



## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

[Docket No.: PTO-P-2026-0199]

### PCT Informed Examination Request 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) is implementing the PCT Informed Examination Request (PIER) Pilot Program to assess the inventory and efficiency impacts of requiring an applicant to request examination in view of applicable Patent Cooperation Treaty (PCT) international phase work products. The USPTO will select certain national stage patent applications for the program. In an application selected for the program, the USPTO will issue a requirement for information referencing the applicable international phase work products and requiring the applicant to indicate whether the applicant opts to: proceed with examination (with the option to place the application in better condition for examination by filing a preliminary amendment), delay examination, or expressly abandon the application in view of the international phase work products. The applicant must respond to the requirement for information to avoid abandonment of the application. The USPTO expects that requiring applicants to indicate that examination is desired upon review of international phase work products present in the application file will contribute to efforts to reduce inventory and pendency.

**DATES:** The USPTO will select applications to participate in the PIER Pilot Program beginning **[INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]** until **[INSERT DATE TWELVE MONTHS AFTER PUBLICATION IN THE FEDERAL REGISTER]**.

The USPTO may extend the program to select additional patent applications if it determines that more information is needed to evaluate the effectiveness of the program. The USPTO may, at its

sole discretion, terminate the program for any reason, including factors such as workload and resources needed to administer the program, feedback from the public, and effectiveness of the program. If the program is terminated, the USPTO will notify the public on its website.

**FOR FURTHER INFORMATION CONTACT:** Erin M. Harriman, Senior Legal Advisor, at (571) 272-7747; Eugenia A. Jones, Senior Legal Advisor, at (571) 272-7727; or Kristie A. Mahone, Senior Legal Advisor, at (571) 272-9016, all from the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents or via email addressed to [PIERPilot@uspto.gov](mailto:PIERPilot@uspto.gov).

**SUPPLEMENTARY INFORMATION:**

The PIER Pilot Program is designed to assess the inventory and efficiency impacts of requiring applicants to request examination in view of applicable Patent Cooperation Treaty (PCT) international phase work products. The USPTO will select certain applications for the program, as identified in Part I of this notice, from the inventory of unexamined national stage applications.

For selected applications that entered the national stage under 35 U.S.C. 371, the USPTO will issue a requirement for information pertaining to the international phase work products in the national stage file. International phase work products include the International Search Report (ISR) and any opinion expressed in a Written Opinion (WO) or International Preliminary Report on Patentability (IPRP). Thus, the requirement for information will reference applicable PCT international phase work products in the application file and require the applicant to indicate, based on review of international phase work products present in the application file, whether the applicant opts to proceed with the national phase of examination, delay the national phase of examination under the program, or expressly abandon the national stage application.

If the applicant desires to proceed with examination of an application selected for the program, the applicant must submit a timely and complete reply to the requirement for information using the reply form described in Part IV of this notice. The reply form references

applicable PCT international work products and provides the applicant with the ability to indicate whether the applicant opts to: proceed with examination, delay examination for 12 months from the date of receipt of the request to delay examination, or expressly abandon the application. A delay in examination under the program provides the applicant with additional time to consider the value and commercial potential of their invention at no additional cost. If the applicant opts to proceed with examination, with or without delay, the applicant may additionally opt to place the application in better condition for examination by filing a preliminary amendment. Alternatively, if the applicant opts not to proceed with examination, the applicant may file a request to expressly abandon the application. A complete reply to a requirement for information issued under the program requesting examination will result in the application being placed on an examiner's docket.

### **Part I. Pilot Program Eligibility**

The USPTO will select certain unexamined national stage applications for the PIER Pilot Program intermittently until the close of the program. To be selected for the program, the application must be an international application that entered the national stage under 35 U.S.C. 371. Applications filed under 35 U.S.C. 111(a), including plant applications, design applications, and reissue applications, will not be selected.

Applications entered into the program are at the sole discretion of the USPTO. The USPTO will not grant any petition to participate, abstain, or be removed from the program.

### **Part II. International Phase Work Products for Applications entering the National Stage under 35 U.S.C. 371**

For selected applications that have entered the national stage, the USPTO will issue a requirement for information as discussed in Part III of this notice. Typically, a national stage application file includes the International Search Report (ISR) and the Written Opinion prepared by the International Searching Authority (WO/ISA). The ISR lists the prior art with relevancy indicators (in the form of citation categories as provided for in WIPO Standard ST. 14), and the

WO/ISA provides a preliminary, non-binding assessment of patentability in view of the ISR references. *See* sections 1893.03(e) and 1845 of the Manual of Patent Examining Procedure (MPEP) (9th Edition, Rev. 01.2024, November 2024). The national stage file may also contain any Supplemental International Search (SIS) requested by the applicant. *See* MPEP 1856. Further, if the applicant timely filed a demand for preliminary examination under Chapter II of the PCT, the International Preliminary Report on Patentability (IPRP) (Chapter II of the PCT) will also be included in the national stage file. *See* MPEP 1893.03(e).

