

U.S. Patent Office Announces Deferred Subject Matter Eligibility Response Pilot Program

The United States Patent and Trademark Office (“USPTO”) announced a new pilot program, called the Deferred Subject Matter Eligibility Response Pilot Program (“Pilot Program”), that will allow certain patent applicants to defer responding to subject matter eligibility rejections. Starting in February 2022, office actions for qualifying patent applications may include an invitation to participate in the Pilot Program. Under the Pilot Program, applicants may delay responding to a subject matter eligibility rejection until a final office action or withdrawal of all other rejections. The Pilot Program will investigate whether subject matter eligibility rejections may be overcome as a natural result of responding to other rejections (e.g., indefiniteness, novelty/obviousness, etc.). From an applicant’s standpoint, the Pilot Program presents the benefits of reduced prosecution history and more time to consider arguments, among others.

The recent tumultuous history of 35 U.S.C. § 101 (the law governing what is patent eligible subject matter) in the courts has resulted in a lack of clarity regarding what subject matter is actually patentable at the USPTO. Senators Thom Tillis of North Carolina and Tom Cotton of Arkansas requested that the USPTO adopt a pilot program allowing Applicants to defer responding to any subject matter eligibility rejections to determine if such a program would result in “more effective” prosecution of patents and produce “higher quality patents.” In view of the Senators’ requests, the USPTO is implementing the Pilot Program.

Under the Pilot Program, office actions issued on or after February 2, 2022 may include an invitation for an applicant to defer responding to any subject matter eligibility rejections until the earlier of final disposition of the application or the withdrawal of, or obviation of, all outstanding rejections. In order to be invited to participate in the Pilot Program, the patent application will need to meet with three requirements. First, the examiner of the patent application must be a primary examiner who has elected to participate in the voluntary Pilot Program. Second, the patent application cannot be a continuation or divisional application of a United States patent application nor can the patent application be advanced out of turn. Third, the office action must include a

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subject matter eligibility rejection and at least one non-subject matter eligibility rejection, such as a definiteness, novelty, or obviousness rejection. Applicants cannot request to be in the Pilot Program, the invitation must be extended by the examiner. To accept the invitation, applicants will need to file a completed request form (PTO/SB/456) along with the response to the office action.

The Pilot Program allows applicants to defer responding to any subject matter eligibility rejections until the earlier of a final disposition of the application or the withdrawal of or obviation of all outstanding rejections. Effectively, this allows applicants to defer responding to subject matter eligibility rejections until a final office action is mailed, which is usually the second office action. In most circumstances, applicants will be able to defer responding to the subject matter eligibility rejections for a single response. Under the Pilot Program, in at least the first office action response, an applicant may completely ignore the subject matter eligibility rejection, respond to only a portion of the subject matter eligibility rejection, or respond to all of the subject matter eligibility rejection.

For patent applicants, the Pilot Program can reduce or possibly even eliminate the need to make on the record arguments to overcome subject matter eligibility rejections. For example, applicants may be able to reduce or eliminate characterizations of claim limitations that are not yet in their final amended form by amending the claims and awaiting disposition of the as-amended claims, without commenting on the subject matter eligibility rejection of the previous version of the claims. Additionally, applicants will have longer to consider the initial subject matter eligibility rejection arguments when responding to an initial subject matter eligibility rejection.

By participating in the Pilot Program, applicants must accept certain limitations such as agreeing to refrain from seeking expedited processing of the patent application.

Dorsey's patent professionals can assist patent applicants navigating the Pilot Program discussed above. For additional information, please feel free to contact the attorneys listed, or see Dorsey's website at www.dorsey.com.