



UNITED STATES PATENT AND TRADEMARK OFFICE

EXPEDITED EXAMINATION

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MPEP § 708.02 Petition To Make Special

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37 CFR § 1.102

37 CFR § 1.102. Advancement of examination.

- (a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.
- (b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.
- (c) A petition to make an application special may be filed without a fee if the basis for the petition is:
 - (1) The applicant's age or health; or
 - (2) That the invention will materially:
 - (i) Enhance the quality of the environment;
 - (ii) Contribute to the development or conservation of energy resources; or
 - (iii) Contribute to countering terrorism.
- (d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).



“Petition to Make Special”

- New applications ordinarily are taken up for examination in the order of their effective United States filing dates.
- ✓ exceptions are made by way of petitions to make special.
- ✓ any statement in support of a petition to make special must be based on a good faith belief that the invention in fact qualifies for special status. See 37 CFR §§1.56 and 11.18.



MPEP § 708.02 “Special”

- A petition to make special filed on or after August 25, 2006 will only be granted if it is:
 - a) based upon applicant’s health or age or
 - b) is under the PPH pilot program, or
 - c) if it complies with the requirements set forth in MPEP § 708.02(a) (special accelerated exam procedure).

- Note: this is in addition to USPTO-based programs that grant “Special” application status.



MPEP § 708.02 III: Health

- **APPLICANT'S HEALTH** (no petition fee):
 - a petition by applicant accompanied by any evidence showing that the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate.

See 37 CFR § 1.102(c)(1).



MPEP § 708.02 IV: Age Petition

- A grantable petition requires one of the following items:
 - (1) Statement by one named inventor in the application that he/she is 65 years of age, or more; or
 - (2) Certification by a registered attorney/agent having evidence such as a birth certificate, passport, driver's license, etc. showing one named inventor in the application is 65 years of age, or more.

- No petition fee;
- See: electronically filed: use Form PTO/SB/130 EFS-Web;
- For petition instructions, see:
http://www.uspto.gov/patents/process/file/efs/guidance/petition_age_quickstart.pdf



MPEP § 708.02 IV: Age/Health Info

- Personal/medical information submitted as evidence to support the petition will be available to the public if the application file and contents are available to the public pursuant to 37 CFR § 1.11 or § 1.14.
- Avoid public disclosure by submitting pursuant to MPEP § 724.02 (Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials)
 - Can include a petition under 37 CFR § 1.59 and fee (37 CFR §1.17(g)) to expunge the information (granted if found not to be material to patentability).



Age/Health: Summary

Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<p>Applications may be accorded accelerated examination status based on an applicant's age or health. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.102 entitled "Advancement of examination."</p> <p>Key requirements include a petition with accompanying evidence showing that (1) the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate or (2) that the applicant is 65 years of age or older.</p> <p>See 37 CFR 1.102(c).</p>	<p>Permanent Program</p> <p><u>Start Date</u> Circa December, 1959</p>	<p>Not Required</p>	<p>No Fees</p>	<p>Applications are placed on an accelerated examination track throughout the entire prosecution in the USPTO.</p>

http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf (page 4/5)



Age/Health: Info/Contacts

- Program Points of Contact:
 - RE: EFS-Web or PAIR system - Patent Electronic Business Center at 866-217-9197
 - RE: specific petition questions: Office of Petitions at 571-272-3282.
- For TC-1600 Program questions contact :
Marianne Seidel (571-272-0584) or marianne.seidel@uspto.gov



Patent Prosecution Highway (PPH)

- Under the PPH, an applicant receiving a ruling from the Office of First Filing (OFF) that at least one claim is patentable may request that the Office of Second Filing (OSF) fast track the examination of corresponding claims in corresponding applications filed in the OSF.
 - All claims in the OSF application must sufficiently correspond to the allowable claims in the OFF application
 - Note: PPH is not full faith and credit.
 - A request may not be filed after US examination has begun (refers to “substantive examination” not “missing parts” or restriction).

