

## Patent Fast Lanes Now Open Despite Holiday Rush!

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The Patent community should celebrate as the U.S. Patent Office has sent a wonderful holiday present to finish out the year. The Patent Office recently **announced expansion** of the “fast lane” priority examination to patent applicants making a Request for Continued Examination (RCE). By providing for this expansion to an RCE application, the Patent Office removed much of the uncertainty and risk associated with the previously limited “Patent Acceleration.” Prior to this expansion, if a patent applicant chose the “fast lane,” it risked being moved to the “slow lane” if it was unsuccessful within the first year. The new expansion program greatly enhances the options for all patent applicants. This should be heralded as good news for all businesses and should enhance commercialization of technology. This expansion by the Patent Office has occurred in now what is just under two months after publishing a final rule implementing the Track I **prioritized examination** of patent applications after passage of the Leahy-Smith America Invents Act in September of 2011.

Track I accelerated examination was created by the America Invents Act as a “fast lane” for patent prosecution. The goal of this program is to create an avenue for a patent applicant to bring an application from filing to final disposition—hopefully allowance—within one year. Previously, “Patent Acceleration” was available only in certain specific cases, such as an elderly or infirm inventor or where environmental technologies were involved. Under Track I, all applicants willing to pay the substantial fee—\$4,800 for an entity not claiming small entity status (or \$2,400 for qualifying small entities)<sup>1</sup> may apply for expedited status upon filing of the application.

The one-year period begins upon grant of priority status and ends upon final disposition of the application. This final disposition is normally in the form of a notice of allowance, a final office action, a filing of appeal, or notably the filing of a Request for Continued Examination. After the occurrence of any of these events, the expedited examination process ends and the application is no longer afforded priority treatment.

With the latest rule change, an applicant may now apply for Track I status not only upon initial filing of the application, but also when filing an RCE. An RCE can be used to continue prosecution of an application after the application is considered closed. The Patent Office typically considers prosecution of an application closed when the application has been appealed or a final office action or a notice of allowance has been issued. Once this occurs, an applicant is severely limited in what actions can be taken as a matter of right. When granted, an RCE reopens and “resets” the prosecution, allowing the applicant to go through the examination phase again as if from the start.

As such, it is possible that a post-RCE application can become as protracted a fight as the initial application. For an applicant who has already endured years of prosecution, the option to switch into the fast lane late into prosecution could well be worth the investment.

Furthermore, the filing of an RCE in a Track I application ends the priority treatment of the application, and the applicant is back in the slow lane. Under the final rule, an applicant can now “renew” priority status for the duration of the continued examination. Where time is of the essence for the applicant, the ability to stay in the fast lane can be critical.

The eligibility rules for requesting Track I status of an application after an RCE is filed are the same as those for an initial application. The application must be in a utility or plant non-provisional patent application, can have no more than 4 independent claims with fewer than 30 total claims, and can have no multiple dependent claims. If the application is amended to be non-compliant with one of these criteria, priority status will be lost.

The expansion of the Track I program to applications undergoing continuing examination provides an excellent avenue for patent applicants who require expedited examination even late into prosecution. Although expensive, having Track I status for the post RCE procedures adds predictability to a patent application and what could be an invaluable competitive advantage that makes all the difference.

Should you have any questions regarding the Track I "fast lane" or how this may impact your patent applications, please contact any one of the authors of this update, or your Bracewell & Giuliani patent attorney. We will, of course, keep you updated should any new information arise.

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<sup>1</sup> Additionally, qualifying "micro entities" will be afforded a 75% discount (i.e., only incur a \$1,200 fee) once the USPTO adjusts its fees to incorporate this feature of the America Invents Act. See 35 U.S.C. § 123 for a definition of a micro entity

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