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COVID-19: Prioritized Patent Application Examination and Patents 4 Partnerships

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The United States Patent and Trademark Office (USPTO) has recently launched two new initiatives to support COVID-19 innovations: 1) a COVID-19 Prioritized Examination Pilot Program, and 2) Patents 4 Partnerships that provides a searchable forum to list COVID-19 related published applications and patents available for licensing.

1. **USPTO COVID-19 Prioritized Examination Pilot Program**

On May 8, 2020, the USPTO announced a new COVID-19 Prioritized Examination Pilot Program.

This pilot program will provide Track 1-type prioritized examination ***without payment of additional fees*** if the following conditions are each met:

- ***Small***: The application is entitled to small or micro entity status;
- ***FDA approvable review for COVID-19***: The application has at least one claim directed to a product or process subject to an applicable FDA approval (e.g., an IND) for prevention and/or treatment of COVID-19; and
- ***Single § 120 priority claim***: The application claims priority to a maximum of one earlier U.S. non-provisional or PCT application. (Applications that claim priority to two or more earlier U.S. non-provisional or PCT applications are not eligible.)

Speed: According to the USPTO, "the USPTO will endeavor to reach final disposition of applications in this program within six months if applicants respond promptly to communications from the USPTO."

July 13 start: The COVID-19 Prioritized Examination Pilot Program will accept requests for prioritized examination beginning July 13, 2020 until the USPTO has accepted a total of 500 requests.

Discussion

To participate in the pilot program, the applicant must qualify for either small or micro entity (37 CFR § 1.27) status under 37 CFR § 1.27 when a request for prioritized examination under the program is made.

At least one of the pending claims of the patent application must cover a product or process related to COVID-19 that is subject to an applicable FDA approval for COVID-19 use. The Federal Register Notice provides a few examples of acceptable FDA approval: an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA).

A request for prioritized examination under the pilot program must be made: (a) with the filing of a non-provisional application; (b) with the filing of a newly-filed continuation application claiming the benefit under 35 U.S.C. §120 of no more than one prior non-provisional or PCT application; or (c) with or after the filing of a request for continued examination (RCE) of a non-provisional application.

An application that claims the benefit of priority to two or more U.S. non-provisional or PCT applications is not eligible for participation under the pilot program. Such applications would still be eligible for Track 1 priority examination with the required fees.

Notwithstanding the above noted USPTO remarks that a 6-month application disposition may be possible with applicant promptness, a 12-month average time to complete examination is the pilot program's stated objective.

What fees are waived

The fees normally associated with prioritized examinations that will be waived under this pilot program are: (1) the prioritized examination fee set forth in 37 CFR § 1.17(c), which is $1,000.00 for a micro entity, or $2,000.00 for a small entity; and (2) the processing fee set forth in 37 CFR § 1.17(i)(1), which is $35 for a micro entity, or $70.00 for a small entity.

2. **Patents 4 Partnerships**

The USPTO also recently launched its “Patents 4 Partnerships” program to provide a new patent marketplace for patent owners to voluntarily list patents and published patent applications that are available for licensing in the field of COVID-19 technologies. This includes technologies related to the prevention, diagnosis, and treatment of COVID-19.

The goal of the program is to provide the public with a centralized, user-friendly, searchable repository for patents and published applications related to COVID-19 technologies that are voluntarily being made available for licensing thus facilitating commercialization of technologies related to prevention, diagnosis, and treatment of COVID-19.

Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, **referred to the program** as “a meeting place that enables patent owners who want to license their IP rights to connect with the individuals and businesses who can turn those rights into solutions for our health and wellbeing”.

The platform provides a searchable database and interested entities are able to search the database by keyword, inventor name, assignee and issue date. Those interested in listing their patents may do so using the Platform Submission Form found on the main webpage of the program: **https://developer.uspto.gov/ipmarketplace/search/patents**.

Although this program is currently limited to COVID-19 related technologies, the USPTO will continue to monitor public feedback on the program to consider expanding to other technologies including Artificial Intelligence.

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