

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

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Objective

- To review:
 - the purpose of the DSMER pilot.
 - the eligibility requirements for examiners and applications in the pilot.
 - how an application enters the pilot.
 - the pilot's impact on examination.

Deferred Subject Matter Eligibility Response pilot - purpose

- To determine whether deferring response to subject matter eligibility (SME) rejection until later in prosecution and addressing non-SME rejections first might resolve 35 USC §101 issues.
- Partial waiver of 37 CFR 1.111(b); response does not need to address SME rejection to be compliant.

Eligible examiners

- Any primary examiner may participate in the pilot.
- Participation open to primary examiners in all technologies.

Patent application criteria

- Original non-provisional utility application.
- Does not claim benefit of an earlier-filed U.S. non-provisional.
 - i.e., is not a continuation, divisional, or continuation-in-part of a U.S. application.
 - National Stage Entry or continuation, divisional, or continuation-in-part of PCT is ok.
 - Claiming benefit to U.S. provisional or a prior application filed in a foreign country is ok.
- No First Action on the Merits (FAOM) mailed yet.
 - RCEs are not eligible.
- No special cases.
 - Track 1, Cancer Immunology, Patent Prosecution Highway, Petition to Make Special (MPEP 708.02) are not eligible.
- FAOM includes at least one SME rejection and at least one other rejection.
 - SME rejection may be based on any of the steps of SME analysis (MPEP 2106).



Pilot process - Overview

- Two-phase process.

Invitation phase: Examiner selects an eligible application, invites applicant to participate in the pilot.

- Applicant cannot initiate a request to participate in the pilot; the initial invitation must come from the examiner.

Examination phase: Applicant elects to participate.

- Application is only in the pilot if both parties agree.
- Once applicant elects to participate, prosecution conducted according to pilot parameters.

Pilot process – Invitation phase

- Examiner prepares FAOM, which includes at least one SME rejection and at least one non-SME rejection.
 - Complete FAOM on all issues, as usual.
- Examiner is required to include form paragraph 99.01 to invite applicant to participate in pilot.
 - Examiner has discretion on whether or not to include any particular application in the pilot.
- Invitation phase runs February 1, 2022 through July 30, 2022.

Form paragraph

¶ 99.01 Invitation to Participate in DSMER Pilot Program

Invitation to Participate in DSMER Pilot Program

The present application satisfies the criteria for participation set forth in the Federal Register Notice entitled “Deferred Subject Matter Eligibility Response (DSMER) Pilot Program.” Therefore, the examiner invites applicant to participate in the DSMER pilot program.

An applicant who accepts the invitation to participate in this pilot program must still file a reply to every Office action mailed in this application, but may defer presenting arguments or amendments in response to subject matter eligibility (SME) rejection(s) until the earlier of final disposition of the application, or the withdrawal or obviation of all other outstanding non-SME rejections. A final disposition for purposes of this pilot program occurs upon the earliest of: mailing of a notice of allowance; mailing of a final Office action; filing of a notice of appeal; filing of a request for continued examination; or abandonment of the application. Other than applicant’s ability to defer responding to SME rejections, participation in the DSMER pilot program does not alter the normal examination process (e.g., as outlined in MPEP 700), and applicant must still respond to all non-SME rejections when replying to Office actions.

Further information about the pilot program, including an explanation of the criteria for receiving an invitation, and the conditions of participation, is provided in the Federal Register Notice announcing the program, which is available on the pilot program website [LINK TO PROGRAM PAGE].

Applicant has two choices with respect to this invitation:

(1) Applicant may elect to participate in the DSMER pilot program. To effect this choice, applicant **MUST** accept this invitation by filing a completed request form PTO/SB/456 with a timely response to this Office action. The DSMER Pilot request form must be signed in accordance with 37 CFR § 1.33(b) by a person having authority to prosecute the application, and must be submitted via the USPTO’s patent electronic filing systems (EFS-Web or Patent Center). The form is available on the pilot program website [LINK TO PROGRAM PAGE]. If the form is properly completed and timely received, the application will be entered into the pilot program.

