQUENTLY ASKED QUESTIONS – QPIDS PILOT PROGRAM

I. LIST OF TOPICS

- A. General Information
- B. Timing for Filing a QPIDS Submission
- C. Fees
- D. Content of a QPIDS Submission
- E. Action after QPIDS Submission
- F. Patent Term Adjustment (PTA) Implications

II. QUESTIONS AND ANSWERS

A. General Information

- Q1. What is the purpose of the QPIDS pilot program? (Posted on 5-11-2012)

The purpose of the QPIDS pilot program is to reduce the need for reopening prosecution via a Request for Continued Examination (RCE) after payment of the issue fee, thereby assisting in achieving Office pendency reduction goals, encouraging compact prosecution, and improving stakeholder satisfaction. In particular, the program will eliminate the requirement for processing of a RCE with an information disclosure statement (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.

- Q2. What items must a QPIDS submission include? (Posted on 5-11-2012)

(1) A transmittal form that designates the submission as a QPIDS submission, such as form PTO/SB/09.

(2) An IDS, including a timeliness statement as set forth in 37 CFR 1.97(e) and the IDS fee set forth in 37 CFR 1.17(p).

(3) A Web-based ePetition to withdraw from issue under 37 CFR 1.313(c)(2), including the petition fee set forth in 37 CFR 1.17(h).

(4) A RCE, including the RCE fee under 37 CFR 1.17(e).

(5) An authorization to charge all fees associated with the QPIDS submission to a USPTO deposit account.

Q3. A QPIDS submission must include a RCE? (Posted on 5-11-2012)

Yes, a QPIDS submission must include a RCE and the RCE fee under 37 CFR 1.17(e). The RCE will be treated as a “conditional” RCE until the examiner determines whether any item of information in the IDS necessitates reopening prosecution.

Q4. In accordance with MPEP 706.07(h), won't the Office treat a “conditional” RCE as if a RCE had been filed? (Posted on 5-11-2012)

The QPIDS pilot program is an exception to the provision in MPEP 706.07(h), which provides that the Office will treat a “conditional” RCE as if an RCE had been filed. A RCE included as part of a QPIDS submission will be processed and treated as a RCE under 37 CFR 1.114 only if the examiner determines that any item of information contained in the IDS necessitates the reopening of prosecution in the application. If the examiner determines that no item of information in the IDS necessitates reopening prosecution, the RCE will not be processed and the RCE fee will be automatically returned.

Q5. May I file a QPIDS submission via mail, facsimile, or hand-carry? (Posted on 5-11-2012)

No, all papers associated with this pilot program must be filed via the USPTO's Electronic Filing System-Web (EFS-Web).

Q6. May I file a QPIDS submission in a reissue application? (Posted on 5-11-2012)

Yes, a QPIDS submission may be filed in a reissue application.

Q7. May I file a QPIDS submission in a design or plant application, or in a reexamination proceeding? (Posted on 5-11-2012)

No, the QPIDS pilot program does not pertain to design or plant applications or to reexamination proceedings.

Q8. May my QPIDS submission include information that I became aware of prior to paying the issue fee? (Posted on 5-16-2012)

Yes, if you are able to provide one of the timeliness statements set forth in 37 CFR 1.97(e).

Q9. What if I cannot make either of the timeliness statements set forth in 37 CFR 1.97(e)? (Posted on 5-11-2012)

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.

B. Timing for Filing a QPIDS Submission

Q10. What is the start date of the QPIDS pilot program? (Posted on 5-11-2012)

May 16, 2012. Do not file a QPIDS submission before the May 16, 2012 start date.

Q11. What is the end date of the QPIDS pilot program? (Posted on 9-16-2015)

The QPIDS pilot program has been extended to **September 30, 2016**. All compliant requests for consideration of an information disclosure statement under the QPIDS pilot program filed on or before **September 30, 2016**, will be considered.

Q12. At what point during the prosecution of an application may I file a QPIDS submission? (Posted on 2-11-2014)

A QPIDS submission may only be filed after payment of the issue fee and before issuance of the patent. Thus, a QPIDS submission may not be filed on the same date or before the date the issue fee is paid, and a QPIDS submission may not be filed on the same date or after the date the patent issues.

