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An Overview of Expedited Prosecution Options for Patent Applicants

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Legal Update

In our November 2010 and January 2010 issues, we reported on the Patent Office's (PTO) then-new Green Technology Pilot Program (GTPP), which was one of several programs that allow an applicant to receive expedited prosecution of their application. The GTPP in particular allows an applicant to petition for his or her application to be examined more quickly if it pertains to the development of a renewable energy source, energy conservation, or the reduction of green house gas emissions. Earlier this year, the PTO officially closed the opportunity to file petitions under the GTPP because the number of granted petitions and pending applications reached the limit of 3,500 applications being accorded special status under the pilot program. Many applicants are now faced with the question of what to do to speed up prosecution of their applications, whether they are directed to "green tech" or not.

Despite the termination of the GTPP, a number of options remain available to expedite prosecution of patent applications. Furthermore, many of these options are not limited to "green" technologies and are options that applicants should generally keep in mind for speeding up prosecution. Expediting prosecution using these options can be beneficial for many reasons, including addressing ongoing potential infringement and securing investments in the protected technology.

The following options are listed in order of monetary cost to the applicant, from lowest to highest. Only basic informational summaries are provided below—prior to filing a request under any of the following programs, be sure to consult the current, complete rules at the PTO's website.

Petition To Make Special Based on the Applicant's Age or Health

Cost: \$0

Qualify by: Filing a petition to make special for a utility application on the basis of the applicant being age 65 or older or on the basis of the applicant's health being that the applicant may not be available to assist in prosecution if prosecution proceeds normally.

Benefit: Applications are normally examined in the order in which they are received by the PTO's various art units, but an application with a granted petition to make special advances the application out of turn to be examined earlier than it otherwise would have been. Such applications are typically fast-tracked for examination within 2–3 months.

Patent Prosecution Highway

Cost: \$0

Qualify by: Filing a petition to make special for a utility application on the basis of receiving a ruling from a participating foreign patent office in which the application was first filed that at least one claim in the application filed in the foreign patent office is patentable. The claim(s) with favorable treatment from the foreign patent office must correspond to the pending U.S. claim(s), and substantive examination must not yet have begun in the U.S. A list of participating foreign patent offices is available at the PTO website.

Benefit: An application with a granted petition to make special advances out of turn to be examined earlier than it otherwise would have been. The PTO's stated goal for Patent Prosecution Highway (PPH) applications is to fast-track the applications for examination within 2–3 months. So far, more than 90% of applications fast-tracked under the PPH have been allowed.

Accelerated Examination for “Green” Technology or for Countering Terrorism

Cost: \$0

Qualify by: Meeting the requirements of accelerated examination (discussed below) and filing a petition to make special on the basis of any one of enhancing the quality of the environment, contributing to the discovery or development of energy resources or the more efficient utilization and conservation of energy resources, or contributing to countering terrorism.

Benefit: An application with a granted petition to make special advances out of turn to be examined earlier than it otherwise would have been. The PTO's stated goal of accelerated examination is to provide final disposition of an application within 12 months. Final disposition includes mailing a notice of allowance, mailing a final office action, filing a notice of appeal, completion of examination as defined in 37 C.F.R. § 41.102, filing a Request for Continued Examination (RCE), and abandonment.

Accelerated Examination for All Other Design and Utility Patent Applications

Cost: \$130

Qualify by: At the time of filing a design or utility application having no more than 3 independent claims, no more than 20 claims total, and no multiple dependent claims, file a petition to make special, file a pre-examination search document (PESD), and file an accelerated examination support document (AESD). The PESD must state that the applicant conducted a prior art search meeting certain requirements. The AESD must include an Information Disclosure Statement (IDS), identification of any references in the IDS disqualified as prior art under 35 U.S.C. § 103(c), identification of claim limitations disclosed in each reference cited in the IDS, a detailed explanation of how each claim is patentable over the references cited in the IDS, identification of each means-plus-function claim and support for each means-plus-function claim element in the specification, a concise statement of the application's utility, and a showing of each claims' 35 U.S.C. § 112, first paragraph, written description support in the application.

Benefit: An application with a granted petition to make special advances out of turn to be examined earlier than it otherwise would have been. The PTO's stated goal of accelerated examination is to provide final disposition of an application within 12 months.

Prioritized Examination

Cost: \$4800 large entity; \$2400 small entity

Qualify by: File a prioritized examination request for a utility or plant application having no more than 4 independent claims, no more than 30 claims total, and no multiple dependent claims. The request must be filed before issuance of a first office action or a first action after the filing of a first RCE. The RCE must have been filed on or after the prioritized examination program's effective date of December 19, 2011.

Benefit: The PTO's stated goal of prioritized examination is to provide final disposition of an application within 12 months.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617-439-2000.

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Intellectual Property

Patent Prosecution and Portfolio Management