



April 7, 2011

CLIENT ALERT

USPTO Implements Prioritized Examination Track (Track I)

Effective May 4, 2011, the USPTO will implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures. Track I allows applicants to request priority handling of a patent application with the goal of reaching final disposition within 12 months. The additional filing fee is \$4000.

Accepted applications will be placed on the examiner's special docket until a final disposition is reached. "Final disposition" is defined as: (1) mailing of a notice of allowance, (2) mailing of a final office action, (3) filing of a notice of appeal, (4) declaration of an interference by the BPAI, (5) filing of an RCE, or (6) abandonment of the application, within twelve months from the date prioritized status was granted. Any of the above events would terminate prioritized examination. Furthermore, if an applicant files a petition for an extension of time to file a reply, prioritized examination will be terminated.

To participate, an application must be a new original utility or plant nonprovisional application filed electronically on or after May 4, 2011. Applicants may also request prioritized examination for a newly filed continuation or divisional application. The application must contain no more than 4 independent claims, no more than 30 total claims, and no multiple dependent claims. The USPTO is limiting requests for prioritized examination to a maximum of 10,000 applications during fiscal year 2011.

While the USPTO claims that the program will provide final disposition within twelve months of acceptance into the program, a conclusive disposition may not result within twelve months if the application does not receive a Notice of Allowance at an early phase of prosecution. For example, since a "final disposition" can include the mailing of a final office action, an application that receives a rejection in the first office action will be finally disposed if the rejection is not overcome in the response and a final action is mailed, upon which prosecution will enter normal examination. Since the pendency of a typical application before a first office action can range up to several years, participation in the program can nevertheless significantly accelerate examination of an application. Furthermore, the Track One program does not impose the additional requirements of other accelerated examination programs currently in place.

Applicants interested in participating in the program should consider certain factors, including: the value of an earlier initial examination, cost of participation, and claim number limitations. If Woodcock Washburn can be of assistance in helping to determine if the USPTO Prioritized Examination Track is appropriate for your particular circumstance, please contact us.

About Woodcock Washburn LLP

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