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Faster at the USPTO: Expedited Patent Prosecution Processes

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September 17, 2020

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Agenda

- **Prioritized Examination**
- **COVID-19 Prioritized Examination Pilot**
- **Fast-Track Appeal Pilot**

Prioritized Examination Program (or Track One)

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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.

CERTIFICATION AND REQUEST FOR PRIORITIZED EXAMINATION UNDER 37 CFR 1.102(e) (Page 1 of 1)			
First Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none"> The processing fee set forth in 37 CFR 1.17(i)(1) and the prioritized examination fee set forth in 37 CFR 1.17(c) have been filed with the request. The publication fee requirement is met because that fee, set forth in 37 CFR 1.18(d), is currently \$0. The basic filing fee, search fee, and examination fee are filed with the request or have been already been paid. I understand that any required excess claims fees or application size fee must be paid for the application. I understand that the application may not contain, or be amended to contain, more than four independent claims, more than thirty total claims, or any multiple dependent claims, and that any request for an extension of time will cause an outstanding Track I request to be dismissed. The applicable box is checked below: <ol style="list-style-type: none"> <input checked="" type="checkbox"/> Original Application (Track One) - Prioritized Examination under § 1.102(e)(1) <ol style="list-style-type: none"> (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web. —OR— (b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application in paper. An executed inventor's oath or declaration under 37 CFR 1.63 or 37 CFR 1.64 for each inventor, <u>or</u> the application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is filed with the application. <input type="checkbox"/> Request for Continued Examination - Prioritized Examination under § 1.102(e)(2) <ol style="list-style-type: none"> A request for continued examination has been filed with, or prior to, this form. If the application is a utility application, this certification and request is being filed via EFS-Web. The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a), or is a national stage entry under 35 U.S.C. 371. This certification and request is being filed prior to the mailing of a first Office action responsive to the request for continued examination. No prior request for continued examination has been granted prioritized examination status under 37 CFR 1.102(e)(2). 			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
<p>Note: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.*</p>			
<input type="checkbox"/> *Total of _____ forms are submitted.			

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)

T1 Requests Received	October	November	December	January	February	March	April	May	June	July	August	September	Total
FY 11												855	855
FY 12	390	302	285	292	371	442	457	516	436	470	517	559	5,037
FY 13	505	513	575	504	468	1,029	400	508	530	584	642	636	6,894
FY 14	715	570	732	650	629	1,028	822	803	795	796	673	911	9,124
FY 15	833	633	758	662	665	867	778	768	877	868	720	857	9,286
FY 16	729	844	1,155	766	773	868	824	776	848	679	773	976	10,011
FY 17	926	735	781	632	656	841	746	886	930	779	821	866	9,599
FY 18	795	813	955	759	805	896	829	918	987	906	970	883	10,516
FY 19	1,018	984	870	984	862	1,077	1,115	1,143	1,002	1,076	967	1,033	12,131
FY 20	1,055	1,025	1,203	1,049	1,090	1,092	981	1,086	1,063	1,090	1,087		11,821

COVID-19 Prioritized Examination Pilot Program

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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.

Doc Code: TRACK1.COVID

Document Description: COVID-19 Prioritized Examination Request

PTO/SB/450 (05-20)

