

DEPARTMENT OF COMMERCE**Patent and Trademark Office****[Docket No.: PTO-P-2022-0042]****First-Time Filer Expedited Examination Pilot Program****AGENCY:** United States Patent and Trademark Office, Department of Commerce.**ACTION:** Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) and its Council for Inclusive Innovation (CI²) are developing strategies to create a more equitable and diverse innovation ecosystem. As one strategy, the USPTO is implementing the First-Time Filer Expedited Examination Pilot Program, designed to increase accessibility to the patent system for inventors who are new to the patent application process, including those in historically underserved geographic and economic areas. The program expedites the first Office action for program participants. Expediting the first Office action reduces time-based barriers for inventors who may otherwise be unable to participate in the patent system, thereby advancing opportunity in the innovation ecosystem. The program requires participants to be reasonably trained in the patent application process so they can engage effectively with the Office and maximize the benefit of expedited examination. The pilot program website identifies a collection of free training resources for anyone interested in learning more about the patent application filing process. This notice outlines the conditions, eligibility requirements, and guidelines of the program.

DATES: The USPTO will accept petitions to make special under the First-Time Filer Expedited Examination Pilot Program beginning March 9, 2023, until either March 11, 2024, or the date the USPTO grants 1,000 petitions to participate in the program, whichever occurs earlier.

The USPTO may exercise its discretion to terminate this pilot program at any time. In the event of any such termination, the USPTO will notify the public. The USPTO will publish on its website an ongoing count of the number of petitions granted for participation in the program.

FOR FURTHER INFORMATION CONTACT: Questions or comments regarding this pilot program may be directed to: Parikha Mehta, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for

Patents, at 571-272-3248 or Parikha.Mehta@uspto.gov, or Brannon Smith, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents, at 571-270-1601 or Brannon.Smith@uspto.gov.

Questions regarding electronic application filing may be directed to the Electronic Business Center at 866-217-9197 during its operating hours of 6 a.m. to midnight ET, Monday-Friday, or at ebc@uspto.gov.

Questions regarding a filed petition to make special under this pilot may be directed to the Office of Petitions at 571-272-3282 during its operating hours of 8:30 a.m. to 5 p.m. ET, Monday-Friday.

SUPPLEMENTARY INFORMATION: Under current USPTO policy, examiners normally take up nonprovisional patent applications filed under 35 U.S.C. 111(a) for examination in the order they were filed. See section 708 of the Manual of Patent Examining Procedure (MPEP) (9th ed., rev. 10.2019, June 2020). An application can be advanced out of turn for examination (that is, accorded special status) when the applicant successfully petitions to make special under 37 CFR 1.102(c) or (d) or requests prioritized examination under 37 CFR 1.102(e). See 37 CFR 1.102(c)-(e) and MPEP sections 708.02, 708.02(a), and 708.02(b).

Generally, petitions to make special under 37 CFR 1.102(c) and (d) must comply with all requirements of the accelerated examination program set forth in MPEP § 708.02(a) unless the petition is based on the inventor's age or health. See Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination, 71 FR 36323 (June 26, 2006), 1308 *Off. Gaz. Pat. Office* 106 (July 18, 2006).

The USPTO is implementing a new First-Time Filer Expedited Examination Pilot Program under the Council for Inclusive Innovation, in alignment with Executive Order 13985 and as previously announced in the 2022 U.S. Department of Commerce Cabinet-Level Equity Action Plan. This program aligns with and supports the Executive Order by creating opportunities for underserved communities. The program enables micro entity first-time filers who meet the requirements detailed in Part I to have their applications examined out of turn. This program is established under 37 CFR 1.102(d) without requiring either the 37 CFR 1.17(h) fee for a petition to make special or all conditions of the accelerated examination program. See MPEP

§ 708.02(a)(I). No other fees or requirements are waived for participants in this program.

Part I. Program Eligibility Requirements**A. Applicant and Inventor Eligibility**

To qualify for this program, the applicant and the inventor must meet the following requirements as of the filing date of the petition to make special:

1. The applicant must certify that the inventor or, where there are joint inventors, each joint inventor has not been named as the sole inventor or a joint inventor on any other U.S. nonprovisional application.

