



USPTO PILOT PROGRAMS

UIC Review of Intellectual Property Law - Young Patent Practitioner Series By Sangik Bae

The United States Patent and Trademark Office (USPTO) has designed several pilot programs to advance patent applications and to provide applicants assistance. It is statistically proven that the pilot programs shown below have increased total rates of allowance over a 5-year period from the filing date and decreased total prosecution time compared to applications which do not take advantage of the pilot programs.

FILING	FIRST ACTION	FINAL REJECTION	ALLOWANCE	ISSUE
<p>PRIOR TO EXAMINATION</p> <ul style="list-style-type: none">• Petition to make special• Track One - Prioritized Examination• Patent Prosecution Highway (PPH)• Full First Action Interview Pilot Program	<p>DURING EXAMINATION</p> <ul style="list-style-type: none">• Petition to make special	<p>AFTER CLOSE OF PROSECUTION</p> <ul style="list-style-type: none">• AFCP 2.0• PE-RCE - Prioritized Examination• Pre-Appeal Brief Conference Pilot Program	<p>AFTER PAYMENT OF ISSUE FEE</p> <ul style="list-style-type: none">• Quick Path Information Disclosure Statement (QPIDS)	

A U.S. application may be advanced for examination if a [petition to make the application special](#) is filed under limited conditions generally before the first office action on the merits. If the petition to make special is not available, the applicant may consider using [Track One –Prioritized Examination](#) with a government fee when filing the U.S. application. Before substantive examination of the U.S. application has begun, the [Patent Prosecution highway \(PPH\)](#) can be another avenue to advance the application out of turn for examination. The PPH requires that a corresponding application be filed in a PPH participating patent office and at least one claim be allowed from the PPT participating patent office.

An applicant may use a [Full First Action Interview Pilot Program](#) prior to the first office action on the merits. This early communication with the examiner on the merits may increase the efficiency and quality of patent examination.

After a final office action, applicant may file a response to the final office action with an [After Final Consideration 2.0](#) for the examiner to have additional time for searching and consideration of the response. When filing a Request for Continued Examination (RCE), [Prioritized Examination for a Request for Continued Examination \(PE-RCE\)](#) can be considered as well. The PE-RCE request must be made concurrently with or subsequently to the filing of the RCE, but before the first office action after the filing of the RCE. In addition, if there is a clear error in the rejections or a missing element for a prima facie rejection, applicant may consider [Pre-Appeal Brief Conference Pilot Program](#) before filing an appeal brief to save applicant's time and expense.

Generally, after the issue fee is paid, no Information Disclosure Statement (IDS) will be considered. However, [Quick Path Information Disclosure Statement \(QPIDS\)](#) program permits an IDS to be considered between the issue fee payment and the patent issuance.

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- **Advancement of examination**

- o **Summary:** Generally, it takes more than 1 year for a utility patent application to receive a first office action and almost 2 years to receive a patent grant or abandonment. However, applicants may advance examination of their applications. Advancement of examination may be sought via a:

- 1) Petition to make special,
- 2) Request for prioritized examination, or
- 3) Request for participation in a PPH program.

- o **Petition to make special**

- ◆ **Summary**

Petition to make special			
Subject Matter	- Applicant's health , - Applicant's age ,	- Material enhancement of the quality of the environment , - Material contribution to the development or conservation of energy resources , or - Material contribution to countering terrorism	Petition on other grounds
Fee	No fee	No fee	Fee
Conditions	Evidence showing the state of health or age	- Complete application in condition for examination - 3 or fewer independent claims and 20 or fewer total claims - Single invention - Willing to have an interview to resolve patentability issues - Pre-examination search statement - Support document	
Duration	Entire course of prosecution		
Withdrawal	N/A	Petition for extension of time	
Twelve-month goal	N/A	12-month from filing to 1) a notice of allowance, 2) a final office action, 3) an RCE, or 4) abandonment of the application	

- ◆ **Duration:** An application for a patent that has once been made special and advanced out of turn for examination will continue to be special throughout its entire course of prosecution in the USPTO, including appeal, if any, to the Patent Trial and Appeal Board.

