

Accelerated Examination v. Prioritized Examination

The Leahy-Smith America Invents Act (AIA) provides for the establishment of a program to allow the expedited examination of patent applications.¹ The U.S. Patent and Trademark Office (USPTO) refers to this program interchangeably as Prioritized Examination and Track I.² However, expedited examination is not a new concept. In addition to Prioritized Examination, the USPTO provides another expedited examination process known as Accelerated Examination.³ Prioritized Examination does not replace Accelerated Examination, but rather offers applicants an additional option for expedited examination.

So which is the best option for having applications examined quickly? This article considers the differences between these two programs in order to address this question. A point-by-point comparison is provided in Table 1.

Application Requirements

Perhaps the most significant difference between Accelerated Examination and Prioritized Examination are the additional filing requirements for an Accelerated Examination application. Notably, these requirements can be a source of prosecution history estoppel.

When filing an application under Accelerated Examination, an applicant must include, among other documents, a Statement of Pre-Examination Search, and an Accelerated Examination Support Document.⁴ To this end, the applicant must conduct (or engage a search firm to conduct) a search on the patentability of each of the filed claims. The Statement of Pre-Examination Search must identify the databases searched and the searching methods used, and must disclose any relevant references discovered.⁵ In addition, the applicant must prepare the Accelerated Examination Support Document, which identifies the references most closely related to the claims, discloses which references teach which claimed features, and sets forth the applicant's arguments for the patentability of each claim.

The Statement of Pre-Examination Search and the Accelerated Examination Support Document both have the potential to create prosecution history estoppel. Particularly, the applicant is admitting to the relevance of the references cited therein, and the relation of these references to the claims. Thus, an applicant should evaluate the risk of such estoppel before proceeding with an Accelerated Examination filing. For many applicants, this risk of estoppel may override any other considerations that favor Accelerated Examination.

In contrast to Accelerated Examination, filing an application under Prioritized Examination requires only a Certification and Request for Prioritized Examination, that the Oath is filed with the application, and upfront payment of the publication fee.⁶ Indeed, Prioritized Examination creates no more estoppel than regular examination.



Cost

Another difference between Accelerated Examination and Prioritized Examination is the total cost of preparing and filing applications. In many cases, the cost of preparing an Accelerated Examination application may exceed that of preparing a Prioritized Examination application. On the other hand, the cost of filing an Accelerated Examination application is significantly lower than that of filing a Prioritized Examination application.

More specifically, between the Statement of Pre-Examination Search and Accelerated Examination Support Document, filing an application under Accelerated Examination is similar to preparing both an Office Action (usually the responsibility of an Examiner at the USPTO) and a Response to the Office Action, all before the application is filed. Thus, the preparation of these documents will entail an additional cost that should be considered by applicants. By comparison, preparing an application for Prioritized Examination is in most respects identical to preparing an application for standard examination. As noted above, there are few additional requirements associated with filing a Prioritized Examination application, and therefore few additional preparation costs.

On the other hand, USPTO fees for filing an Accelerated Examination Application are significantly lower than those for filing an application under Prioritized Examination. Accelerated Examination requires only a \$130 fee in addition to the regular filing, search, and examination fees.⁷ Prioritized Examination requires a special \$4800 fee and the up-front payment of the \$300⁸ publication fee (regardless of whether or not non-publication is requested) as well as the regular fees.

Thus, despite the significantly lower cost of filing an application under Accelerated Examination, the total cost of preparing an application for Accelerated Examination could equal or, in some cases, exceed the total cost of preparing and filing an application under Prioritized Examination. Accordingly, when deciding between Accelerated Examination and Prioritized Examination, applicants should weigh the preparation costs involved in Accelerated Examination against the USPTO fees for Prioritized Examination.

On the other hand, Accelerated Examination may result in lower overall prosecution costs, as the process of preparing the Statement of Pre-Examination Search and Accelerated Examination Support Document may result in applicants seeking more focused claims. Consequently, fewer office actions and responses may be required before an application is allowed, resulting in an overall prosecution cost that may be commensurate with that of a non-expedited application.

