

Considering The USPTO Pilot Program For Deferred Response

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Under the U.S. Patent and Trademark Office's Deferred Subject Matter Eligibility Response program, an examiner may invite a patent applicant to defer presenting arguments or amendments in response to a rejection under Title 35 of the U.S. Code, Section 101, until the earlier of final disposition of the application, or the withdrawal of all other outstanding rejections.

The program, which continues through July, was initiated earlier this year both because the lack of clarity on Section 101 often prevented a meaningful examination under Sections 102, 103 and 112 and to generate higher-quality patents.

This article discusses aspects of the DSMER pilot program and various points of consideration.[1]

When to Consider DSMER

First, the patent applicant may want to consider participating in the DSMER program when the application is docketed in art units where Section 101 rejections are common and hard to overcome — e.g., art units 1631 and 3600.

It is often the case that the patent applicant may need to have a lot of back-and-forth with the examiner to overcome a Section 101 rejection in such art units. But this back-and-forth is often unnecessarily prolonged because of the need to tackle both the art-based rejections and the Section 101 rejection.

This can increase prosecution costs and result in unnecessary prosecution delays. Accordingly, the patent applicant may want to consider participating in the DSMER program so that they can quickly resolve any art-based and clarity rejections first. Thereafter, they and the examiner can more efficiently focus on the Section 101 rejection.

Second, a patent applicant may want to consider participating in the DSMER program if it is foreseen that an examiner would identify novel subject matter in the application prior to considering any Section 101 rejection. For example, an examiner may identify specific subject matter in the patent application that is not well-understood, routine and conventional activity in the field.



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The patent applicant may then add this specific subject matter to the claims and argue that this subject matter is indicative of an inventive concept — also known as significantly more — because it is different from what is well-understood, routine and conventional activity in the field.

By contrast, in traditional prosecution, patents applicants often fail to learn on the record which subject matter in the patent application is not well-understood, routine and conventional activity in the field when an examiner simultaneously addresses art-based rejections and a Section 101 rejection.

In fact, under the DSMER program, an examiner may choose to remove the Section 101 rejection without the patent applicant even having to address the Section 101 rejection because the claims recite a limitation that is not well-understood, routine and conventional activity in the field.

Thus, the DSMER program may allow the patent applicant to quickly identify novel subject matter in the application, and then use the identified novel subject matter to overcome the Section 101 rejection.

Third, a patent applicant may want to consider participating in the DSMER program when there is a need or desire for additional time to develop the argument for overcoming the Section 101 rejection.

Since the patent applicant can defer presenting arguments in response to a Section 101 rejection, the patent applicant may use the additional time to wait for favorable decisions from the U.S. Court of Appeals for the Federal Circuit or Patent Trial and Appeal Board, or additional guidance from the USPTO.

The patent applicant may also use the additional time to gather extrinsic evidence — e.g., data, declarations, real-world examples, etc. — to use in their arguments for overcoming the Section 101 rejection.

When To Consider Not Participating in DSMER

A patent applicant may also consider not participating in the DSMER program for various reasons.

First, a patent applicant may consider not participating in the DSMER program because doing so may cause unnecessary prosecution delays.

For example, patent applicants may believe they can address both the Section 101 and art-based rejections with similar amendments and arguments. However, if they participate in the DSMER program, they will be forced to postpone presenting such amendments and arguments to overcome the Section 101 rejection, thereby ensuring at least another round of prosecution.

Thus, where the patent applicant believes they have convincing amendments and arguments to overcome both the Section 101 and art-based rejections, the applicant may choose to not participate in the DSMER program and thereby potentially avoid additional rounds of prosecution.

Specifically, instead of participating in the DSMER program, the patent applicant may present their amendments and arguments to both the Section 101 and art-based rejections in the applicant's response to the first Office Action on the Merits. Such an approach may avoid prosecution delays and decrease prosecution costs — including attorney costs and USPTO fees for a request for continued examination.

Second, a patent applicant may consider not participating in the DSMER program because the applicant

wants to avoid unnecessarily narrowing the claims. Oftentimes, patent applicants need to submit substantial claim amendments to overcome both a Section 101 rejection and art-based rejections.

Under DSMER program, a patent applicant may initially address an art-based rejection with an initial set of claim amendments and subsequently address the Section 101 rejection with additional claim amendments. This may cause the patent applicant to introduce unnecessary narrowing claim amendments.

Instead, it may be more effective for the patent applicant to address both the Section 101 and art-based rejections simultaneously, using the same set of claim amendments. The patent applicant may target amendments that both are not disclosed by the applied art and demonstrate an improvement to the functioning of a computer, another technology, or technical field. This approach may result in capturing a broader claim scope.

For patent applicants, the choice of whether to participate in DSMER program will likely depend on various considerations. In particular, patent applicants may want to carefully consider the subject matter of the patent application, the art unit where the application is being examined, and prosecution time and cost constraints before deciding whether to participate in the DSMER program.

These points of consideration may affect the overall long-term strategy of obtaining a patent with or without the DSMER program.

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[1] <https://www.uspto.gov/patents/initiatives/patent-application-initiatives/deferred-subject-matter-eligibility-response>.