

Cantor Colburn Client Alert: USPTO Announces Launch of Deferred Subject Matter Eligibility Response Pilot Program

The U.S. Patent and Trademark Office (USPTO) has announced that it is launching a Deferred Subject Matter Eligibility Response Pilot Program. The program launches on February 1, 2022 and provides applicants with a limited waiver with respect to subject matter eligibility (SME) rejections identified in an office action in a participating application. The program provides a sequenced approach to handling substantive rejections, where SME rejections are handled after the resolution of all other patentability rejections. As summarized by the USPTO, “although the applicant must still file a reply to every office action, the limited waiver permits the applicant to defer presenting arguments or amendments in response to the SME rejection(s) until the earlier of final disposition of the participating application” or the resolution of all other rejections.

Limited Access to the Program

Participation in the program is by invitation only, and invitations are being sent to eligible applicants between February 1 and July 30, 2022. The program applies to applications that meet four criteria: (i) the application is an original nonprovisional utility application or national stage of an international application; (ii) the application does not claim the benefit of the earlier filing date of any prior nonprovisional application; (iii) the application has not been advanced out of turn (accorded special status); and (iv) the first office action on the merits makes both SME and non-SME rejections. The USPTO has not yet shared how it will select applicants from the eligible pool.

What This Means to You

Applicants under the program can benefit from a focused and streamlined process that enables them to determine much more readily whether their inventions are patentable from a non-SME perspective. This approach can minimize the chance that an applicant will be prevented from obtaining a patent solely due to unclear and inconsistent SME-related issues. For years, 101 rejections have hindered the ability to obtain patents across various technologies that are important for economic growth. With this program the PTO is providing a pathway that may avoid the time and expense associated with overcoming subject matter eligibility rejections until non-SME conditions for patentability have been resolved. In some cases, the bifurcation of SME and non-SME issues may lead to SME issues being resolved without being directly addressed as a result of resolving the other issues. For more information about the program, and to determine whether you may benefit from it, please contact us.

For Further Information and Assistance

Cantor Colburn’s dedicated [Computer Science Practice Group](#) is [#3 in the U.S. for obtaining software patents](#) for its clients in a very challenging environment after the Supreme Court’s *Alice* ruling on SME. Cantor Colburn is [top 10](#) in both getting SME allowances and overcoming SME rejections. Our attorneys offer our clients the most current and most informed counsel in this changing landscape. Please contact Computer Science Practice Group Co-Chairs [Anne Davis Barry](#) at abarry@cantorcolburn.com or [Jeff Waters](#) at jwaters@cantorcolburn.com or your Cantor Colburn attorney with any questions you may have regarding this matter and your IP in general.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.