



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2020-0027]

Fast-Track Appeals Pilot Program

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is initiating the Fast-Track Appeals Pilot Program to provide for the advancement of applications out of turn in ex parte appeals before the Patent Trial and Appeal Board (PTAB). An appellant who has filed an ex parte appeal and received a notice that the appeal has been docketed may file a petition, accompanied by a petition fee, to expedite the review of his or her appeal. The Fast-Track Appeals Pilot Program sets a target of reaching a decision on the ex parte appeal within six months from the date an appeal is entered into the Pilot Program.

DATES: *Applicability Date:* [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]. *Duration:* The Fast-Track Appeals Pilot Program is offered on a temporary basis, and petitions to request inclusion of an ex parte appeal in the Pilot Program will be accepted until 500 appeals have been accorded fast-track status under the program, or until **July 2, 2021**, whichever occurs earlier. The USPTO may extend the Fast-Track Appeals Pilot Program (with or without modification) on either a temporary or a permanent basis, or may discontinue the program for either insufficient usage or after **July 2, 2021**.

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

SUPPLEMENTARY INFORMATION:

Background

Appeals to the PTAB are normally taken up for decision in the order in which they are docketed. *See* USPTO Standard Operating Procedure 1 (Sept. 20, 2018), available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/resources>. However, a small number of appeals are advanced out of turn due to a special status. For example, reexamination proceedings, which are handled by the USPTO with “special dispatch,” and reissue applications are treated as special throughout their pendency, including during appeal. *See* Manual of Patent Examining Procedure (MPEP) 708.01. Applications that have been “made special” during examination through a petition based on the age or health of an applicant, or for other reasons listed in 37 CFR 1.102 (a)–(d), also maintain their special status through any appeal. *See* MPEP 1203(II). Furthermore, for the same reasons, an appellant may also petition the PTAB to have an application on appeal made special. *See id.* Currently, about 1.1% of appeals are given a special status through one of the above methods.

The America Invents Act created a mechanism for the prioritized examination of patent applications, which permits an applicant to advance an application out of turn (i.e., accord special status) for examination by filing a request accompanied by the appropriate fees. *See* Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America

Invents Act, 76 FR 59050 (Sept. 23, 2011) (Track I Notice). In view of the program's popularity and high demand, the USPTO recently increased the yearly number of requests that may be granted from 10,000 to 12,000. *See* Increase of the Annual Limit on Accepted Requests for Track I Prioritized Examination, 84 FR 45907 (Sept. 3, 2019). In FY 2019, prioritized examination was granted for approximately 2.7% of the total number of applications filed. Prioritized examination status, however, does not carry through to any appeal from a final rejection. *See* 76 FR 59051.

In view of the success and popularity of prioritized examination, the PTAB is adopting, on a temporary basis, the Fast-Track Appeals Pilot Program, under which an appellant may have any ex parte appeal to the PTAB accorded fast-track status by filing a petition accompanied by a fee. Under the Pilot Program, the PTAB will endeavor to issue a decision on an ex parte appeal within six months from the date the appeal is entered into the program. Currently, the average appeal pendency is about 15 months. *See* PTAB Statistics, available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/statistics>. Thus, fast-track decisions on ex parte appeals under this Pilot Program may hasten patentability determinations on new inventions and the pace at which products or services embodying these inventions are brought to the marketplace, thus spurring follow-on innovation, economic growth, and job creation.

The Fast-Track Appeals Pilot Program will accept petitions for advancing out of turn and according fast-track status to ex parte appeals for up to one year from the effective date of the program or until 500 appeals have been accorded fast-track status under the program,

whichever occurs earlier. The threshold of 500 granted petitions corresponds to approximately 8% of the total number of new appeals received in the average fiscal year and was chosen in accordance with maintaining the PTAB's overall decision pendency goals.

The USPTO will evaluate the Pilot Program at the conclusion of this one-year period or 500-appeal threshold to determine if it should be made permanent. Likewise, the USPTO will consider what changes, if any, would be required to provide a sustainable mechanism for some number of ex parte appeals to be advanced out of turn without adversely affecting the timeliness of providing decisions on the other appeals before the PTAB.

If the USPTO finds that the Fast-Track Appeals Pilot Program adversely impacts the pendency of other appeals at any point in time during the program's operation, then the USPTO may modify or terminate the Pilot Program. Moreover, if the Pilot Program is not sufficiently used, it may be modified or terminated.

Requirements for Entry Into the Pilot Program

The PTAB will accord fast-track status to a pending ex parte appeal in accordance with the following conditions:

(1) The application must be an original utility, design, or plant nonprovisional application. The Fast-Track Appeals Pilot Program is not available for applications or proceedings that are already treated as special during appeal, such as reissue applications, reexamination proceedings, appeals made special due to the age or health of an applicant,

or appeals subject to any other pilot program that advances an appeal out of turn.