(2) Applicant may decline to participate in the pilot program. No action is required from applicant to effect this choice, because if applicant does not timely file a properly completed form PTO/SB/456, the application will not be entered into the pilot program.

Pilot process – Examination phase

- Applicant chooses whether or not to join the pilot.
 - If applicant does not join pilot, prosecution continues according to traditional procedure.
 - To join pilot, applicant timely files a properly completed form PTO/SB/456, replies to all non-SME rejections.
 - Response is compliant with 37 CFR 1.111, even though it does not address SME rejection.
 - If applicant submits PTO/SB/456 and also argues SME rejections, examiner must respond to those arguments.

PTO/SB/456

PTO/SB/456 (07-21)

CERTIFICATION AND REQUEST TO PARTICIPATE IN THE DEFERRED SUBJECT MATTER ELIGIBILITY RESPONSE (DSMER) PILOT PROGRAM	
Application No.:	First Named Inventor:
Filing Date:	Title:
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PARTICIPATION IN THE DSMER PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none">1. The above-identified application contains an outstanding Office action in which applicant was invited to participate in the DSMER pilot program.2. This certification and request form is being electronically filed using the USPTO electronic filing system (EFS-Web or Patent Center).3. I understand that to keep this application pending, I must file a reply to every Office action mailed in the application, but that participation in this program allows me to defer presenting arguments or amendments in response to subject matter eligibility rejection(s) until the earlier of final disposition of this application, or the withdrawal or obviation of all other outstanding rejections.4. Submitted herewith is applicant's reply under 37 CFR 1.111 to the outstanding Office action. Other than the deferred response to subject matter eligibility rejection(s) permitted by this program, the reply is fully responsive to the Office action.5. I agree that I will not seek special status or expedited processing of this application until final disposition is reached.	
Signature	Date
Name (Print/Typed)	Practitioner Registration Number
<p><i>Note:</i> This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.</p>	
<input type="checkbox"/> * Total of _____ forms are submitted.	

uspto

Pilot process – Examination phase

- Until applicants elect to join the pilot, examination follows traditional procedure except for the inclusion of the form paragraph.
- When preparing the second and subsequent Office actions, examiners will follow non-traditional procedures if applicant has joined the pilot.

