



Intellectual Property ADVISORY ■

JULY 25, 2014

A New Alternative for Expediting a Patent Application

Are you interested in expediting the examination of a patent application? Applicants now have a temporary opportunity to obtain expedited examination via the new glossary pilot program that went into effect on June 2, 2014, at the United States Patent and Trademark Office (USPTO). The goal of the new glossary pilot program is to provide the USPTO the opportunity to determine the effectiveness of requiring a glossary to aid in clarifying patent claims. The program will run for six months or until 200 grantable petitions are accepted by the USPTO. The program requires applicants to provide (1) a petition to make special using Form PTO/SB/436 ("Certification and Petition to Make Special Under the Glossary Pilot Program") and (2) a formal glossary section of claim terms within the specification. Under the program, applicants are not required to pay a fee when submitting petitions using Form PTO/SB/436.

An applicant may apply for the glossary pilot program if the application is an original, non-reissue, non-continuation or non-provisional utility application filed under 35 U.S.C. 111(a). An application submitted under the program must be classified in certain technological fields that fall under Technology Center 2100 (Computer Architecture and Software), 2400 (Networking, Multiplexing, Cable, and Security), 2600 (Communications) or 3600 (Business Methods). In return, accepted applications will receive expedited processing. The application will also be placed on the examiner's special docket until the issuance of a first office action. Should an applicant request expedited examination based on another procedure, such as Accelerated Examination, Prioritized Examination, etc., along with a petition to expedite examination under the glossary pilot program, the application must meet all conditions and requirements for both programs, and the applicant must pay any fees required by the other procedure.

Applications must include a glossary placed at the beginning of the detailed description of the original specification. The glossary must be identified with a heading and filed with the application. The glossary cannot be submitted after the filing date of the application, and the definitions cannot rely upon other parts of the specification or other sources (e.g., an incorporation by reference) for completeness. The definitions must present a positive statement of what each term means; therefore, a definition cannot consist solely of a statement of what the term does not mean and must not be open-ended. Definitions may include examples, synonyms and exclusions. Such glossary definitions cannot be disavowed in the application. Definitions included in the glossary should assist in clarifying the claimed invention and creating a clear application file wrapper record.

*This advisory was written by **R. Flynt Strean, Esq.**, and **Tearra Vaughn, Esq.***

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