



Training Academy Session #1

# Handy Tips and Tricks for U.S. Patent Prosecution

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# 1. Fast Track Appeals Pilot Program

- Started on July 2, 2020, and has been extended to run through July 2, 2022 (*85 Fed. Reg. 39,888 (July 2, 2020)*; extension *86 Fed. Reg. 36,530 (July 12, 2021)*)
- What is it?
  - *Ex parte* appeals can be advanced out of turn
  - Patent Trial and Appeal Board (“PTAB”) targets issuing a decision within 6 months of the petition being granted (average appeal pendency was about 15 months)
- Eligibility Requirements:
  - For original utility, design, or plant nonprovisional applications
  - Notice of Appeal filed and PTAB docketing notice has issued
  - Appeal not currently treated as special under MPEP § 708.01
    - (reissues, reexams, age or health, other pilot programs)
  - Must file a Petition (should have a decision within a month)
    - Form PTO/SB/451
  - Must pay a \$420 fee with the Petition (no discounts)

# 1. Fast Track Appeals Pilot Program

- Can still have an oral hearing, but:
  - may not seek to relocate the hearing
  - may not reschedule the hearing and remain in the Program (no refund if you must opt out)
- The PTO has decided over “162 fast-track appeals with an average decision time of about 2 months from the date the petition for fast-track review was granted, and about 6 months from the date the PTAB received the appeal. Thus, the overall decision time is at least 50% faster than the average appeal time.”
- Limited to 125 granted petitions per quarter
  - Can find the number of available slots here:  
<https://www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program>

# 2. Accelerating Examination

- Several ways to speed up prosecution
  1. Petitions to Make Special
  2. Patent Prosecution Highway (“PPH”)
  3. Accelerated Examination
  4. Prioritize Examination

# 2. Accelerating Examination

- **1. Petitions to Make Special**
  - (1) age or health; (2) invention materially enhances the quality of the environment or contributes to the development or conservation of energy resources; (3) contributes to countering terrorism *M.P.E.P. § 708.01; 37 C.F.R. § 1.102(c)*
  - **(1) Age or Health** (no fee)
    - Age – 65 years of age or older
    - Health – such that an inventor may not be available to assist during prosecution via the normal course
    - **Practice tip:** applies if even one inventor satisfies the age and/or health requirements
  - Evidence: medical records, birth certificates, driver's license, statement from practitioner, etc. (note: will become public)
  - Application is advanced out of turn for the first Office Action (~ 6 months)

# 2. Accelerating Examination

- **1. Petitions to Make Special**
  - **(2) Environment and Conservation of Energy**
    - **Environment:** restoration or maintenance of basic, life-sustaining natural elements (air, water, soil); no fee
    - **Energy:** discovery or development of energy resources (fossil fuels, hydrogen fuel technology, nuclear energy, solar energy, etc.), more efficient utilization and conservation of energy resources (reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc.); no fee

