New USPTO Expedited Patent Appeal Pilot Program

Friday, June 19, 2015

On June 15, 2015, the United States Patent and Trademark Office ("USPTO") issued Notice in the Federal Register announcing a new pilot program, the Expedited Patent Appeal Pilot. Under the program 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 of another application in which an ex parte appeal is also pending before the Board. According special status is a procedure under which an application is advanced out of turn. A stated goal of the Expedited Patent Appeal Pilot is to reduce the backlog of appeals pending before the Board. The pilot program also will allow appellants having multiple ex parte appeals pending before the Board to have greater control over the priority with which their appeals are decided. Petitions can be filed to participate in the pilot program until June 20, 2016, or until 2,000 petitions are granted, whichever occurs first.

The Board normally takes up appeals for decision in the order in which they are docketed. Under the USPTO’s traditional protocol for advancing appealed applications out of turn, special status may be accorded if the applicant files a petition that demonstrates a sufficient showing as to why special status is appropriate. See 37 C.F.R. § 1.102 and MPEP § 708.02. For example, applications with inventions of peculiar importance to public service – the invention will material enhance the quality of the environment, contribute to the development or conservation of energy resources, or contribute to countering terrorism – can be petitioned to receive special status. Under the Expedited Patent Appeal Pilot, however, an appellant may now have one ex parte appeal advanced out of turn in exchange simply for withdrawing the ex parte appeal of another application.

Under this new program, the USPTO will accord special status to a pending appeal under five conditions: (i) the electronic filing of a certification and petition under 37 C.F.R. § 41.3 identifying the application and appeal for which special status is sought and waving any requested oral hearing and any associated fee paid; (ii) identifying and requesting to withdraw the appeal in another application or ex parte reexamination and waving any fees paid in connection with the appeal to be withdrawn; (iii) both identified appeals docketed with the Board before June 19, 2015; (iv) both identified appeals name at least one common inventor or are owned by the same party as of June 19, 2015; and (v) the registered practitioner submitting the certification and petition has a power of attorney (37 C.F.R. § 1.32), or has authority to act (37 C.F.R. § 1.34), for both identified applications. To assist in the filing of the petition, the USPTO has created an informative web page and Form PTO/SB/438.

Other notable aspects of the program are as follows: (i) waiver of the typically-required $400 petition fee, (ii) a withdrawn appeal can be the basis of only one petition to make special, (iii) an appealed application accorded special status under the Expedited Patent Appeal Pilot will not have a special status under 37 C.F.R. § 1.102 and MPEP § 708.02, the application will not continue to be special throughout its entire course of prosecution at the USPTO, (iv) the program does not apply to appeals in ex parte reexaminations, and (v) the process for handling an application of a withdrawn appeal under the pilot program will follow that which is set forth in MPEP § 1215, including abandonment of any such application having no allowed claims.
As for time-saving benefits afforded by jumping an appeal ahead of turn using this new pilot program, the USPTO
aims to (i) render a decision on the petition within two months from its filing date; and (ii) render a decision on the
appeal within four months from the date the petition is granted.

©1994-2019 Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. All Rights Reserved.