



USPTO Announces Launch Date for Fast-Track Patent Processing

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The United States Patent and Trademark Office (PTO) announced on April 4, 2011 that it will begin accepting requests on May 4, 2011 for prioritized examination of patent applications - allowing inventors and businesses to get their patent applications processed within twelve months. Under this program, eligible applications will be accorded special status and placed on the examiner's special docket throughout prosecution until final disposition. At this time, the PTO is limiting such requests to a maximum of 10,000 applications during fiscal year 2011, which ends September 30th.

The most significant aspect of this program, known as Track I, is the twelve month turnaround from application to final disposition. It is important to note that a twelve month turnaround is defined as a goal "in the aggregate," for all the prioritized applications handled, and not for any one application. Therefore, an applicant would not be guaranteed a final disposition within twelve months. However, in comparison to the current three year average to process a patent, prioritized applications will certainly proceed faster than the current process.

Also, "final disposition" is not simply allowance or rejection, but could also occur upon one of three actions by the applicant: (i) filing a notice of appeal; (ii) filing a request for continued examination; or (iii) abandonment of the application. The PTO will not refund the prioritized examination fee under any of these circumstances, and the prioritization status does not extend to RCE applications or to actions taken up by the Board of Patent Appeals and Interferences (BPAI). Moreover, extension of time requests and requests for Suspension of Action will also terminate the prioritized examination proceedings.

Track I prioritized examination will become available for any original, continuation, or divisional utility or plant application filed on or after May 4, 2011. Track I is not available for international applications (including PCT applications that have entered the US stage), design applications, reissue applications, provisional applications or reexamination applications.

Eligible applications, except for plant patent applications, must be electronically filed with no

missing parts, with all requisite fees, and with a request for prioritized examination. Applications may contain no more than four independent claims and no more than thirty total claims. The application may not contain any multiple dependent claims. Amendments resulting in claims not in compliance with program limits will terminate the prioritized examination proceedings.

Filing a request for prioritized examination through Track I will require a fee under 37 CFR ? 1.102(e) of \$4,000, in addition to filing fees for the application. At this time, there is no discount for small entities. Adding the standard processing fees, which are discountable for small entities, a corporate applicant choosing prioritized examination will pay \$5,090, with the small-entity applicant paying \$4,545, assuming the application conforms to the standard three independent claim and twenty total claims limit. However, the patent reform bills in Congress, S. 23 and H.R. 1249, would specifically allow the 50 percent discount for small entities filing an application under the Track I program. Should the 50 percent small-entity discount become available, the prioritized examination fee is expected to change to \$4,800 for a corporate applicant, and hence \$2,400 for small-entity applicants. The PTO explained that this large fee for prioritized examination would include the cost of hiring and training additional examiners in an attempt to prevent non-prioritized applications from being delayed as a result of diverting resources to process the prioritized applications.

The final rule is available at <http://pub.bna.com/ptcj/PTOchangesApr4.pdf> or on the PTO website at <http://www.uspto.gov/news/pr/2011/11-24.jsp>.

Should you have any questions, please contact Alison S. McGeary at 919.981.4319 or or any other member of the Williams Mullen Intellectual Property Team.

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