

IP LAW ADVISORY

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U.S. Patent Office Implements Optional "Fast Track" Patent Examination

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The U.S. Patent & Trademark Office has announced implementation of prioritized patent examination starting May 4, 2011. This new "fast-track" examination is Track I of the 3-Track Proposal which has been under consideration since June 2010, and would provide a final disposition within 12 months of filing a patent application. The average time for final disposition of a patent application is currently just under 3 years. In order to take advantage of this prioritized examination, applicants must pay an additional \$4000 fee, ensure that the patent application meets certain requirements, and never seek an extension of time. The Patent Office's fast track examination program is part of several recent initiatives intended to offer greater flexibility to applicants and to address the backlog of unexamined applications. These initiatives include the Accelerated Examination Program, Green Technology Pilot Program, Project Exchange, special status afforded applications based on an inventor's age or health, and the Patent Prosecution Highway.

Prioritized examination will generally be available to all original utility and plant patent applications filed on or after May 4, 2011, including continuing applications. Applications that are not eligible for prioritized examination include applications entering the U.S national stage under Section 371 from an international application, design patent applications, reissue applications and reexamination proceedings. Applications under prioritized examination will remain on an examiner's special docket

throughout prosecution with a goal of a first office action on the merits within 4 months, and a final disposition within 12 months. Final disposition may involve a notice of allowance, final rejection, request for continued examination, notice of appeal, declaration of interference or abandonment. The time periods set for responses and actions will be the same as in regular examination, but prioritized status will be terminated if the applicant requests an extension of time. Examiner interviews are encouraged during prioritized examination.

A request for prioritized examination under Track I must be made at the time the application is filed. The fee of \$4000 is based on the Patent Office's estimated average cost of performing the service without diversion of resources which might otherwise delay non-prioritized applications. A reduction in the \$4000 fee may be made available for small entity applicants if pending legislation is enacted. Qualifying applications are limited to 4 independent claims and 30 total claims, and can be brought into compliance at the time of filing via a preliminary amendment. Other formal requirements for prioritized examination dictate that the application must be filed using the Patent Office's electronic filing system complete with all associated fees. Early publication and nonpublication are still available under the program. Applicants will be notified upon the grant or dismissal of their request for prioritized examination.

Though prioritization will terminate upon final disposition, the Patent Office is considering an expedited appeals process as well. Likewise, with respect to requests

for continued examination, the Patent Office is considering allowing applicants to file a single submission after final rejection of a prioritized application for a fee, with the next action being made final if the submission does not place the application in condition for allowance.

The Patent Office is limiting prioritized examination to 10,000 participating applications for fiscal year 2011. This new fast track program may meet the needs of

applicants requiring more timely examination who cannot qualify for special status, and who might not want to perform the search and analysis required for the Accelerated Examination Program. Though costly, prioritized examination may provide a good option for applicants who may be negatively impacted by delays in obtaining patent protection, such as applicants seeking funding or already commercializing their technology.

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