See: http://www.uspto.gov/patents/init_events/pph/index.jsp and [PPH Frequently Asked Questions \(FAQs\)](#) (May 2010)



PPH and PCT-PPH

- PPH arrangements with various foreign patent offices: Australia, Austria, Canada, Denmark, EPO, Finland, Germany, Hungary, Japan, Mexico, Republic of Korea, Russia, Spain, Singapore and the UK.
- PCT-PPH participating offices are the:
 - Trilateral Offices: USPTO/JPO/EPO
 - Korean Intellectual Property Office (KIPO);
 - Austrian Patent Office (APO);
 - Russia (ROSPATENT); and
 - Spanish Patent and Trademark Office (SPTO).

See PPH Brochure at http://www.uspto.gov/patents/init_events/pph/pphbrochure.pdf.



PPH

- As of May 25, 2010 (75FR 29312)
 - No Petition Fee
 - Electronically filed using EFS-Web
 - Include the relevant work of the office of first filing with any necessary translation (e.g. allowed claims or those indicated as having novelty, inventive step and industrial applicability; office actions; and cited references).
 - Advantage: leverages fast-track examination procedures available in the OSF to obtain patents faster and more efficiently.
- Use appropriate PTO Request Form (PTO/SB/20) based on type of application filed (nat'l or int'l) in the office of first filing.



PPH: Corp. Statistics: (as of end of April 2011)*

- 4,793 PPH and 1,258 PCT-PPH requests received since 2006.
- First Action Allowance Rate: PPH: 25%; PCT-PPH: 20%
 - Compared to 16% for USPTO average for all applications**;
- Overall Allowance Rate: PPH: 90.70%; PCT-PPH: 96.81%
 - **Compared to 46.3% overall allowance rate for all applications;**
- Average actions/disposal: PPH: 1.88; PCT-PPH: 1.17
 - Significantly less than 2.41 actions/disposal for non-PPH applications.

* The data for all cases (PPH and non-PPH) for the patent examining corps is available at the Patents dashboard at <http://www.uspto.gov/dashboards/patents/main.dashxml>:

** all applications include utility, plant and reissues, including RCEs.



PPH: More Information

- BCP Meeting December 8, 2010:
- ❖ PPH/Workshare: 26 slides can be found at <http://www.cabic.com/bcp/>

BY: Bruce Kisliuk, Assistant Deputy Commissioner for Patent Operations for Chemical Disciplines



PPH: Info/Contacts

- Program Points of Info/Contacts:
 - RE: A list of frequently asked questions (FAQs): available on the USPTO website at: http://www.uspto.gov/patents/init_events/pph/pph_faqs.pdf
 - RE: USPTO/JPO one-stop PPH information portal at <http://www.jpo.go.jp/>
 - RE: specific questions: PPH Team at PPHfeedback@uspto.gov.
- For TC-1600 Program questions contact :
 - Ram Shukla (571-272-0735) or ram.shukla@uspto.gov
 - Cecilia Tsang (571-272-0562) or cecilia.tsang@uspto.gov



MPEP § 708.02(a): Special AE procedure

- 37 CFR 1.102 and MPEP 708.02 VIII
 - Effective August 25, 2006: Petitions prior to this date were not included
 - Goal: complete examination w/n 12 months of filing date.
 - For more information, see “Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination”: 71FR (June 26, 2006)36323: available on USPTO web site at:

<http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.htm>

<http://www.uspto.gov/patents/process/file/accelerated/index.jsp>



Special AE: Filing Requirements

- 1) Petition: electronically filed
- 2) Application: complete at filing
- 3) Claims:
 - a) $< 3/20$: directed to a single invention
 - b) No multiple dependent claim (s)
- 4) Fee: 37 CFR 1.17 (h)



Special AE: Petition Requirements

- Petition must be accompanied by:
 1. Pre-Examination Search
 2. Examination Support Document (ESD)
- Statements that applicant will:
 - Make election w/o traverse in a telephonic interview;
 - Agree to have an interview when requested by the examiner;
 - Not separately argue any dependent claim on appeal.



Special AE: Use PTO/SB/28

- See: PTO/SB/28 Petition to Make Special Under Accelerated Examination Program at http://www.uspto.gov/patents/process/file/efs/guidance/Form_fillable_pdfs_available.jsp
- For Petitions (w/o a fee) directed to environmental quality, energy, or countering terrorism under 37 CFR 1.102(c)(2) check box d:

d.

