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## USPTO Deferred Subject Matter Eligibility Response Pilot Program Appears to Benefit Applicants

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It is a basic truism in patent law that the scope of patent claims can change during the course of prosecution. Current examination guidelines require an examiner to identify all applicable grounds of rejection in a first office action and require an applicant to respond to all such rejections. Claim amendments addressing one rejection can directly or indirectly resolve other rejections, for example by adding clarity or causing mootness. This is a common occurrence when claims are rejected based on prior art under sections 102 or 103 and also as directed to ineligible subject matter under section 101, since amendments intended to overcome the cited prior art can impact the “inventive concept” analysis of section 101.

To address this issue, the U.S. Patent and Trademark Office (“USPTO”) has [announced](#) a new Deferred Subject Matter Eligibility Response (“DSMER”) pilot program, which allows for a sequenced approach to patent examination for subject matter eligibility (“SME”) rejections under 35 U.S.C. 101. This pilot

program, starting on February 1, 2022, and ending on July 30, 2022, will invite patent applicants to participate if their application does not claim benefit of an earlier filing date from a prior nonprovisional application, has not been accorded special status, and has a first office action that includes both a SME rejection and a non-SME rejection, such as a rejection under 35 U.S.C. 102, 103, or 112.

If invited, applicants choosing to participate in the pilot program will be able to defer a response to the SME rejection until all other rejections have been addressed or resolved. Invitations to the pilot program will be provided by a [form paragraph](#) in the first office action and elections to participate will be accepted via [request form PTO/SB/456](#) filed concurrently with a response to the first office action. Not all examiners will be participating in the pilot program, but the USPTO anticipates that a representative number of primary examiners from each applicable technology center will participate.

Responding to early SME rejections can be a time intensive and expensive proposition, especially as claims can substantially change throughout the course of prosecution. Under the pilot program, an applicant has an opportunity to defer addressing the SME rejections until non-SME rejections have been addressed. The applicant can also integrate an amendment addressing the SME rejection with other amendments directed to the non-SME rejections without having to directly argue the SME rejection. This can help reduce costs associated with the response and leaves a leaner prosecution history. It remains to be seen whether deferred examination

of the SME rejections may cause an increase in the number of early SME rejections that are later withdrawn. For now, the new pilot program looks to be a beneficial change that can help bring some relief to the current imprecision of SME jurisprudence.

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