- ◆ **Petition to make special**

- ◇ **Applicant's health:** An application may be made special upon a petition by the applicant's health.
 - * **Requirement:** Any evidence showing that the state of health of applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course such are a doctor's certificate or other medical certificate.
- ◇ **Applicant's age:** An application may be made special upon filing a petition if applicant is 65 years of age or older.
 - * **Requirement:** Any evidence showing that applicant is 65 years of age, or more, such as applicant's statement or a statement from a registered practitioner that he or she has evidence that applicant is 65 years of age or older.
- ◇ **Environmental quality:** The USPTO will accord special status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements, i.e., air, water, and soil.
 - * **Requirements:** The petition must state that special status is sought because the invention materially enhances the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements.

- * **Materiality standard:** If the application disclosure is not clear on its face, the petition must be accompanied by a statement by applicant, assignee, or a registered attorney/agent explaining how the materiality standard is met. It should not be speculative. The materiality standard is also applied to energy and countering terrorism inventions below.
- ◇ **Energy:** The USPTO on petition will accord special status to all patent applications for inventions which materially contribute to a) the discovery or development of energy resources, or b) the more efficient utilization and conservation of energy resources.
- * **Requirements:** The petition must state that special status is sought because the invention materially contributes to category a) or b) above. The materiality standard is applied as well.
- ◇ **Inventions for countering terrorism:** The USPTO on petition will accord special status to all patent applications for inventions which materially contribute to countering terrorism.
- * **Requirement:** The petition must state that special status is sought because the invention materially contributes to countering terrorism. The materiality standard is applied as well.
- ◇ **Inventions for other grounds:** The petition must be accompanied by the fee.
- ◆ **Requirements for all petitions to make special except those based on applicant's health or age:**
 - ◇ The application must be filed with a petition to make special accompanied by either a fee or a statement that the claimed subject matter is directed to environmental quality, the development or conservation of energy resources, or countering terrorism.
 - ◇ The application must be a non-reissue utility or design application.
 - ◇ At the time of filing, the application must be complete and in condition for examination.
 - ◇ The application must contain three or fewer independent claims and twenty or fewer total claims and no multiple dependent claims is allowed.
 - ◇ The claims must be directed to a single invention (if not, must make an election without traverse in a telephonic interview).
 - ◇ Applicant must be willing to have an interview to resolve all issues with respect to patentability.
 - ◇ Applicant must provide a statement that a preexamination search was conducted.
 - ◇ At the time of filing, applicant must provide in support of the petition an accelerated examination support document about how to overcome the cited reference.
- ◆ **Decision on petition to make special:**
 - ◇ If the petition or accelerated examination support document is defective, applicant will be given a single opportunity to perfect the petition or accelerated examination support document with two months. Extensions of time are permitted.
- ◆ **The initial action on the application by the examiner**
 - ◇ **Restriction:** If it is determined that all claims are not directed to a single invention, applicant must make an election without traverse during the telephonic interview.
 - ◇ **Telephone interview:** If a possible rejection or other issues must be addressed, the examiner will telephone applicant to discuss the issue and any possible amendment or submission to resolve such issue.
 - ◇ **Office action:** After mailing an office action other than a notice of allowance, the office action will set a shortened statutory period of two months.
 - ◇ **Extension of times:** Extensions are permitted but will result in the application being taken out of the accelerated examination program.
 - ◇ **Continuing application:** Continuing applications will not automatically be given special status. Each continuing application must on its own meet all requirements for special status.