Other (e.g., a statement that the claimed subject matter is directed to environmental quality, energy, or countering terrorism (37 CFR 1.102(c)(2))).



Corp-Wide AE Statistics: as of Jan. 5, 2011

AE Petition Status		
Petition Status	Number of Applications	Percentage
Granted	2745	61.5%
Denied (Not Meeting Formal Requirements, such as application not being complete upon filing)	812	18.2%
Denied (Based on Merits)	332	7.4%
Dismissed (No response from Applicant - Applicant could have cured, but chose not to attempt)	289	6.5%
Pending (Undecided)	228	5.1%
Express Abandonments	58	1.3%
<i>Total</i>	4464	

See: http://www.uspto.gov/patents/process/file/accelerated/ae_stats_v8_05jan2011.pdf



Corp-Wide AE Statistics: as of Jan. 5, 2011

First Office Actions		
	Number of Applications	Percentage
Rejection	1497	54.5%
Ex parte Quayle	6	0.2%
Allowed	1090	39.7%
Abandoned before first action	5	0.2%
Pending	147	5.4%
Total	2745	

AE Final Disposition (as defined in the Fed. Reg. Notice)		
	Number of Applications	Percentage
Allowed	1560	
Abandoned	100	
Final Rejection	863	
Total	2523	91.9%
Pending Final Disposition	222	8.1%

See: http://www.uspto.gov/patents/process/file/accelerated/ae_stats_v8_05jan2011.pdf

- 40% AE first office action allowance rate favorably compares to 16% first action allowance rate for all applications as of April 2011. See <http://www.uspto.gov/dashboards/patents/main.dashxml>



AE: Summary

Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<p>Pursuant to the Accelerated Examination Program, an applicant may have an application granted accelerated examination status provided certain conditions are met. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.102 entitled "Advancement of examination."</p> <p>Key requirements include the following:</p> <ul style="list-style-type: none"> (1) the application must be filed via EFS-Web with a petition to make special along with (a) required petition fee or (b) a statement that the claimed invention is directed to environmental quality, development or conservation of energy resources, or counter terrorism; (2) the application must be complete and in condition for examination; (3) the application must contain three or fewer independent and twenty or fewer total claims, and must not contain any multiple dependent claims; (4) the claims must be directed to a single invention; (5) the petition must include a statement agreeing to have an interview; (6) applicant must provide a statement that a pre-examination search was conducted that meets certain requirements; and (7) applicant must provide an accelerated examination support document that satisfies certain requirements. 	<p>Permanent Program</p> <p><u>Start Date</u> Aug. 25, 2006</p>	<p>Complete Examination Support Document Required</p>	<p>US \$130 Petition Fee to Request Accelerated Examination</p> <p>No petition fee required for inventions that will enhance the quality of the environment, relate to the development or conservation of energy resources or, contribute to counterterrorism.</p>	<p>Goal is to complete examination of an application within 12 months from the filing date of the application.</p> <p>Applications are placed on an accelerated examination track throughout the entire prosecution in the USPTO.</p>

http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf (page 1/5)



Special AE: Info/Contacts

- Pilot Program Points of Info/Contacts:
 - RE: A list of frequently asked questions (FAQs) is available on the USPTO website at: http://www.uspto.gov/patents/process/file/accelerated/ae_faq_091207.pdf
 - RE: Overview of TC1600 Special AE practice: see BCP March 2, 2010: “Accelerated Examination” by Bennett Celsa at <http://www.cabic.com/bcp/030210/>
 - RE: specific questions: AcceleratedExam@uspto.gov.
- For TC-1600 Program questions:
 - Bennett Celsa (571-272-0807) or bennett.celsa@uspto.gov
 - Jean Vollano (571-272-0648) or jean.vollano@uspto.gov
 - Cecilia Tsang (571-272-0562) or cecilia.tsang@uspto.gov
- For TC-1600 Program petition questions:
 - Marianne Seidel (571-272-0584) or marianne.seidel@uspto.gov



Project Exchange-Patent Backlog Reduction Stimulus Plan

- A patent application can receive special, accelerated status if the applicant abandons another related unexamined application.
- Applicant must file a petition to make special that satisfies:
 - (i) the *conditions* sets forth in 74 FR 62285 (Nov. 27, 2009); and
 - (ii) the *requirements* set forth in 75 FR 36063 9(June 24, 2010) other than the small entity requirement, which is no longer a requirement.
- extended to run until December 31, 2011 or until 10,000 petitions have been granted, whichever occurs earlier (75 FR 71072 (Nov. 22, 2010)).