2. The applicant must certify that the applicant and the inventor or, where there are joint inventors, the applicant and each joint inventor qualify for micro entity status under the gross income basis requirement. See 37 CFR 1.29 and MPEP section 509.04. Note that the applicant must separately and properly establish micro entity status by filing USPTO Form SB/15A (Certification of Micro Entity Status—Gross Income Basis) no later than the date that the petition to participate in this pilot is filed. For more information regarding micro entity status requirements, see the USPTO Micro Entity Status web page (<https://www.uspto.gov/PatentMicroentity>).

3. The applicant must certify that the inventor, or, where there are joint inventors, each joint inventor, named on the application is reasonably trained on the basics of the USPTO's patent application process. For applicants who are unsure whether they meet this requirement, exemplary patent application training resources that could be used to meet this requirement are available at the pilot program web page (<https://www.uspto.gov/FirstTimePatentFiler>).

B. Eligible Applications

This program is available for original, noncontinuing, nonprovisional utility applications filed under 35 U.S.C. 111(a). The application must be filed electronically via Patent Center. The abstract, specification, and claim(s) must be provided on filing in DOCX format.

The petition to make special under this program should not be filed until the application is complete under 37 CFR 1.51(b). To be complete under 37 CFR 1.51(b), the application must include a specification, drawing(s) if necessary, at least one claim, a properly executed inventor's oath or declaration under 37 CFR 1.63, and payment of all

appropriate fees (that is, basic filing, search, and examination fees, and an application size fee if required). If the application is not complete under 37 CFR 1.51(b) on the date the petition to make special under this program is filed, the petition will be dismissed without further opportunity to request participation in the program.

Applications claiming the benefit of the filing date of one or more provisional applications under 35 U.S.C. 119(e) are eligible for this program. Applications claiming the benefit of the filing date of any previously filed nonprovisional U.S. applications or international applications designating the United States under 35 U.S.C. 120, 121, 365(c), or 386(c) (for example, continuation, continuation-in-part, divisional, and bypass applications) are not eligible for this program. In addition, applications claiming a right of foreign priority under 35 U.S.C. 119(a)–(d) or (f) to one or more foreign applications are not eligible for this program. This ensures that the benefits of the program are reserved for inventors who are new to the patent application process. Other expedited programs under petitions to make special and prioritized examination are still available as provided by 37 CFR 1.102(c)–(e) for applications that are otherwise ineligible for this program.

Applications entering the national stage under the Patent Cooperation Treaty (PCT) as set forth in 35 U.S.C. 371 are not eligible for this program. National stage applications may be advanced out of turn under 37 CFR 1.496 or the Patent Prosecution Highway program.

Applications in this pilot program may not have special status under any other category or pilot program under 37 CFR 1.102 (for example, if the application has been granted special status for age of inventor, it is not eligible for participation in this pilot).

C. Claim Requirements

The application must meet the following claim requirements for a petition to make special under this program to be granted, and for the remainder of prosecution (that is, until abandonment or issuance as a patent):

1. There are no more than three independent claims.
2. There are no more than 20 claims total, and
3. There are no multiple dependent claims.

An applicant may file a petition to make special under this program in a previously filed application, if an Office action has not yet been issued in that application. In this situation, if the

claims do not already conform to the program requirements, the applicant should file a preliminary amendment in compliance with 37 CFR 1.121 canceling any excess claims and any multiple dependent claims. This should be done no later than the date the petition to make special is filed. Applicants may choose to wait to file their petition to make special under this program until after the claims have been amended to conform with the program requirements, but the petition must nevertheless be filed prior to a first Office action as detailed in Part I(E) of this notice. Therefore, the petition should be filed as soon as the application conforms with the program requirements.

