



USPTO Prioritized Examination Pilot

Pilot Starts May 4, 2011

USPTO Prioritized Examination Pilot

Prosecution will be processed under 3 Tracks

- ❖ Track I – Prioritized Examination
- ❖ Track II – Examination under current procedure
- ❖ Track III – Delayed Examination

Track I - Prioritized Examination

- ❖ Prioritized Examination of an original utility or plant non-provisional application (also available for new continuing applications – Continuations, Divisions)
- ❖ Not available for Reissue or Reexam Applications
- ❖ Not available for 371 National Phase Applications (file bypass Continuation)
- ❖ Final Disposition in 12 months
- ❖ Extensions not permitted – filing extension terminates prioritized status
- ❖ Limited to first 10,000 Requests filed during 2011 fiscal year
- ❖ Available for new applications filed on or after May 4, 2011

Track I - Prioritized Examination

- ❖ Request fee of \$4000 (plus publication fee \$300 and processing fee \$130 – currently no small entity reduction)
- ❖ Regular application filing fees must be paid in addition to Request fee
- ❖ Request fee may increase if Congress passes patent reform
- ❖ Filing a search report and written analysis is not required
- ❖ Different requirements than Accelerated Examination – less rigorous
- ❖ Track I rules will be implemented first so that Prioritized Examination option is available before Delayed Examination
- ❖ 10,000 application limit will be re-evaluated at the end of 2011 fiscal year

Track I - Prioritized Examination

Filing Requirements

- Request for PE must be filed with new application
- Up to 4 independent claims; 30 total claims
- No multiple dependent claims allowed
- Must pay excess claim fees at time of filing
- Complete application as required by 37 C.F.R. 1.51(b)
- Signed Declaration at time of filing
- Must file using Electronic Filing System (EFS)

Track I - Prioritized Examination

- ❖ Pilot promises Final Disposition in 12 months
- ❖ Events that define Final Disposition
 - Mailing Notice of Allowance
 - Mailing Final Office Action
 - Filing Notice of Appeal
 - Filing RCE
 - Declaration of Interference
 - Abandonment
 - Special status ends during Appeal or Interference

Track II - Examination under current procedure

- ❖ Default track if Track I or Track III are not requested
- ❖ No changes under Track II prosecution procedure

Track III - Delayed Examination

- ❖ Delay period cannot exceed 30 months in an original utility or plant application filed under 35 U.S.C. 111(a)
- ❖ Request delay in docketing application for Examination by filing Request for delay in payment of Search, Examination, Claims, and other surcharge fees
- ❖ Must pay filing fee
- ❖ Track III rules may not be ready by May 4, 2011

For more information or questions, please contact

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