



GETTING A PATENT FASTER – FOR A PRICE

New ‘prioritized examination’ could reduce wait to 12 months

By JAY H. ANDERSON

An inventor seeking a U.S. patent must file an application in the U.S. Patent and Trademark Office (USPTO), and then typically waits many months for the application to be examined. Depending on the technology involved, an application in the normal examination queue might wait as long as three years for any action by the USPTO. Such a long period of pendency is frustrating for many would-be patent owners.

Starting on May 4, 2011, the USPTO will offer “prioritized examination” of patent applications. (See 76 Fed. Reg. 64 (4 April 2011), pages 18,399-18,407, setting forth a “final rule” with changes to Title 37 of the Code of Federal Regulations.) This program was previously called Track I examination, with the current examination procedure referred to as Track II.

Under the new prioritized examination program, an application can get a final disposition in 12 months – in most cases, either a notice of allowance or a final rejection. The program is called “prioritized” examination to distinguish it from the USPTO’s existing “accelerated” examination procedures, which apply only in certain situations and have not changed. The USPTO is limiting the number of requests for prioritized examination to 10,000 applications during the remainder of fiscal year 2011 (ending Sept. 30).

Prioritized examination will be available only for new, non-provisional, utility or plant applications. Applications for design patents and applications already pending

will not be accepted for prioritized examination (although one may file a new “continuation” or “division” of a pending application, and request prioritized examination of that application).

Several strict requirements must be met at the time of filing: The application must be filed electronically (by uploading to the EFS-Web system on the USPTO web site); must be complete, including a signed declaration by the inventors and a request for prioritized status; and may have only a limited number of claims (30 claims total, with at most four independent claims).

Last but certainly not least, all of the fees – the regular filing and publication fees, a processing fee, and a \$4,000 fee for prioritized examination – must be paid when the application is filed. The USPTO gives a discount of 50 percent on most fees to small entities (which includes individuals, small businesses, and nonprofits). At present, however, the \$4,000 fee will apply to all applicants, large and small. This is because the small-entity discount is set by statute, not by the USPTO, and the new fee is not covered by the existing statute. Legislation granting the USPTO authority to set the small-entity discount is pending.

What does the applicant get for \$4,000? The 12-month period begins when the request for prioritized examination is granted. The application is then placed on the examiner’s special docket throughout the course of prosecution until a final disposition is reached. The examiner will issue a first Office Action, in which some claims may be allowed and other claims rejected. The appli-

cant typically has three months to respond to a rejection, by amending the claims and/or trying to persuade the examiner to withdraw the rejection. The next correspondence

from the examiner is generally either a Notice of Allowance or a “final” Office Action with a rejection of claims – both of which are treated as a final disposition under the prioritized examination procedures.

Less often, the second Office Action is not a final action, and the applicant can present further amendments and/or arguments. Once there is a final disposition, the application loses its special, prioritized status. The USPTO does not guarantee that this process will be completed in 12 months; there are no refunds of fees if the 12-month goal is not met.

To benefit from prioritized examination, the applicant should present at least some claims where allowance can be expected on the first or second Office Action. This means that the applicant needs to become familiar with the literature (especially patent publications) that the examiner is likely to cite as “prior art” – references showing that the claimed invention is not novel or would have been obvious.

It will be to the applicant’s advantage if the claims vary widely in scope – from the



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broadest that the applicant believes he is entitled to, given the state of the prior art, to the narrowest that the applicant is willing to accept. This is good practice in patent prosecution generally, but is especially important when seeking a quick allowance.

Interviews with the examiner (typically by telephone) to reach an agreement about allowable subject matter are encouraged by the USPTO, and are particularly valuable in prioritized examination. The applicant must take care to make a complete response to the Office Action within the allowed time; any request for extension of time results in loss of prioritized status. If the applicant at-

tempts to forestall a final Office Action by filing a Notice of Appeal, prioritized status is also lost.

If the application loses prioritized status without being allowed, due to a final rejection or otherwise, it remains pending and is returned to the normal examination queue. If the final disposition is a Notice of Allowance, the applicant has three months in which to pay another fee (the "issue fee"); the patent issues about eight weeks later.

Prioritized examination can be helpful to a highly motivated applicant who is willing to pay stiff fees to get quick issuance of claims with narrower scope than he might

get in standard (much longer) prosecution.

There are some applicants who, for a variety of reasons, may wish to *delay* action by the USPTO. The USPTO plans to offer a new program for these applicants also (presently called Track III), where an applicant may request a delay in payment of the search fee, the examination fee, and any claims fees. This will result in a delay in docketing the application for examination for up to thirty months. The USPTO hopes that these multi-track programs will give applicants greater control over when their applications are examined and promote greater efficiency in the patent examination process. ■