Faster at the USPTO: Expedited Patent Prosecution Processes

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September 17, 2020
Agenda

• Prioritized Examination
• COVID-19 Prioritized Examination Pilot
• Fast-Track Appeal Pilot
Prioritized Examination Program (or Track One)
Prioritized Examination Program
(or Track One)

• Applicants may request prioritized examination of their patent applications.
  – For a new application, the request must be made on filing.
  – After prosecution is closed in an application, applicant may request prioritized examination with the filing of a request for continued examination under 37 CFR 1.114 (RCE).

• The USPTO’s goal is to provide a final disposition within twelve months of prioritized status being granted.
  – Final disposition includes mailing of a notice of allowance or final office action, filing of a notice of appeal, completion of examination as defined in 37 CFR 41.102, filing of an RCE, or abandonment of the application.
Track One requirements

• Original utility or plant nonprovisional applications filed under 35 U.S.C. 111(a), may be continuation or divisional applications

• Must contain four or less independent claims, thirty or less total claims, and no multiple dependent claims
Track One requirements

- Track One utility applications must be filed via EFS-Web.
- Applicants are advised to submit Prioritized Examination request form PTO/AIA/424 when filing the application.
- PTO/AIA/424 identifies all the requirements that must be submitted with the request.
Track One requirements for RCEs

• Requests for prioritized examination may be filed concurrently with or subsequently to the filing of an RCE.

• The request for prioritized examination must be filed before the mailing of the first office action after the filing of the RCE.
  – Prioritized examination fee and the processing fee must accompany request.
When Track One is terminated before final disposition

• Prioritized examination of an application in the Track One program will be terminated
  – If applicant files a petition for an extension of time to file a reply or a request for suspension of action.
  – If applicant files an amendment to the application resulting in more than four independent claims, more than thirty total claims, or a multiple dependent claim.

• Upon termination of prioritized examination, the application will be placed on the examiner’s regular docket in accordance with its stage of prosecution.
Track One (Fiscal Year 2020 cumulative through August 2020)

• Pendency continues to be extremely low
  – Average time from filing to petition grant: 1.1 months
  – Average time from petition grant to first action: 1.7 months
  – Average time from petition grant to final disposition: 6.3 months
Track One requests  
(data as of August 31, 2020)

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COVID-19 Prioritized Examination Pilot Program
COVID-19 Prioritized Examination Program

• The USPTO considers the effects of the COVID-19 outbreak to be an “extraordinary situation,” such that fees not required by statute may be waived.

• Accordingly, the USPTO is accepting requests for prioritized examination for applications that claim a product or process related to COVID–19 without the additional fee.

• The USPTO’s goal is to provide a final disposition within six months of prioritized status being granted if applicants respond within 30 days to a notice from the USPTO.
COVID-19 Prioritized Examination Pilot
Program Requirements

• Same requirements as Prioritized Examination (Track 1) except:
  – The prioritized examination fee is waived.
  – Open to small and micro entities only.
  – The application must be a non-continuing nonprovisional application or a continuing application claiming the benefit of one nonprovisional application or one prior international application designating the United States.
  – Applicants must certify claim(s) of the application must cover a product or process subject to an applicable FDA approval for COVID–19 use.
  – The request must include an Application Data Sheet (ADS).
COVID-19 Prioritized Examination Pilot
“FDA Certification”

• Applicants must certify their applications claim products or processes that are subject to an applicable FDA approval, which may include, but are not limited to: an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA).

• “Subject to . . . approval” does not mean approval has already been sought or granted, but rather that the product or process covered by the claim is subject to the FDA’s jurisdiction before it can be marketed for use in prevention, diagnosis, or treatment of COVID-19.
Requesting prioritized examination under the pilot

- Applicants are encouraged to submit form PTO/SB/450.
- Form PTO/SB/450 contains the necessary certifications for qualification to participate in the pilot.
- Use of form PTO/SB/450 will also enable the USPTO to quickly identify and timely process the request.
Duration of the COVID-19 prioritized examination

- Until 500 requests are accepted:
  - As of September 10, 2020: 307 filed / 169 granted / 331 available
- The USPTO may extend, modify, or terminate the program depending on the workload and resources needed to administer the program, feedback from the public, and the effectiveness of the program.
- Comments may be addressed to: Covid19PrioritizedExamPilot@uspto.gov.
Fast-Track Appeals Pilot Program
Overview

• One Year Pilot: starting July 2, 2020.
• $400 fee.
• 6 month pendency goal.
• 125-granted-petition limit per quarter (500 total).
• Hearings permitted, with some restrictions.
What the Program is not

• No impact on procedures before Docketing Notice issued.

• No change in briefing before the Examiner.
What appeals qualify?

• Pending appeal (Docketing Notice issued)
  – Not limited to “new” appeals, i.e., a petition may be submitted for any currently pending appeal.

• Appeal not already being treated as special under MPEP 708.01
  – E.g., not already special due to age or health of inventor.
Requirements of petition to Chief APJ

• Application and appeal numbers
• Certifications that the appeal qualifies
  – Pending appeal, not currently treated as special
• $400 fee under 37 C.F.R. 41.20(a)
  – Non-refundable, even if petition denied
Petitioning Chief APJ

• Submit by EFS-Web, Patent Center, or Postal Service
  – Electronic submission is preferred
• Form PTO/SB/451 recommended, but not required
• Petitioner notified of grant or denial
• May petition again if denied, but will not get the filing date of a denied petition
Fast-Track website

Petition form

Form-fillable pdf also available at: https://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012
Program limits

• 125 granted petitions per quarter and 500 total.
  – Quarter is 3-month period and first quarter started July 2 (day Federal Register Notice published).
  – If 125 granted petitions in a quarter, additional petitions may be held in abeyance and considered in the following.
Program limits

• Limits chosen to provide robust participation while not compromising other PTAB goals, such as pendency.

• Track progress toward limits on fast-track website.
Routine updates of progress toward limits

- Check website to gauge how close we are to limits.
**Hearings**

- Yes, heard cases can be fast-tracked.
- Hearing requests can include time and location preferences.
  - Hearings team will do best to accommodate.
  - But, may be scheduled in any available hearing room in any Office location, by video, or by telephone.
Hearings

• No rescheduling of hearings and staying in the pilot program
  – May opt out of fast track and reschedule hearing.
  – May request video/telephone if Office location is inconvenient.
  – May waive hearing and continue on fast-track.

• Right now, default for all appeals hearings (including fast-track) is telephonic.
  – https://www.uspto.gov/coronavirus
Further information

• Federal Register notice:

• Frequently asked questions:
Thank you!

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