- ◆ **Reply by applicant:**
 - ◇ Any amendment that attempts to 1) add claims having more than 3 independent claims or more than 20 total claims, 2) present claims not encompassed by the preexamination search or an updated accelerated examination support document (required to provide updated one to encompass the amended or new claims), or 3) present claims that are directed to a nonelected invention or an invention other than previously claimed in the application, will treat as not fully responsive and will not be entered.
- ◆ **Post-allowance processing:**
 - ◇ The mailing of a notice of allowance is the final disposition for purposes of the 12-month goal for the accelerated examination program. For the accelerated application, applicant must pay issue fee without 1 month and not file any post-allowance papers that are not required by the USPTO e.g., 1.132 amendment.
- ◆ **After-final and appeal procedures:**
 - ◇ The mailing of a final office action or the filing of a **notice of appeal**, whichever is earlier, is the final disposition for purpose of the 12-month goal. Prior to the mailing of the final office action, the USPTO will conduct a conference to review the rejection set forth in the final office action. For the application to be expeditiously forwarded to the PTAB for a decision, applicant must 1) promptly file the notice of appeal, appeal brief, and appeal fees, and 2) NOT request a pre-appeal brief conference. During the appeal process, the application will be treated in accordance with the normal appeal procedure. After decision by the PTAB, the USPTO will continue to treat the application as special.
- ◆ **Request for continued examination (RCE):**
 - ◇ The filing of a RCE is a final disposition for purposes of the 12-month goal. The application will retain its special status and remain in the accelerated examination program. The goal of the accelerated examination program will be to reach a final disposition of the application within 12-months from the filing of the RCE.
- ◆ **Withdrawal from accelerated examination:**
 - ◇ Filing a petition for extension of time will result in the application being taken out of the accelerated examination program. But, an RCE will not result in an application being withdrawn from special status.
- ◆ **The twelve-month goal:**
 - ◇ The 12-month goal is achieved when one of the following final dispositions occurs: 1) the mailing of a notice of allowance, 2) the mailing of a final office action, 3) the filing of an RCE, or 4) abandonment of the application.

o **Prioritized Examination (Track One and PE-RCE)**

◆ **Summary**

Prioritized Examination		
	Track One Prioritized Examination for Application Filings	PE-RCE Prioritized Examination for a Request
Type of application	A utility or plant nonprovisional application. No international application entering the national stage	A utility or plant nonprovisional application including a national stage application filing an RCE
Claims	No more than 4 independent claims no more than 30 total claims	No more than 4 independent claims no more than 30 total claims
Timing	On filing of the new application (Single request)	On filing of an RCE or before the first office action is issued after the RCE (Single request)
Termination	A petition for an extension of time or a request for suspension of action Claim amendment resulting in more than 4 independent claims or 30 total claims	
Yearly limit	10,000 per fiscal year in total including Track One and PE-RCE applications	
Twelve-month goal	12-month from filing to 1) a notice of allowance, 2) a final office action, 3) an RCE, or 4) abandonment of the application	

- ◆ **Twelve-month goal:** Under prioritized examination, an application will be accorded special status until a final disposition is reached in the application on average within 12 months. The final disposition includes: 1) the mailing of a notice of allowance, 2) the mailing of a final office action, 3) the filing of a notice of appeal, 4) completion of examination, 5) filing an RCE, or 6) abandonment of the application.

◆ **Termination:**

- ◇ A petition for an extension of time or a request for suspension of action will result in terminating the prioritized examination.
- ◇ Filing an amendment to the application which results in more than 4 independent claim or 30 total claims or a multiple dependent claim will terminate the prioritized examination.
- ◆ **Yearly limit:** The number of granted requests for prioritized examination is limited to a maximum of 10,000 per fiscal year.

◆ **Prioritized examination for application filings under § 111(a) (Track One)**

- ◇ **Type of application:** The application must be a utility or plant nonprovisional application, including a continuing application. This does not apply to design, reissue, provisional applications, reexamination proceedings, and international applications that have entered the national stage under § 371. However, a by-pass continuation (a new application in the US under § 111(a) claiming the benefit of the earlier international application under § 365(c), rather than entering the national stage under § 371) is eligible.
- ◇ **Timing:** The prioritized examination is available at the time of filing an application.
- ◇ **Fees:** The prioritized examination fee, processing fee, publication fee, basic filing fee, search fee, and examination fee must be paid.
- ◇ **Claims:** No more than 4 independent claims and no more than 30 total claims and no multiple dependent claim are allowed. Applicant will have one month to amend claims if the filed claims are not consistent with the requirements.

