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New Fast Track Patent Examination Program

On Monday, April 4, 2011, the United States Patent and Trademark Office (USPTO) announced that it will be implementing a new prioritized patent application examination program beginning May 4, 2011. Under this program, patent applicants can obtain prioritized examination for eligible patent applications upon payment of an appropriate fee. This program is a significant departure from previous expedited examination programs at the USPTO that required a patent applicant to perform an extensive patentability search and provide the USPTO with a detailed patentability report in order to obtain faster examination.

The basic parameters of this new "Track 1" prioritized examination program are:

- Eligible patent applications are U.S. patent applications filed on or after May 4, 2011. If a patent applicant has a patent application that was already pending prior to this time, the applicant can still take advantage of the prioritized examination program by filing a continuation patent application from the pending patent application on or after May 4, 2011. U.S. national stage entry patent applications from PCT patent applications are not eligible for prioritized examination. However, a continuation patent application filed from such a U.S. national stage entry patent application may be eligible.
- The USPTO fee for requesting prioritized examination will be \$4,130. A small entity fee reduction is NOT currently available for this program. Also, applicants will need to pay a publication fee of \$300 at the time of filing, which represents an early payment of a fee that is normally not payable until the issue fee is due. Furthermore, for an applicant that files a continuation patent application to take advantage of the prioritized examination program, the normal filing fees for the continuation patent application also must be paid.
- The claims of the eligible patent application must be limited to no more than 30 total claims, of which no more than four can be independent (the "4/30" rule).
- The eligible patent application must be "complete" at the time of filing, which means that it must be filed with a signed Declaration and include all USPTO fees that are due.
- The prioritized examination program is limited in size to 10,000 patent applications for the current USPTO fiscal year.

The USPTO announcement states that the USPTO will commit itself to providing a final disposition of a patent application through this program within 12 months of the

prioritized examination request. The USPTO announcement defines “final disposition” as (1) the USPTO mailing a Notice of Allowance, (2) the USPTO mailing a final Office Action, (3) the applicant filing a Notice of Appeal, (4) the USPTO declaring an interference, (5) the applicant filing a Request for Continued Examination (RCE), or (6) the applicant abandoning the patent application. This can be contrasted with regular examination times for patent applications, which are often at least three years in duration (or longer for patent applications in technology areas where the USPTO has a large backlog of unexamined patent applications). Thus, the USPTO’s new prioritized examination program can provide significant acceleration of the patent examination process, which may result in applicants being able to obtain issued patents earlier than they would otherwise. Prioritized examination can be particularly valuable for inventions in swift- moving technology areas.

For patent applications undergoing prioritized examination, applicants are still permitted to request extensions of time for responding to Office Actions during the examination process, but doing so will remove the patent application from the prioritized examination program.

Also, if a patent application undergoing prioritized examination is amended in a manner to cause the claims to violate the 4/30 rule, then the application will be removed from the prioritized examination program. This scenario may arise, for example, where an applicant amends five dependent claims into independent form in response to an examiner’s rejection of the underlying independent claims and indication of allowability of the dependent claims. Although such an amendment would result in the application being removed from the prioritized examination program, the removal at this late stage of the examination process may not result in a significant delay in further processing by the examiner.

If an applicant desires to keep the content of that patent application confidential while it is pending, it should not use the prioritized examination program because the program requires publication of the eligible patent application. As such, applicants will need to balance their interests in nonpublication against any interests in obtaining prompter examination.

If you are interested in participating in this prioritized examination program or otherwise have questions about this prioritized examination program, please contact your Thompson Coburn attorney, or one of the Intellectual Property attorneys listed below:

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