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A Review of USPTO Pilot Programs

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Discussion

1. Fast-Track Appeals Pilot Program
2. Collaborative Search Pilot
3. Patents 4 Patients
4. COVID-19 Prioritized Examination Pilot Program
5. Patents for Humanity

Fast-Track Appeals Pilot Program

- Under the Fast-Track Appeals Pilot Program, appellants can have their ex parte appeals advanced out of turn by filing a petition to the Chief Judge under 37 CFR 41.3 and submitting a fee of $420 under 37 CFR 41.20(a).
- Appellants who have filed an ex parte appeal and received a notice that the appeal has been docketed may file a petition, accompanied by the petition fee, to expedite the review of the appeal.
- Target of reaching a decision on the ex parte appeal within six months from the date an appeal is entered into the Pilot Program (vs. average of 13 months for appeal cases not under fast-track review).

Fast-Track Appeals Pilot Program

- Start Date: July 2, 2020.
- Offered on a temporary basis, and petitions to request inclusion of an ex parte appeal in the Pilot Program will be accepted until 500 appeals (i.e., 125/quarter) have been accorded fast-track status under the program, or until July 2, 2021.
- Petitions received this quarter (Q4, starting 4/1/21): 3
- Average time to decide petition: 1.4 days
- Available slots this quarter: 122.
- Average time to decision on appeal: **2.2 months**.

Fast-Track Appeals Pilot Program

- The PTAB may exercise discretion to grant a small number of petitions above the 125-petition limit (per quarter). Should a significant number of petitions exceeding the limit be filed in a quarter, such petitions will be held in abeyance and decided, in order of receipt, in a subsequent quarter.
- Hearings in ex parte appeals accorded fast-track status will be conducted according to ordinary PTAB hearing procedures.
- An appellant who does not wish to attend the hearing at the designated place, date, and time may waive the hearing. An appellant may not reschedule a hearing and remain in the pilot program.

Fast-Track Appeals Pilot Program

- How to File?
  - File a petition under 37 C.F.R 41.3 through the USPTO's electronic filing system (EFS-Web or PTAB Center), identifying that application and appeal by application number and appeal number, respectively.
  - The appellant may use the form-fillable Portable Document Format (PDF) "PETITION—Fast-Track Appeals Pilot Program" (Form PTO/SB/451). The appellant must accompany the petition with the fee of $420.
  - The Appeal must not be currently treated as special under MPEP 708.01 (e.g., age or health of inventor).

Fast-Track Appeals Pilot Program

PTO/SB/451

Doc Code: PET. 41.3
Document Description: **Petition under Rule 41.3 to Chief Admin Patent Judge** PTO/SB/451 (07-20)

PETITION
Fast-Track Appeals Pilot Program

PART I. IDENTIFICATION OF THE APPEAL TO ACCORD FAST-TRACK STATUS

Appeal No.:		Application Number:	
First Named Inventor:		Filing Date:	
Title of Invention:			

PART II. CERTIFICATIONS: Appellant hereby certifies the following and petitions to participate in the Fast-Track Appeals Pilot Program for the above-identified appeal.

1. Appellant files this certification and petition under 37 CFR 41.3 to include the appeal in the application identified in Part I (above) in the Fast-Track Appeals Pilot Program.

2. The above-identified appeal is pending before the Patent Trial and Appeal Board (PTAB) and a docketing notice has been issued.

3. The petition fee for filing a petition under 37 CFR 41.3 accompanies this petition.

4. The above-identified appeal is currently not treated as special under MPEP 708.01 (e.g., age or health of the inventor).

5. The registered practitioner submitting this certification and petition has a power of attorney (37 CFR 1.32), or has authority to act (37 CFR 1.34), for the above-identified application, or the appellant is prosecuting the appellant's own case (37 CFR 1.31).

PART III. ORAL HEARING: For informational purposes, please indicate whether Appellant has filed a compliant Request for Oral Hearing per 37 CFR 41.47 for the above-identified appeal:

Yes ☐ No ☐

☐ If yes, Appellant hereby waives the Oral Hearing. (Appellant is not required to waive an Oral Hearing to participate in the Fast-Track Patent Appeal Pilot.)

