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# PTO Practice

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## Five Impactful USPTO Procedural Developments for Patent Practitioners

As the world pivoted to navigate obstacles brought on by the COVID-19 pandemic, the USPTO not only adapted to address the challenges, but appeared to make the most of this period by improving existing procedures. Widely publicized adjustments, such as efficiently moving 13,000 examiners and other employees to a remote working environment<sup>1</sup> and reducing the average examination time<sup>2</sup>, overshadow equally laudable advances that have resulted in more robust and streamlined examination, with a seeming aim at achieving improved customer service toward its applicants and stronger international partnerships. This article summarizes five procedural developments that have greatly impacted U.S. prosecution, and in many instances, improved the experience for USPTO customers.

### Development #1: More Robust Searching Capabilities

The Patents End-to-End (PE2E) search tool provides examiners, through a single interface, more robust searching capabilities than currently available through the antiquated Examiner Automated Search Tool (EAST) and Web-based Examiner

Search Tool (WEST) software that examiners have most recently used, first rolled out 20 years ago.<sup>3</sup>

The platform includes a Highlight Text image (HToi) tool, which allows examiners to rapidly identify the relevant language from the text, and then use a highlighting tool to place the language in the proper context in the original U.S. patent document, thus allowing examiners to appreciate the full context from which the passage originates to determine whether the snippet originating from the keyword search is actually relevant to the Applicant's claims.<sup>4</sup>

Improvements have also been made on the foreign patent literature front, as examiners now have access to more than 40 million foreign patent documents from six countries, including full images and full English language translations, through the Foreign Image and Text (FIT) database.<sup>5</sup> The USPTO expects to increase the number of jurisdictions for which this enhanced access is provided to 70 jurisdictions by April 2021, thus leading to more robust searches and consequently stronger issued patents.<sup>6</sup> The PE2E tool is expected to help the USPTO achieve gold standard status with respect to its search results.

### Development #2: COVID Relief

In addition to extending deadlines under certain circumstances, the USPTO offered several relief packages to Applicants in response to the pandemic, including the COVID-19 Deferred Fee Provisional Patent Application Pilot Program and

COVID-19 Prioritized Patent Pilot Program.

The COVID-19 Deferred Fee Provisional Patent Application Pilot Program allows Applicants to file a provisional application without fees and submit the previously due fees up to twelve months later at the time of the non-provisional filing.<sup>7</sup> The Deferred Fee Pilot Program is available for provisional applications concerning COVID-19 and for which Food and Drug Administration (FDA) approval is required. The program is currently scheduled to be available from September 17, 2020 through September 17, 2021.<sup>8</sup>

The USPTO has also offered prioritized examination for COVID-19-related inventions.<sup>9</sup> Under the COVID-19 Prioritized Examination Pilot Program, small and micro entity applicants qualifying for the program are afforded expedited examination, without the typically-required payment fees, with the goal of reaching a final disposition within six months. Similar to the Deferred Fee Pilot Program, the claims must be directed to a product or process subject to FDA approval for the treatment of COVID-19. The program began on July 13, 2020, and was initially set to extend until the USPTO granted 500 requests under the pilot program.<sup>10</sup>

No fees are required for either program.

The USPTO also formed a COVID-19 Response Resource Center, a landing page aimed at providing all of the USPTO's COVID-19-related initiatives to assist applicants in continuing to innovate during the pandemic.<sup>11</sup>

### Development #3: Building Connections

The USPTO and the Mexican Institute of Industrial Property

(IMPI) collaborated on the Parallel Patent Grant Initiative, in which IMPI will expedite examination of Mexican applications for which a corresponding U.S. patent has granted.<sup>12</sup> USPTO & Mexico—Parallel Patent Grant Initiative. The program was launched as a direct result of a work-sharing agreement the two offices entered into in January 2020. The agreement is expected to benefit both innovation and economies.<sup>13</sup>

Domestically, the USPTO launched the Patents 4 Partnerships platform, a tool intended to promote licensing of available technologies.<sup>14</sup> The program's initial focus is on COVID-19-related technologies, connecting patent owners with potential licensees to help commercialize innovations.

## Development #4: Expedited Appeals

Relief has also been granted to applicants desiring to expedite the decision of ex parte appeals. Filing a request under the Fast Track Appeals Pilot Program, along with the requisite fee of \$420, grants the Applicant an opportunity to bypass the pending appeals of other applicants to obtain a decision sooner.<sup>15</sup> The Patent Trial and Appeal Board aims to provide to the program participants a decision within six

months of the grant date of the request.

The program started on July 2, 2020, with an expected trial period of one year. To control the number of such out-of-turn procedures, the USPTO has limited the number of granted petitions per quarter during the first year to 125 petitions. The PTAB, however, may grant a small number of petitions beyond this limit.<sup>16</sup>

## Development #5: Reallocating Resources—Termination of First Action Interview Pilot Program

In a surprising pivot, the USPTO decided to eliminate the First Action Interview Pilot Program. The First Action Interview Program has been hailed as an opportunity to make early and meaningful contact with the examiner, and for the examiner to identify the relevant prior. In the First Action Interview Pilot Program, the Examiner issues a Pre-Interview Communication, outlining the rejections in brief, without substantial explanation, after which period the Applicant schedules an interview with the examiner and optionally submits proposed

claim amendments to address the rejections.<sup>17</sup> Many have hailed the program as a way to expedite applications, which is particularly desirable for many biopharma companies.

On December 23, 2020, Director Andrei Iancu announced the program will conclude on January 15, 2021. In a blog post, Director Iancu touted interviews as highly desirable mechanisms for streamlining prosecution and that the USPTO would continue to support interviews.<sup>18</sup> However, the blog post states that only approximately 0.2% of eligible applications have made use of the program. After twelve years, the USPTO will discontinue the program to allow for programs it considers to be more effective. Applicants may continue to file requests to participate in the First Action Interview Program until July 15, 2021, and any compliant requests filed within this period will be examined in accordance with the program provisions.<sup>19</sup>

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