D. Must File Specific PTO Form Electronically To Participate

To participate in this program, an applicant must file a petition to make special using form PTO/SB/464, titled “Certification and Petition for the First-Time Filer Expedited Examination Pilot Program” (available at <https://www.uspto.gov/PatentForms>). The PTO/SB/464 form contains all required certifications detailed in Part I(A) of this notice. The form must be filed electronically via Patent Center. Modified versions of form PTO/SB/464 will not be accepted. If the petition is not properly signed, it will be dismissed. See 37 CFR 1.33(b) for signature requirements. If there are multiple joint inventors filing the application as the applicant (that is, the applicant consists of joint inventor-applicants), either a single copy of the form must be signed by a patent practitioner or each joint inventor-applicant must sign a separate copy of the form. Multiple forms must be submitted if more than one signature is required.

Under 5 CFR 1320.3(h), form PTO/SB/464 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

E. Time for Filing the Petition To Make Special

The Certification and Petition for the First-Time Filer Expedited Examination Pilot Program (that is, form PTO/SB/464) must be filed before a first Office action (including an action containing only a restriction requirement) is issued in the application.

Part II. Procedures After the Petition To Make Special Is Filed

A. Petition Decision

The USPTO Office of Petitions will review and decide petitions to make

special under this program after the corresponding application has undergone initial pre-examination processing. Petition review will not be delayed or held back in view of outstanding notices to file missing items. If the application does not meet all requirements noted in Part I at the time the petition is reviewed, the petition will be dismissed. The petition decision will identify the specific deficiencies for which the petition is being dismissed. In the event of a dismissal, applicant may be able to correct certain deficiencies and file a new petition to make special under this program, as detailed in Part II(A)(i).

i. Correctable Deficiencies

If the USPTO determines that a petition to make special under this program does not comply with the requirements set forth in Part I of this notice, the USPTO will dismiss the petition. If each identified deficiency is correctable, the applicant will be given a single opportunity to correct each identified deficiency and file a new petition to participate in the pilot program. This means that the applicant must file a reply via Patent Center that includes appropriate corrections and a new, properly signed petition form PTO/SB/464 within two months of the mailing notification date of the deficiency notice. This two-month time period for replying is not extendable under 37 CFR 1.136(a). Deficiencies for which applicants may be given one opportunity to correct include:

- Not using form PTO/SB/464
- Not filing the petition via Patent Center
- Not signing the petition according to 37 CFR 1.33(b)
- Filing more than 20 claims total
- Filing more than three independent claims
- Filing any multiple dependent claims
- Not properly establishing micro entity status using form PTO/SB/15A

If the applicant fails to submit a paper correcting the deficiencies identified in the petition decision, accompanied by a properly signed petition form within the two-month reply period, there will be no further opportunity for applicant to petition to make special under this program; the application will instead be examined in regular turn.

ii. Non-Correctable Deficiencies

The petition will be dismissed without any opportunity for correction if any of the following deficiencies exist:

- The initial petition was not filed before a first Office action was issued in the application.

- The inventor or, where there are joint inventors, at least one joint inventor has been named as the sole inventor or a joint inventor on a previously filed nonprovisional application.
- The application was not filed electronically using Patent Center.
- The specification, claim(s), and abstract on filing were not submitted in DOCX format.
- The application does any of the following:
 - Claims the benefit of the filing date of one or more prior filed applications that are nonprovisional applications and/or international applications designating the United States,
 - Claims a right to priority to one or more foreign applications, and
 - Is entering the national stage under the Patent Cooperation Treaty (PCT) as set forth in 35 U.S.C. 371.
- The application was not complete under 37 CFR 1.51(b) as of the filing of the petition to make special under this program.
- The application was previously granted special status.

iii. Special Status After the Petition Is Granted

If a petition to make an application special under this program is granted, the application will be accorded special status and placed on an examiner's special docket until the first Office action (including an action that contains only a restriction requirement). After the examiner issues the first Office action, special status for the application will conclude under this program, and any subsequent reply filed by the applicant will place the application on the examiner's regular amended docket.

Amendments that do not meet the claim requirements of Part (I)(C) of this notice will be considered non-responsive, as further detailed in Part (II)(C) of this notice.

