

April 8, 2011

USPTO Issues Final Rules to Implement Prioritized Examination Track (Track I)

In June 2010, the United States Patent and Trademark Office (USPTO) proposed a three-track patent application examination system, whereby the applicants are given greater control over when their original patent applications are examined. Under the proposal, applicants would be able to: (1) request prioritized examination (Track I); (2) request a delay for examination (Track III); or (3) obtain processing under the current examination procedure (Track II) by not requesting either Track I or Track III.

On April 4, 2011, the USPTO issued a final rule to implement the Prioritized Examination Track (Track I) by allowing applicants to request prioritized examination with a payment of a \$4,000 request fee. The goal of Track I is to provide eligible patent applications a final disposition within 12 months of the request being granted.

Qualification Requirements

Applicants may submit request for prioritization on or after the effective date of May 4, 2011. Under a new 37 C.F.R. 1.102(e), to be eligible for Track I, (1) the application must be an original utility or plant non-provisional application; (2) the application must be filed with an executed oath or declaration under 37 C.F.R. 1.63 and all applicable fees; (3) the application must contain no more than four independent claims and no more than thirty total claims; and (4) a request for prioritized examination must be filed along with a \$4,000 filing fee. The Office is limiting requests for prioritized examination to a maximum of 10,000 applications for fiscal year 2011.

The Office plans to revisit the 10,000-application limit at the end of fiscal year 2011 for future years. Currently, the Office does not have the authority to reduce the \$4,000 filing fee for small entities. However, the patent reform legislation passed by the Senate (S.23) and pending in the House (H.R. 1249) contains such authority. Thus, a reduced filing fee could be made available to small entities in the future.

Prioritized Examination Process

Once granted prioritized status, an application will be given special status and placed on the examiner's special docket throughout its entire course of prosecution until a final disposition is issued. "Disposition" is defined to mean (1) mailing of a notice of allowance; (2) mailing of a final Office action; (3) filing of a notice of appeal; (4) declaration of an interference by the Board of Patent Appeals and Interference (BPAI); (5) filing of a request of continued examination; or (6) abandonment of the application.

For more information, please contact your Katten Muchin Rosenman LLP attorney, or any of the following members of Katten's **Intellectual Property Practice**:

Annette Kwok
202.625.3734 / annette.kwok@kattenlaw.com

John S. Paniaguas
202.625.3734 / johnp@kattenlaw.com

Samson Helfgott
212.940.8683 / samson.helfgott@kattenlaw.com

Richard P. Bauer
202.625.3507 / richard.bauer@kattenlaw.com

Justin L. Krieger
202.625.3858 / justin.krieger@kattenlaw.com

Summary

Track I is advantageous for applicants seeking to expedite the prosecution of original applications. Care should be taken when drafting claims and preparing the application to ensure that the application meets the requirements as set forth in the rule.

For a copy of the Federal Register notice, please click [here](#).

Katten

www.kattenlaw.com

KattenMuchinRosenman LLP

CHARLOTTE

CHICAGO

IRVING

LONDON

LOS ANGELES

NEW YORK

WASHINGTON, DC

Published as a source of information only. The material contained herein is not to be construed as legal advice or opinion.

©2011 Katten Muchin Rosenman LLP. All rights reserved.

Circular 230 Disclosure: Pursuant to regulations governing practice before the Internal Revenue Service, any tax advice contained herein is not intended or written to be used and cannot be used by a taxpayer for the purpose of avoiding tax penalties that may be imposed on the taxpayer. Katten Muchin Rosenman LLP is an Illinois limited liability partnership including professional corporations that has elected to be governed by the Illinois Uniform Partnership Act (1997). London affiliate: Katten Muchin Rosenman UK LLP.