Signature	Date
Name (Print/Typed)	Practitioner Registration Number

***Note**: This form must be signed in accordance with 37 CFR 1.33 and consistent with Certification 5 above. See 37 CFR 1.4(d) for signature requirements and certifications.*
*Submit multiple forms if more than one signature is required.**
*Total of _____forms are submitted.

Fast-Track Appeals Pilot Program

- Limits:
  - No refund if petition for inclusion in the Fast-Track Appeals Program was denied.
  - Fee not discounted for small and micro entities.
  - Quarterly limit of 125 granted petitions.
  - If the appeal has been granted fast-track review, and the client wishes to file an RCE, the case will no longer remain expedited (will no longer be in the program, thus will no longer have fast-track status).

Fast-Track Appeals Pilot Program

Fast-track status ends when:

(1) the Director or the PTAB enters a remand order;

(2) the PTAB enters a final decision, and judicial review is sought or the time for seeking judicial review has expired;

(3) an express abandonment is filed and recognized by the USPTO;

(4) a RCE is filed;

(5) the PTAB enters an order of dismissal; or

(6) the appellant reopens prosecution, including in response to a new ground of rejection entered in a decision of the PTAB.

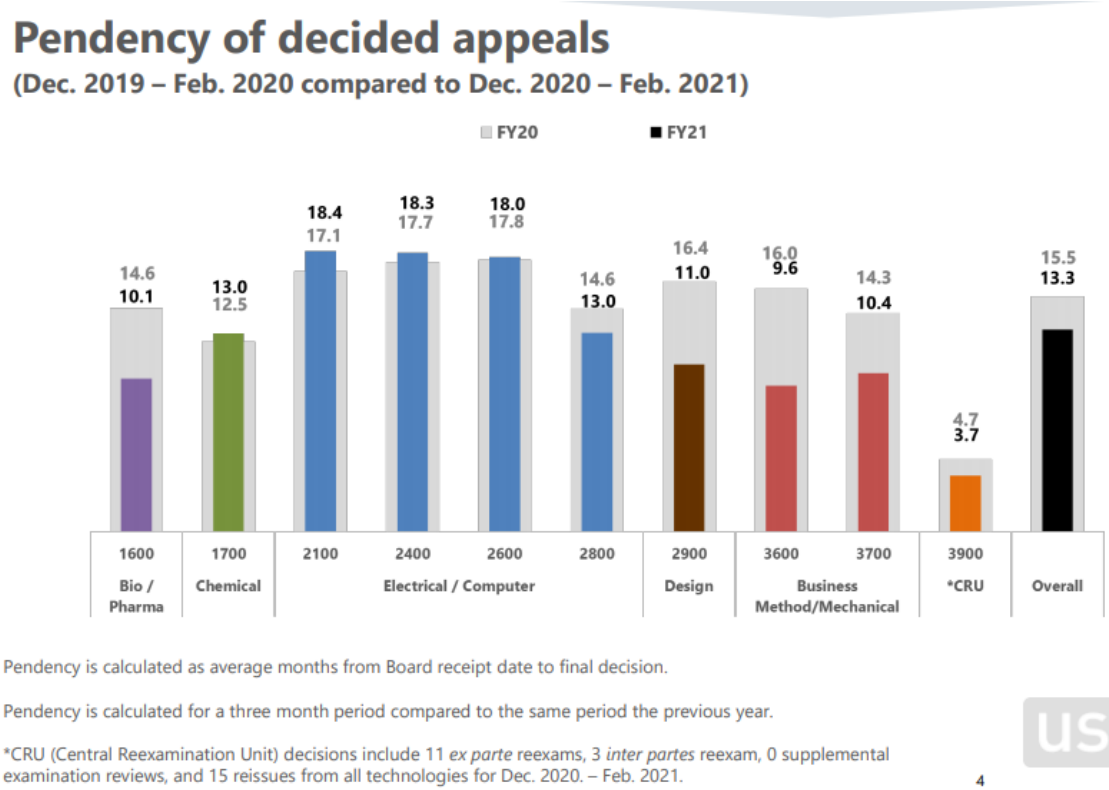
Fast-Track Appeals Pilot Program

Hearings

- Oral hearings may be requested. May not request to reschedule an oral hearing and remain in the program.
- An appellant who does not wish to attend the scheduled hearing at the designated place may request to attend the hearing by video or telephone, in accordance with current PTAB hearing procedures.
- May also waive the hearing and continue in the program.
- If opts out of the program by rescheduling the place, date, or time of the appeal, the appellant will not be entitled to a refund of the petition fee.

