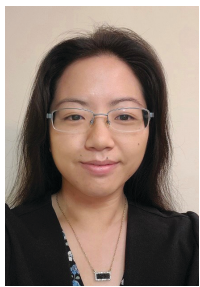


First-time filer expedited examination pilot program | IP Frontiers

■ Christina E. Brule

The United States Patent and Trademark Office (“USPTO”) launched the First-Time Filer Expedited Examination Pilot Program (“Program”) on March 9, 2023. The Program is one of several initiatives developed by the USPTO and its Council for Inclusive Innovation (“CI²”) to promote diversity within the innovation ecosystem.



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Generally, under normal examination, non-provisional patent applications are examined in the order in which they were filed. Under normal examination, a first Office Action is typically issued between 16 to 20 months from the filing date of the non-provisional patent application. However, an application may be accorded special status and examined out of turn when an applicant’s petition to make special or re-

quest for prioritized examination is granted. This new Program will reduce the time to a first Office Action.

Of the new Program, Kathi Vidal – Under Secretary of Commerce for Intellectual Property and Director of the USPTO – stated:

“This new initiative is another way we are working through our Council for Inclusive Innovation to lift independent inventors and small business owners – including those from underrepresented communities – who are new to the patent process and provide them with resources and assistance they need to protect patentable innovations.

“By accelerating the examination process, it is our hope that expedited feedback from the agency’s initial review of the application will allow them to make key business decisions at an earlier stage as we work together to bring more innovation to impact.”

ELIGIBILITY REQUIREMENTS

To qualify for the program, the applicant must make three certifications. First, the applicant must certify that the inventor or inventors have not been named as an inventor on any other U.S. non-provisional application. This is more stringent than the related requirement to qualify for micro entity status, where the applicant and the inventor must not be named as inventor on more than four previously filed applications.

Second, the applicant must certify that the applicant and inventor or inventors qualify for micro entity status under the gross income basis requirement. Under the gross income basis, (a) the applicant must qualify as a USPTO-defined small entity; (b) neither applicant nor the inventor nor a joint inventor had a gross income in the previous year from when the fee(s) is paid of more than the “Maximum Qualifying Gross Income,” which is three times

the median household income; and (c) neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation to assign, grant, or convey, a license or other ownership interest to another entity that does not meet the same “Maximum Qualifying Gross Income” limit.

Third, the applicant must certify that the inventor or inventors are reasonably trained on the basics of the USPTO’s patent application process. A list of “exemplary training resources” are provided by the USPTO at <https://www.uspto.gov/First-TimePatentFiler>.

QUALIFYING APPLICATIONS

The Program is available for original, non-continuing, non-provisional utility applications filed under 3 U.S.C. §111(a). Further, a previously filed application may be eligible for this Program if an Office Action has not yet been issued and the applicant, inventors, and application otherwise meet all other requirements. Moreover, there is no additional filing fee for the petition to make special under this Program.

Additional requirements include the following: (i) the application must be filed electronically via Patent Center; (ii) the abstract, specification, and

claim(s) must be provided in DOCX format; (iii) the petition to make special under this Program should be filed once the application is complete under 37 CFR 1.51(b); (iv) the claims may not include more than three independent claims, more than 20 claims total, or any multiple dependent claims; and (v) form PTO/SB/464 must be filed.

An application is considered complete under 37 CFR 1.51(b) if the submission to the USPTO includes (1) a specification, (2) drawings if necessary, (3) at least one claim, (4) an oath or declaration in compliance with 37 CFR 1.63, and (5) payment of all appropriate fees, including the basic filing, search, and examination fees, prior to or concurrently with filing the petition to make special under this program.

OPPORTUNITY TO CORRECT DEFICIENCIES

If a petition is found to not comply with the requirements, it will be dismissed. However, if each deficiency is correctable, the applicant has one opportunity to correct the deficiencies and file a new petition. The deficiencies that are correctable include:

- not using form PTO/SB/464;
- not filing the petition via Patent Center;

- not signing the petition according to 37 CFR 1.33(b);
- filing more than 20 claims total;
- filing more than three independent claims;
- filing any multiple dependent claims; and
- not properly establishing micro entity status using form PTO/SB/15A.

Examples of non-correctable deficiencies include the following:

- the initial petition was not filed before a first Office Action was issued in the application;
- the inventor or, where there are joint inventors, at least one joint inventor has been named as an inventor on a previously filed non-provisional application; and
- the application was previously granted special status.

The USPTO will accept petitions to make special under this program until March 11, 2024, or until 1,000 patent applications have been granted special status under this program, whichever occurs earlier.

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