Claim Requirements

Accelerated Examination applications are limited to 3 independent claims and 20 total claims.⁹ Prioritized Examination applications are allowed up to 4 independent claims and up to 30 total claims.¹⁰ Depending on the nature of the application, some applicants may desire the higher number of claims allowed by Prioritized Examination.



Requests for Continued Examination and Notices of Appeal

Another significant difference between applications filed under Accelerated Examination and those filed under Prioritized Examination are the options to file a Request for Continued Examination (RCE) and a Notice of Appeal.

For applications filed under Accelerated Examination, expedited examination of the application will continue after an RCE is filed and if prosecution is re-opened after a Notice of Appeal is filed.¹¹ By contrast, in Prioritized Examination the filing of an RCE or Notice of Appeal results in loss the application's status under Prioritized Examination.¹² That said, it is possible to pay another Prioritized Examination fee of \$4800, as noted above, to reinstate the application's status under Prioritized Examination after the filing of an RCE (but not after the filing of a Notice of Appeal).¹³

Time-to-Allowance and Examiner Cooperation

A number of attorneys and agents at MBHB have successfully prosecuted Accelerated Examination applications to allowance. We have observed a very short time-to-allowance for this type of application, including a number of first-action allowances. Additionally, we have observed a high level of Examiner cooperation. In particular, many Examiners seem eager to work with the applicant to find allowable subject matter.

We do not yet know whether a similarly favorable time-to-allowance and level of examiner cooperation will exist for Prioritized Examination applications. However, in a recently-released report on the Prioritized Examination program, the USPTO has indicated that on average, a first Office Action is mailed 66.4 days after a Prioritized Examination application is filed.¹⁴

As a practice note, it is important to remember that the filing receipt of a Prioritized Examination application will not indicate whether the application has been approved for the program, or whether it is in the program at all. Instead, an additional "Decision for Granting Request for Prioritized Examination" will be mailed approximately 30 days after the filing receipt is mailed.

Number of Applications

Still another notable difference between Accelerated Examination and Prioritized Examination is the number of applications the USPTO allows to be filed under each program. An unlimited number of cases can be filed under Accelerated Examination in any year. However, the Prioritized Examination program is limited to 10,000 applications per USPTO fiscal year, which runs until October 1.¹⁵ That said, as of January 4, 2012, only 980 cases have been filed under Prioritized Examination for the current fiscal year.¹⁶ At this rate, the limit is not likely to be met.



Insight from MBHB's Accelerated Examination Practice

As noted above, attorneys and agents at MBHB have prosecuted a number of Accelerated Examination applications. Based on this experience, we have compiled the following pointers for the preparation and filing of Accelerated Examination applications.

We have observed that USPTO Examiners can be inconsistent in their adherence to the Accelerated Examination procedures outlined in the Examiner's Checklist for Accelerated Examination. In particular, we've observed that some Examiners will strictly review the Pre-Examination Search Statement and Accelerated Examination Support Document, which can result in petitions for Accelerated Examination to be rejected for seemingly minor reasons.

Applicants have only one chance to correct these documents and remain under Accelerated Examination. A second rejection will cause an application to lose its status as an Accelerated Examination application. Below is a sampling of pitfalls to avoid in preparing these documents.

Pre-Examination Search

The Examiner's checklist specifies that the Pre-Examination Search must "be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation" and further must "encompass the disclosed features that may be claimed." Some Examiners have interpreted this language to require that the applicant search not only the limitations of all of the independent claims, but also the limitations of all of the dependent claims. For this reason, it is perhaps advisable to perform a Pre-Examination Search after finalizing the claim listing for an application, to ensure that all of the claims, and the exact language of the claims, is the subject of the search.

Accelerated Examination Support Document

Additionally, the Examiner's checklist specifies that the Pre-Examination Search must include a "detailed explanation of how each claim is patentable over the references cited with particularity" Some Examiners have interpreted this language to require that the applicant argue for the patentability of each dependent claim as well as each independent claim. Thus, the Accelerated Support Document may generate more prosecution history estoppels than a typical Office Action Response. For this reason, we believe that Prioritized Examination is a better choice for most applications.



