

# Life in the fast lane

**Carson Fincham** reviews the various fast track options for patent examinations at the USPTO

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**The US Patent and Trademark Office (USPTO) has implemented a rule<sup>1</sup> that will create from May 4, 2011 a new “fast track” for patent application examination.** This new “fast track” comprises “Track I” of a proposed three-tier system for prosecution and is called “Prioritized Examination”. The first tier or Track I is a fast track for prosecution, the second tier or Track II is the standard prosecution process, and the third tier or Track III will be a delayed prosecution option (which has not yet been formally published for notice and comment).

Any new and complete<sup>2</sup> non-provisional (or plant) patent application will qualify, and for a fee of \$4,000, the first 10,000 applications (in the first year) requesting Prioritized Examination will be granted *limited* “special status”. The special status is limited by nature of only staying in effect until “final disposition” of the case during the first 12 months of prosecution. “Final disposition” may be achieved via mailing of a Notice of Allowance of Final Office Action by the office or by abandonment or filing of a Request for Continued Examination (RCE) or Notice of Appeal by the applicant. This may at first glance appear adequate, but for those well versed in the process of sparring with the USPTO, it is well understood that final Office Actions are all too often premature, improper, or simply without merit (and accordingly easily overcome, but necessitating the filing of either an RCE or Notice of Appeal to do so). The special status

may also be forfeited in the case that an applicant requests an extension of time for filing a response to the office.

The Prioritized Examination application must be limited to four independent and 30 total claims, which is slightly more liberal than the claim limitations for the current Accelerated Examination Program. In addition to the Prioritized Examination fee of \$4,000, a processing fee of \$130 must be paid upon filing. Further, similar to the Green Tech Pilot Program, while normally not paid until allowance (or in the case that the applicant desires early publication), the publication fee of \$300 must also be paid upon filing to qualify for Prioritized Examination. Although early publication is not required for Track I as it is with the Green Tech Pilot.

## Other options

Currently, there are three principal ways<sup>3</sup> that an applicant for a US patent may receive expedited examination of their application: (1) a Petition to Make Special under 37 CFR §1.102(c), (2) the Accelerated Examination Program pursuant to MPEP §708.02(a), and (3) the Green Tech Pilot Program<sup>4</sup>. Each current option has distinct advantages and limitations.

The Petition to Make Special, while being free of charge for example, is now limited (for applications filed after August 25, 2006) to situations where the inventor’s age or health warrant an expedited examination

Expedited examination option	Eligibility	Limitations / Drawbacks	Official fees <sup>11</sup>	Estimated labor cost <sup>12</sup>	Total estimated cost
Petition to Make Special	Petition based on: Inventor Age or Health, or “Project Exchange”	None	None	\$700–\$1,050	\$700–\$1,050
Accelerated Examination Program	Petition based on: Prospective Manufacture, Actual Infringement, Environmental Quality, Energy, Recombinant DNA, Superconductivity, HIV/AIDS or Cancer, Counter-Terrorism, or Small Entity Biotech or no particular grounds	<ul style="list-style-type: none"> <li>• Requires detailed prior art search;</li> <li>• Requires Examination Support Document (ESD);</li> <li>• Limited to three independent and 20 total claims;</li> <li>• Strict examination timelines and procedures</li> </ul>	\$0 - \$130 (depends on basis for petition)	\$2,000–\$6,000	\$2,000–\$6,130
Green Tech Pilot Program	Petition based on: “Green” technology; only 3,000 available per year	Early publication required	\$300	\$700–\$1,050	\$1,000–\$1,350
Prioritised Examination (Track I)	Only 10,000 available per year	<ul style="list-style-type: none"> <li>• Limited to four independent and 30 total claims;</li> <li>• “Special status” is limited and may be forfeited</li> </ul>	\$4,430	\$175	\$4,605

## Patent examinations

process<sup>5</sup>. If the Petition to Make Special is granted, the “special status” (ie, being placed on the Examiner’s Special Docket – with the goal of average pendency being reduced to approximately 12 months<sup>6</sup>) accorded to the application is maintained for the duration of prosecution.

The Accelerated Examination Program (which has replaced all of the pre-2006 Petition to Make Special situations except situations based on the inventor’s age or health) requires applicants to conduct a rigorous pre-examination prior art search. It also requires the applicant to draft and supply an onerous Examination Support Document (ESD), comply with shortened response deadlines, and is limited to examination of three independent and 20 total claims.

The Green Tech Pilot Program is a great and inexpensive<sup>7</sup> option for environmentally-oriented applications, but space in the program is limited (based on current figures<sup>8</sup>, no petitions seem likely to be granted after August 2011), early publication is required, and grant rates for the petitions have been 50% or less<sup>9</sup>.

For ease of comparison amongst the various fast track options, including the new Prioritized Examination (Track I), a revised and enhanced version of the “USPTO Patent Examination Acceleration Programs and Proposals”<sup>10</sup> chart is provided for reference (for applications filed after August 25, 2006).

### Footnotes

1. Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures, 76 FR 18399 (April 4, 2011); <http://edocket.access.gpo.gov/2011/pdf/2011-7807.pdf>
2. “Complete” means that the application comprises all requisite parts, including an executed inventor oath or declaration (ie, no “missing part” applications will qualify), as well as payment of any excess claim fees.
3. The Patent Prosecution Highway (PPH) Program is not considered here because it does not assist in expediting prosecution of an original application, and the expedited examination of inventions “of peculiar importance to some branch

of public service and the head of some department of the Government” under 37 C.F.R. §1.102(b) is not considered due to limited practical applicability.

4. [http://www.uspto.gov/patents/init\\_events/green\\_tech.jsp](http://www.uspto.gov/patents/init_events/green_tech.jsp)
5. Or where the applicants qualifies for and requests entry into the “Project Exchange” program, which allows an applicants to receive expedited examination in one application in exchange for express abandonment of another application; [http://www.uspto.gov/patents/init\\_events/PatentStimulusPlan.jsp](http://www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp)
6. Compared to a general average pendency of two (2) to four (4) years; <http://www.uspto.gov/patents/stats/patentpendency.jsp>
7. The only out-of-the-ordinary fee is the requirement to pay the publication fee of three hundred dollars (\$300); which is normally only paid upon allowance of an application.
8. [http://www.uspto.gov/patents/init\\_events/green\\_report\\_summary20110307.pdf](http://www.uspto.gov/patents/init_events/green_report_summary20110307.pdf)
9. See Note 4.
10. [http://www.uspto.gov/patents/process/file/accelerated/comp\\_chart\\_dom\\_accel.pdf](http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf)
11. Includes any fees that would not normally be paid upon filing.
12. Estimated labor based on an attorney rate of \$350 per hour and a paralegal rate of \$175 per hour.

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