B. Adding Joint Inventors After a Petition Has Been Granted

If any joint inventor is added to the application after a petition has been granted under this program, the applicant must certify (for example, on a separate letter) that the added joint inventor(s) meet the criteria in Part (I)(A).

C. Claim Amendments During Prosecution

A reply to an Office action must be fully responsive to the rejections, objections, and requirements made by the examiner. A reply may include amendments to the claims. If an applicant amends the claims during

prosecution such that the amended claims do not conform to the claim requirements in Part (I)(C) of this notice, the amendment may be treated by the examiner as nonresponsive.

In this situation, if the amendment was a *bona fide* reply, the examiner may notify the applicant of the initial deficiency by issuing a notice of nonresponsive amendment, which will have a shortened statutory period for reply of two months. Any subsequent nonresponsive amendment filed by the applicant will typically be treated as non-*bona fide*, and the time period set in the initial notice of nonresponsive amendment will continue to run.

For example, if the applicant responds to the first Office action by filing an amendment with four independent claims, 21 total claims, no multiple dependent claims, and the appropriate excess claim fees under 37 CFR 1.16(h) and (i), the examiner may send a notice of nonresponsive amendment identifying two deficiencies in the amendment: more than three independent claims and more than 20 claims total. The examiner's notice will have a shortened statutory period for reply of two months, extendable under 37 CFR 1.136(a), but not extendable beyond the maximum time period of six months set by statute. *See* 35 U.S.C. 133. If the applicant responds to the examiner's notice by timely filing an appropriate amendment that cancels one of the independent claims such that there are now three independent claims, 20 claims total, and no multiple dependent claims, the amendment will conform to all requirements of Part (I)(C) and the deficiencies identified in the original notice of nonresponsive amendment will be considered corrected.

However, if the applicant timely responds to the examiner's notice with an amendment that only cancels one of the dependent claims (that is, there are now four independent claims, 20 claims total, and no multiple dependent claims), this reply may be treated as non-*bona fide* because there are still more than three independent claims. In this situation, the time period for filing a responsive reply (that is, an amendment conforming to all requirements of Part (I)(C)) will continue to run from the date of the examiner's initial notice of nonresponsive amendment. If there is sufficient time remaining for the applicant's reply to be filed within the time period set forth in the initial notice of nonresponsive amendment (or within any extension of time pursuant to 37 CFR 1.136(a)), the examiner will notify the applicant of the deficiency by

issuing another notice of nonresponsive amendment without setting a new time period for reply. If the applicant does not file a responsive reply within the remaining time period for reply (or within any extension of time pursuant to 37 CFR 1.136(a)), the application will be abandoned.

D. Extensions of Time Permitted for Replies to Office Actions

Extensions of time under 37 CFR 1.136(a) are permitted for replies to Office actions, but are not extendable beyond the maximum time period of six months set by statute. *See* 35 U.S.C. 133.

Note that responses to notices of defective petitions are not eligible for extensions of time, as detailed under Part (II)(A)(i) of this notice. The availability of extensions of time during pre-examination and appeal are not impacted by this program.

E. Additional Support

The USPTO provides additional support and resources for inventors and entrepreneurs at <https://www.uspto.gov/CES>.

F. Withdrawal From the Program

There is no provision for withdrawal from this program. An applicant may abandon the application granted special status under the program in favor of a continuing application. However, any continuing application would not be eligible for special status under this program, for the reasons detailed in Part I of this notice. Requests for deferred examination under 37 CFR 1.103(d) are considered to be requests for withdrawal from the program and will not be granted.

Part III. Voluntary Demographic Survey

The USPTO currently intends to survey pilot program participants to collect limited inventor demographic information. Participation in the survey would be strictly voluntary, and the information collected would only be used for USPTO process improvement purposes. Survey responses would not impact pilot program eligibility for applicants, would not be part of the application file or otherwise accessible by examiners, and would not impact examination decisions in pilot program participants' applications. The USPTO would notify the public before implementing any such survey.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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