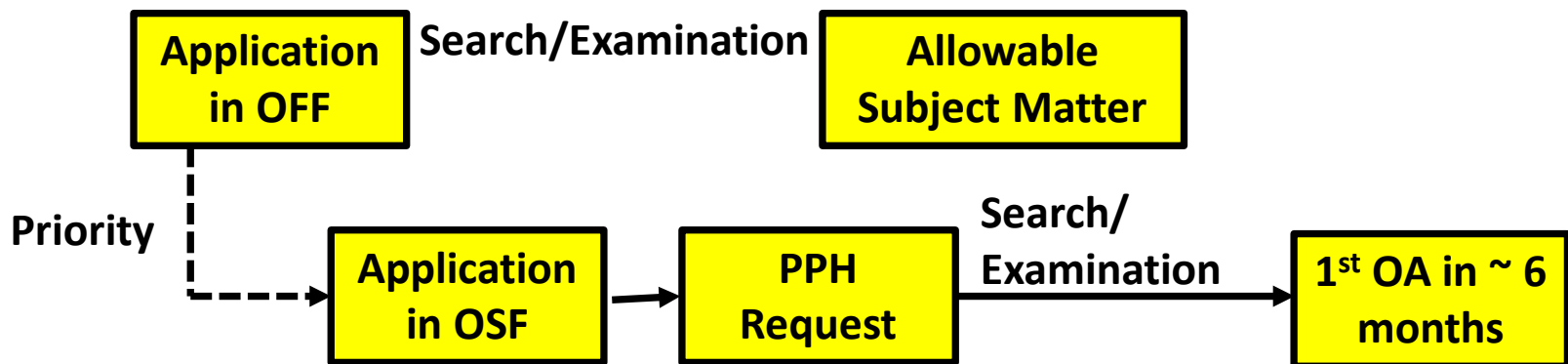
# 2. Accelerating Examination

- **1. Petitions to Make Special**
  - **(3) Countering Terrorism**
    - Defined in 18 U.S.C. § 2331: activities that involve violent acts or acts dangerous to human life, acts intended to intimidate or coerce a civilian population or policy of government, affect the conduct of a government by assassination or kidnapping
    - Examples include detecting/identifying explosives, aircraft sensors/security systems, vehicular barricades/disabling systems
    - No fee



# 2. Accelerating Examination

- 2. Patent Prosecution Highway (“PPH”)
  - At least one claim allowed in office of first filing (OFF) or at international stage
  - Fast tracks issuance of 1<sup>st</sup> Office Action
    - ~ 2-3 months for decision on petition + ~2-3 months for 1<sup>st</sup> Office Action
  - Substantive examination has not started
  - Qualifying relationship



# 2. Accelerating Examination

- 2. Patent Prosecution Highway (“PPH”)
  - Pending claims “sufficiently correspond” to the claims in the OFF/PCT application
  - Form PTO/SB/20GLBL
    - **Practice Tip:** Work with client on claims correspondence table
  - Submit:
    - Copies of all relied-upon work product (office actions)
    - IDS including these documents and any cited references
    - Claims correspondence table
  - One chance to fix any deficiencies
    - Usually in claim correspondence requirement
  - No fee
  - ***Doubles chances of first action allowance at USPTO:***
    - Non-PPH applications – 13%
    - PPH applications – 28%

# 2. Accelerating Examination

- **3. Accelerated Examination**
  - Goal is 12 months to final disposition
  - Eligibility:
    - Utility or Design (no 371 applications)
    - $\leq 20$  claims total and  $\leq 3$  independent claims
    - Single invention
  - \$140 petition fee
  - Pre-examination search
  - Examination support document
    - Detailed explanation of patentability
    - Concise statement of utility
    - Support for each claim limitation
  - Costly, time consuming and could lead to estoppel

# 2. Accelerating Examination

- 4. Prioritized Examination (“Track One”)
  - Goal is 12 months to final disposition
  - 1st Office Action within 4 months of filing
  - Eligibility:
    - Utility and plant (no U.S. national stage applications)
    - $\leq 30$  claims total and  $\leq 4$  independent claims
    - For a U.S. national stage application, can be filed with 1<sup>st</sup> RCE
  - \$4,200 fee + \$140 processing fee
    - Small entity: \$2,100 fee + \$70 processing fee
    - Micro entity: \$1,050 fee + \$35 processing fee
  - Form PTO/AIA/424
  - **Practice Tip:** Do not file extension of time and do not amend claims outside of limits
  - See slide 34 for pendency data

# 3. COVID-19 Initiatives

- Link to PTO Notices regarding COVID-19:  
<https://www.uspto.gov/coronavirus>
- **COVID-19 Prioritized Examination Pilot Program**
  - Announced on May 14, 2020 (*85 Fed. Reg. 28,932 (May 14, 2020)*)
  - Currently extended through March 31, 2022 (*86 Fed. Reg. 74,406 (Dec. 31, 2021)*)
  - Request must be made:
    - (1) with the filing of a non-continuing original utility or plant nonprovisional application
    - (2) with the filing of an original utility or plant nonprovisional claiming benefit under 35 U.S.C. §§ 120, 121, or 365(c) of one prior nonprovisional or one prior international application designating the U.S.
    - (3) with or after the filing of an RCE
  - Form PTO/SB/450

