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[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2015-0030]

Expedited Patent Appeal Pilot

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) has a procedure under which an application will be advanced out of turn (accorded special status) for examination if the applicant files a petition to make special with the appropriate showing. The USPTO is providing a temporary basis (the Expedited Patent Appeal Pilot) under which an appellant may have an ex parte appeal to the Patent Trial and Appeal Board (Board) accorded special status if the appellant withdraws the appeal in another application in which an ex parte appeal is also pending before the Board. The Expedited Patent Appeal Pilot will allow appellants having multiple ex parte appeals currently

pending before the Board to have greater control over the priority with which their appeals are decided and reduce the backlog of appeals pending before the Board.

DATES: EFFECTIVE DATE: June 19, 2015.

DURATION: The Expedited Patent Appeal Pilot is being adopted on a temporary basis and will run until two thousand (2,000) appeals have been accorded special status under the Expedited Patent Appeal Pilot, or until June 20, 2016, whichever occurs earlier. The USPTO may extend the Expedited Patent Appeal Pilot (with or without modification) on either a temporary or permanent basis, or may discontinue the Expedited Patent Appeal Pilot after June 20, 2016, depending upon the results of the Expedited Patent Appeal Pilot.

FOR FURTHER INFORMATION CONTACT: Steven Bartlett, Patent Trial and Appeal Board, by telephone at 571-272-9797, or by electronic mail message at expeditedpatentappealspilot@uspto.gov.

SUPPLEMENTARY INFORMATION: Appeals to the Board are normally taken up for decision by the Board in the order in which they are docketed. The USPTO has a preexisting procedure under which an application will be advanced out of turn (accorded special status) if the applicant files a petition to make special with the appropriate showing. See 37 CFR 1.102 and MPEP § 708.02. The USPTO is adopting, on a

temporary basis, the Expedited Patent Appeal Pilot, under which an appellant may have an ex parte appeal to the Board in an application accorded special status if the appellant withdraws the appeal in another application or ex parte reexamination with an ex parte appeal also pending before the Board. The Expedited Patent Appeal Pilot will permit an appellant having multiple appeals pending before the Board to accelerate the Board decision on an appeal involving an invention of greater importance to the appellant, possibly hastening the pace at which the invention is patented and products or services embodying the patent are brought to the marketplace, and thus spurring follow-on innovation, economic growth, and job creation, by foregoing another pending appeal in which the underlying invention is no longer a business pursuit or priority to the appellant.

The USPTO will accord special status to an appeal pending before the Board under the following conditions:

(1) A certification and petition under 37 CFR 41.3 must be filed by the USPTO's electronic filing system (EFS-Web) in the application involved in the ex parte appeal for which special status is sought ("appeal to be made special"), identifying that application and appeal by application and appeal number, respectively. In addition, the appeal to be made special must be an appeal for which a docketing notice was mailed no later than June 19, 2015. Moreover, there must be no request for an oral hearing, or any request for an oral hearing must be withdrawn, for the appeal to be made special, and the appellant must agree not to request a refund of any oral hearing fees paid with respect to the appeal to be made special.

(2) The petition under 37 CFR 41.3 must include a request to withdraw the appeal in another application or ex parte reexamination for which a docketing notice was mailed no later than June 19, 2015 (“appeal to be withdrawn”), identifying that application or ex parte reexamination and appeal by application or reexamination control number and appeal number, respectively. The petition under 37 CFR 41.3 must be filed before the appeal to be withdrawn has been taken up for decision. The appellant also must agree not to request a refund of any appeal fees, including oral hearing fees, paid with respect to the appeal to be withdrawn.

(3) The application involved in the appeal to be made special and the application or patent under reexamination involved in the appeal to be withdrawn must be either owned by the same party as of June 19, 2015, or name at least one inventor in common.

(4) The petition under 37 CFR 41.3 must be signed by a registered practitioner who has a power of attorney under 37 CFR 1.32, or has authority to act under 37 CFR 1.34, for the application involved in the appeal to be made special and for the application or patent under reexamination involved in the appeal to be withdrawn.

The USPTO has created a form-fillable Portable Document Format (PDF) “Petition to Make Special – Expedited Patent Appeal Pilot” (Form PTO/SB/438) for use in filing a certification and petition under 37 CFR 41.3 under the Expedited Patent Appeal Pilot. Form PTO/SB/438 is available on the USPTO’s Internet Web site on the micro site for USPTO patent-related forms (<http://www.uspto.gov/patent/patents-forms>). Form

PTO/SB/438 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). See 5 CFR 1320.3(h). Therefore, this notice does not involve information collection requirements which are subject to review by OMB.

No petition fee is required. The \$400.00 fee for a petition under 37 CFR 41.3 is hereby sua sponte waived for any petition to make an appeal special under the Expedited Patent Appeal Pilot.