CERTIFICATION AND REQUEST FOR COVID-19 PRIORITIZED EXAMINATION PILOT PROGRAM UNDER 37 CFR 1.102(e) (Page 1 of 1)			
First Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION UNDER THE COVID-19 PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <ol style="list-style-type: none"> The claim(s) of the above-identified application cover a product or process relating to COVID-19 and such product or process is subject to an applicable FDA approval for COVID-19 use. Applicant qualifies for small entity (37 CFR 1.27) or micro entity (37 CFR 1.29) status. If the application contains a benefit claim under 35 U.S.C. 120, 121, or 365(c), it is to only one prior nonprovisional U.S. application or international application designating the United States. The basic filing fee, search fee, and examination fee are filed with this request or have been already been paid. I understand that any required excess claims fees or application size fee must be paid for the application. The fees set in 37 CFR 1.17(c) and 1.17(i)(1) are waived. I understand that the application may not contain, or be amended to contain, more than four independent claims, more than thirty total claims, or any multiple dependent claims, and that any request for an extension of time will cause an outstanding request to be dismissed. The applicable box is checked below: <p>I. <input type="checkbox"/> Original Application - Prioritized Examination under § 1.102(e)(1)</p> <ol style="list-style-type: none"> (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web or Patent Center. ---OR--- (b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application. An application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is filed with the application. <p>II. <input type="checkbox"/> Request for Continued Examination - Prioritized Examination under § 1.102(e)(2)</p> <ol style="list-style-type: none"> A request for continued examination has been filed with, or prior to, this form. If the application is a utility application, this certification and request is being filed via EFS-Web or Patent Center. The application is an original nonprovisional utility or plant application filed under 35 U.S.C. 111(a), or is a national stage entry under 35 U.S.C. 371. This certification and request is being filed prior to the mailing of a first Office action responsive to the request for continued examination. No prior request for continued examination has been granted prioritized examination status under 37 CFR 1.102(e)(2). 			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
<p>Note: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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.
- More information available at:
<https://www.uspto.gov/initiatives/covid-19-prioritized-examination-pilot>

Fast-Track Appeals Pilot Program

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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.