See MPEP 708.01 for a complete list of cases that are treated as special.

(2) Petition Requirements

A petition under 37 CFR 41.3 must be filed in the application involved in the ex parte appeal for which fast-track status is sought and must identify that application and appeal by application number and appeal number, respectively. *See* MPEP 502.05. The petition may be submitted via: (1) the USPTO patent electronic filing systems (EFS-Web or Patent Center); (2) the U.S. Postal Service by Priority Mail Express under 37 CFR 1.10 or with a certificate of mailing under 37 CFR 1.8; or (3) hand-delivery to the USPTO Customer Service Window (MPEP 501). Electronic submission of a petition is preferred for faster petition processing. In addition, the appeal for which fast-track status is sought must be an appeal for which a notice of appeal has been filed under 37 CFR 41.31 and an appeal docketing notice has been mailed by the PTAB.

The USPTO has created a form-fillable Portable Document Format (PDF) “Petition—Fast-Track Appeals Pilot Program” (Form PTO/SB/451) for use in filing a certification and petition under 37 CFR 41.3 for the Fast-Track Appeals Pilot Program. Form PTO/SB/451 is available on the USPTO’s website (<http://www.uspto.gov/patent/patents-forms>). Form PTO/SB/451 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 that are subject to review by the Office of Management and Budget. Appellants are recommended

to use, but are not required to use, Form PTO/SB/451 when petitioning for entry into the Fast-Track Appeals Pilot Program. Any petition filed by any means other than Form PTO/SB/451 must still contain the required information.

(3) Signature Requirements

The petition under 37 CFR 41.3 must be signed by an applicant who is prosecuting the applicant's own case under 37 CFR 1.31 (except that a juristic entity must be represented by a registered practitioner even if the juristic entity is the applicant), a registered practitioner who has a power of attorney under 37 CFR 1.32, or a registered practitioner who has authority to act under 37 CFR 1.34, in order for the application involved in the appeal to be accorded fast-track status.

(4) Fee

A petition fee of \$400 under 37 CFR 41.20(a) is required at the time the petition is filed. Due to statutory limitations on fee collection, the USPTO may not refund the petition fee once collected. *See* 35 U.S.C. 42(d) and 37 CFR 1.26(a) (permits refunds only for fees "paid by mistake or any amount paid in excess of that required"). Thus, no refund will be granted for any petition that does not meet the requirements set forth above and/or is not granted for any other reason.

(5) Limit on Number of Ex Parte Appeals Accorded Fast-Track Status

One purpose of the Fast-Track Appeals Pilot Program is to gauge the public's interest in the ability to obtain a speedier resolution of an ex parte appeal. The number of granted

petitions in the Fast-Track Appeals Pilot Program during the one-year program period is limited to 125 granted petitions per quarter, and a total of 500 granted petitions. A “quarter” under this Pilot Program is defined as a three-month period measured from the applicability date of this Notice. For example, if this Notice has an applicability date of June 1, then a “quarter” under this Pilot Program spans the three months from June 1 to August 31.

The thresholds of 125 and 500 granted petitions have been chosen to allow for robust participation in the Fast-Track Appeals Pilot Program without compromising the PTAB’s ability to deliver on other appeal pendency goals. The limit of 500 granted petitions corresponds to approximately 8% of the total number of new appeals received in the average fiscal year. If the Pilot Program adversely impacts the pendency of other appeals, then the USPTO may modify or terminate the Pilot Program. Additionally, if the Pilot Program is not sufficiently used, it may be modified or terminated.

Handling of Petitions in the Fast-Track Appeals Pilot Program

Petitions for entry into the Fast-Track Appeals Pilot Program will be decided in the order they are received. Petitions meeting the requirements listed above for entry into the Pilot Program will be granted, and the petitioner will be notified by a decision granting the petition to accord fast-track status. Petitions not meeting the requirements listed above for entry into the Pilot Program will be denied, and the petitioner will be notified of a decision denying the petition. A petitioner may reapply if a first petition is denied. Any second petition filed by a petitioner for the same application and same appeal covered by

a first, failed petition will not be accorded the filing date of the first petition for purposes of determining whether the second petition fell within the thresholds of 125 or 500 granted petitions.

The PTAB will communicate the number of granted petitions for fast-track appeal via the PTAB website, www.uspto.gov/PTABFastTrack, and appellants should take this information into account when deciding whether to file a petition. Consequently, appellants should consult the PTAB's website for information on the status of the Fast-Track Appeals Pilot Program.