### **Part III. Pilot Program Requirement for Information under 37 CFR 1.105**

Only national stage applications that have completed pre-examination processing will be selected for the program. In selected applications, the USPTO will issue a requirement for information under 37 CFR 1.105 that will be placed in the file. A requirement for information issued under the program is an Office action under 35 U.S.C. 132, but not a first action on the merits. The requirement for information will set a two-month period for reply, which the applicant may extend for up to six months in accordance with 37 CFR 1.136(a). *See* MPEP 704.13.

A requirement for information under the program will require the applicant to indicate whether the applicant opts to proceed with examination, delay examination for 12 months from the date of receipt of the request to delay examination, or expressly abandon the application in accordance with 37 CFR 1.138. To avoid abandonment of an application selected for the program, the applicant must submit a complete and timely reply using the USPTO form described in Part IV of this notice. A complete reply to a requirement for information requesting to proceed with examination will result in the application being placed on an examiner's docket. A complete reply requesting delay of examination will result in the application being placed on an examiner's docket after the expiration of the 12-month delay period. Thus, an applicant who desires to prosecute the application will have greater control as to when their application will be examined.

A delay of examination under the PIER Pilot Program is distinct from a suspension or deferral request under 37 CFR 1.103. The option to delay examination under the program affords the applicant a non-terminable 12-month period after the date of receipt of the request to delay examination under the program to assess the viability of the invention, without the processing fee required for a suspension or deferral of examination. The Office will treat the request for the 12-month delay of examination as a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application under 35 U.S.C. 154(b)(2)(C)(i) and (iii) and 37 CFR 1.704(c). The delay period begins on the date of the receipt of the request to delay examination and ends on the one year anniversary date of the request. In addition, the mailing of the requirement under 37 CFR 1.105 will be considered the date that the Office met the requirement of 35 U.S.C. 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1). If the applicant desires to avoid further prosecution costs, the applicant may request to expressly abandon the application under 37 CFR 1.138(a) in reply to the requirement for information. The applicant may also file a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application. However, such a petition must be submitted as a separate request (*e.g.*, form PTO/AIA/24A) accompanying the reply to the requirement for information. A petition for express abandonment under 37 CFR 1.138(c) generally will not be effective to stop publication of the application unless it is recognized by the appropriate Office personnel more than four weeks prior to the projected publication date. Where an applicant files a request to expressly abandon the application under 37 CFR 1.138(a) in reply to the requirement for information, such a request will still be granted (if properly signed) even if the petition under 37 CFR 1.138(c) cannot be granted. Because a requirement for information is an action under 35 U.S.C. 132, express abandonment under 37 CFR 1.138(d) to obtain a refund of the search and excess claims fees is unavailable. A registered practitioner acting in a representative capacity is not authorized to sign an express abandonment except when filing a continuing application. *See* 37 CFR 1.138(b).

#### **Part IV. Replying to a Pilot Program Requirement for Information**

An applicant must use form PTO/SB/478 to reply to a requirement for information under the program. If filing the PTO/SB/478 electronically in Patent Center (at <https://patentcenter.uspto.gov>), the applicant must use the document description provided on the form to ensure that the appropriate area of the USPTO is notified of the reply. Under 5 CFR 1320.3(h), Form PTO/SB/478 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995. Use of the form will enable the USPTO to quickly identify and timely process the applicant’s reply. The form will be available at: [www.uspto.gov/PatentForms](http://www.uspto.gov/PatentForms).

Form PTO/SB/478 includes a reference to applicable PCT international work products. The form also includes a series of selectable checkboxes for the applicant to indicate whether a request is being made to proceed with examination, delay examination, or expressly abandon the application. If the applicant opts to proceed with examination (including after the 12-month delay), the applicant may additionally file a preliminary amendment in compliance with 37 CFR 1.115. Alternatively, if the applicant selects the option to expressly abandon the application, it is recommended that, in addition to selecting the express abandonment checkbox, the applicant also include a separate request for express abandonment under 37 CFR 1.138, (*e.g.*, form PTO/AIA/24) to facilitate processing. As discussed above, a registered practitioner acting in a representative capacity is not authorized to sign an express abandonment except when filing a continuing application. *See* 37 CFR 1.138(b). Therefore, the only time the USPTO will accept form PTO/SB/478 with the express abandonment box selected and signed by an individual who is acting in a representative capacity is when a separate letter of express abandonment is also submitted indicating that the application is expressly abandoned in favor of a continuing application (*e.g.*, form PTO/AIA/24). In all other instances, when the express abandonment box is selected, form PTO/SB/478 must be signed by an individual authorized under 37 CFR 1.33(b)(1) or (b)(3), that is by the patent practitioner of record, or by the applicant who is not a juristic entity. *See* MPEP 711.01 for more information on express abandonment.