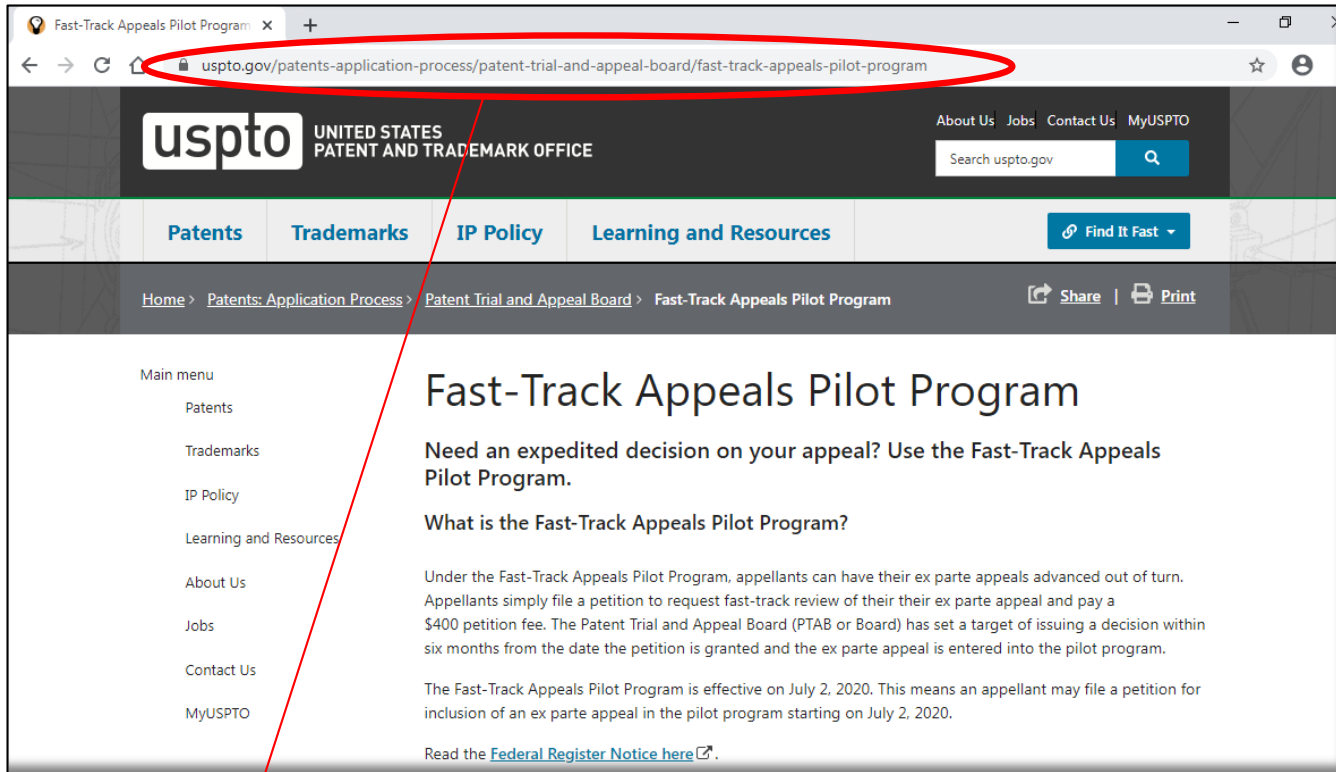
Requirements of petition to Chief APJ

- 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



<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/fast-track-appeals-pilot-program>

Petition form

Doc Code: PET. 41.3
Document Description: Petition under Rule 41.3 to Chief Admin Patent Judge PTO/SB/451 (07-20)

PETITION Fast-Track Appeals Pilot Program			
PART I. IDENTIFICATION OF THE APPEAL TO ACCORD FAST-TRACK STATUS			
Appeal No.:		Application Number:	
First Named Inventor:		Filing Date:	
Title of Invention:			
PART II. CERTIFICATIONS: Appellant hereby certifies the following and petitions to participate in the Fast-Track Appeals Pilot Program for the above-identified appeal.			
1. Appellant files this certification and petition under 37 CFR 41.3 to include the appeal in the application identified in Part I (above) in the Fast-Track Appeals Pilot Program. 2. The above-identified appeal is pending before the Patent Trial and Appeal Board (PTAB) and a docketing notice <u>has been issued</u> . 3. The petition fee for filing a petition under 37 CFR 41.3 accompanies this petition. 4. The above-identified appeal <u>is currently not treated</u> as special under MPEP 708.01 (e.g., age or health of the inventor). 5. The registered practitioner submitting this certification and petition has a power of attorney (37 CFR 1.32), or has authority to act (37 CFR 1.34), for the above-identified application, or the appellant is prosecuting the appellant's own case (37 CFR 1.31).			
PART III. ORAL HEARING: For informational purposes, please indicate whether Appellant has filed a <u>compliant</u> Request for Oral Hearing per 37 CFR 41.47 for the above-identified appeal:			
Yes <input type="checkbox"/> No <input type="checkbox"/> <input type="checkbox"/> If yes, Appellant hereby waives the Oral Hearing. (Appellant is not required to waive an Oral Hearing to participate in the Fast-Track Patent Appeal Pilot.)			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
Note: This form <u>must be signed</u> in accordance with 37 CFR 1.33 and consistent with Certification 5 above. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.* *Total of _____ forms are submitted.			

Fast-Track Appeals Pilot Program

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Fast-Track Appeals Pilot Program

Need an expedited decision on your appeal? Use the Fast-Track Appeals Pilot Program.

What is the Fast-Track Appeals Pilot Program?

Under the Fast-Track Appeals Pilot Program, appellants can have their ex parte appeals advanced out of turn. Appellants simply file a petition to request fast-track review of their their ex parte appeal and pay a \$400 petition fee. The Patent Trial and Appeal Board (PTAB or Board) has set a target of issuing a decision within six months from the date the petition is granted and the ex parte appeal is entered into the pilot program.

The Fast-Track Appeals Pilot Program is effective on July 2, 2020. This means an appellant may file a petition for inclusion of an ex parte appeal in the pilot program starting on July 2, 2020.

Read the [Federal Register Notice here](#).