The PTAB may also exercise discretion to grant a small number of petitions in excess of the thresholds of 125 and 500 granted petitions in a given quarter or for the year, respectively. Should a significant number of petitions exceeding the quarterly threshold of 125 granted petitions be filed in a quarter, those petitions may be held in abeyance and decided, in order of receipt, in the subsequent quarter. An appeal for which a petition is held in abeyance will not be accelerated unless and until the petition is granted in the subsequent quarter.

Conduct of Fast-Track Appeals Pilot Program

(1) Time to Decision

The goal for rendering a decision on the petition to accord fast-track status to an ex parte appeal is no later than one month from the filing date of the petition. The goal for rendering a decision on the ex parte appeal is no later than six months from the date an

appeal is entered into the program, which occurs when a petition to accord fast-track status to the appeal is granted.

(2) When a Petition May Be Filed

A petition may be filed anytime between (1) the date when the PTAB issues a notice that the appeal has been docketed to the PTAB, and (2) the date at which the appellant withdraws the appeal, a final decision is rendered by the PTAB under 37 CFR 41.50, or PTAB jurisdiction ends under 37 CFR 41.35. Petitions for fast-track status may be filed for ex parte appeals regardless of whether the appeal is newly docketed or was docketed previously. If the petition complies with the formal requirements (e.g., signature, identification of application) and is accompanied by the required fee, the appeal will be given fast-track status in accordance with current procedures, including the quarterly and overall program thresholds described above.

(3) Hearings

Inclusion in the Fast-Track Appeals Pilot Program may be requested for ex parte appeals in which the appellant seeks an oral hearing before the PTAB (“heard” appeals), as well as those appeals for which no oral hearing is requested (“on-brief” appeals). Hearings in ex parte appeals accorded fast-track status under the Pilot Program will be conducted according to the ordinary PTAB hearing procedures. Appellants seeking an oral hearing should submit with the request for oral hearing any preferences as to the time, date, or location of the hearing. The PTAB will make its best efforts to schedule a hearing in accordance with such preferences, consistent with the goals of the Pilot Program. If the

PTAB is unable to accommodate an appellant's preferences, it will schedule the hearing in an available hearing room at any office, including a regional office, and at a time and date best suited to meeting the goals of the Pilot Program. If no such hearing room is available, the PTAB will schedule a hearing to be conducted by videoconference or telephone.

Because an appellant seeks a faster decision and hearing room availability is limited, an appellant in an ex parte appeal accorded fast-track status may not seek to relocate (to a different office) the hearing after receiving a Notice of Hearing. An appellant who does not wish to attend the hearing at the designated location may, however, request to attend the hearing by videoconference or telephone, in accordance with current PTAB hearing procedures. An appellant may also waive the hearing and continue under the Fast-Track Appeals Pilot Program for consideration and decision on the briefs.

An appellant may not reschedule the date or time of a hearing and remain in the Fast-Track Appeals Pilot Program. If an appellant in an ex parte appeal accorded fast-track status must reschedule the date or time of a hearing and is not willing to waive the oral hearing, then the appellant may opt out of the Fast-Track Appeals Pilot Program, thereby regaining the ability to reschedule or relocate the hearing as per ordinary PTAB hearing procedures. If an appellant opts out of the Fast-Track Appeals Pilot Program for purposes of rescheduling the date of a hearing, the appellant will not be entitled to a refund of the petition fee.

(4) Termination of Fast-Track Status Under the Fast-Track Appeals Pilot Program

Fast-track status will be maintained in an ex parte appeal from the date at which the petition for inclusion in the Fast-Track Appeals Pilot Program is granted until the PTAB's jurisdiction ends under 37 CFR 41.35(b). Activities subsequent to an appellant's withdrawal from the Pilot Program or the PTAB's decision, including any reopened prosecution, will not be treated as subject to fast-track status, nor will filing a petition for inclusion in the Fast-Track Appeals Pilot Program cause an application to be accorded fast-track status outside the jurisdiction of the PTAB. Additionally, any request by an appellant causing a delay in the conduct of the appeal, such as for an extension of time under 37 CFR 1.136(b), or for additional briefing, will be cause for removal of fast-track status without refund of the petition fee.

Status of the Pilot Program

The Fast-Track Appeals Pilot Program is being adopted on a temporary basis until **July 2, 2021** or 500 appeals have been accorded fast-track status under the Fast-Track Appeals Pilot Program, whichever occurs earlier. The USPTO may extend the Fast-Track Appeals Pilot Program (with or without modification) on either a temporary or a permanent basis or may discontinue the Pilot Program for adversely interfering with the timely processing of other appeals or insufficient usage. The USPTO will notify the public when the threshold of 500 granted petitions for the Fast-Track Appeals Pilot Program is about to be reached, and with any further relevant information, on the PTAB website at www.uspto.gov/PTABFastTrack.

Dated: June 19, 2020.

Andrei Iancu,

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

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