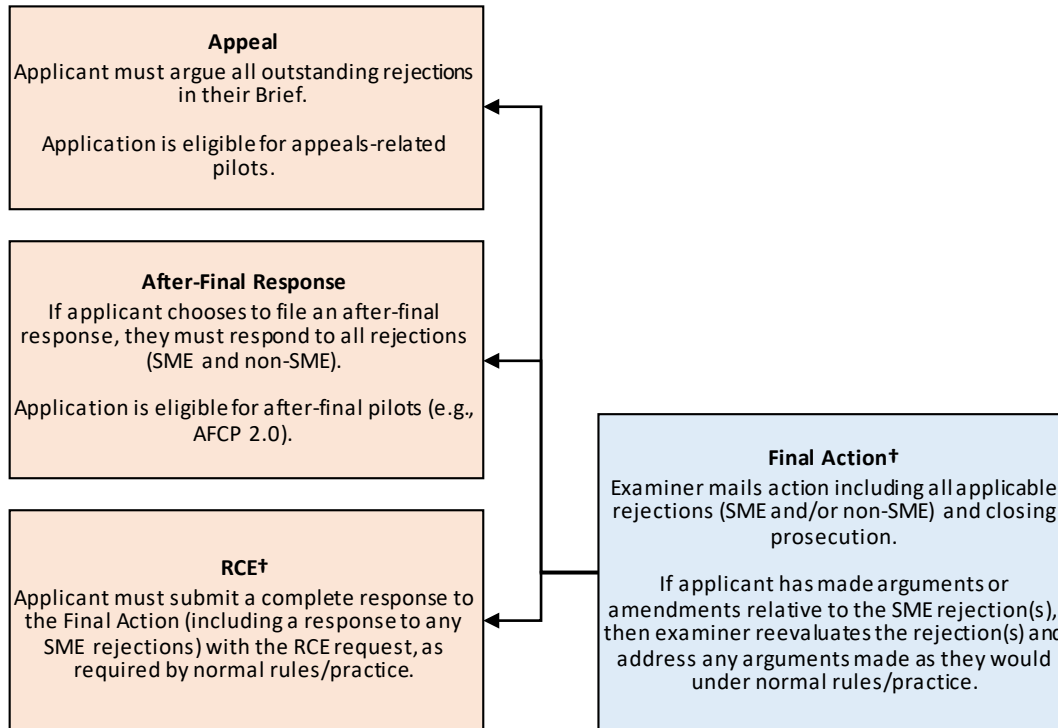
Pilot process – Examination phase

- Consider and respond to all arguments, evidence, and amendments per traditional procedure.
- Maintain, update, or withdraw SME rejection(s) as appropriate, whether or not applicant explicitly responded to the SME rejection(s).
 - Amendments, arguments, or evidence submitted in response to a non-SME rejection may have overcome the SME rejection, even if not mentioned in response as related to the SME rejection.
- Consistent with traditional practice, any discussion of SME rejection during an interview must be documented on an interview summary.

Pilot process – Examination phase

- Second action may be made final, consistent with traditional examination procedure.
- If examiner mails a second or subsequent non-final Office action, and the only remaining issues are SME rejections, applicant must respond in full even though the application has not reached final disposition.

Flow chart – After final rejection



Pilot process - After final rejection

- If SME rejection remains in final Office action, applicant must respond to the SME rejection in the next reply.
 - If a response after final rejection overcomes the SME rejection, the examiner's Office action should indicate this.
 - If a response after final does not overcome the SME rejection, examiner must respond to applicant's arguments to the SME rejection in full.

Responding to applicant after final rejection

- General principles:
 - All after final programs are available to applicant, including 37 CFR 1.116, After Final Consideration Pilot (AFCP), pre-appeal brief request for conference.
 - Examiner is eligible for time given under these programs and follows traditional procedure, except for response to SME rejection.
 - Examiner's response to applicant's SME arguments after final, whether in writing or in an interview, should be as thorough as it would be after non-final.
 - Traditional after final practice is followed for amendments and responses to non-SME rejections.
 - Because this is additional work at a time when examiners usually do not get production credit, attribute time will be given.

DSMER attribute time

- When there is an SME rejection in a final Office action, generally, DSMER attribute time is provided to the examiner to consider newly-presented SME arguments after final rejection.
 - Response after final, examiner maintains SME rejection.
 - Response after final, examiner withdraws SME rejection.
 - Time is permitted whether advisory action or allowance is mailed.
 - Pre-appeal brief review is eligible for DSMER attribute time.
 - Response to appeal brief, arguments not previously addressed in advisory action.
 - Time is permitted whether response to brief is examiner's answer, allowance, or non-final Office action.

Pre-appeal brief review practice

- If first response after final rejection is a request for pre-appeal brief review, examiner is entitled to some DSMER attribute time for considering SME arguments. This is in addition to pre-appeal time.
 - Consider applicant's arguments presented in pre-appeal.
Follow standard TC procedure for responses to pre-appeal.
- Examiner's answer following pre-appeal conference is eligible for additional DSMER attribute time even if time was also granted at pre-appeal.

Interviews after final

- Interview practice after final is unchanged
 - Use traditional criteria for granting or denying interview requests.
 - Examiner and applicant may discuss SME rejection in an interview or any other issues.
 - Document the interview consistent with MPEP 713.04.
 - Additional DSMER attribute time may be granted for consideration and documentation of SME conversations after final rejection.