Eligibility requirements

To qualify for fast-track status, the following four conditions must be met:

- Application type:** The application must be an original utility, design, or plant nonprovisional application.
- Status of appeal:** The appeal for fast-track status must be an ex parte appeal for which a notice of appeal has been filed and a PIAR docketing notice has been issued by the USPTO (i.e., the appeal is pending before the PTAB).
- Petition:** The appellant must file a petition under 37 CFR 41.3 via the [USPTO's electronic filing system](#) identifying the application and appeal by application number and appeal number, respectively, for which fast-track review is sought.
 - Form: Petition—Fast-Track Appeals Pilot Program ([Form PTO/SB/451](#))
- Fee:** The appellant must pay a \$400 fee under 37 CFR 41.3(a)(1)(i).

[USPTO Fee Schedule](#)

Granted petition limits

The USPTO has limited the number of granted petitions to 125 per quarter for the duration of the Fast-Track Appeals Pilot Program, which is expected to run for one year.

The table shows the status of the number of granted petitions per quarter and total for the pilot duration, as well as open slots available during each time period. A "quarter" under this pilot program is defined as a three-month period measured from the start date of the pilot program. For example, if the pilot program has a start date of June 1, then a "quarter" spans the three months from June 1 to August 31.

	As of date	Petitions received in quarter	Petitions granted in quarter	Available petition slots in quarter	Petitions held in abeyance	Total granted petitions
Quarter 1 (starting 7/2/2020)	9/11/2020	55	52	73	0	52

The PTAB may exercise discretion to grant a small number of petitions above the 125-petition limit. Should a significant number of petitions exceeding the limit be filed in a quarter, such petitions will be held in abeyance and decided, in order of receipt, in a subsequent quarter.

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.

	As of date	Petitions received in quarter	Petitions granted in quarter	Available petition slots in quarter	Petitions held in abeyance	Total granted petitions
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Fast-Track Appeals Pilot Program

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Fast-Track Appeals Pilot Program

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The Fast-Track Appeals Pilot Program is effective on July 2, 2020. This means an appellant may file a petition for inclusion of an ex parte appeal in the pilot program starting on July 2, 2020.

Read the [Federal Register Notice here](#).

Eligibility requirements

To qualify for fast-track status, the following four conditions must be met:

- Application type:** The application must be an original utility, design, or plant nonprovisional application.
- Status of appeal:** The appeal for fast-track status must be an ex parte appeal for which a notice of appeal has been filed and a PTAB docketing notice has been issued by the USPTO (i.e., the appeal is pending before the PTAB).
- Petition:** The appellant must file a petition under 37 CFR 41.3 via the [USPTO's electronic filing system](#) identifying the application and appeal by application number and appeal number, respectively, for which fast-track review is sought.
 - Form: Petition—Fast-Track Appeals Pilot Program ([Form PTO/SB/451](#))
- Fee:** The appellant must pay a \$400 fee under 37 CFR 41.20(a) with the petition.
 - [USPTO Fee Schedule](#)

Granted petition limits

The USPTO has limited the number of granted petitions to 125 per quarter for the duration of the Fast-Track Appeals Pilot Program, which is expected to run for one year.

The table shows the status of the number of granted petitions per quarter and total for the pilot duration, as well as open slots available during each time period. A "quarter" under this pilot program is defined as a three-month period measured from the start date of the pilot program. For example, if the pilot program has a start date of June 1, then a "quarter" spans the three months from June 1 to August 31.

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The PTAB may exercise discretion to grant a small number of petitions above the 125-petition limit. Should a significant number of petitions exceeding the limit be filed in a quarter, such petitions will be held in abeyance and decided, in order of receipt, in a subsequent quarter.

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:
 - <https://www.federalregister.gov/documents/2020/07/02/2020-14244/fast-track-appeals-pilot-program>
- Frequently asked questions:
 - <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/fast-track-appeals-pilot-program>



Thank you!

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