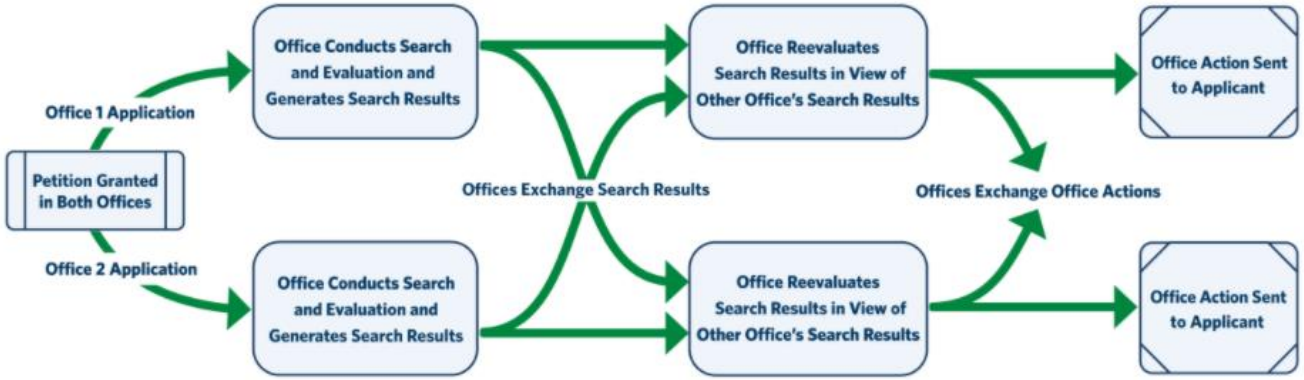
Fast-Track Appeals Pilot Program

- USPTO Contact
  - PTAB 571-272-9797
  - fasttrackappeals@uspto.gov



Collaborative Search Pilot

- Provides applicants who cross-file their patent applications internationally with search results from multiple offices early in the examination process.
- Accelerates examination and provides the applicant with more comprehensive prior art by combining the search expertise of examiners at the USPTO and the Japan Patent Office (**JPO**) or the Korean Intellectual Property Office (**KIPO**) before issuing a first OA.



Collaborative Search Pilot

Benefits include:

- Free to file and leads to greater consistency in examination across offices and to more certainty of IP rights.
- Applications will be taken out of turn resulting in expedited first action on merits.
- Combined search expertise provides more comprehensive prior art.
- Collaborative examination requires fewer office actions to complete prosecution (on average, compared to non-CSP applications).

Collaborative Search Pilot

Eligibility

- The U.S. application must be a non-reissue, non-provisional utility application or an international application that has entered the national stage.
- Plant applications are also eligible if KIPO is the designated partner IP office.
- The U.S. application and all corresponding counterpart applications must have a common earliest priority date.
- The U.S. application must contain 3 or fewer independent claims and 20 or fewer total claims directed to a single invention. The U.S. application must not contain any multiple dependent claims.

Collaborative Search Pilot

Eligibility

- The petition submission must include a claims correspondence table, which at a minimum must establish "substantial corresponding scope" between all *independent claims* present in the U.S. application and the corresponding counterpart application(s) filed in the designated partner IP office(s).
- The claims correspondence table must individually list the claims of the instant U.S. application, and correlate them to the claims of the corresponding counterpart application having a substantially corresponding scope.

Collaborative Search Pilot

PART V – CLAIMS CORRESPONDENCE TABLE (each independent claim must have correspondence with the independent claims of the identified corresponding counterpart application(s)). Corresponding dependent claims should also be listed. List each corresponding claim in the US application separately and check the box for any independent claims.

Claims in U.S. application (check if Independent)	Corresponding Application No.	Claims in Corresponding Application	Claims in U.S. application (check if Independent)	Corresponding Application No.	Claims in Corresponding Application
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Explanation Regarding the Correspondence:

Collaborative Search Pilot

Eligibility

- Claims are considered to have a "substantially corresponding scope" where, after accounting for differences due to claim format requirements, the scope of the corresponding claims in the corresponding counterpart application(s) would either anticipate or render obvious the subject matter recited under U.S. law.
- Applicants may file a preliminary amendment in compliance with 37 CFR 1.121 to amend or cancel claims to satisfy this requirement.
- Non-corresponding claims need not be listed.

