In a June 15, 2015 Federal Register Notice, the USPTO announced the Expedited Patent Appeal Pilot program, which will run until 2,000 ex parte patent appeals are expedited under the program, or until June 20, 2016, whichever occurs first. This program is more like the old “Dump One, Bump One” program that permitted an applicant to obtain expedited examination of one application by abandoning another than the fee-based Track I prioritized examination program, although an appellant can file an RCE in the “dumped” appeal instead of completely abandoning the application. Other “costs” of the program are outlined below.

The Expedited Patent Appeal Pilot Program

As explained in the Federal Register Notice (“FRN”), appeals generally are taken up for review by the Board in the order in which they were docketed to the Board. This chart from the FRN shows that pharmaceutical and biotechnology applications, which typically are examined in Technology Center 1600, face the longest wait.

According to the FRN, the program “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.” However, instead of letting appellants select applications to trade places in the appeal queue, the program requires that a pending appeal be withdrawn in one application in order to expedite review of another. The program also requires that oral hearing be waived in the expedited appeal.

The basic requirements for the program are as follows:

- both applications must be either owned by the same party as of June 19, 2015, or name at least one inventor in common.
- both applications must have had docketing notices mailed no later than June 19, 2015.
- any request for oral hearing in the appeal to be expedited must be withdrawn, and the appellant must agree not to request a refund of any oral hearing fees that were paid.
- the appellant must agree not to request a refund of any appeal fees, including oral hearing fees, paid with respect to the appeal to be withdrawn.
- no other fee is required

The FRN cautions that if the application of the appeal to be withdrawn is not to be abandoned, an RCE should be filed in that application at the same time the petition to expedite is filed, and reminds applicants that an RCE must include a “submission,” such as a paper reiterating or incorporating by reference the arguments presented in the appeal brief.

The FRN sets forth the following goals for expedited appeals:
• Rendering a decision on the petition to make the appeal special no later than 2 months from filing.
• Rendering a decision on the appeal no later than 4 months from the date the petition was granted.

Costs of the Expedited Patent Appeal Pilot Program

Although the FRN states that the usual $400 fee for a petition to make special is “waived” under the program, because the USPTO will not refund the appeal fees paid for the withdrawn appeal or any oral hearing fees paid in either appeal, the USPTO will be pocketing far more than $400 per petition. Since March 19, 2013, large entity appellants have paid a $2000 fee to have their applications transferred to the Board and a $1300 fee to support a request for oral hearing. Thus, a petition to make special under the Expedited Patent Appeal Pilot Program could cost an appellant $4600 in lost fees.

A more worrisome cost of the program is the requirement to waive oral hearing. Maybe my concern is misplaced, but I am reluctant to give up an opportunity to explain my position to the Board and answer the judges’ questions in exchange for a quicker decision.

Another cost of the program that is not addressed in the FRN is the impact on Patent Term Adjustment for the application with the withdrawn appeal. An application in which an appeal is decided favorably can earn PTA for the time spent on appeal, but if an appeal is withdrawn prior to a favorable Board decision, all of the time spent on appeal up until that point will be lost.

An Age-Old Alternative to the Patent Appeal Pilot Program

Although not available for every application, applicants should remember that an application can be accorded “special” status through the appeal stage based on the age of the inventor, if any inventor is at least 65 years old. For other cases, a better way to reduce the appeal backlog would be to conduct a more thorough assessment of rejections at the pre-appeal brief review and appeal conference stages, to ensure that only strong rejections are sustained for review by the Board.

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