See: http://www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp



Backlog Reduction Stimulus Plan: Conditions

- Conditions for application to be accorded special status :
 - (1) Nonprovisional applications filed earlier than October 1, 2009.
 - (2) Applicant has a copending nonprovisional application with an actual filing date earlier than October 1, 2009, and is complete under 37 CFR § 1.53. (e.g. contain an executed oath or declaration and payment of filing/search/ examination/size or excess claims fees).
 - (3) Both applications must be either owned by the same party as of October 1, 2009, or name at least one inventor in common.
 - (4) Applicant must expressly abandon under 37 CFR § 1.138(a) the copending nonprovisional application prior to its examination.
 - (5) Applicant files a petition under 37 CFR § 1.102 in the application for which special status is sought.



Backlog Reduction: Petition Requirements

- Petition must:
 - a) identify the basis under which special status is being sought (express abandonment of another copending application);
 - b) include a copy of a letter of express abandonment and the statements that accompany the letter of express abandonment from the copending abandoned application;
 - c) include a specific identification of the relationship between the applications that qualifies the application for special status (e.g. identify by name, a common inventor/assignee);
 - d) identify (e.g., by application #), the expressly abandoned application;
 - e) certify that applicant has not filed petitions in more than fourteen other applications requesting special status under this program; and
 - f) agree to make an election w/o traverse in a telephonic interview if the claims of the “special” application are directed to two or more independent and distinct inventions.



Backlog Reduction: Abandonment Statement

- Applicant must include the following statements with the letter of express abandonment:
 - a) state that applicant has not and will not file an application that claims the benefit of the expressly abandoned application under any provision of title 35, United States Code;
 - b) state that the applicant agrees not to request a refund of any fees paid in the expressly abandoned application; and
 - c) state that the applicant has not and will not file a new application that claims the “same invention” claimed in the expressly abandoned application (“same invention” as used in the context of statutory double patenting under 35 U.S.C. § 101).



Backlog: Project Exchange Report Summary (Report date: 05/02/2011)

□ Petition Summary: USPTO

Awaiting decision: 1
Petitions granted : 155
Petitions dismissed: 38
Total Petitions : 194

Petitions: by TC

TC 1600	30
TC 1700	9
TC 2100	10
TC 2400	35
TC 2600	38
TC 2800	25
TC 3600	8
TC 3700	35
TC 4100	3

See: [Project Exchange Report Summary](http://www.uspto.gov/patents/init_events/brs_report_summary20110502.pdf) at http://www.uspto.gov/patents/init_events/brs_report_summary20110502.pdf



Backlog Reduction: Summary

Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<p>The Project Exchange Program was initially designed to allow small-entity applicants having multiple applications pending before the USPTO to have an application accorded accelerated examination status if the applicant expressly abandons another co-pending unexamined application. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.102 entitled “Advancement of examination.”</p> <p>Some of the key requirements include the following:</p> <ul style="list-style-type: none"> (1) the non-provisional application for which accelerated status is sought must be filed before October 1, 2009; (2) the applicant has another co-pending non-provisional application that has an actual filing date earlier than October 1, 2009, and is complete; (3) the application for which accelerated status is sought and the other co-pending application either are owned by the same party as of October 1, 2009, or name at least one inventor in common; and (4) the applicant files a letter of express abandonment in the co-pending application before it has been taken up for examination. <p>The small-entity status requirement was removed on June 24, 2010 to increase participation in the Program.</p>	<p>Pilot Program</p> <p><u>Start Date</u> Nov. 27, 2009</p> <p><u>Termination Date</u> Dec. 31, 2011 or when 10,000 applications have been granted accelerated status under this program, whichever is earlier</p>	<p>Not Required</p>	<p>No Fees</p>	<p>Applications will be placed on an accelerated examination track in the following situations:</p> <ul style="list-style-type: none"> (1) prior to the first communication on merits, <i>i.e.</i>, first Office action; (2) any appeal to the Board of Patent Appeals and Interferences; and (3) the patent publication process.



