

IP Alert | Nuts and Bolts of the USPTO's Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

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Beginning on February 1, 2022, the USPTO will invite qualified applicants to participate in the Deferred Subject Matter Eligibility Response Pilot Program (DSMER) Pilot Program (87 FR 776). Under this program, an applicant is permitted to defer responding to 35 USC 101 subject matter eligibility (SME) Alice rejections until the earlier of final disposition of the application, or the withdrawal or obviation of all other outstanding rejections—but an applicant must still file a reply to every Office action mailed regarding the application. The DSMER Pilot Program deviates from traditional compact prosecution because participating applicants may defer engaging examiners on SME issues until after non-SME issues have been addressed.

WHO? An application that meets the following conditions may be identified by the USPTO and invited to participate:

1. The application is assigned to a participating examiner;
2. The application must be an original nonprovisional utility application (plant and design applications do not qualify) and must not have been advanced out of turn (e.g., accorded special status under 37 CFR 1.102, fast-track examination); and
3. The claims of the application must raise both SME issues and non-SME issues that necessitate rejections, and the first Office action on the merits must make both SME and non-SME rejections—but the program does not require that any individual claim be the subject of both SME and non-SME rejections.

HOW? If the USPTO chooses to invite an application, an identification will be made in the first Office action on the merits. The applicant can accept or deny the invitation. If the applicant agrees to participate, there is no provision for them to withdraw a participating application. However, an applicant may choose, at any time, to simply not avail themselves of the program's benefit and voluntarily reply to outstanding SME rejections.

WHEN? Applicants should watch for invitations in Office actions starting Feb. 1, 2022. The program ends July 30, 2022.

WHY? On March 22, 2021, Senators Thom Tillis and Tom Cotton wrote to the Commissioner for Patents and suggested that the USPTO modify the compact prosecution process with respect to SME issues. The program will provide the USPTO the opportunity to evaluate how deferred applicant responses to SME rejections affect examination efficiency and patent quality.

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