◆ **Prioritized Examination for a Request for Continued Examination (PE-RCE)**

- ◇ **Type of application:** The application must be a non-reissue utility or plant nonprovisional application filed under § 111(a) or that has entered the national stage under § 371.

- ◇ **Timing:** A single PE-RCE request may be filed concurrently with or subsequently to the filing of a RCE but must be filed before the mailing of the first OA after the filing of the RCE.
- ◇ **Fees:** The prioritized examination fee and the publication fee must be paid for the application.
- ◇ **Claims:** No more than 4 independent claims and no more than 30 total claims and no multiple dependent claim are allowed.

o **Patent Prosecution Highway Program (PPH)**

- ◆ **Summary:** The Patent Prosecution highway (PPH) speeds up the examination process for corresponding applications filed in participating patent offices. Under the PPH, participating patent offices have agreed that when an applicant receives a final ruling from an office of earlier examination (OEE) that at least one claim is allowed, an applicant may request fast track examination of corresponding claim(s) in a corresponding U.S. patent application.

◆ **Participating patent offices**

◇ **Global and IP5 PPH participants with the USPTO**



- ◇ **Other PPH programs:** Other countries (Brazil, Chile, Czech, Eurasian, Mexico, Nicaragua, Philippines, Romania, Saudi Arabia, and Taiwan) are not yet included in the Global PPH. Thus, special forms are necessary to participate in the PPH programs in these countries.

◆ **Eligibility**

- ◇ **Same earliest priority date:** The U.S. patent application must have the same earliest priority date as that of a corresponding national or regional application filed with OEE or a corresponding PCT application for which one of the Global PPH participating offices was the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA).
- ◇ **At least one allowable claim in OEE:** The corresponding application has at least one allowable claim indicated by the OEE.
- ◇ **All sufficiently corresponding US claims:** All claims in the U.S. patent application must sufficiently correspond to the allowable claims in the corresponding OEE application. A claim is considered to sufficiently correspond if the claim is of the same or similar scope as an allowable claim in the corresponding OEE application.
- ◇ **Before substantive examination:** The PPH request must be made before substantive examination of the U.S. application has begun.

◆ **Required documents**

- ◇ A request for participation in the PPH pilot program and a request that the U.S. application be advanced out of turn for examination. A petition fee is not required.
- ◇ A claims correspondence table.
- ◇ A copy of the office action issued just prior to the Decision to Grant a Patent in the OEE application along with an English translation thereof, if applicable, or the latest work product