Backlog Reduction: Info/Contacts

- Pilot Program Points of Contact:
 - RE: EFS-Web or PAIR system - Patent Electronic Business Center at 866-217-9197.
 - RE: specific petition questions: Office of Petitions at 571-272-3282.
 - RE: The Patent Application Backlog Reduction Stimulus Plan Pilot Program Notice - contact the Office of Patent Legal Administration at 571-272-7701 or e-mail PatentPractice@uspto.gov.
- For TC-1600 Program questions contact :
 - Ram Shukla (571-272-0735) or ram.shukla@uspto.gov
 - Cecilia Tsang (571-272-0562) or cecilia.tsang@uspto.gov



Green Technology Pilot Program

- The Pilot Program for Green Technologies Including Greenhouse Gas Reduction notice was signed November 30, 2009, and published on December 8, 2009, at [74 Fed. Reg. 64666](#).
- “Special Status” under the Green Technology Pilot Program:
 - Advances an application out of turn for examination; and
 - Accords “special status” in BPAI appeals and in the patent publication process;without meeting all of the current requirements of the accelerated examination program (e.g., examination support document).

See: http://www.uspto.gov/patents/init_events/green_tech.jsp.



Green Tech

- Applications pertaining to green technologies including greenhouse gas reduction, environmental quality, energy conservation, development of renewable energy resources or greenhouse gas emission reduction.
 - Limited to the first 3,000 petitions granted by USPTO.
- ❖ [75 Fed. Reg. 28554](#)) (May 21, 2010): Eliminated class/subclass requirement.
- ❖ [75 Fed. Reg. 69049](#) (Nov. 10, 2010): Removed filing date requirements and **extended Pilot to run until December 31, 2011** .
- Use [Form PTO/SB/420](#) : "Petition to Make Special Under the Green Technology Pilot Program "available through EFS-Web or at <http://www.uspto.gov/forms/>.



Green Tech: Petition (Form PTO/SB/420)

- Applicant must:

1. State the basis for the special status:

a. enhances the quality of the environment, or

b. contributes to enhancing environmental quality (see: eligibility requirements above).

2. Provide a statement pertaining to the materiality standard if the application disclosure is not clear on its face as to the basis for the special status of the invention.

- It is strongly recommended that applicant provide such a statement, since what may seem “clear on its face” to applicant who has full appreciation of the invention may not be clear to the official deciding the petition.



Green Tech: Petition Requirements

1. Non-provisional utility application filed under 35 U.S.C. 111(a), or 35 U.S.C. 371 (Reissues and Reexams excluded);
2. Electronically filed using EFS-Web at least one day prior to the date of a first Office action appears in PAIR.
3. $\leq 3/20$ claims: (No multiple dependent claims).
4. Directed to a single invention
5. State that applicant *will telephonically elect w/o traverse* if examiner requires restriction.
6. Request early publication in compliance with 37 CFR 1.219 and include Rule 1.18(d) publication fee.



Green Tech: Common Petition Filing Errors

- Petition Goal: initial decision w/n two weeks of petition receipt date.
- Denied (treated as a regular application);
 - not in docket-ready examiner status i.e. must be released by Office of Patent Application Processing (OPAP);
 - untimely e.g. first action already mailed.
- Dismissed (one month to cure)
 - Missing materiality statement
 - Does not include publication fee.