# 3. COVID-19 Initiatives

- COVID-19 Prioritized Examination Pilot Program
  - ***Only for small and micro entity status applicants***
  - Can request prioritized examination under this program if:
    - (1) ***at least one of the pending claims*** covers a product or process related to COVID-19; and
    - (2) the product or process is subject to FDA approval for COVID-19 use; and
    - (3) application includes an executed Application Data Sheet
  - ***Will lose prioritized status if:***
    - Extension of time filed
    - Amendment made results in more than 4 independent claims, 30 total claims, or multiple dependent claim
    - Final Office Action issues
    - Notice of Appeal filed

# 3. COVID-19 Initiatives

- **COVID-19 Prioritized Examination Pilot Program**
  - As of November 29, 2021, 180 patents had issued under the program
  - PTO's goal was completed examination (notice of allowance, Final Office Action, RCE, abandonment, Notice of Appeal) within 12 months of special status being granted
  - Average total pendency, from filing date to issuance, was 276 days (shortest pendency was 75 days)

# 3. COVID-19 Initiatives

- **COVID fast-track appeals pilot program**
  - No cost
  - Need to file a Petition under 37 C.F.R. § 41.3 (Form PTO/SB/454)
  - For original utility, design, or plant non-provisional application
  - “must relate to a product or process that is subject to an applicable U.S. Food and Drug Administration(FDA) approval for COVID-19 use.”
    - Includes INDs, IDEs, NDAs, BLAs, PMAs, and EUAs
  - Limited to 500 granted Petitions (only 1 received so far)
  - Goal of issuing decisions within 6 months of entry into the program
  - Hearing expedited and once scheduled cannot be rescheduled or relocated



# 4. Sequence Listing Updates

- Final rule announced on October 14, 2021 (*86 Fed. Reg. 57,035 (Oct. 14, 2021)*) [no comments were received on the proposed rule changes]
- **“the rules of practice no longer permit an applicant to rely on a previously submitted computer readable form (CRF) of required sequence information.”** *Id. at 57,036.*
- Addresses large sequence listings that exceed the capacity of EFS
- PTO revised the rules to permit DVD-R or RVD+R as an alternative to compact discs for cases where the data exceed EFS limits
- If the sequence listing is filed as an ASCII plain text file either via EFS or on a read-only optical disc, it will serve as both the paper copy required by 37 C.F.R. § 1.821(c) and the CRF required by 37 C.F.R. § 1.821(e)
- An incorporation by reference statement under 37 C.F.R. § 1.77(b)(5) is still needed

# 4. Sequence Listing Updates

- Reminder, if a paper copy is filed, application size fees will have to be paid if the application exceeds 100 sheets of paper
- If a paper copy is filed, still need a statement that the CRF is identical to either the pdf or physical paper version
- **Practice Tip:** Any amendments to the sequence listing must be explained in a response filed with the Office
- WIPO Standard ST.26 had been scheduled to take effect on ~~January~~ July 1, 2022, which will require a sequence listing to be presented as a single file in eXtensible Markup Language (XML), which cannot be on paper or as a pdf
  - “As a result, in an original application filed on or after WIPO Standard ST.26 takes effect . . . The ‘Sequence Listing’ part will not be accepted on physical sheets of paper or as a PDF image file.”

# 5. AFCP2.0

- The program has been extended to September 30, 2022
- Requirements
  - An original utility, plant, or design nonprovisional application filed under 35 U.S.C. § 111(a) (including continuations and divisionals, but no reissues or reexams), or a U.S. national stage application
  - Has an outstanding final rejection
  - Need to file with a response that includes an amendment to at least one independent claim, and the amendment does not broaden the scope of the independent claim in any aspect
  - Can only do one request
  - Must file via EFS and with all necessary fees (no fee for the request)
  - Form PTO/SB/34

