

# Pilot Program Options

The U.S. Patent and Trademark Office (USPTO) is facing a growing backlog of more than 700,000 patent applications. On average, it currently takes about 25 months after the filing of an application for examination to begin. Once examination begins, an additional 10-36 months may be necessary for an application to issue as a patent. In cases where an application must go through the appeals process within the USPTO, the process can take as long as 53 additional months.

The USPTO has initiated a number of pilot programs and other proposals that are geared toward reducing both the backlog and pendency of application processing. These include the following:

- First-Action Interview Pilot Program
- Ombudsman Pilot Program
- Green Technology Pilot Program
- Peer Review Pilot Program
- Patent Prosecution Highway Pilot Program
- Missing Parts Pilot Program
- Patent Application Backlog Reduction Stimulus Plan
- Proposal to Extend Terms of Provisional Applications
- Proposed Three-Track System

These programs and proposals each present different options to accelerate the examination process and reduce the number of applications that enter examination.

## First-Action Interview Pilot Program

The First-Action Interview Pilot Program allows applicants to conduct an interview with examiners before a First Office Action is prepared (normally the beginning of examination). Initially launched in April 2008 and limited to computer-related inventions, the program was enhanced and extended to additional technologies in October 2009.

Under the enhanced program, an eligible applicant can file a request to participate in the program. Approval is at the discretion of the examiner; once approved, the examiner will conduct a prior art search and provide the applicant with a pre-interview communication, which is a condensed preview of objections or rejections proposed against the claims.

Within 30 days from the issue date of the pre-interview communication, the applicant must either choose not to have a first-action interview with the examiner or schedule the interview. If an interview is conducted and agreement is reached, the applica-

tion will be allowed. If an agreement is not reached or an interview is not conducted, a First-Action Interview Office Action will be entered and the applicant will have a limited time to reply.

## Ombudsman Pilot Program

The Ombudsman Pilot Program allows applicants experiencing problems during the processing of applications to contact an ombudsman representative “if the normal channels have not been successful.” The ombudsman representative will call the applicant within one day for assistance in resolving the problem.

As stated in a USPTO press release, “The Ombudsman Pilot Program does not replace other existing resources available to patent applicants, attorneys or agents.... The ombudsman should only be contacted if an applicant, attorney or agent feels that examination has stalled and that their efforts to move their application forward through the normal channels (e.g., contacting the examiner or supervisory patent examiner) have not been effective.”

## Green Technology Pilot Program

The Green Technology Pilot Program allows applicants to accelerate the examination of unexamined applications that pertain to “green technologies.” To participate in the program, an applicant must file a petition (no fee required) and substantiate that the invention pertains to environmental quality, energy conservation, development of renewable energy resources or greenhouse gas. If the applicant’s petition is granted, the application will be accorded special status and advanced out of turn for examination.

## Peer Review Pilot Program

The Peer Review Pilot Program involves the use of an Internet-based review process in which the public is allowed to review volunteered published patent applications and submit technical references and comments on what they believe to be the best prior art to consider during the examination. Patent examiners can then use (and supplement) the submitted prior art to evaluate patentability of an application during the examination process.

This program was initially limited to computer-related inventions when it launched in June 2007. It was expanded in October 2010 to include applications in biotechnology, bioinformatics, telecommunications and speech recognition.

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# IP IN DEPTH

## Patent Prosecution Highway Pilot Program

The Patent Prosecution Highway (PPH) Pilot Program is based on the recognition that many large companies file corresponding patents in several countries simultaneously. The PPH program allows participating patent offices in different countries to benefit from work that was previously done by another country's patent office, with the goal of reducing examination workload.

Under the PPH program, when an applicant obtains a favorable examination in an office of first filing, they can request that the other participating countries accelerate the examination of the corresponding claims.

## Missing Parts Pilot Program

The Missing Parts Pilot Program allows an applicant to delay the payment of non-provisional application search and examination fees (currently \$760 for a large entity) for up to 12 months from the filing date of

a non-provisional application that claims priority to a provisional application.

## Patent Application Backlog Reduction Stimulus Plan

The Patent Application Backlog Reduction Stimulus Plan allows a small entity inventor who has more than one pending, unexamined application to abandon one application in exchange for another application being advanced out of turn (accorded special status).

## Proposal to Extend Terms of Provisional Applications

The Proposal to Extend Terms of Provisional Applications seeks to extend the term of a provisional application to 24 months. Currently, a provisional application has to be converted into a non-provisional application within 12 months.

## Proposed Three-Track System

The Proposed Three-Track System seeks

to create a three-track process from which applicants can choose how quickly they want their applications processed. One track will give applicants a "prioritized examination." The fee for this track will be set to cover the cost of expediting the examination and be high enough to deter inventors from using this track for all their patent applications. The second track will be the USPTO's traditional examination timeline. The third track would allow applicants to delay examination for up to 30 months.

## Careful Consideration

Each of these pilot programs and proposals has benefits and disadvantages. In view of the fact that a number of the pilot programs that were initiated some time ago have repeatedly been extended and expanded, it is reasonable to believe that at least some of these programs will be available for patent applicants for some time to come. 🌐