Corp-Wide Green Tech Petition Report Summary

Report date: 05/02/2011

Total Petitions by TC

TC1600	146
TC1700	899
TC2100	142
TC2400	8
TC2600	26
TC2800	827
TC3600	337
TC3700	807
TC4100	6
None	53

Corp. Petition Summary

Petitions awaiting decision	327
Petitions granted	1681
Petitions dismissed	1034
Petitions denied	209
Total Petitions	3251
Issued US Green Patents	290

See: http://www.uspto.gov/patents/init_events/green_report_summary20110502.pdf



Green Tech: Summary

Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<p>The Green Technology Pilot Program permits applicants to request accelerated examination for applications pertaining to clean technologies, such as environmental quality, energy conservation, development of renewable energy resources, and greenhouse gas emission reductions. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.102 entitled “Advancement of examination.”</p> <p>Some key requirements include the following:</p> <ul style="list-style-type: none"> (1) the application must be filed before December 8, 2009; (2) the application must contain three or fewer independent claims and twenty or fewer total claims, and must not contain any multiple dependent claims; (3) the claims must be directed to a single invention that materially enhances the quality of the environment; (4) the petition must include a statement explaining how the materiality standard is met if it is not clear on its face from the application disclosure; (5) the petition must be filed via EFS-Web; and (6) the petition must be accompanied by a request for early publication and the publication fee. 	<p>Pilot Program</p> <p><u>Start Date</u> Dec. 8, 2009</p> <p><u>Termination Date</u> Dec. 31, 2011, or when the first 3,000 grantable petitions are filed, whichever is earlier</p>	<p>Not Required</p>	<p>No Fees</p>	<p>Applications will be placed on an accelerated examination track in the following situations:</p> <ul style="list-style-type: none"> (1) prior to the first communication on merits, <i>i.e.</i>, first Office action; (2) any appeal to the Board of Patent Appeals and Interferences; and (3) the patent publication process.

http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf (page 2/5).



Green Tech: Info/Contacts

- Pilot Program Points of Info/Contact:
- RE: Frequently Asked Questions: at http://www.uspto.gov/patents/init_events/faqs_on_green_tech.pdf
- RE: The Green Technology Pilot Program Notice - contact the Office of Patent Legal Administration at 571-272-7701 or e-mail PatentPractice@uspto.gov.

- For TC-1600 Program questions contact :
 - Manjunath Rao (571-272-0939) or manjunath.rao@uspto.gov
 - Cecilia Tsang (571-272-0562) or cecilia.tsang@uspto.gov



The Three-Track Proposal

- Applicants can choose one of three “tracks” for patent examination:

Track I (prioritized examination): Submit a request and pay an additional fee will place the application in an accelerated queue for examination.

Track II (standard or traditional timing for examination): This option will involve standard fees and will proceed under current examination procedures.

Track III (applicant controlled up to 30 months queue prior to docketing for examination): Certain applications that originate in the United States may have examination delayed for up to 30 months.



Tracks: Advantages

- Advantages:
 - greater control over the timing of examination;
 - increased efficiency of examination

- See 75 FR 31763 (June 4, 2010).
http://www.uspto.gov/news/pr/2010/10_24.jsp



Track I: Effective Date Postponed Until Further Notice

- “Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures”
 - 76 FR (Feb. 4, 2011), 6369 (Proposed rulemaking);
 - 76 FR (April 4, 2011), 18399 (Final rule):
<http://edocket.access.gpo.gov/2011/pdf/2011-7807.pdf>
 - *Implementation on hold due to funding limitations. See:*
76 FR (April 29, 2011), 23876
 - *Under Final Rule:*
- Optional prioritized examination upon applicant’s request and payment of § 1.102(e) \$4,000 prioritized examination fee, a \$130 processing fee, and a \$300 publication fee (in addition to the regular filing/search/ examination fee).
- Aggregate goal for Track I prioritized examination is a final disposition within twelve months of prioritized status being granted.



Track I: Special Status

- Under Track I, an application would be accorded special status and placed on the examiner's special docket throughout its entire course of prosecution before a final disposition is reached in the application.
- The final disposition for the twelve-month goal means:
 - (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 a request for continued examination, or
 - (6) abandonment of the application.
- An application in Track I, is *not* accorded special status throughout its entire course of appeal or interference before the BPAI.