When DSMER attribute time is generally not available

- Allowance before final Office action.
- Final rejection, whether or not SME rejection is present.
- Response after final, but no SME rejection in final Office action.
- RCE filed after final rejection.
- Abandonment.

Pilot survey

- For applications in the pilot program (i.e., applicant accepted examiner's invitation), examiner must complete a survey; link to survey will arrive by email.
- Examiner requests time from SPE; additional attribute time will be added to the Office action that contains first response to applicant's SME arguments.
- Survey must be done within 14 days of receiving the email to receive this additional attribute time.

Focus groups

- A selection of participating examiners may be invited to optional focus groups; non-production time will be given for attendance at a focus group.

Resources

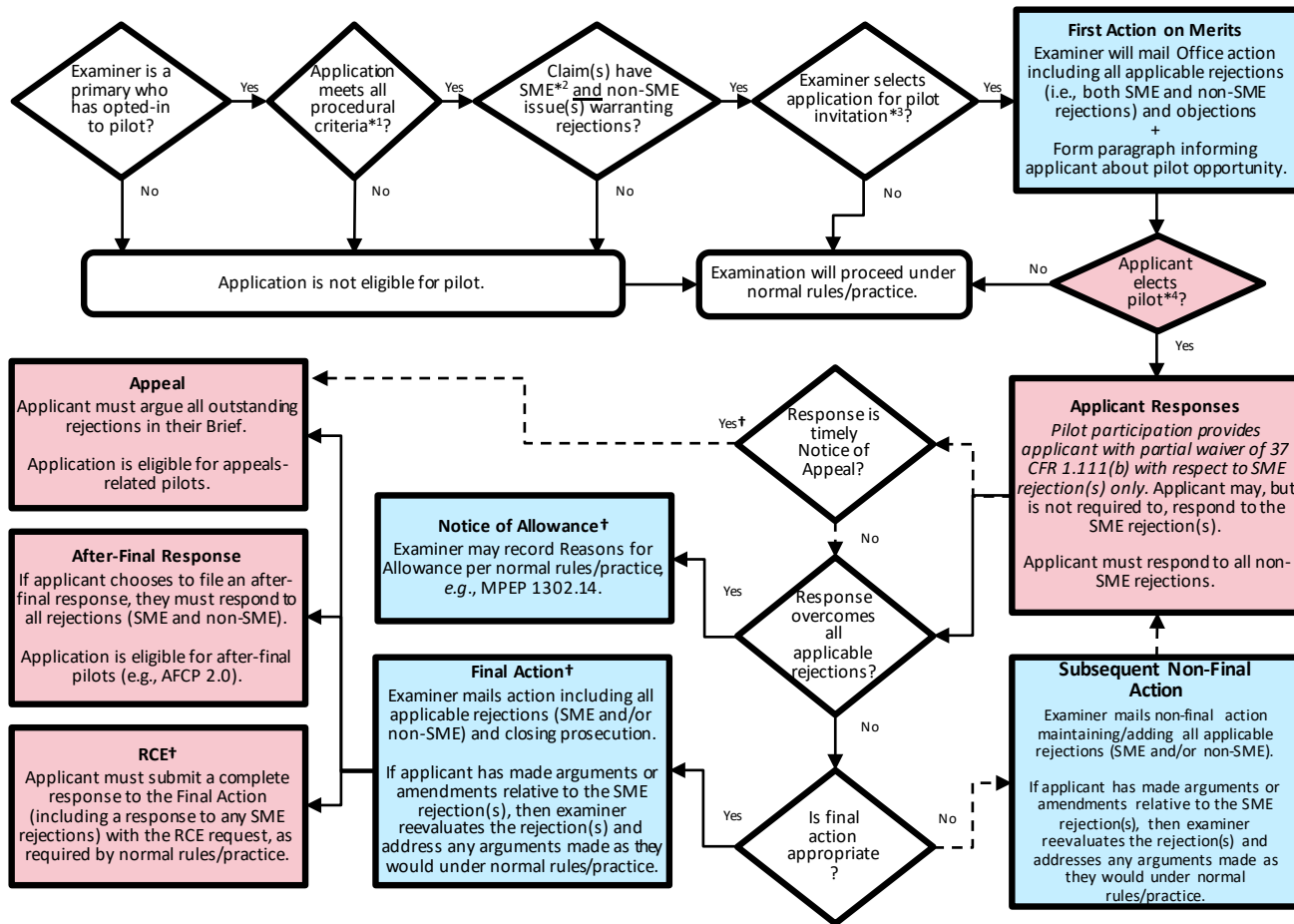
- Public Website [Deferred Subject Matter Eligibility Response \(DSMER\) pilot program | USPTO](#)
- [Federal Register: Deferred Subject Matter Eligibility Response Pilot Program](#)

