

USPTO Accepting Prioritized (Fast Track) Examination Requests Beginning May 4, 2011

April 7, 2011

On April 4, 2011, the United States Patent and Trademark Office (USPTO) announced that it will begin accepting requests for prioritized examination of patent applications. The requests will allow applicants to have their patents processed within 12 months, reducing the prosecution time from the nearly three years it takes, on average, to prosecute a patent application. The program is called Track One and it launches on May 4, 2011. Track One is part of a new Three-Track system, which the USPTO expects will provide applicants with greater control over when their applications are examined and promote greater efficiency in the patent examination process.

The program at this time is first-come, first-serve. Requests for prioritized examination will initially be limited to a maximum of 10,000 applications starting May 4, 2011, through the end of fiscal year 2011 (September 30, 2011). The USPTO will re-evaluate and make any necessary adjustments at that time (presumably with respect to the maximum number of applications that will be accepted for Track One).

The privilege of expedited prosecution comes with a hefty price tag – nearly five times the large entity filing fee of \$1,090 currently charged for a utility patent application. The request for prioritized examination through Track One will add \$4,000 to the standard filing fees for the application. The small entity discount of 50 percent will not be applied to the prioritized examination request fee, as it is with many other standard processing fees. The PTO indicated that it is working to obtain legislative authority for the small entity discount, but until that happens, small entities must pay the same as large entities for expedited prosecution.

Applicants must adhere to certain conditions to maintain Track One eligibility. Eligibility is lost when an applicant files a petition for an extension of time to file a reply, files a request for a suspension of action, or files an amendment to the application which results in more than four independent claims, more than thirty claims, or multiple dependent claims. The original application must be "complete" when filed. The complete application must include any excess claims fees paid on filing, and be filed via the Office's electronic filing system if it is a utility application. Thus, the application must be filed with an oath or declaration under 37 CFR 1.63, the basic filing fee, the search fee, the examination fee, any excess claims fees, and any application size fee. The request for prioritized application must be filed with the application itself. Any Notice to File Missing Parts of the application will presumably result in the forfeiture of Track One eligibility - and the request fee (unless of course, the request fee was missing from the original filing.)

The procedure for prioritized examination does not apply to international applications, design applications, reissue applications, provisional applications, and reexamination proceedings. Applicants may request prioritized examination for a continuing application (e.g., a continuation or divisional application) by filing a request and the required fees including the \$4,000 prioritized examination fee. However, a continuing application will not automatically be given prioritized examination status based on the request filed in the parent application. Each continuing application must independently meet all requirements for prioritized

examination.

In addition to Track One, the Track Two option offers traditional patent examination under the current procedures. Track Three, which is not yet available, will allow applicants to delay prosecution for up to 30 months, which is available now only to PCT applicants. Track Three is expected to be available by September 30, 2011. We expect a comparable fee to apply to the Track Three option when it is eventually implemented by the Office.

Some clients may want to see their patent issued as early as possible (under Track One), while others may be content to defer the issue date of their patent (under the yet to be implemented Track Three). Either way, the term of the eventual patent will not change, i.e., twenty years from the filing date of the original patent application. Depending on your patent strategy – and your patent budget – Track One may be an attractive option for you to consider.

Please contact the [Intellectual Property Group](#) of McNees Wallace and Nurick if you have questions related to these new programs.

© 2010 McNees Wallace & Nurick LLC

This document is presented with the understanding that the publisher does not render specific legal, accounting or other professional service to the reader. Due to the rapidly changing nature of the law, information contained in this publication may become outdated. Anyone using this material must always research original sources of authority and update this information to ensure accuracy and applicability to specific legal matters. In no event will the authors, the reviewers or the publisher be liable for any damage, whether direct, indirect or consequential, claimed to result from the use of this material.