Track I: Requirements

For prioritized Track I examination:

- (1) original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) (371 national stage ineligible)*;
 - (2) If utility, electronically filed using EFS Web; if plant, filed by paper.
 - (3) complete under 37 CFR 1.51(b) with any excess claims fees paid on filing, and
 - (4) application contains, or is amended to contain, no more than four independent and 30 total claims (4/30 rule).
- See 37 CFR 1.102(e)
 - * Consider filing under 35 U.S.C. § 111(a), and claiming benefit to the earlier international application through 35 U.S.C. §§ 365(c)/120. See 76 FR (April 4, 2011), 18399 at 18403-18404.



Track I: Implementation (on hold)

- Requests for prioritized examination under § 1.102(e) would be limited to a maximum number of applications (originally set at 10,000 applications for FY '11):
- Requests to participate would *include* a certification and request for prioritized examination, preferably by using Form PTO/SB/424:
 - available only for applications (including new continuing applications) filed under 35 U.S.C. § 111(a) on or after the date of implementation.
 - unavailable for reissue applications, design applications, provisional applications, national stage applications, PCT international applications, and reexamination proceedings.
- The Office will not prohibit the use of extensions of time for prioritized examination applications:
 - however, a petition for an extension of time for filing a reply, terminates prioritized examination.



Three-Track Proposal: Info/Contacts

- Pilot Program Points of Info/Contact:
 - RE: EFS-Web questions contact the EBC at 866-217-9197
 - RE: Track I Procedure: <http://edocket.access.gpo.gov/2011/pdf/2011-7807.pdf>
- For Program Questions contact :
 - Office of Patent Legal Administration (by telephone):
Eugenia A. Jones (571) 272-7727;
Kathleen Kahler Fonda (571) 272-7754; or
Michael T. Cygan (571) 272-7700,
 - Office of Patent Legal Administration (by mail):
Mail Stop Comments Patents, Commissioner for Patents, P.O. Box 1450 Alexandria,
VA 22313-1450, marked to the attention
of Eugenia A. Jones.



First Action Interview Pilot Program

- Upon request, applicants, prior to first office action, may conduct an examiner interview after reviewing a “Pre-Interview Communication” provided by the examiner.
 - See: http://www.uspto.gov/patents/init_events/faipp_landing.jsp
 - Extended: to run until **May 16, 2012**;
 - Expanded: corps-wide;
 - NOW: “Full” First Action Interview Pilot Program:

See: http://www.uspto.gov/patents/init_events/faipp_full.jsp



“Full” First Action Interview Pilot Program: Requirements for Request

- The application must be a non-reissue, non-provisional utility application filed under 35 USC 111(a) or 371 containing three (3) or fewer independent claims and twenty (20) or fewer total claims. (no multiple dependent claims) drawn to a single invention.
- The request must be filed:
 - (i) on or after April 1, 2011, and before May 16, 2012, and
 - (ii) at least one day before a first Office action on the merits of the application appears in the PAIR system. See http://www.uspto.gov/patents/init_events/faipp_full_preog.pdf
 - (iii) using EFS-Web.



“Full” First Action Interview Pilot Program: Request cont.

- By filing the request Applicant agrees:
 - I. to make an *election w/o traverse* if the Office determines that the claims are not directed to a single invention; and
 - II. not to request a refund of the search fee and any excess claims fee paid in the application after the mailing or notification of the pre-interview communication prepared by the examiner.

- ✓ Use PTO/SB/413C: “REQUEST FOR FIRST ACTION INTERVIEW (FULL PILOT PROGRAM)”: at <http://www.uspto.gov/forms/sb0413c.pdf>



“Full” First Action Interview Pilot Program: Evaluation of Request

- Is there a Notice of Non-compliance?
 - Yes, then determine if Applicant has timely cured the request (either 30 days from notice or a new request before examination)
 - If Applicant does not timely cure then examination in accordance with standard practices and procedures will result.
- Verify propriety of the Request
 - No FAOM
 - No more than 3 independent and 20 total claims
 - No multiple dependent claims
- If request is not proper then forward application to the appropriate TSS team leader for generation of a notice of non-compliance.
- See [Full First Action Interview Pilot Program: Overview](http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9) [PPT] slide 6 at http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9.