Additionally, as discussed above, the applicant may also file a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application. However, such a petition must be submitted as a separate request (*e.g.*, form PTO/AIA/24A). See Part V of this notice for information on treatment of an incomplete reply to a requirement for information under the program.

Prior to selecting the express abandonment checkbox (Item 2c) on the PTO/SB/478, it is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant. *See* MPEP 711.01. Note that where the applicant deliberately permits an application to become abandoned, the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as “unintentional” within the meaning of 37 CFR 1.137. *See* MPEP 711.03(c), subsection II.C.

#### **Part V. Internal Processing of an Applicant’s Reply to a Pilot Program Requirement for Information**

Failure to timely submit a complete, properly signed PTO/SB/478 will result in abandonment of the application. *See* MPEP 711.02. USPTO personnel will review PTO/SB/478 and any accompanying documents (*e.g.*, preliminary amendment, petition under 37 CFR 1.138(c)).

In order for an applicant’s reply to be considered complete, the PTO/SB/478 must be properly signed and only one of the provided checkboxes must be selected. Note that a reply under 37 CFR 1.105(a)(3) that states that the information required to be submitted is unknown to or is not readily available would not be considered a proper reply because, if the applicant has not determined whether they would like to move forward with examination, the applicant has the option to delay examination for a period of 12 months.

An incomplete or improperly signed PTO/SB/478 will be handled in substantially the same manner as an amendment not fully responsive to a non-final Office action. *See* MPEP

704.12(c) and MPEP 714.03. If an applicant's reply is a *bona fide* attempt to advance action on the application, the applicant will be notified of the deficiency and may be given a shortened statutory period of two months to provide a fully responsive reply. Extensions of this time period set by the notice of nonresponsive reply will be permitted under 37 CFR 1.136(a), but in no way can any extension carry the date for reply to this notice beyond the maximum period of six months set by statute. *See* 35 U.S.C. 133. However, any further nonresponsive reply typically will not be treated as *bona fide* and, therefore, the time period set in the prior notice will continue to run.

If the applicant has submitted a complete reply opting to proceed with examination, the application will be placed on an examiner's docket. Alternatively, if an applicant's complete reply includes a request for delay of examination, the USPTO will notify the applicant that the request to delay examination under the program has been approved. Once a request to delay examination under the program has been approved, the applicant will not be permitted to terminate the delay period early. The application will be docketed for examination after the expiration of 12 months from the date of receipt of the request to delay examination under the program.

When examining an application that entered the national stage under 35 U.S.C. 371, the examiner will consider all U.S patent applications, U.S. patent application publications, and U.S. pending applications cited in the ISR and stored in the USPTO's Image File Wrapper (IFW) system. *See* MPEP 609.03. Other cited documents will be considered by the examiner if form PCT/DO/EO/903 indicates that the ISR and the copies of such documents are present in the national stage file. *See id.* The examiner is not required to list references cited in the ISR on a PTO-892 and there is no requirement for the applicant to separately list the references. *See id.* References cited in the PCT international phase will only be printed on a resulting patent if the applicant cites the references on an IDS in compliance with 37 CFR 1.97 and 1.98. *See id.* and MPEP 609.06.

## **Part VI. Evaluation of the Pilot Program**

The pilot program is designed to assess the inventory and efficiency impacts of requesting examination in view of applicable PCT international phase work products. The USPTO plans to evaluate how requiring an applicant who desires to prosecute an application to request examination in view of international phase work products in the application file impacts an applicant's decision making and application inventory, as well as the quality and efficiency of examination. During or after the pilot program, the USPTO anticipates providing an avenue for participants to provide feedback regarding the pilot program. As applicable, the USPTO will follow the GAO's Leading Practices for Effective Pilot Design, including: (1) establishing clear objectives; (2) collecting relevant data; (3) evaluating outcomes; (4) considering scalability; and (5) ensuring stakeholder communication. *See GAO, Data Act: Section 5 Pilot Design Issues Need to Be Addressed to Meet Goal of Reducing Recipient Reporting Burden, GAO-16-438* (Washington, D.C.; April 19, 2016).

**John A. Squires,**

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

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