

## Intellectual Property ADVISORY

September 26, 2011

### Prioritized Examination Enacted by the America Invents Act

On September 16, 2011, the Leahy-Smith America Invents Act (the “Act”) was signed into law. Among the major reforms codified by this important legislation, the Act provides two new tools for prioritized examination of patent applications. First, applicants may secure prioritized examination status for any patent application filed with the U.S. Patent & Trademark Office (USPTO) on or after **September 26, 2011**, by submitting a petition and a \$4,800 fee (\$2,400 for small entities) with the application at the time of filing.<sup>1</sup> Second, while likely not available until September 16, 2012, the Act authorizes the USPTO to grant prioritized examination to patent applications directed to “products, processes, or technologies that are important to the national economy or national competitiveness.”

### Fee-Based Prioritized Examination

This program allows any applicant to expedite examination regardless of the inventor’s health, age or field of research. Although USPTO regulations have yet to be issued, we expect this fee-based prioritized examination program to be similar to the “Track One” prioritized examination program that was announced and then suspended earlier this year. As such, the new program will likely attempt to bring a patent application to final disposition within 12 months of the prioritized status being granted. Although actual pendency times vary across USPTO art units, it currently takes about 35 months, on average, to obtain final disposition for a non-prioritized patent application. Thus, in exchange for the \$4,800 fee (\$2,400 for small entities), applicants may be able to reduce examination pendency for important patent applications by two years or more.<sup>2</sup>

We do not expect fee-based prioritized examination to be available for patent applications filed before September 26, 2011. However, continuation applications that are filed on or after September 26, 2011, would appear to qualify for the fee-based prioritized examination program. Accordingly, some applicants may choose to file and expedite a continuation application through the fee-based program, while allowing the parent application to go abandoned, or perhaps maintained and leveraged, to seek a scope of protection that is different from (e.g., broader than) that obtained by the expedited continuation application.

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<sup>1</sup> Notably, the \$4,800 prioritized examination fee does not include traditional filing, search and examination fees that are also due at filing of a new patent application.

<sup>2</sup> The Act states that fee-based prioritized examination will only be granted for utility patent applications having no more than four independent claims and 30 total claims. The Act further restricts fee-based prioritized examination to a maximum of 10,000 patent applications per year.

## Important Technology Prioritized Examination

Section 25 of the Act states that the USPTO may provide for “prioritization of examination of applications for products, processes, or technologies that are *important to the national economy or national competitiveness*[.]” [*Emphasis added.*] Regulations for this section of the Act have not yet been issued by the USPTO. Thus, it is not yet clear how the USPTO intends to implement this newly enacted authority, or which types of technologies will be deemed “important to the national economy or national competitiveness.” Alston & Bird attorneys are closely monitoring USPTO developments in this regard and further updates and advisories will be forthcoming.

## Multiple Prioritized Examination Tools Are Available

The two new prioritized examination programs referenced by the Act add to the list of currently available programs for expediting examination, including the Patent Prosecution Highway programs, the Accelerated Examination Programs (including those requiring a petition to make special), the Green Technology Pilot Program, the Peer-to-Patent Review Pilot Program and various others. These programs vary in expense and restrictiveness and certain programs may be better suited for particular applicants or patent applications. Alston & Bird’s patent attorneys are knowledgeable with regard to each of these programs and regularly work with clients to identify which patent applications are appropriate for prioritized examination and which prioritized examination programs are best suited for such applications.

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

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