Collaborative Search Pilot

Eligibility

- An English translation of the foreign claims is required if the application in the designated partner IP office is not publicly available in English. A machine translation is sufficient. Use doc code CLM.CSP for any claim documents submitted to satisfy this requirement. Do not use doc code CLM for these translated claim sets.
- There must be a remaining slot in the program. Each IP office will grant no more than 400 requests per year per partner office. As of **March 23, 2021**, greater than 75% of the slots are available for both JPO and KIPO.

Collaborative Search Pilot

Eligibility

- Petitions are required in both offices before examination has commenced.
- The petition and any request in a designated partner IP office must be filed within fifteen days of each other, if not, applicant runs the risk of one of the pending applications being acted upon before entry into the pilot program, which will result in the applications being denied.
  - Examination must not have commenced in the identified corresponding counterpart application(s) before each designated partner IP office when filing the petition in the U.S. application.

Collaborative Search Pilot

Eligibility

- Applicant cannot request a refund of the search fee and any excess claims fee paid in the application after the mailing or notification of the decision on the petition to join Expanded CSP.
- Applicant will make an election without traverse (express or constructive) if the Office determines that the claims are not directed to a single invention.
- All submissions for the participating application must be filed via EFS-Web.

Collaborative Search Pilot

- Applicant must certify they are providing express written consent under 35 U.S.C. 122(c) and authorizes the USPTO to forward to and receive from the identified partner IP office prior art references and comments to be considered during the examination of the above identified application participating in the Expanded CSP program (part of the form).
- Applicant must also authorize the USPTO to provide the identified partner IP offices access to the participating U.S. application's bibliographic data and search results in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c). No other consents are provided.
- Must identify all corresponding foreign and U.S. applications having the same priority/filing date.

Collaborative Search Pilot

Resources

- US CSP Petition Form
- US-JP Collaborative Search Pilot Program | Japan Patent Office (jpo.go.jp)
- KIPO Collaborative Search Program

Collaborative Search Pilot

Initial CSP Pilot Stats (2015-2017)

	JPO	KIPO	Total/AVG
Applications with Petitions	72	112	184
Granted Petitions	67	89	156
Completed Applications	30	47	77
Allowance Rate*	97%	91%	94%
Average Pendency to FA (from Petition Grant)*	92 days	60 days	72 days
Average Pendency to Final Disposal (from petition grant)*	236 days	319 days	287 days

* Completed applications

- Allowances occur on average of 8-9 months.

Patents 4 Patients

- The USPTO established Patents 4 Patients, also known as the Cancer Immunotherapy Pilot Program.
  - First implemented June 29, 2016.
- Provides a fast-track review for cancer immunotherapy-related patent applications without the need for applicant to pay a petition fee.
- Aims to cut the time it takes to review patent applications pertaining to cancer immunotherapy in half by issuing final decisions in one year or less after they are received.
- The USPTO has extended Patents 4 Patients until June 30, 2022.

Patents 4 Patients

Requirements

- Applications must contain one or more claims to a method of treating a cancer using immunotherapy.
- Must attest there is a claimed method of treating a cancer using immunotherapy.
- No more than three (3) independent claims and twenty (20) total claims.
- Does not contain any multiple dependent claims.
- Applicants must file a grantable petition under this initiative using the USPTO patent electronic filing system (EFS-Web).

Patents 4 Patients

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).
- 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.
- Must agree to make an election without traverse in a telephonic interview and elect an invention that is directed to a method of treating a cancer using immunotherapy.

