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U.S. Patent and Trademark Office Introduces Pilot Program for Expedited Review of Semiconductor Manufacturing-Related Patent Applications

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The U.S. Patent and Trademark Office (USPTO) has implemented the Semiconductor Technology Pilot Program in a stated effort to incentivize intellectual property protection for certain semiconductor manufacturing innovations.

This action is commensurate with the objectives of the government's 2022 CHIPS and Science Act, including boosting research and development in the semiconductor area and revitalizing the domestic semiconductor manufacturing industry to gain a global competitive advantage. The USPTO press release states that this program is designed to "encourage innovations that increase semiconductor device production, reduce semiconductor manufacturing costs and strengthen the semiconductor supply chain."

According to data released by the USPTO in October 2023, regular non-prioritized patent applications currently have an average pendency of about 21 months from the filing date before

the first substantive Office Action is mailed, and an average pendency of 25 months before the application has reached a final disposition (i.e., has been issued as a patent or abandoned). This long and uncertain waiting period often discourages patent applicants who would like to bring their innovation faster to the market with the security of patent protection.

One way to accelerate the examination of a patent application is to choose the "Track One" prioritized examination option, which allows the applicant to get to a final disposition in about 12 months. However, the fee for fast-tracking examination of a patent application is substantial, especially for applicants who do not qualify as a small entity or a micro entity.

Under the Semiconductor Technology Pilot Program, certain semiconductor manufacturing-related patent applications will have a chance to be advanced out of turn, i.e., will be accorded "special" status to be examined ahead of the other regular applications, if a proper "Petition to Make Special" is timely filed. The prioritization fees will be waived, irrespective of the entity status of the applicant under this pilot program.

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ELIGIBILITY AND OTHER REQUIREMENTS

Number of Applications and Date

The Office began accepting Petitions to Make Special beginning December 1, 2023, and will do so until either December 2, 2024, or the date by which 1,000 grantable petitions are accepted, whichever occurs first. The USPTO may, at its sole discretion, terminate the pilot program depending on factors such as workload and resources needed to administer the program, feedback from the public, and the effectiveness of the program. If the pilot program is terminated, the USPTO will notify the public. The USPTO will indicate on its website¹ the total number of petitions filed and the number of applications accepted into the pilot program.

Type of Application

The application for which a petition is being filed must be a noncontinuing original utility nonprovisional application or a continuation, divisional, or continuation-in-part application that claims priority to only one prior application. International applications entering the national stage in the United States are also eligible if certain conditions are met. Claiming the benefit of one or more prior provisional applications or claiming a right of priority to one or more foreign applications will not affect eligibility for this pilot program.

Subject Matter of the Application

The application must contain at least one claim that covers a process or an apparatus for manufacturing a semiconductor device and that corresponds to one or more of the technical concepts within H10 (Semiconductor Devices; Electric Solid-State Devices Not Otherwise Provided For) or H01L (Semiconductor Devices Not Covered by Class H10) in the Cooperative Patent Classification (CPC) system.² Examples of subject matter covered under H10 and H01L include, but are not limited to, semiconductor devices, electric solid-state devices, organic solid-state devices, method of manufacturing of these devices, and packaging and assembly of these devices.

Procedural Requirements

The Petition to Make Special must be electronically filed at the Patent Center using Form PTO/SB/467, which has the required certifications, including the applicant's good faith belief that the claimed invention(s) meet(s) the technology requirement of the pilot program as being primarily focused on the manufacturing of semiconductor devices.

The applicant also has to certify that the inventor, or any joint inventor, has not been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a Petition to Make Special under this pilot program has been filed.

The specification, claims, and abstract accompanying the petition must be filed in the DOCX format.

The petition must be submitted at the time of filing or within 30 days of filing the application.

The application cannot opt for non-publication of the application.

The application cannot contain more than 20 total claims, including a maximum of three independent claims. The application cannot have any claims with multiple dependency. This number limit will be in effect throughout the prosecution phase.

If a requirement of restriction or unity of invention is made, the applicant will have to make an election to an invention that meets the technology requirement of the pilot program.

Cost of Petition

The petition fees are waived by the USPTO. Therefore, the main cost for the applicant lies in evaluating whether the application qualifies under the pilot program and in preparing and filing the petition.

Coverage of the Petition

Once granted, the "special" status will remain in effect during the regular prosecution. During the appeals process, the application will be treated in accordance with the normal appeal procedure.

A continuing application will not be automatically granted a special status based on the petition granted in a parent application.

WHAT INTERESTED COMPANIES CAN DO IMMEDIATELY AND IN THE NEAR FUTURE

Since the current pilot program is capped at just 1,000 petitions, time is of the essence for semiconductor companies to file their original applications quickly as long as the technology requirement is met. For large entities, this petition can save a significant amount in administrative fees that they otherwise would have had to pay in order to ensure prioritized examination.

For smaller companies, such as startups, this program not only saves prioritization fees (which are not insignificant even after the small-entity discount) but can also accelerate the building of a robust patent portfolio that gives them a competitive advantage in the market and/or can attract further investment to improve their products.

Companies may want to file continuations, divisionals, and continuations-in-part relatively early, i.e., in the near future) rather than waiting for the parent application to be nearing issuance. If a currently pending patent application does not have a specific claim set that meets the condition of the pilot program, but the specification has enough support for qualifying claims, a continuing application with a properly tailored claim set can be filed to take advantage of this program.

While this program has a number of advantages, as discussed above, companies should also consider the pitfalls of getting a patent application issued too

soon, such as creating prior art unintentionally and prematurely, not having the budget to file a continuing application in targeted jurisdictions, not being able to take advantage of the non-publication option, and so forth.

Additionally, companies should keep in mind that not all applications may be suitable for this program because of the procedural constraints (such as the maximum of 20 claims, the stringent restriction requirement, etc.). For example, if a company is interested in an omnibus patent application with a large number of claims of wide variety, this program may not be the best option for a company.

Companies should also keep in mind that if there are prolific inventors in a company, only a maximum of five of the applications naming them as inventors can be filed with a Petition to Make Special under this pilot program. So an internal tracking of inventorship is crucial.

Overall, the Semiconductor Technology Pilot Program seems to be an attractive option for companies that would like to get quick allowance of certain patents without having to pay the fees for prioritized examination, if they are comfortable with the required technology certifications.

Notes

1. <https://www.uspto.gov/patents/initiatives/patent-application-initiatives/semiconductor-technology-pilot-program?MURL=SemiconductorTechnology>.
2. <https://www.uspto.gov/web/patents/classification/>.

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