

## Intellectual Property **ADVISORY**

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### USPTO Offers Fee-Based Expedited Examination

The United States Patent and Trademark Office (USPTO) recently announced a new fast-track program for patent applications called the “Track One” program. This program compliments other programs for accelerating examination by allowing for examination to be expedited by any applicant who pays an additional fee when filing a new patent application. The new Prioritized Examination Track is designed to give all applicants, regardless of health, age or field of research, an opportunity to significantly reduce the time it takes to get a patent. Larger patent holders can also use the new fast track program as a strategic tool in managing their patent portfolio by allowing business concerns to play a more dominant role in determining which applications get preferential treatment by the USPTO.

As of May 4, 2011, applicants may pay a prioritized examination fee when a patent application is filed to receive special status, placing the application ahead of others in the Examiner’s queue.<sup>1</sup> Like existing acceleration programs, the goal is to have a final disposition of the application within 12 months of prioritized status being granted. Although variations exist depending on the type of invention, it currently takes about 35 months on average to obtain final disposition for a patent application. This means that placing an application on prioritized examination can reduce prosecution time by about two years.<sup>2</sup>

Unlike other acceleration programs that require a search to be performed by another government agency or third party, the new fast-track program simply requires payment of an additional \$4,000 at filing.<sup>3</sup> This cost is predictable. Businesses can now more easily budget for inventions that have a higher importance, such as those that are likely to be marketed or infringed by a competitor during the pendency of the related patent application(s).

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<sup>1</sup> According to the Notice of Final Rulemaking, published April 4, 2011, the USPTO has placed a 10,000 application limit for acceptance into prioritized examination for the fiscal year 2011. Also, utility applications must be filed using the USPTO’s electronic filing system, must be complete when filed and must include no more than four independent claims, no more than 30 total claims and no multiple dependent claims.

<sup>2</sup> The time periods set in USPTO actions for applications utilizing this program would be the same as set forth in MPEP § 710.02(b). Prioritized examination can be lost if the applicant files a petition for an extension of time to file a reply. Likewise, prioritized examination can be terminated if the applicant files a request for a suspension of action or an amendment to the application that results in more than four independent claims, more than 30 total claims or a multiple dependent claim.

<sup>3</sup> The original indication by the USPTO of a discount for small entities has been removed, as the USPTO does not have the legal authority to implement such a discount. However, a change in the prioritized examination fee to \$4,800 for large entities and \$2,400 for small entities is awaiting enactment by Congress.

While the new fast-track program is a relatively simple way to expedite prosecution of any patent application, other currently existing programs, although more restrictive, may be less expensive. Alston & Bird's patent attorneys would be happy to discuss your particular situation and tailor a recommendation for accelerating examination of your patent application(s).

In conclusion, if an invention potentially has near-term commercial value or is likely to be infringed during the patent application's pendency, we would suggest you consider your options for expediting examination. Expedited examination is no longer limited to certain applications or those that have undergone prior art searches, and is now a beneficial option available to all applicants that can be used to more quickly gain an advantage over competitors.

For more information regarding prioritized examination, obtaining a tailored recommendation or any other patent related issues, please contact Alston & Bird.

*This advisory was prepared by **Guy Gosnell, Adam Kaplan and Patrick Kartes**, members of the firm's Intellectual Property – Patents Group.*

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