“Full” First Action Interview Pilot Program: Pre-Interview Procedure

- Upon receiving the request, the Examiner
 - conducts a prior art search and
 - sends applicant a pre-interview communication (PTOL-413FP) citing relevant prior art and identifying proposed rejections or objections.
- Applicant has: 1 month/30 day response period to request or decline an interview (extendible by one month under 37 CFR 1.136(a)).
- Failure to timely reply to the Pre-Interview Communication or to timely conduct the interview:
 - will not result in abandonment of the application:
 - instead, a first action will be provided i.e. the interview is waived.

See: http://www.uspto.gov/patents/init_events/form-ptol-413fp_enhanced.pdf



“Full” First Action Interview Pilot Program: Pre-Interview Procedure

- Applicant response to the Pre-Interview Communication:
 - I. Request not to have the interview;
 - II. Request not to have the interview AND submit a reply in accordance with 37 CFR 1.111; or
 - III. **File: an “Applicant Initiated Interview Request” form (PTOL-413A) along with a proposed amendment and/or arguments via EFS-Web, and conduct the interview within 60 days from the filing of the Applicant Initiated Interview Request.**

See [Full First Action Interview Pilot Program: Overview](http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9) [PPT] slides 7-8 at http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9



“Full” First Action Interview Pilot Program: Interview Procedure

- Follows current policy and practice (See MPEP 713);
- At the interview, the relevant prior art, proposed rejections, amendments and arguments are discussed.
- Post-interview: the examiner completes an interview summary (PTOL-413) noting/attaching relevant amendments and/or arguments and a completed copy of the Applicant Initiated Interview Request form.
 - If agreement on allowability is reached, if applicant requests an *unofficial* courtesy copy, the examiner generates a notice of allowability (PTOL-37) that includes an interview summary (PTOL-413) with reasons for allowance.
 - If agreement is not reached, applicant receives a first Office action (PTOL-413FA) that includes an interview summary (PTOL-413) that is a first Office action on the merits under 35 USC 132.

See [Full First Action Interview Pilot Program: Overview](http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9) [PPT] slides 8-10 at http://www.uspto.gov/patents/init_events/faipp_full.jsp#heading-9



“First Action Interview Pilot Program”: Results as of April 21, 2011

Total Overall	Original	Enhanced	
1145	502	643	Applicants have joined the pilot program
394	392	2	Pre-interview Communications (PFA OA) have been mailed
439	11	428	Pre-interview Communication (MPICO) have been mailed
711	379	332	Interviews have been conducted
498	294	204	First Action Interview Office Actions have been mailed
79	23	56	Final Rejection mailed with No FAI Office Action
492	260	232	Allowances
185	66	119	Allowed after pre-interview communication but before FAI office action
201	153	48	Allowed after the FAI office action
33.5%	25.2%	41.4%	First Action Allowance rate

See: http://www.uspto.gov/patents/init_events/faipp_full_overview.ppt (slide 15).



First Action Interview Pilot: Info/Contacts

- Pilot Program Points of Contact:

RE: EFS-Web questions contact the EBC at 866-217-9197

RE: Notice/Legal questions contact Joseph Weiss OPLA 571-272-7759 or
first.action.interview@uspto.gov

For Program questions contact :

- » Tech Center 1600 – Johann Richter 571-272-0646 or johann.richter@uspto.gov
- » Tech Center 1700 – Patrick Ryan 571-272-1292 or patrick.ryan@uspto.gov
- » Tech Center 2100 – James Trujillo 571-272-3677 or james.trujillo@uspto.gov
- » Tech Center 2400 – John Follansbee 571-272-3964 or john.follansbee@uspto.gov
- » Tech Center 2600 – Nick Corsaro 571-272-7876 or nick.corsaro@uspto.gov
- » Tech Center 2800 – Darren Schuberg 571-272- 2044 or
darran.schuberg@uspto.gov
- » Tech Center 3600 – Vic Batson 571-272- 6987 or victor.batson@uspto.gov
- » Tech Center 3700 – Linda Dvorak – 571-272-4764 or linda.dvorak@uspto.gov

See http://www.uspto.gov/patents/init_events/faipp_full_overview.ppt (slides 16-18: dated April 26, 2011)



Questions

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