

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Deferred Subject Matter Eligibility Response (DSMER) Pilot Program

June E. Cohan

Senior Legal Advisor, Office of Patent Legal Administration

March 10, 2022

Patent Public Advisory Committee public meeting

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What is the DSMER pilot program?

- Temporary program that allows participating applicants to deviate from traditional compact prosecution practice
 - Examiners will still mail actions containing all applicable rejections.
 - Participating applicants may defer responding to subject matter eligibility (SME) rejections under 35 U.S.C. 101 until later in prosecution.
 - USPTO will evaluate how this deferral affects examination efficiency and patent quality as compared to traditional practice.

How to participate

- Applications will be selected for invitations based on procedural and patentability-related criteria.
 - Invitation phase runs from February 1 through July 30, 2022.
 - Invitation will appear as a special form paragraph in the First Action on the Merits (FAOM).
- Invited applicant must formally accept invitation in order to participate.

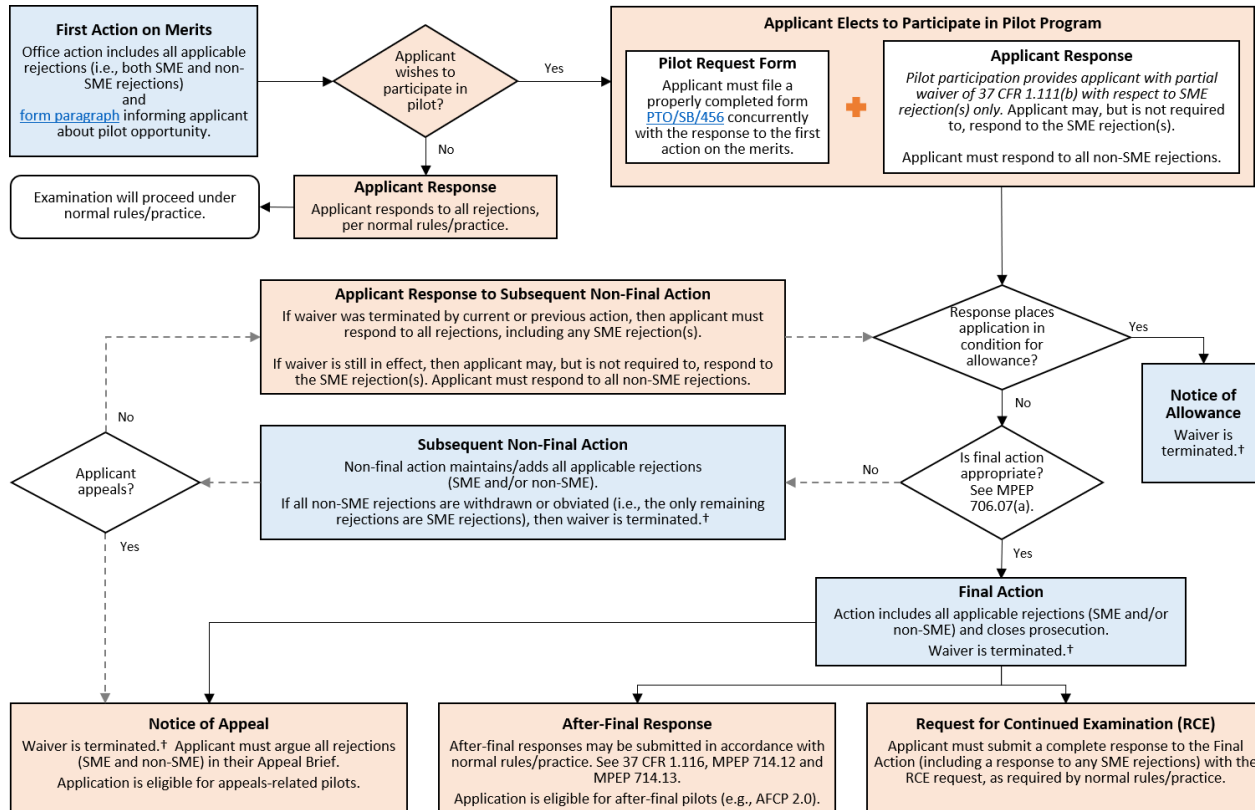
Application criteria

- Utility non-provisional application that is a first filing;
- Must be on regular examination track; and
- FAOM contains at least one SME rejection, and at least one non-SME rejection.
 - “SME rejection” = Step 1 (not in statutory category) or Step 2B (judicial exception without significantly more) rejection.
 - “non-SME rejection” = rejection on any other statutory basis, e.g., anticipation, indefiniteness, utility, or written description.