# 5. AFCP2.0

- The Examiner will verify the submission is compliant, if it is:
  - Examiner will see if additional search and/or consideration is required and if it can be completed within the time allotted.
    - If too much time is required, the Examiner will issue an Advisory Action
    - If no additional search and/or consideration is needed or it can be completed in the time allotted, the Examiner will:
      - decide if the case is in condition for allowance; or
      - contact the Applicant and request an interview
        - If the Applicant declines the interview or if it cannot be scheduled within 10 calendar days of when the Examiner reaches out, the Examiner will proceed
- **Practice Tip:** Call the Examiner and discuss this option

# 5. AFCP2.0

**Q2. I just received an advisory action for an application in which I filed a 37 CFR 1.116 after final amendment without an AFCP 2.0 request (a “non-pilot after final amendment”). 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.

**Q3. I previously filed a notice of appeal. Can I file an AFCP 2.0 request?**

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.

**Q4. I have not yet received a response to a previously filed non-pilot after final amendment. Can I now file a PTO/SB/434 AFCP 2.0 request form in an effort to transform the 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.

# 6. Pre-Appeal Brief Requests for Review

- Purpose
  - Provide opportunity for review prior to filing of an Appeal Brief
  - Potentially save time and expense associated with preparing a longer and more detailed full Appeal Brief
- Requirements
  - A claim has been twice rejected
  - File Pre-Appeal Brief Request for Review together with Notice of Appeal
  - Include arguments in Pre-Appeal Brief Request for Review (limited to 5 pages)
  - Pay USPTO Notice of Appeal fee (currently \$840 for large entity)

# 6. Pre-Appeal Brief Requests for Review

- Procedure
  - Supervisory examiner designates review panel
    - Includes supervisory examiner, examiner of record, and usually one additional member of the USPTO's staff
  - Applicant does not attend review
  - Review is terminated if applicant files full Appeal Brief, Request for Continued Examination (RCE), or after final amendment
  - Panel reviews application and mails decision

# 6. Pre-Appeal Brief Requests for Review

- Review outcomes
  - Application remains under appeal (60-65%)
    - Appeal Brief is due (extendible) within the greater of 1 month from mailing of review panel decision or remainder of 2-month period from USPTO's receipt of Notice of Appeal
  - Prosecution (examination) is reopened (20-25%)
  - Application is allowed (10-15%)
- When to file a Pre-Appeal Brief Request for Review
  - Examiner of record has made a clear legal error (*e.g.*, sending of a final rejection was improper, an argument of the Applicant was not properly addressed in the final rejection)
  - Examiner of record is unable or unwilling to understand essential aspects of Applicant's argument, and formal review by a supervisory examiner may advance examination



# 7. QPIDS

## (Quick Path Information Disclosure Statement)

- Purpose
  - Provide mechanism for USPTO review of an Information Disclosure Statement (IDS) following payment of the Issue Fee that avoids need to withdraw application from issue and file a Request for Continued Examination (RCE) or a continuing application
- Requirements
  - Available for utility applications (not design or plant applications)
  - Designation as a QPIDS submission
  - IDS with statement that information therein was not cited in a counterpart foreign application or known more than 3 months prior and fee
  - Petition to withdraw application from issue with fee and RCE with fee

# 7. QPIDS

## (Quick Path Information Disclosure Statement)

- Outcomes
  - Examiner determines that no information in the IDS necessitates reopening prosecution
    - Corrected Notice of Allowability is sent
    - RCE fee is refunded
  - Examiner determines that information in the IDS necessitates reopening prosecution
    - RCE is processed and examination continues
    - IDS fee is refunded

# 8. Declarations in RCEs in U.S. National Stage Cases

- Watch out for U.S. national stage cases when filing an RCE
  - Has the Declaration been filed?
  - The provisions of 37 C.F.R. § 1.114 do not apply to “an international application that does not comply with 35 U.S.C. 371”
    - 35 U.S.C. § 371(c)(4) requires an oath or declaration of the inventor
- **Practice Tip:** Make sure the declaration has been filed before attempting to file an RCE in a U.S. national stage case

