

## CLIENT ALERT

### USPTO Announces Prioritized Examination for One Year Prosecution Available May 4th

April 4, 2011

Today the United States Patent and Trademark Office (U.S.P.T.O.) announced a final rule implementing a prioritized examination track with a goal of providing a final disposition of an application within 12 months of prioritized status being granted. A request for prioritized examination may be submitted with any original non-provisional application filed on or after **May 4, 2011**.

Prioritized status is only accorded until final disposition is reached (e.g., mailing a Notice of Allowance, mailing a final Office Action, filing a Notice of Appeal or filing a Request for Continued Examination (RCE)). The minimum fees for an application to participate in this program will be \$5,520 for large entities and \$4,892 for small entities. Accordingly, applicants may wish to reserve this procedure for those applications in which it is believed that an agreement on allowable subject matter can be reached with only a first Office Action and possibly an Examiner interview. Otherwise, the procedure may at best result in prompt issuance of a first Office Action and a subsequent final Office Action, at which time the application will no longer be accorded special status and will be treated as a regular application for purposes of Appeal or continued examination by filing an RCE.

To qualify for prioritized examination, an application must be complete (i.e., include an oath or declaration and the basic filing fee, the search fee, the examination fee, any excess claim fees, any application size fee and the publication fee), and be filed with an **additional** prioritized examination fee of \$4,000 (there is no discount of the prioritized examination fee for small entities at this time). Accordingly, the minimum fees for an application to participate in this program will be \$5,520 for large entities and \$4,892 for small entities. The application may not have more than 4 independent claims or 30 total claims and may not contain any multiple dependent claims.

Under prioritized examination, an application is accorded special status and placed on the Examiner's special docket until a final disposition is reached. A 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 Board of Patent Appeals and Interferences (BPAI)
5. Filing of a Request for Continued Examination (RCE), or
6. Abandonment of the application

The prioritized examination is also terminated if the applicant files a petition for extension of time, or an amendment that results in more than 4 independent claims, more than 30 total claims, or any multiple dependent claims. After termination the application is examined under a regular status.

The prioritized examination procedure may not be used for international (PCT) applications, design applications, reissue applications, provisional applications, reexamination proceedings, or applications pending before May 4, 2011. However, an

applicant may request prioritized examination upon filing a continuing application of any pending application, including a “bypass continuation” of a PCT application.

A pre-filing prior art search or analysis is not required to qualify for prioritized examination. However, the U.S.P.T.O. recommends that applicants become familiar with the prior art, file a clear specification with well-defined claims, file replies that are completely responsive to the previous Office Action, and be willing to conduct Examiner interviews.

A copy of the published rules can be downloaded from the following link: <http://edocket.access.gpo.gov/2011/pdf/2011-7807.pdf>

For more information, please contact the professional(s) listed below, or your regular Crowell & Moring contact.

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