



Life in the fast lane

Carson Fincham reviews the various fast track options for patent examinations at the USPTO

Picture: Dudarev Mikhail / Shutterstock

The US Patent and Trademark Office (USPTO) has implemented a rule¹ that will create from May 4, 2011 a new “fast track” for patent application examination. This new “fast track” comprises “Track I” of a proposed three-tier system for prosecution and is called “Prioritized Examination”. The first tier or Track I is a fast track for prosecution, the second tier or Track II is the standard prosecution process, and the third tier or Track III will be a delayed prosecution option (which has not yet been formally published for notice and comment).

Any new and complete² non-provisional (or plant) patent application will qualify, and for a fee of \$4,000, the first 10,000 applications (in the first year) requesting Prioritized Examination will be granted *limited* “special status”. The special status is limited by nature of only staying in effect until “final disposition” of the case during the first 12 months of prosecution. “Final disposition” may be achieved via mailing of a Notice of Allowance of Final Office Action by the office or by abandonment or filing of a Request for Continued Examination (RCE) or Notice of Appeal by the applicant. This may at first glance appear adequate, but for those well versed in the process of sparring with the USPTO, it is well understood that final Office Actions are all too often premature, improper, or simply without merit (and accordingly easily overcome, but necessitating the filing of either an RCE or Notice of Appeal to do so). The special status

may also be forfeited in the case that an applicant requests an extension of time for filing a response to the office.

The Prioritized Examination application must be limited to four independent and 30 total claims, which is slightly more liberal than the claim limitations for the current Accelerated Examination Program. In addition to the Prioritized Examination fee of \$4,000, a processing fee of \$130 must be paid upon filing. Further, similar to the Green Tech Pilot Program, while normally not paid until allowance (or in the case that the applicant desires early publication), the publication fee of \$300 must also be paid upon filing to qualify for Prioritized Examination. Although early publication is not required for Track I as it is with the Green Tech Pilot.

Other options

Currently, there are three principal ways³ that an applicant for a US patent may receive expedited examination of their application: (1) a Petition to Make Special under 37 CFR §1.102(c), (2) the Accelerated Examination Program pursuant to MPEP §708.02(a), and (3) the Green Tech Pilot Program⁴. Each current option has distinct advantages and limitations.

The Petition to Make Special, while being free of charge for example, is now limited (for applications filed after August 25, 2006) to situations where the inventor’s age or health warrant an expedited examination

Expedited examination option	Eligibility	Limitations / Drawbacks	Official fees ¹¹	Estimated labor cost ¹²	Total estimated cost
Petition to Make Special	Petition based on: Inventor Age or Health, or “Project Exchange”	None	None	\$700–\$1,050	\$700–\$1,050
Accelerated Examination Program	Petition based on: Prospective Manufacture, Actual Infringement, Environmental Quality, Energy, Recombinant DNA, Superconductivity, HIV/AIDS or Cancer, Counter-Terrorism, or Small Entity Biotech or no particular grounds	<ul style="list-style-type: none"> • Requires detailed prior art search; • Requires Examination Support Document (ESD); • Limited to three independent and 20 total claims; • Strict examination timelines and procedures 	\$0 - \$130 (depends on basis for petition)	\$2,000–\$6,000	\$2,000–\$6,130
Green Tech Pilot Program	Petition based on: “Green” technology; only 3,000 available per year	Early publication required	\$300	\$700–\$1,050	\$1,000–\$1,350
Prioritised Examination (Track I)	Only 10,000 available per year	<ul style="list-style-type: none"> • Limited to four independent and 30 total claims; • “Special status” is limited and may be forfeited 	\$4,430	\$175	\$4,605

Patent examinations

process⁵. If the Petition to Make Special is granted, the “special status” (ie, being placed on the Examiner’s Special Docket – with the goal of average pendency being reduced to approximately 12 months⁶) accorded to the application is maintained for the duration of prosecution.

The Accelerated Examination Program (which has replaced all of the pre-2006 Petition to Make Special situations except situations based on the inventor’s age or health) requires applicants to conduct a rigorous pre-examination prior art search. It also requires the applicant to draft and supply an onerous Examination Support Document (ESD), comply with shortened response deadlines, and is limited to examination of three independent and 20 total claims.

The Green Tech Pilot Program is a great and inexpensive⁷ option for environmentally-oriented applications, but space in the program is limited (based on current figures⁸, no petitions seem likely to be granted after August 2011), early publication is required, and grant rates for the petitions have been 50% or less⁹.

For ease of comparison amongst the various fast track options, including the new Prioritized Examination (Track I), a revised and enhanced version of the “USPTO Patent Examination Acceleration Programs and Proposals”¹⁰ chart is provided for reference (for applications filed after August 25, 2006).

Footnotes

1. Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures, 76 FR 18399 (April 4, 2011); <http://edocket.access.gpo.gov/2011/pdf/2011-7807.pdf>
2. “Complete” means that the application comprises all requisite parts, including an executed inventor oath or declaration (ie, no “missing part” applications will qualify), as well as payment of any excess claim fees.
3. The Patent Prosecution Highway (PPH) Program is not considered here because it does not assist in expediting prosecution of an original application, and the expedited examination of inventions “of peculiar importance to some branch

of public service and the head of some department of the Government” under 37 C.F.R. §1.102(b) is not considered due to limited practical applicability.

4. http://www.uspto.gov/patents/init_events/green_tech.jsp
5. Or where the applicants qualifies for and requests entry into the “Project Exchange” program, which allows an applicants to receive expedited examination in one application in exchange for express abandonment of another application; http://www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp
6. Compared to a general average pendency of two (2) to four (4) years; <http://www.uspto.gov/patents/stats/patentpendency.jsp>
7. The only out-of-the-ordinary fee is the requirement to pay the publication fee of three hundred dollars (\$300); which is normally only paid upon allowance of an application.
8. http://www.uspto.gov/patents/init_events/green_report_summary20110307.pdf
9. See Note 4.
10. http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf
11. Includes any fees that would not normally be paid upon filing.
12. Estimated labor based on an attorney rate of \$350 per hour and a paralegal rate of \$175 per hour.

Author



Carson CK Fincham is a founding partner at Fincham Downs, LLC, a boutique intellectual property firm in Ridgefield, CT, US. Mr Fincham previously was in-house counsel at Walker Digital, LLC, creators of priceline.com, an associate at Buckley, Maschoff & Talwalkar in New Canaan, CT, and is a civil/environmental engineer with experience and knowledge in many areas of technology.

GOODRICH

RIQUELME
 ASOCIADOS

75

2009

1934

MEXICO

- Industrial and Intellectual Property
- Litigation
- Licensing Enforcement
- Entertainment and Sport Law
- Copyrights

Enrique A. Diaz	ediaz@goodrichriquelme.com	(5255) 5525 1422
Jaime Delgado	jdelgado@goodrichriquelme.com	(5255) 5207 5324
Juan Carlos Suarez	jcsuarez@goodrichriquelme.com	(5255) 5207 9261

Paseo de la Reforma 265, M2
Col. y Del. Cuauhtemoc
06500 Mexico, D.F.
Tel. (5255) 5533 0040
Fax. (5255) 5207 3150

e-mail: mailcentral@goodrichriquelme.com

website: www.goodrichriquelme.com