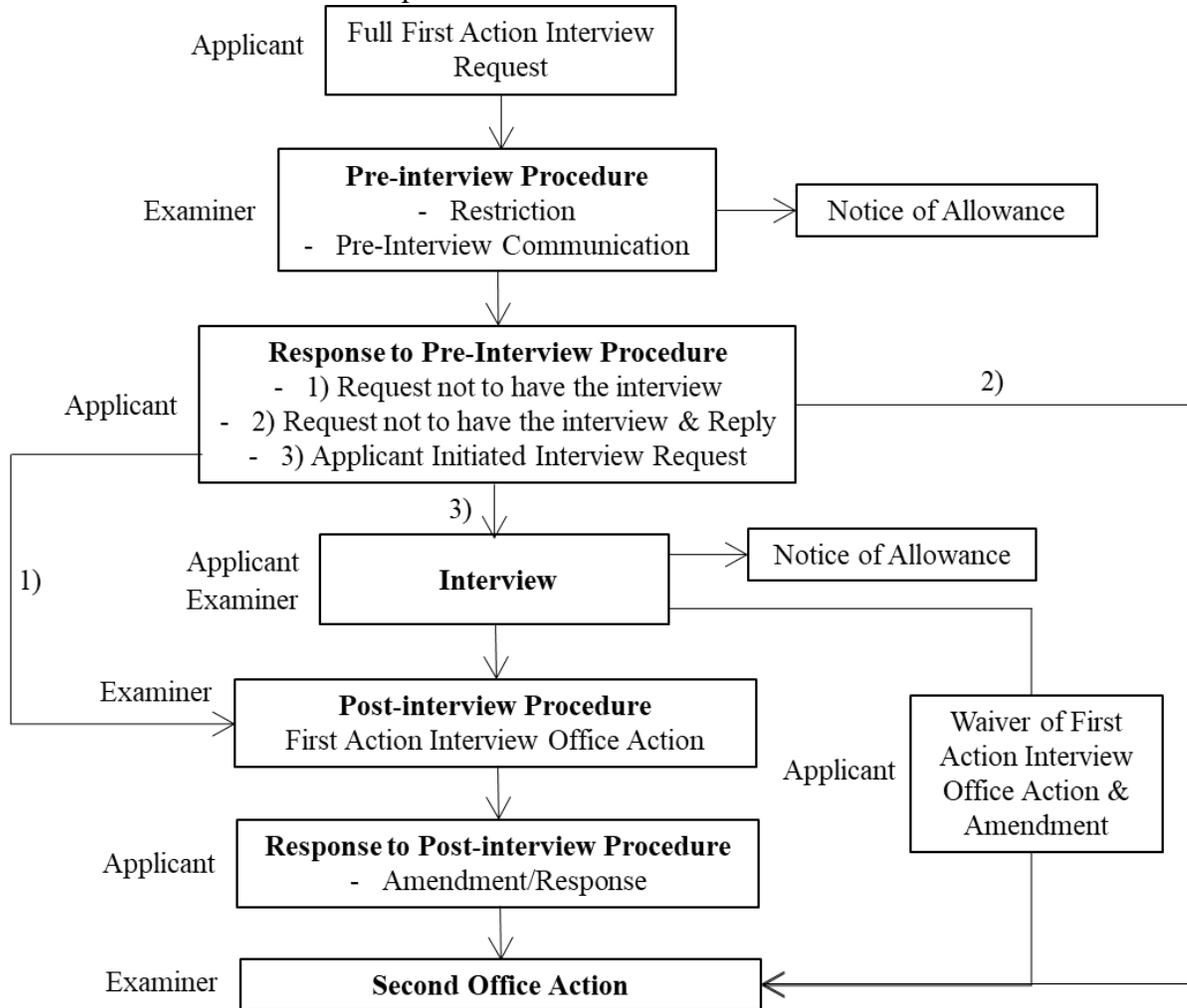
in the international phase of the OEE PCT application along with an English translation, if applicable.

- ◇ An information disclosure statement (IDS) listing the documents cited in the office action or PCT work product along with copies of all documents except U.S. patents and U.S patent application publications.
- ◆ **One opportunity to cure:** If the request does not meet all requirements, applicant will be notified about the defects in the request. Applicant will be given one opportunity to perfect the request in a renewed request for participation.

- **Interviews**

- **Full First Action Interview Pilot Program**

- ◆ **Summary:** Under the Full First Action Interview Pilot Program, applicant is entitled to a first action interview, upon request, prior to the first office action on the merits. Due to early communication with the examiner on the merits, this free pilot program may increase the allowance rate and decrease the prosecution time.