Illinois MCLE Board Grants MBHB Accredited CLE Provider Status Effective January 1, 2012

McDonnell Boehnen Hulbert & Berghoff LLP ("MBHB") has been granted Accredited Continuing Legal Education ("CLE") Provider status in Illinois by the Minimum Continuing Legal Education ("MCLE") Board of the Supreme Court of Illinois. As an Accredited CLE provider, all of the firm's CLE programs are presumptively approved for general credits. MBHB was retroactively granted this status as of January 1, 2012.

By way of background, when establishing the MCLE Rules, the Illinois Supreme Court created the MCLE Board of the Supreme Court of Illinois to administer the MCLE program. On September 29, 2005, the Supreme Court of Illinois ordered MCLE under Supreme Court Rules 790 through 798. With certain exceptions set forth under Rule 791(a), MCLE is required for "every attorney admitted to practice in the State of Illinois." The rules cover

the administration of the program for MCLE, what education is actually required and what programs can be accredited for such education.

Every Illinois attorney subject to the MCLE Rules is required to complete a certain number of hours each two-year reporting period (Rule 794). An attorney's two-year reporting period depends on the first letter of the attorney's last name as it appeared on the master roll of attorneys when the individual attorney was admitted to the Illinois bar. The CLE reporting period is broken down for attorneys with last names beginning A-M and, separately, N-Z. Beginning with the July 1, 2010 through June 30, 2012 two-year reporting period for attorneys with last names beginning A-M, and all two-year reporting periods thereafter, 30 CLE activity hours are required. Of these total hours, at least 6 must be in the area of professional responsibility.

Table 1: Comparison of Accelerated and Prioritized Examination

	Prioritized Examination¹⁷	Accelerated Examination¹⁸
Timeline for Final Disposition	Final Disposition in 12 months. Final Disposition entails: (a) Applicant files a petition for extension of time to extend the time period for filing a reply; (b) Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim; (c) Applicant files an RCE; (d) Applicant files a Notice of Appeal; (e) Applicant files a request for suspension of action; (f) A Notice of Allowance is mailed; (g) A Final Office Action is mailed; (h) The application is abandoned; or (i) Examination is completed as defined in 37 CFR 41.102.	Final Disposition in 12 months. Final Disposition entails: (a) A Notice of Allowance is mailed; (b) A Final Office Action is mailed; (c) Applicant files an RCE; or (d) The application is abandoned.
Claim Limits	4 independent claims; 30 total claims.	3 independent claims; 20 total claims.
Timeline for Examination	Standard timeframe for responses set forth by MPEP 710.02(b), e.g., 3 months to respond to an office action.	1 month to respond to an office action.
Effect of Applicant Taking an Extension of Time	Available, but results in removal of special status.	Not available; failure to timely reply will result in abandonment.
Pre-Examination Search	Not Required.	Required.
Maximum Number of Applications	10,000 per fiscal year.	No maximum.
Eligible Applications	Any original utility non-provisional applications (including continuing and divisional applications). Not available for international, design, reissue, provisional, and reexamination applications.	Any non-reissue utility or design application (including continuing and divisional applications). Not available for international, plant, reissue, provisional, and reexamination applications.
Effect of RCE	Special status is withdrawn when an RCE is filed. However, an applicant can pay an additional Prioritized Examination fee to keep the RCE on prioritized Examination.	Special status is retained when an RCE is filed.
Effect of Appeal	Special Status withdrawn when Notice of Appeal filed. Applicant cannot pay for Prioritized Examination again on the application.	Standard appeal process. If examination is re-opened then Accelerated Examination procedures still apply.