For example, if an applicant paid the issue fee on January 9, 2014, a QPIDS submission filed later on the same date, January 9, 2014, would be an improper QPIDS submission. Participation in the QPIDS pilot program would be premature because 37 CFR 1.97 provides for the filing of an IDS on the same date the issue fee is paid. In this example, it would only be appropriate to file a QPIDS submission on or after January 10, 2014, and prior to the date the patent issues.

Q13. I've received an Issue Notification notifying me that a patent number and issue date have been assigned to my application. May I still file a QPIDS submission? (Posted on 5-11-2012)

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>.

C. Fees

Q14. A QPIDS submission must include a RCE fee? (Posted on 5-11-2012)

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.

Q15. A QPIDS submission must include an IDS fee? (Posted on 5-11-2012)

Yes, a QPIDS submission must include the IDS fee under 37 CFR 1.17(p). If the examiner determines that any item of information contained in the IDS necessitates the reopening of prosecution in the application, the IDS fee under 37 CFR 1.17(p) will be automatically returned because the IDS in such an instance would comply with 37 CFR 1.97(b)(4).

Q16. What other fees, besides the RCE fee and the IDS fee, are required with a QPIDS submission? (Posted on 5-11-2012)

Besides the RCE fee under 37 CFR 1.17(e) and the IDS fee under 37 CFR 1.17(p), the only other fee required with a QPIDS submission is the petition fee under 37 CFR 1.17(h) for a petition to withdraw an application from issue under 37 CFR 1.313.

Q17. 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? What if the examiner determines that any item of information contained in the IDS necessitates the reopening of prosecution in the application? (Posted on 5-11-2012)

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.

Q18. Must I have an established USPTO deposit account to participate in the QPIDS pilot program? (Posted on 5-11-2012)

Yes. All fees required under the QPIDS pilot program must be paid by authorization to charge a USPTO deposit account. Information on USPTO deposit accounts is available at http://www.uspto.gov/about/offices/cfo/finance/Dep_Account_Rules_and_Info.jsp.

Q19. What is the amount of the RCE fee under 37 CFR 1.17(e), the IDS fee under 37 CFR 1.17(p), and the petition fee under 37 CFR 1.17(h)? (Posted on 5-11-2012)

For a complete list of current USPTO fee amounts, including the RCE fee under 37 CFR 1.17(e), the IDS fee under 37 CFR 1.17(p), and the petition fee under 37 CFR 1.17(h), please visit www.uspto.gov/curr_fees.

D. Content of a QPIDS Submission

Q20. When and where can the QPIDS transmittal form (PTO/SB/09) be obtained? (Posted on 9-16-2015)

Form PTO/SB/09 will be available at <http://www.uspto.gov/forms/index.jsp> during the term of the QPIDS pilot program, *i.e.*, from May 16, 2012, until September 30, 2016.

Q21. Is it an absolute requirement to include form PTO/SB/09 with a QPIDS submission? (Posted on 2-11-2014)

No, but it is highly recommended, and if form PTO/SB/09 is not included with a QPIDS submission, a separate transmittal form that designates the submission as a QPIDS submission must be included. Having a transmittal form that is separate from other papers being submitted with the QPIDS submission is required to ensure proper processing of the submission.

Using the PTO/SB/09 form as the required separate transmittal form is the best way to ensure that the Office quickly identifies and timely processes a QPIDS submission. In addition, by providing the appropriate timeliness statements for selection by applicant and the authorization to charge a deposit account for payment of the IDS fee, the PTO/SB/09 form helps ensure that important requirements of the QPIDS pilot program are not overlooked.

Q22. May a QPIDS submission contain an amendment? (Posted on 5-11-2012)

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

Q23. May a QPIDS submission contain a statement under 37 CFR 1.704(d)? (Posted on 5-11-2012)

Yes, when applicable, applicants are encouraged to include a statement under 37 CFR 1.704(d) so as to avoid a reduction in patent term adjustment pursuant to 37 CFR 1.704(c)(10).

E. Action after QPIDS Submission

Q24. How do I learn whether the examiner determined that my QPIDS submission does not necessitate reopening prosecution? (Posted on 5-11-2012)

The Office will issue a corrected notice of allowability (form PTOL-37), which will identify the IDS and be accompanied by a copy of the submitted IDS listing (*e.g.*, form PTO/SB/08) as considered by the examiner. Considered information will be printed on the patent pursuant to MPEP 609.06. A new Notice of Allowance and Fee(s) Due (*i.e.*, PTOL-85) will not be issued.

Q25. Do I need to respond to the corrected notice of allowability? (Posted on 5-11-2012)

No applicant response to the corrected notice of allowability is necessary.