# 9. Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

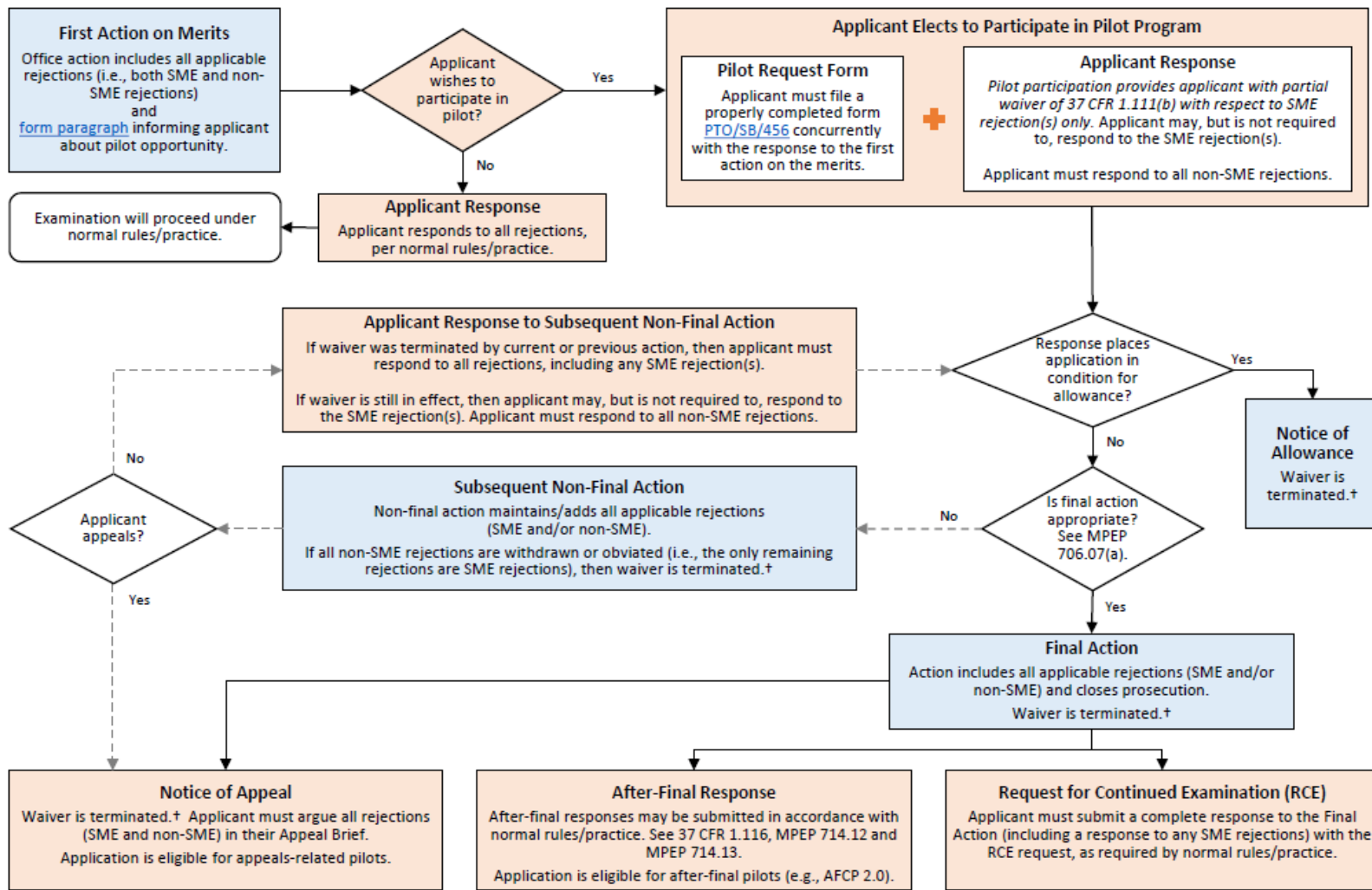
- Participation by invitation only
  - Invitations will mail February 1, 2022, to July 30, 2022
- Requirements
  - Original nonprovisional utility or U.S. national stage application
  - Does not claim the benefit of the earlier date of any prior nonprovisional application
  - Has not been advanced out of turn/no special status
  - First Office Action on the merits makes both subject matter eligibility (“SME”) rejections and non-SME rejections
- Must electronically file a completed form PTO/SB/456 with the response