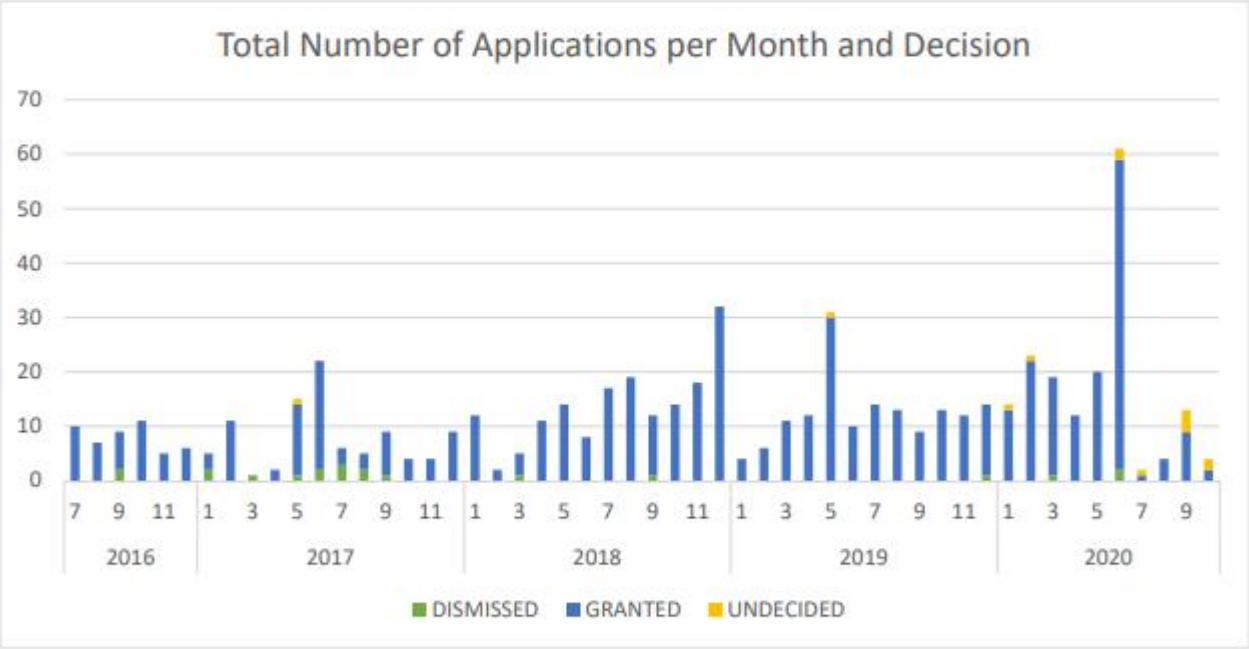
Patents 4 Patients

Progress Report (10/20/2020)

Total Number of Submissions: 626

***Undecided are applications still in Pre-exam**

Submissions by Month and Decision:



Total Submission Decision: 593 Granted, 20 Dismissed

Patents 4 Patients

As of **October 20, 2020**:

- Avg. Days from Petition Grant to FAOM: 30 days.
- Granted Applications Current Status (Considered closed by Final Rejection, NOA or Abandonment):
  - Closed/Issued: 483
    - 69% Issued, 18% Closed
  - Pending: 110 (13%)
- Petition Form

COVID-19 Prioritized Examination Pilot Program

- Prioritized examination of up to 500 qualifying patent applications without requiring payment of any fees.
- The USPTO aims to provide final disposition of patent applications in the pilot in one year or less after it grants prioritized status.
- Went into effect July 13, 2020.
- Applications granted prioritized examination status for this pilot as of April 13, 2021:
  - 591 filed / 353 granted / **147 available**

COVID-19 Prioritized Examination Pilot Program

Eligibility

- Claim(s) must be directed to any process, machine, manufacture, or composition of matter relating to COVID-19 and such product or process is subject to an applicable FDA approval for COVID-19 use.
  - May not contain (or be amended to contain) more than four independent claims, more than thirty total claims, or any multiple dependent claims.
- U.S. FDA approvals may include, but are not limited to, an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA). www.fda.gov.

COVID-19 Prioritized Examination Pilot Program

Eligibility

- Applicant must qualify for small entity (37 CFR 1.27) or micro entity (37 CFR 1.29) status.
- If the application contains a benefit claim under 35 U.S.C. 120, 121, or 365(c), it is to only one prior nonprovisional U.S. application or international application designating the United States.
- Must be filed before a first Office Action, and may be filed after the filing of an RCE.
  - Include utility and plant application (nonprovisional)

COVID-19 Prioritized Examination Pilot Program

FAQ

- Why does the program include RCEs?
  - Some inventions that are useful in treating COVID-19 patients were invented prior to the known cases of COVID-19 in humans.
- Cannot withdraw the application from the program.
  - But will be terminated if applicant files an extension of time or Applicant abandons the application.
- If terminated, the application is removed from the Examiner's special docket.