Program procedure

- Participation provides a partial waiver of 37 CFR 1.111(b) with respect to SME rejection(s) only. Applicants must still respond to all non-SME rejections.
- Other than the waiver, participation in this program does not alter the normal prosecution process.
- Waiver is terminated by “final disposition” (e.g., allowance or final rejection), or by the withdrawal or obviation of all non-SME rejections.

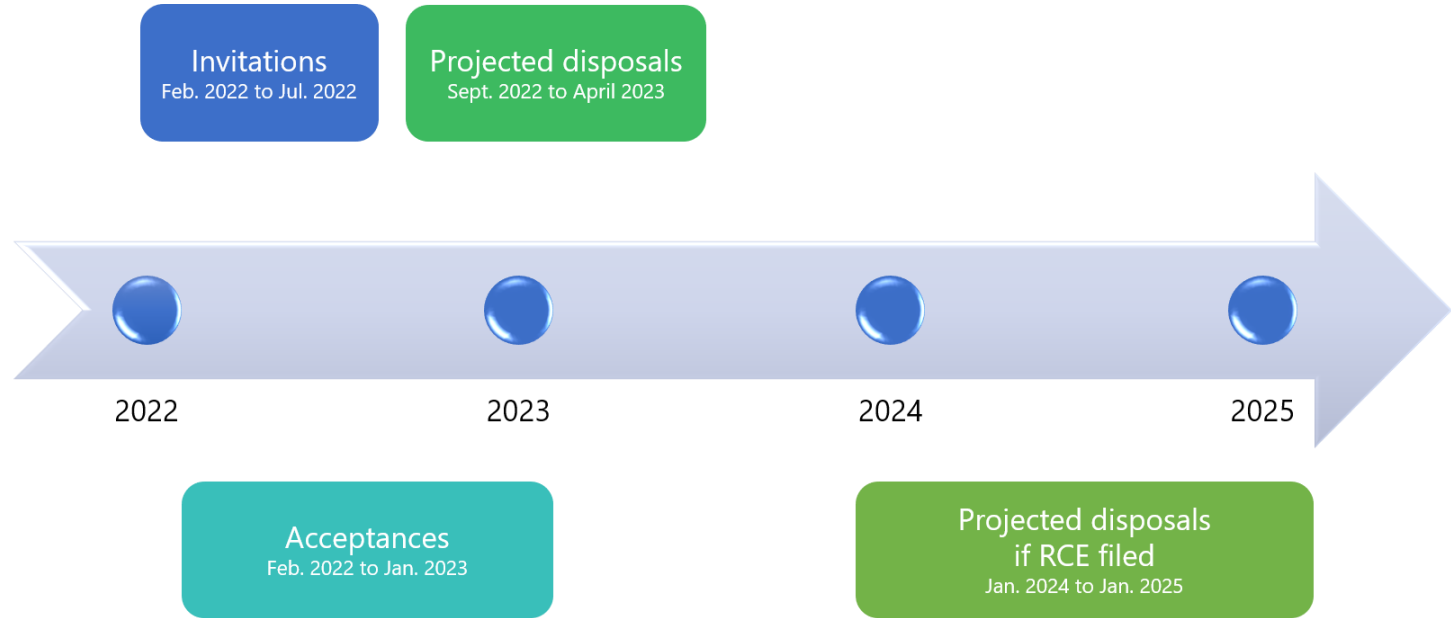
Program flowchart



† The waiver is terminated by a “final disposition”, or by the withdrawal or obviation of all other (non-SME) outstanding rejections. See Section III.A. of the pilot program [Notice](#) for more information about “final dispositions” and the waiver. Once the waiver is terminated, examination proceeds under normal rules/practice.

Solid line (→) indicates typical process flow. Dashed line (- ->) indicates alternative flow that may occur for some applications. Although not shown here, applicant may also choose to abandon the application before or after final action, and to file continuing applications, in accordance with normal rules/practice.

Program timeline



*Projections are based on FY21 average timing data using the compact prosecution model



USPTO resources

- Program page:
www.uspto.gov/patents/initiatives/patent-application-initiatives/deferred-subject-matter-eligibility-response
 - Includes notice, flow chart, form, and more information
 - Includes links to public comments
- Eligibility webpage:
www.uspto.gov/PatentEligibility





Thank you!

June E. Cohan

Senior Legal Advisor, Office of
Patent Legal Administration

june.cohan@uspto.gov

571-272-7744

www.uspto.gov