The withdrawal of an appeal in an application or ex parte reexamination may not form the basis for more than one petition to make special under the Expedited Patent Appeal Pilot, including a petition to make special for a subsequent appeal in the application for which a petition to make an appeal special was granted, or any continuing application of the application for which a petition to make an appeal special was granted.

MPEP § 1203 provides that an application made special and advanced out of turn for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. An appeal that is accorded special status for decision on an appeal to the Board under the Expedited Patent Appeal Pilot will be advanced similarly out of turn for a decision on the appeal by the Board. The difference between the Expedited Patent Appeal Pilot and an application made special under 37 CFR 1.102 and MPEP § 708.02 is that an application in which an appeal is accorded

special status for decision on an appeal to the Board under the Expedited Patent Appeal Pilot will not have a special status under CFR 1.102 and MPEP § 708.02 after the decision on the appeal.

The goal for handling an application in which a petition to make an appeal special under the Expedited Patent Appeal Pilot is filed is as follows: (1) rendering a decision on the petition to make the appeal special no later than two (2) months from the filing date of the petition; and (2) rendering a decision on the appeal no later than four (4) months from the date a petition to make an appeal special under the Expedited Patent Appeal Pilot is granted. The current pendency of decided appeals in applications, for those appeals decided this fiscal year, ranges between an average of 24.7 months for appeals from applications assigned to Technology Center 1700 and an average of 32.5 months for appeals from applications assigned to Technology Center 1600, and is shown for each Technology Center in the following table:

Technology Center	Average Months From Docketing Notice to Board Decision
1600	32.5
1700	24.7
2100	32.0
2400	32.0
2600	31.7
2800	26.9
2900	26.1
3600	31.7
3700	29.9

Ex parte reexamination proceedings, including any appeal to the Board, are conducted with special dispatch within the USPTO. See 35 U.S.C. 305. The current average pendency of appeals in ex parte reexaminations, for those appeals decided this fiscal year, is 5.7 months. The USPTO is not making the Expedited Patent Appeal Pilot applicable to appeals in ex parte reexaminations as these appeals already are handled with special dispatch, and the petition evaluation process would only delay the Board decision in an appeal in an ex parte reexamination.

The process for handling an application in which an appeal is withdrawn is set forth in MPEP § 1215. Appellants should specifically note that an application having no allowed claims becomes abandoned upon withdrawal of an appeal, and that claims indicated as allowable but for their dependency from rejected claims are not considered allowed claims but are treated as rejected claims. See MPEP § 1215.01.

The filing of a request for continued examination under 37 CFR 1.114 in an application on appeal to the Board is treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. See 37 CFR 1.114(d). A request for continued examination may be filed with a petition under 37 CFR 41.3, and the withdrawal of an appeal in that application resulting from the filing of such a request for continued examination may form the basis for a petition to make special based upon the Expedited Patent Appeal Pilot. The withdrawal of an appeal resulting from the filing of a

request for continued examination **prior** to the filing of a petition under 37 CFR 41.3, however, may **not** form the basis for a petition to make special based upon the Expedited Patent Appeal Pilot.

As discussed previously, an application having no allowed claims becomes abandoned upon withdrawal of an appeal. Any request for continued examination, however, must be filed prior to the abandonment of the application. See 37 CFR 1.114(a)(2). Thus, an appellant wishing to file a request for continued examination in an application in which there is an appeal to be withdrawn under the Expedited Patent Appeal Pilot must, if there are no allowed claims, file the request for continued examination with the petition under 37 CFR 41.3 to ensure that the request for continued examination is filed prior to the abandonment of the application that will result from the dismissal of the appeal.

A request for continued examination must include a submission. See 37 CFR 1.114(a) and (c). An appeal brief, or a reply brief, or related papers, are not considered a submission under 37 CFR 1.114. See 37 CFR 1.114(c). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. See MPEP § 706.07(h).

The Expedited Patent Appeal Pilot is being adopted on a temporary basis until two thousand (2,000) appeals have been accorded special status under the Expedited Patent

Appeal Pilot, or until June 20, 2016, whichever occurs earlier. The USPTO may extend the Expedited Patent Appeal Pilot (with or without modification) on either a temporary or permanent basis, or may discontinue the Expedited Patent Appeal Pilot after June 20, 2016, depending upon the results of the Expedited Patent Appeal Pilot. Additional information concerning the Expedited Patent Appeal Pilot, including statistical information concerning the Expedited Patent Appeal Pilot and pendency of appeals before the Board, can found on the USPTO Internet Web site at:

<https://www-cms.uspto.gov/patents-application-process/patent-trial-and-appeal-board/expedited-patent-appeal-pilot>.

Date: June 10, 2015.

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

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