COVID-19 Prioritized Examination Pilot Program

Resources

- Federal Register 2020-10372.pdf (govinfo.gov)
- Certification and Request for COVID-19 Prioritized Examination Pilot Program under 37 CFR 1.102(e) (uspto.gov) (PTO/SB/450)

Patents for Humanity

- Awards competition recognizing innovators who use game-changing technology to meet global humanitarian challenges.
- Winners receive an acceleration certificate to expedite select proceedings at the USPTO, as well as public recognition of their work.
- Submissions are evaluated on the effectiveness of their technology to address humanitarian issues, the contributions made by applicants to increase use of their technology among the impoverished, and the impact those contributions have made to improve lives. The program is open to all types of patent holders, applicants, and licensees.

Patents for Humanity

- Application must have less than four independent claims and thirty total claims, and must not contain any multiple dependent claims.
- Applications will be kept on file for three cycles (one cycle = one year).
- Usually a short application period (October – January) or until 300 application are received.
- Patents for Humanity Acceleration Certificates may be transferred, including by sale, to other parties.

Patents for Humanity

- The competition is open to any patent owners, patent applicants, or patent licensees. Applicants may team together to submit a single joint application as long as at least one applicant meets the eligibility criteria.
  - Joint applications must designate a single applicant for any acceleration certificate awarded.
- Application period has opened on April 5, 2021 specifically for the new category of COVID-19.
- Closing date has not yet been announced.
- Apply through particular website - Link to apply.

Patents for Humanity

- Can be redeemed to accelerate one of the following matters: an ex parte reexamination proceeding, including one appeal to the Patent Trial and Appeal Board (PTAB) from that proceeding; a patent application, including one appeal to the PTAB from that application;
- or an appeal to the PTAB of a claim twice rejected in a patent application or reissue application or finally rejected in an ex parte reexamination, without accelerating the underlying matter that generated the appeal.
  - Inter partes reviews and post-grant reviews are not eligible for acceleration, nor are covered business method reviews, derivation proceedings, supplemental examinations, inter partes reexaminations, or interference proceedings.

Patents for Humanity

- The application consists of a core section and supplements.
- The core section will address how the applicant meets the defined competition criteria within a strict 7,000-character limit.
- Applicants may supplement the core section with any supporting material they wish to provide, such as project brochures, adoption data, case studies, published articles, or third party testimonials.
- Judges will review the materials and score the applications.

Patents for Humanity

- Top-scoring applications will be forwarded to reviewers from participating Federal agencies to recommend award recipients.
- Final decisions are made at the discretion of the Director of the USPTO.
- Program goal is to complete the recommendation process within 90 days of the close of the application period.
- Once awarded, there will be a public award ceremony.
  - May be good marketing for our clients.

Patents for Humanity

- Examples
  - Nokero (no kerosene) – low-cost solar light for the developing world.

Nokero[1]

Golden Rice[2]

  - Golden rice – vitamin A enriched rice that prevents blindness and death. (vitamin A deficiency is the leading killer of children globally, 2-3 million annually and the leading cause of childhood blindness, 500k annually).

1. http://www.nokero.com/
2. https://www.flickr.com/photos/ricephotos/5516789000/in/set-72157626241604366

Patents for Humanity

Categories

- Medicine
  - any medical-related technology such as medicines, vaccines, diagnostics, or medical devices.
- Nutrition
  - technologies which improve nutrition such as higher yield crops, more nutritious food sources, food preservation, storage, or preparation.
- Sanitation
  - improving lives by addressing environmental factors such as clean water, waste treatment, air pollution, and toxic substances.

Patents for Humanity

Categories

- Household energy
  - technologies providing power to energy-poor homes and communities for household needs like lighting, cooking, and heating.
- Living standards
  - technologies that raise living standards to empower people to escape poverty, such as literacy, education, communications, information delivery, access to markets, and microfinance.
- No preset limit on the number of awards that can be given.

Questions?

- Thanks!