DSMER team

- Leads: Dan Sullivan, 1600; Dave Wiley, 2100; Pinchus Laufer, OPLA
- TC POCs
 - ❑ 1600 – Dan Kolker
 - ❑ 1700 – Colleen Dunn
 - ❑ 2100 – Christyann Pulliam
 - ❑ 2400 – Chris Biagini
 - ❑ 2600 – Daniel Washburn
 - ❑ 2800 – Andrew Schechter
 - ❑ 3600 – Brian Epstein
 - ❑ 3700 – Unsu Jung

Appendix - Process flow chart

Appendix B– Simplified process flow chart for DSMER Pilot



Simplified Process Flow Chart for Deferred SME Response Pilot

Notes:

^{*1} **Procedural criteria** for application (all must be met):

- Original utility application filed under 35 U.S.C. 111(a) or national stage application submitted under 35 U.S.C. 371 (no design, plant, or reissue applications)
- Not a continuing application (no benefit claims to non-provisional applications or Hague applications, except under 35 U.S.C. 365(c))
- May include priority/benefit claim(s) to foreign, provisional, and/or PCT international applications in which the basic national fee has not been paid (bypass continuation okay)
- Newly filed (not an RCE; no first action on the merits mailed yet)
- No special status or expedited examination (no petitions to make special, Track One, etc.), which excludes participation in most pilot programs (with exception of after-final and appeal pilot programs)

^{*2} **SME issues** may be Step 1 issues (for failure to claim within a statutory category) and/or Step 2B issues (for claiming a judicial exception without significantly more).

^{*3} **Prospective Pilot applications** (applications selected by examiners for possible inclusion for pilot) will include a form paragraph in the first action on the merits indicating that the applicant may elect to have the application treated under the pilot program. Examiner has discretion to pick and choose applications.

^{*4} **Pilot election** requires applicant to file a PTO/SB/456 form setting out particulars and conditions/requirements of the Pilot. Form must be filed with a timely response to the first action on the merits.

† Pilot deferral ends at the earliest of: Notice of Allowance mailed; Final Action mailed; Notice of Appeal filed; RCE request; or abandonment of the application.

-----> refers to alternate flow in some situations

Form Paragraph:

- Contains information about how applicant opts into the pilot, e.g., by filing a request form to accept invitation
- Indicates that pilot permits applicant to defer responding to SME rejection(s) made in non-final actions
- Indicates that pilot deferral ends upon the earliest of Notice of Allowance, Final Rejection, Notice of Appeal filed, RCE request, or abandonment of the application
- Refers applicant to the Fed Register notice and/or request form for complete details and conditions

Pilot Request Form (PTO/SB/456):

- Applicant accepts Pilot invitation by filing PTO/SB/456 form with a timely response to first office action on merits
- Must be signed in accordance with 37 CFR § 1.33(b) by a person having authority to prosecute the application
- Must be submitted via the USPTO's patent electronic filing systems (EFS-Web or Patent Center)
- Applicant certifies that no special status or expedited processing will be sought in the application until final disposition is reached



