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Patent Office Announces Ombudsman Pilot Program to Advance “Stalled” Prosecution and Proposes Procedures to Allow Delay of Certain Provisional Application Fees

The U.S. Patent and Trademark Office (“Patent Office”) has made two recent announcements impacting prosecution delay and fee deferral.

First, a one-year Ombudsman Pilot Program has been instituted to assist applicants when prosecution has stalled due to a breakdown in the normal process. Examples of such breakdowns might include communication barriers between the applicant/attorney/agency and the examiner or when there is prolonged prosecution. This program is not intended to circumvent normal communication between applicants and the Patent Office. Instead, the program is to be used by applicants who believe that their applications have stalled in the examination process. According to the Patent Office (*see* <http://www.uspto.gov/patents/ombudsman.jsp>), the program is intended for those applications in which the normal process has gone awry, and all other avenues have failed to provide the needed assistance. For example, the ombudsman may be contacted for an application-processing issue that applicant has been unable to resolve using Patent Office’s existing processes (*e.g.*, the examiner does not appear to address a new argument or amendment, and the applicant cannot reach the examiner and Supervisory Patent Examiner after a reasonable period of time). The ombudsman may be a Supervisory Patent Examiner or a Training Quality Assurance Specialist, and will ensure that the issue is appropriately addressed by an official that is best suited to resolve the issue. Communication between the applicant and the ombudsman will be made of record in the application file.

Second, in the Federal Register (*see* 75 FR 16750 (Apr. 2, 2010)), the Patent Office has also proposed a change to allow applicants to keep an application pending longer without payment of the requisite fees. Under the current rules, when an applicant files a nonprovisional application claiming priority to a provisional application and does not include the basic filing fee, the search fee,

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the examination fee, or an oath or declaration, the Patent Office will send a missing parts notice and set a time period for the applicant to submit the missing items and pay any required surcharge to avoid abandonment. The applicant can respond to the missing parts notice within two months, but the time period is extendable for five more months (with extension fees). Under the proposed rules, if the applicant files a nonprovisional application claiming priority to a provisional application and:

- includes the basic filing fee (\$165 for a small entity, \$330 for a non-small entity),
- includes an oath or declaration, and
- does not include a nonpublication request (and the application is in condition for publication), then

the applicant will receive a non-extendable 12-month period for paying the remaining fees (\$445 for a small entity, \$890 for a non-small entity). The invention disclosed in the provisional application would publish in 18 months. The Patent Office believes that this proposed procedure would effectively extend the provisional application period and benefit the Patent Office and the public by adding publications to the body of prior art. The Patent Office has requested comments regarding this proposed practice by June 1, 2010.

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