

# Merchant & Gould

An Intellectual Property Law Firm

## **New USPTO Pilot Program Concerning Public Submission of Peer Reviewed Prior Art**

The USPTO recently re-launched its Peer Review Pilot Program, under which participating patent applications are examined earlier than their normal turn. By participating in this program, the time it takes for an application to receive a first Office Action can be reduced by at least six months, or even longer if participation is paired with a request for early publication. In exchange, the applicant must submit the application for open review by the public and must consent to public submissions of prior art and associated comments.

More specifically, the program permits any member of the public to identify prior art references believed to be relevant to a participating application, and then upload those references in association with the application on a publicly available website (<http://www.peertopatent.org>). Comments, annotations, and voting on the merits of a reference are also permitted. Of the submitted references, only the six most relevant will be given to the USPTO for review by the examiner. The review period (including any discussion and ratings of the references) typically lasts 90 days, after which the public cannot intervene in the examination of the application.

### **Requirements for Participation**

To participate in the program, a patent applicant must file a request form certifying that:

- (a) the application is unpublished or has been published no more than a month before the filing of the request;
- (b) the claimed subject matter is classified in at least one eligible U.S. patent class/subclass, which includes computer architecture, software and information security, business methods and e-commerce, telecommunications, carbon compounds, biopharmaceuticals, molecular biology and microbiology, organic compounds, speech signal processing, linguistics, language translation, and audio codex, among others;<sup>1</sup>
- (c) the applicant agrees to full participation in the program; and
- (d) the applicant or applicant's assignee has not previously submitted more than 25 applications for participation in the program.

Additionally, the patent applicant must consent to the submission of up to six publications by third parties during a window of 18 weeks following publication of the application. A submission may include annotations as well as comments describing the relevance of the submitted document to the participating application.

### **Potential Advantages**

1) Reduction of pendency time: As mentioned above, pendency is reduced by at least six months. This may be more important for inventions with a time-limited useful life. For longer life inventions, such as drug products, this advantage should be weighed against the availability of patent term adjustment that gives patent term back to the applicant in order to compensate for prosecution delays by the USPTO.

<sup>1</sup> Eligible classes/subclasses are listed at [www.uspto.gov/patents/init\\_events/class\\_subclasses\\_FY2011pilot.jsp](http://www.uspto.gov/patents/init_events/class_subclasses_FY2011pilot.jsp).

2) Low effort by and cost to the applicant: In contrast with another established acceleration procedure (petition to make special), this pilot program does not require the applicant to conduct a prior art search, submit references deemed most closely related to the claimed subject matter, or provide a report discussing the relevance of each reference in detail. Also, the program does not require the applicant to pay a petition fee.

3) Potentially higher quality of examination: Because the pilot program may expose the application to prior art references that might not otherwise be considered by an examiner, the resulting patent may be stronger. This can reduce the chance of an important reference being identified later and threatening the validity of an issued patent.

### **Potential Disadvantages**

It is not known how the USPTO will react to comments submitted by competitors, and whether or what extent an examiner may be swayed or even misled by such comments. According to the USPTO, only 189 applications were volunteered to participate in the previous pilot program that ran from June 2007 to June 2009, during which 603 pieces of prior art were submitted by more than 500 reviewers. Thus, the waters of this program remain largely untested.

### **Duration of the Pilot Program**

The current pilot program began on October 25, 2010 and will continue until September 30, 2011 or until the limit of 1,000 participating applications has been reached. As of this writing, less than 40 patent applications have been accepted.

*This communication is provided as a general informational service to clients and friends of Merchant & Gould P.C. It should not be construed as, and does not constitute, legal advice on any specific matter, nor does this message create an attorney-client relationship. These materials may be considered attorney advertising in some states. Please note that any prior results discussed in this material do not guarantee similar outcomes.*