

# REPORT

## EXPANSION AND EXPIRATION OF ACCELERATED PATENT EXAMINATION PROGRAMS

December 21, 2011

The U.S. Patent and Trademark Office (USPTO) has expanded and clarified its Track 1 Prioritized Examination program to allow a request for prioritized examination to be made when or after a Request for Continued Examination (RCE) is filed in a patent application, including in a U.S. national stage PCT application. The USPTO has also announced that it will allow two other pilot accelerated examination programs to expire.

### I. Track 1 Prioritized Examination

Track 1 Prioritized Examination allows patent applications to be more quickly examined for a fee, without the burdensome requirements of "Accelerated Examination."<sup>\*</sup>

The USPTO has amended its rules, effective December 19, 2011, to allow a Request for Prioritized Examination to be filed simultaneously with an RCE or before the mailing of the first Office Action after the filing of an RCE. Thus, the revised rule allows Applicants to request prioritized examination at the time of filing an application and/or at any time before a first action in one RCE. Only a

single prioritized examination request may be granted in an application after an RCE has been filed. Thus, applications will be permitted to have prioritized examination under Track 1 no more than twice (upon the filing of the application and with or after one RCE). Applicants will not be granted prioritized examination on an application after prioritized examination has already once been granted in connection with a prior RCE in that application.

In addition, the amendments newly allow international applications that have entered the U.S. national stage to be granted prioritized examination under Track 1 if prioritized examination is requested when or after an RCE is filed. Track 1 Prioritized Examination remains unavailable in PCT U.S. national stage applications in which no RCE has been filed. However, if prioritized examination is desired, an Applicant could forgo entering the U.S. national stage in favor of a by-pass continuation of a PCT application in order to request Track 1 Prioritized Examination when filing the U.S. by-pass continuation application.

The USPTO goal for handling applications under Track 1 Prioritized Examination is to, on average, provide a final disposition within twelve months of prioritized status being granted. For purposes of the twelve-month goal, "final disposition" can be any of the following:

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<sup>\*</sup> See section I.E. of our Special Report entitled "Updated Analysis Of America Invents Act (AIA)," and our April 6, 2011 Special Report entitled "New Prioritized Examination Procedure For U.S. Patent Applications ('Track I')," for additional information regarding the Track 1 Prioritized Examination program.

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- Mailing of a Notice of Allowance;
- Mailing of a final Office Action;
- Filing of a Notice of Appeal;
- Completion of examination as defined in 37 CFR 41.102;
- Filing of a subsequent RCE; or
- Abandonment of the application.

An application under prioritized examination does not retain special status in appeals or interferences before the U.S. Board of Patent Appeals and Interferences (BPAI), or after the filing of a subsequent RCE.

The following requirements must be met for Track 1 examination to be granted:

- The request for prioritized examination must be filed:
  - i. concurrently with an application that is a complete utility or plant nonprovisional application filed under 35 U.S.C. § 111(a) (i.e., with Declaration and filing fee, search fee, examination fee, any extra claims fee, and any application size fee); or
  - ii. concurrently with or subsequent to an RCE before a first Office Action for a utility or plant nonprovisional application, or an application that has entered the national stage under 35 U.S.C. 371;
- Prioritized examination fee of \$4800 (\$2400 for small entities), processing fee (\$130), and publication fee (\$300) if not already paid, must be paid when filing the request for prioritized examination;
- The request for prioritized examination must be electronically filed, except in a

plant application for which a paper request must be filed;

- If filing the request with a utility application, the utility application must be electronically filed;
- The application cannot have (or must be amended at the time of filing the request for prioritized examination not to have) more than four independent claims and thirty total claims, or any multiple dependent claims; and
- The application will lose prioritized status if (1) any extensions of time are taken by the Applicant; (2) an RCE or Notice of Appeal is filed; or (3) the application is amended to have (i) more than four independent claims or thirty total claims, or (ii) any multiple dependent claims. Termination of prioritized examination will not entitle the Applicant to a refund of the prioritized examination fee.

Upon termination of prioritized examination, the application will be removed from the examiner's special docket. The USPTO has clarified in the rulemaking that the application will then be placed on the examiner's regular docket "in accordance with its stage of prosecution." Thus, if an application loses its prioritized status because, for example, an RCE is filed in that application, the application would be placed in queue on the Examiner's special new docket with divisional and continuation applications, and other applications in which an RCE has been filed. If an application loses its prioritized status because, for example, it is amended after a first Office Action to have more than four independent claims, or for example, if an extension of time is required, that application would be placed in queue on the Examiner's regular amended docket with other applications in

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which a response to a first Office Action has been filed, for further action within (on average) 2 to 4 months. Thus, even if an application loses prioritized status during prosecution, Applicants would still benefit in that pre-examination backlog delays (which often total several years) would be avoided.

The number of requests for Track 1 Prioritized Examination that the Patent Office may accept is a maximum of 10,000 per fiscal year. This quota includes requests for prioritized examination both for initial examination and with or after filing of an RCE. From the beginning of the USPTO fiscal year, October 1, to December 15, 2011, only 331 requests for prioritized examination have been granted, and 462 other requests await a decision.

## **II. Upcoming Expiration of Other Ways To Accelerate Examination**

The deadline for filing petitions under the Green Technology Pilot Program, originally set to expire on December 31, 2011, is being extended to March 30, 2012 or until 3,500 applications have been accorded special status under the program. As of December 5, 2011, 2,913 applications have already been accorded special status under the Green Technology Pilot Program, and 373 additional applications are awaiting decision. Thus, the Green Technology Pilot Program may expire before March 30, 2012.

Additionally, the Patent Application Backlog Reduction Stimulus Plan ("Project Exchange"), which allowed Applicants to obtain expedited examination of certain applications in exchange for abandoning certain other applications, will expire on December 31, 2011.

See Section III of our April 6, 2011 Special Report for a comparison of various ways to accelerate examination of a U.S. patent application. Please let us know if you desire any additional information about ways to expedite examination of U.S. patent applications.

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