Q26. Do I need to request return of the RCE fee if prosecution is not reopened? (Posted on 6-30-2015)

In most cases, no. The RCE fee should be automatically returned by the Office, if the examiner determines that no item of information in the IDS necessitates reopening prosecution. However, if more than three (3) months have passed from the date the corrected notice of allowability (form PTOL-37) was mailed, and applicant has yet to have their RCE fee returned, applicant may file a written request for return of the RCE fee.

Q27. How do I learn whether the examiner determined that my QPIDS submission necessitated reopening prosecution? (Posted on 5-11-2012)

The Office will issue a form PTO-2300, which is titled "Notification Of Reopening Of Prosecution Due To Consideration Of An Information Disclosure Statement Filed After Mailing Of A Notice Of Allowance."

Q28. What happens after I receive a form PTO-2300? (Posted on 5-11-2012)

The Office issues an Office action in due course after issuance of a form PTO-2300.

Q29. Do I need to request return of the IDS fee if prosecution is reopened? (Posted on 6-30-2015)

In most cases, no. The IDS fee should be automatically returned by the Office, if the examiner determines that any item of information in the IDS necessitates reopening prosecution. However, if more than three (3) months have passed from the date the form PTO-2300 was mailed, and applicant has yet to have their IDS fee returned, applicant may file a written request for return of the IDS fee.

Q30. If prosecution is reopened, may I request return of the issue fee? (Posted on 5-11-2012)

No. If, however, the application is subsequently again found allowable, upon receipt of a new Notice of Allowance and Issue Fee Due, the previously submitted issue fee may be reapplied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due.

Q31. If I filed a QPIDS submission in an application, can I file a second or subsequent QPIDS submission in the same application? (Posted on 5-16-2013)

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.

Q32. If I filed a QPIDS submission in an application, can I make an IDS submission in accordance with 37 CFR 1.97 in the same application before the examiner considers the QPIDS submission? (Posted on 2-11-2014)

No. Only if the Office issues a form PTO-2300 in response to the QPIDS submission, indicating that the examiner reopened prosecution, may applicant make an IDS submission in accordance with 37 CFR 1.97. If the Office issues a corrected notice of allowability (form PTOL-37) indicating that the examiner considered the 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 (37 CFR 1.97 is not applicable). Likewise, 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 (37 CFR 1.97 is not applicable).

F. Patent Term Adjustment (PTA) Implications

Q33. Will the submission of a "conditional" RCE be deemed as time consumed by continued examination of the application requested by the applicant under 35 U.S.C. 132(b) within the meaning of 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.703(a)(b)(1) and, accordingly, not be included within the 35 USC 154(b)(1) "B" period? (Posted on 5-11-2012)

No, the filing of a "conditional" RCE will not be considered as time consumed by continued examination, unless the examiner determines that an item of information in the IDS necessitates reopening prosecution, and the "conditional" RCE is processed and treated as a RCE under 37 CFR 1.114. Accordingly, the period of time beginning on the date of filing of the "conditional" RCE to the ending date of patent issuance may be included in the 35 USC 154(b)(1)(B) period, assuming the application does not contain a previously filed RCE. If the examiner determines that an item of information in the IDS necessitates reopening prosecution, then the submission will be deemed an RCE and the 35 USC 154(b)(1)(B) period would not include the period beginning on the filing of the RCE and ending on the date of issuance of the patent, assuming that 35 USC 154(b)(1)(B) period had not already ended by the previous filing of an RCE.

Q34. Will the filing of an IDS along with the "conditional" RCE be considered an applicant delay under 37 CFR 1.704(c)(10)? (Posted on 5-11-2012)

If the examiner determines that the IDS submission does not include any item of information necessitating reopening prosecution, the submission of the IDS will be deemed an applicant delay under 37 CFR 1.704(c)(10). If the examiner determines that the IDS submission does

include an item of information necessitating reopening prosecution, the IDS submission will not be considered filed after allowance since the filing of an RCE withdraws the application from allowance. See MPEP 706.07(h)(IX). Since the RCE and IDS are submitted concurrently, the Office would also not consider the submission of the IDS to be a reduction under 37 CFR 1.704(c)(8). Thus, if the concurrent IDS includes an item of information that requires reopening prosecution, no applicant delay under 37 CFR 1.704(c)(10) would result from the submission of the RCE and IDS.