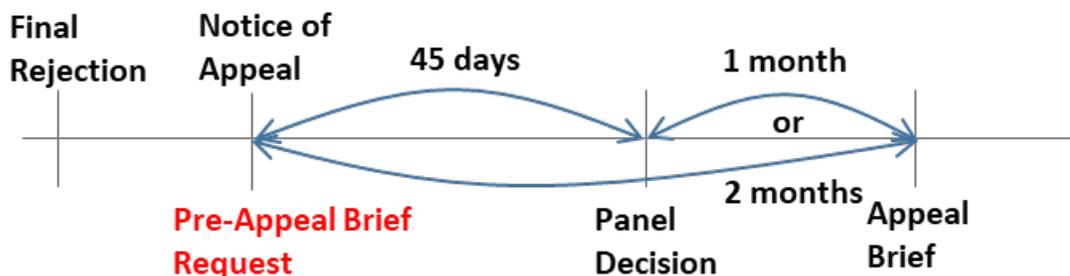


- ◆ **Interview on the merits:** Under the program, applicant can conduct an interview with the examiner after the examiner provides the result of a prior art search and any rejections or objections through a Pre-Interview Communication. Through the program, applicant can resolve patentability issues with the examiner at the beginning of the prosecution process.
- ◆ **Eligibility:** Any utility application is eligible.
- ◆ **Timing:** The request must be filed at least one day before a first office action on the merits
- ◆ **Requirements:**
 - ◇ **Types of application:** a non-reissue and nonprovisional utility application under 35 U.S.C. 111(a) or national stage application under 35 U.S.C. 371
 - ◇ **Number of claims:** three or fewer independent claims and twenty or fewer total claims without any multiple dependent claims
 - ◇ **Number of inventions:** a single invention
 - ◇ **Filing type:** filing using the USPTO's electronic filing system, EFS-Web

◆ **Process**

- ◇ **Request:** Applicant must file the request to join the Full First Action Interview Pilot Program via EFS-Web before the first office action on the merits is issued.
- ◇ **Pre-Interview Procedures**
 - * **Restriction:** The examiner may make a telephone restriction requirement for the application claims having two or more independent and distinct inventions. Applicant must elect without traverse to stay in the pilot program.
 - * **Pre-Interview Communication:** After searching prior art, the examiner may issue a notice of allowance or a Pre-Interview Communication. The Pre-Interview Communication includes prior art references and any identified rejections or objections.
 - * **Response to Pre-Interview Communication:** Applicant has three options to respond to Pre-Interview Communication. Applicant has a one month or thirty days, whichever is longer, for the response. The response time period may be extended for one additional month.
 - **1) Request not to have the interview:** Applicant may file a request not to have the interview within the response time period. The examiner will issue the First Action Interview Office Action.
 - **2) Request not to have the interview & reply:** Applicant may file a request not to have the interview and reply to Pre-Interview Communication within the response time period. In this situation, Pre-Interview Communication will be deemed the first office action on the merits. The examiner will consider the reply and issue a second office action.
 - **3) Applicant Initiated Interview Request:** Applicant may file an Applicant Initiated Interview Request with a proposed amendment and/or arguments. Applicant must also designate a proposed interview date within two months or sixty days, whichever is longer.
- ◇ **Interview:** The interview includes a discussion of the invention, prior art references, allowable subject matter, and proposed amendments. The substance of the interview must be made of record. There are three possible outcomes of the interview as post-interview procedures.
- ◇ **Post-Interview Procedures**
 - * **1) Notice of allowance:** An agreement is reached and all claims are in condition for allowance.
 - * **2) First Action Interview Action:** If an agreement is not reached, the examiner will issue the First Action Interview Action with the requirements, rejections or objections.
 - * **3) Waiver of First Action Interview Action & Amendment:** Applicant may wish to convert the previously submitted proposed amendment into a reply and waive receipt of a First Action Interview Action. In this case, the Pre-Interview Communication and interview will be deemed the first office action on the merits. The examiner will consider the proposed amendment and provide the second office action on the merits.

