

U.S. Patent and Trademark Office Issues Final Rule to Implement Prioritized Examination "Track 1"

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The U.S. Patent and Trademark Office (PTO) on April 4, 2011, issued a final rule to implement prioritized examination based on an applicant's request along with a payment of a \$4,000 request fee and additional filing fees. The final rule implements an earlier notice issued on February 4, 2011, which proposed rules for implementing the prioritized examination track (Track 1) of the Office's new examination timing control procedures.

The prioritized examination program is a recognition that all patent applications are not viewed equally by applicants. Some applicants are willing to pay an additional fee to get an application to the front of the examination queue. Some reasons why an applicant may wish to have a priority examination include a potential infringer on the market or an anticipated round of financing. The multi-year backlog of applications yet to be examined is the driving force for the program.

Under Track 1, applicants will have the opportunity to pursue accelerated examination of a patent application for an additional fee of \$4,000 (i.e., on top of the normal \$1,090 fee for filing, search and examination). The PTO also limits the number of claims it will examine in a Track 1 application. In accelerated examination, the PTO will issue a first Office action in four months and have a final disposition of the application in 12 months. The PTO has capped the number of prioritized examinations at 10,000 applications for the first year so that a final disposition can be provided within 12 months in the rule.

What are "Tracks"?

Once the prioritized examination is fully implemented, applicants will have three examination timing options, or "tracks":

- Track 1: Applicants submit a request and paying an additional fee can obtain accelerated examination of a patent.
- Track 2: Applicants pay standard fees and proceed under current examination procedures.
- Track 3: Applicants may be able to delay paying certain fees by deferring examination in this track. Non-continuing applications that originate in the United States may have examination

delayed for up to 30 months. This is not yet implemented.

Track 1 has advantages over the preexisting accelerated examination procedure. The Track 1 procedure guarantees a final disposition within 12 months from the date prioritized status has been granted. Unlike the PTO's preexisting accelerated program, Track 1 does not require that the applicant file an examination support document to qualify for the program. Elimination of the requirement for examination support documents helps applicants save the time and money needed to conduct special searches and characterize references. The required characterization of references in examination support documents under the preexisting process also introduces added estoppel and other file history-related risks for applicants, which they can avoid under Track 1.

This is useful to consider if your strategy includes obtaining action on your patent applications quickly.

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