	Prioritized Examination ¹⁷	Accelerated Examination ¹⁸
Carry Over to Continuations	Status as Prioritized Examination application does <i>not</i> carry over to child.	Status as Accelerated Examination application does <i>not</i> carry over to child.
Filing Requirements	Must: (i) file complete application under 37 CFR 1.51(b); (ii) file via EFS-Web; (iii) file with oath or declaration; and (iv) file with all applicable fees.	Must: (i) file complete application under 37 CFR 1.51(b); (ii) file via EFS-Web; (iii) file with oath or declaration; (iv) file with all applicable fees; (v) file with petition to make special; (vi) file with combined pre-examination search statement and accelerated examination support document; and (vii) file an IDS. ¹⁹
Petition Dismissal	Applicant can file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing the request for prioritized examination is not proper. Applicant should review the reason(s) stated in the decision dismissing the request and make a determination that an error was made by the Office in not granting the request before filing such a petition under 37 CFR 1.181.	Applicant is allowed one chance to fix a dismissed petition with a one month response period.
Fees	\$6,480, plus any excess claims fees (includes: (i) \$4,800 prioritized examination fee, (ii) \$1,250 filing fees, (iii) \$130 processing fee, and (iv) \$300 publication fee. ²⁰	Standard application fees, plus \$130 fee for petition to make special.
Interviews	Encouraged.	Applicant must agree to an interview with the examiner to discuss any outstanding issues arising in the examination process. Any pre-first action interview should be held within two weeks of initial contact by the examiner.
Restriction Practice	Standard restriction practice applies.	Applicant agrees to elect without traverse a single invention for examination.
Non-Publication Request allowed?	Yes.	Yes.

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Endnotes

1. Leahy-Smith America Invents Act, Pub. L. No. 112-29, <http://www.gpo.gov/fdsys/pkg/PLAW-112publ29/pdf/PLAW-112publ29.pdf>.
2. Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59050-55 (Sep. 23, 2011) [hereinafter Prioritized Examination].
3. Changes to Practice for Petitions in Patent Applications To Make Special and for Accelerated Examination, 71 Fed. Reg. 36323-27 (June 26, 2006) [hereinafter Accelerated Examination].
4. *Id.* at 36324.
5. *Id.* at 36324-25.
6. Prioritized Examination, *supra* note 2, at 59051.
7. U.S. Patent and Trademark Office, Accelerated Examination FAQs 5, http://www.uspto.gov/patents/process/file/accelerated/ae_faq_091207.pdf (last visited Jan. 28, 2012); 37 C.F.R. § 1.17(h).
8. U.S. Patent and Trademark Office, Frequently Asked Questions, Prioritized Examination (Track 1), Question PE4, http://www.uspto.gov/aia_implementation/faq.jsp#heading-9 (last visited Jan. 28, 2012).
9. Accelerated Examination, *supra* note 3, at 36324.
10. Prioritized Examination, *supra* note 2, at 59051.
11. Accelerated Examination FAQs, *supra* note 7, at 9 (“In the very rare circumstance where an examiner might re-open prosecution after the filing of an appeal brief, the application would still be examined under the accelerated examination program.”).
12. Frequently Asked Questions, Prioritized Examination (Track 1), *supra* note 8, at Question PE15.
13. Changes To Implement the Prioritized Examination for Requests for Continued Examination, 76 Fed. Reg. 78566 (Dec. 19, 2011).
14. U.S. Patent and Trademark Office, USPTO Track I: The Agency’s Self-Report on Implementation Performance Through Year-End 2011, http://www.uspto.gov/blog/director/entry/uspto_track_i_the_agency (last visited Jan. 28, 2012).
15. Frequently Asked Questions, Prioritized Examination (Track 1), *supra* note 8, at Questions PE11 and PE13.
16. U.S. Patent and Trademark Office, Patents Examination, Prioritized Examination, http://www.uspto.gov/aia_implementation/patents.jsp#heading-5 (last visited Jan. 28, 2012).
17. See, e.g., Prioritized Examination, *supra* note 2; Frequently Asked Questions, Prioritized Examination (Track 1), *supra* note 8.
18. See, e.g., Accelerated Examination, *supra* note 3; Accelerated Examination FAQs, *supra* note 7.
19. An applicant typically needs to file two IDSs with the application – one “full” IDS and another IDS with the “most closely related” reference(s).
20. The publication fee is required even if a non-publication request is filed, but is refundable if the application issues and the application has not published (the assumption is that this applies if the application is abandoned without publishing, but this is not explicitly stated).