# 9. Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

- Must still file a response, but
  - Can defer presenting arguments or amendments in response to the SME rejections until the earlier of
    - Final disposition, or
    - The withdrawal or obviation of all other outstanding rejections

# 9. Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

## Typical process flow for DSMER Pilot Program (applicant perspective)



† The waiver is terminated by a “final disposition”, or by the withdrawal or obviation of all other (non-SME) outstanding rejections. See Section III.A. of the pilot program [Notice](#) for more information about “final dispositions” and the waiver. Once the waiver is terminated, examination proceeds under normal rules/practice.

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Solid line (→) indicates typical process flow. Dashed line (- ->) indicates alternative flow that may occur for some applications. Although not shown here, applicant may also choose to abandon the application before or after final action, and to file continuing applications, in accordance with normal rules/practice.

# 10. Examiner Interviews

- Purpose
  - Applicant (or representative) and USPTO Examiner can in real time (in person, by Internet-based video, or by telephone) discuss matters such as an Examiner's rejection or the Applicant's Response
- Requirements and format
  - Generally, an interview is to be scheduled in advance
  - Generally, an Examiner will request a summary of points to be discussed during the interview
  - It is advisable to inform the Examiner in advance of who will be participating in the interview, e.g., Applicant's representative and an inventor
  - Interviews are usually under 60 minutes

# 10. Examiner Interviews

- Timing
  - An examiner interview is often conducted after a 1<sup>st</sup> Office Action has been sent: the Applicant can request clarification of a rejection by and explore potential claim amendments and explanations or arguments with the Examiner prior to filing a Response
  - An examiner interview may be conducted after a final Office Action has been sent
  - An examiner interview may be conducted prior to a 1<sup>st</sup> Office Action having been sent in a continuing application and in special circumstances
- Outcomes
  - Often the Applicant receives guidance for a subsequent Response; however, an Examiner will usually not commit to allow claims based on an envisioned Response



# 11. Pendency Statistics

- How is the PTO doing (as of January 2022)?
  - 668,869 applications pending
  - 17,502 RCEs awaiting an initial action
  - “Average action per disposal” (the average number of examiner actions leading to final disposition) is down to 2.2 from 2.4
  - “First Office Action Pendency” (filing date to the date of first Office Action is mailed) is 17.9 months
  - Total pendency is 23.4 months (28.5 months, when RCEs are included)
  - Pendency of applications which include at least one RCE is 44.5 months
  - RCE to next office action is 2.2 months

# 11. Pendency Statistics

- How is the PTO doing (as of January 2022)?
  - For Track One Cases
    - Average number of months from filing to grant of Petition is 2.2 months
    - Average number of months from petition grant to first Office Action is 1.4 months
    - Average number of months from petition grant to a Final Rejection, Notice of Abandonment, or Notice of Allowance is 4.8 months
  - For Pre-Appeal Brief Requests for Review
    - 60-65% proceed to the PTAB, 20-25% prosecution re-opened, 10-15% allowed

# 12. Ombudsman Program

- “provides assistance to applicants and attorneys throughout the application process including initial filing, patent examination, and post examination. We assist applicants when the normal processing has stalled, helping to get applications back on track.”
- “We also provide assistance on the merits where there is an issue with Case Prosecution Concerns, such as: Claim Objections, After-Final Procedure, Claim Rejections, Restrictions”
- 571-272-5555 or 855-559-8589 (can also do an online form or contact them via email)
- Helpful links
  - <https://www.uspto.gov/patents/ombudsman-program>
  - [https://www.uspto.gov/sites/default/files/documents/PatentsOmbudsman\\_Flyer\\_508Compliant\\_042517.pdf](https://www.uspto.gov/sites/default/files/documents/PatentsOmbudsman_Flyer_508Compliant_042517.pdf)



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