- **After Close of Prosecution**
 - **PE-RCE – Prioritized Examination**
 - ◆ **See above** (Advancement of examination > Prioritized Examination (Track One and PE-RCE) > Prioritized Examination for a Request for Continued Examination (PE-RCE))
 - **After Final Consideration Pilot 2.0 (AFCP 2.0)**
 - ◆ **Summary:** Under AFCP 2.0, applicant has another chance for the application to be searched and considered under limited circumstances without any fees. Also, applicant is entitled to an interview with the examiner if the response does not put the application in condition for allowance.
 - ◆ **Requirements**
 - ◇ A response to a final office action.
 - ◇ A request for consideration under the pilot.
 - ◇ An amendment to at least one independent claim that does not broaden the scope of the independent claim in any respect.
 - ◆ **Determination**
 - ◇ If additional search and/or consideration is required and could be completed within the allotted time,
 - * the examiner will determine the rejections are overcome and a Notice of allowance is issued,
 - * the examiner will determine the amendment would not overcome all of the rejections and conduct an interview with applicant, or
 - * the examiner will determine the amendment raises a new issue and conduct an interview with applicant
 - ◇ If additional search and/or consideration would be required but could not be completed within the allotted time,
 - * the examiner will treat the amendment under pre-pilot program.
 - ◇ If an improper request is made, the request will be treated under pre-pilot procedure.
 - **Pre-Appeal Brief Conference Pilot Program**
 - ◆ **Summary:**



If the final rejections include a clear error on the rejections or omission of an essential element for a *prima facie* rejection, applicant may consider Pre-Appeal Brief Conference Pilot Program before filing an appeal brief. The request for the pilot program must be filed along with the notice of appeal.

- ◆ **Panel review:** Under this pilot program, applicant may request that a panel of three examiners including the examiner of record consider the merits of each ground of rejection for which appeal has been requested.
- ◆ **Timing:** Applicant must file the request of a panel review with the filing of a notice of appeal and before the filing of an appeal brief.
- ◆ **Ground:** The request should specify:
 - ◇ clear errors in the examiner's rejections; or
 - ◇ the examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

- ◆ **Content of Request:**
 - ◇ Request form (PTO/SB/33);
 - ◇ Arguments in five or less total pages without any proposed amendments; and
 - ◇ the notice of appeal.
- ◆ **Decision:** A panel decision should be mailed within 45 days after the filed request.
- ◆ **Time period of appeal brief:** The time period for filing an appeal brief will be reset to be:
 - ◇ one month from 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 is greater.
 - ◇ The time period for filing of the appeal brief is extendible.
- ◆ **Termination:** The review process will be terminated if any of the following responses is filed after the request:
 - ◇ an appeal brief;
 - ◇ a request for continued examination (RCE);
 - ◇ an after-final amendment;
 - ◇ an affidavit or other evidence; or
 - ◇ an express abandonment.

- **Information Disclosure Statement (IDS)**

- **Summary:** Applicants and other people involved in an application have a duty to disclose information material to patentability. The duty can be satisfied by submitting an IDS. The IDS must be filed within time requirements. Although no IDS will be considered after the issue fee is paid, the QPIDS program permits an IDS to be considered between the issue fee payment and the patent issuance.
- **Quick Path Information Disclosure Statement (QPIDS)**
 - ◆ **IDS consideration after issue fee payment:** The QPIDS program eliminates the requirement for processing of a Request for Continued Examination (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.
 - ◆ **Type of application:** A utility or reissue application.
 - ◆ **Timing:** A QPIDS may only be filed after payment of the issue fee and before issuance of the patent.
 - ◆ **Requirements:** A QPIDS transmittal form (PTO/SB/09), an IDS with the fee and certification statement, ePetition to withdraw from issue with the petition fee, an RCE with the fee.
 - ◆ **RCE and Fee:** The RCE will be treated as a conditional RCE until the examiner determines whether any item of information in the IDS necessitate reopening prosecution. If no item of the IDS necessitates reopening prosecution, the RCE will not be processed and the RCE fee will be returned.
 - ◆ **IDS Fee:** If any item of information in the IDS necessitate reopening prosecution, the RCE will be processed and the IDS fee will be returned.
 - ◆ **Processing of QPIDS:** If no item of the IDS necessitates reopening prosecution, the examiner will issue a corrected notice of allowability.