

COMMON BASIS FOR A PETITION TO MAKE SPECIAL

Patent prosecution typically takes 2-5 years until a patent issues. There are circumstances where an application can be made “special” or “fast-tracked” such that it passes through the system at expedited processing rates. Two of the more common basis for seeking special status are actual infringement and meeting the requirements for accelerated examination.

The requirements for granting special status under accelerated examination are:

- a. A petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- b. all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention;
- c. a statement that a pre-examination search was made listing the field of search;
- d. one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- e. a detailed discussion of how the claim subject matter is patentable over the references in accordance with 37 CFR 1.11 (b) and (c)

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following:

1. the appropriate petition fee under 37 CFR 1.17(h);
2. a statement by the assignee, applicant, or attorney alleging:
 - a. that there is an infringing device or product actually on the market or method in use;
 - b. that a rigid comparison of the alleged infringing device, product of method with the claims of the application has been made and that, in his or her opinion, some of the claims are unquestionably infringed; and
 - c. that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

have been distinguished from the above references found in the pre-application search and that the claims are now allowable.

The Application should be made special because of infringement under MPEP 708.02, Paragraph II.

Applicant petitions the Commissioner to make the application special for the reason that his invention, as presently claimed, is being infringed, and that Applicant receive Letters Patent for the Applicant's invention. The following facts are submitted in compliance with Paragraph II of MPEP 708.02:

[Infringing apparatus/process] which are believed to infringe the [Applicant's invention] claims of the Application are now being used, as noted below:

- (a) Infringing products' methods: [details of alleged infringing item]
- (b) Comparison of the [infringing apparatus/process] with claims [details of alleged infringing item]

In view of the foregoing facts, the Information Disclosure Statement and the Supplement of Information Disclosure Statement, Applicant respectfully petitions that his application be made Special. Applicant believes that if the Application is examined and processed to issue in its regular order, too great a period of time will elapse before the patent can be issued, and hence, before the infringement can be halted, resulting in irreparable or at least substantial loss of the Applicant's investment due to the at least partial saturation of a large segment of the applicable market with infringing website.

The Application should be granted Special Status under MPEP 708.02 Paragraph VIII

In compliance with Paragraph VIII, noted above:

- (a) Applicant submits this written petition to have the application made special;
- (b) Applicant submits that the claims presented in the application are directed to a single invention and further submits that if the Patent Office determine that all of the claims are not directed to a single invention, Applicant will make an election without traverse for the purpose of examination;
- (c) Applicant hereby states that a pre-examination search of the art of an [invention] was made prior to the filing of the Application. Applicant has submitted in this Application an Information Disclosure Statement setting forth the patents and other art that the searcher found to be the closest art located during the search and of other patents known to the Applicant or their attorney of record.
- (d) Applicant with the submission of the Disclosure Statement herewith submits one copy of the reference obtained in the pre-examination search and other patents as described above;
- (e) Applicants in the Disclosure Statement described above have submitted a detailed description of the references which points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is distinguished over the references.

As noted above, Applicant has complied with the requirements of Paragraph VIII, and requests that this Application be granted special status to receive accelerated examination and be given top priority for printing after allowance, in accordance therewith.

Conclusions

Applicant has presented facts and circumstances which clearly indicate irreparable damage will occur if the Application is permitted to be examined and processes to issue in it regular order. Applicants have shown that the requirements of MPEP 708.02, Paragraph II, have been fulfilled, and that therefore this petition should be granted and the Application made Special because of infringement.

Independently of Applicant's request on the basis of the infringement, Applicant has petitioned that the Application be granted special status and receive accelerated examination and top priority to issue after allowance, on the ground that they have fulfilled all of the requirements of Paragraph VIII of MPEP 708.02. Applicant respectfully requests that an order be issued directing the above-identified Application be made "Special."

A check fee is submitted herewith for filing this Petition to Make Special.

Respectfully submitted,

[Submitter's Name]

[Date of Signature]