

## **Ways to expedite examination of a patent application filed in US**

How long does it take to get a patent granted, is one of the most common questions every patent applicant has. The time required to have a patent granted depends on various factors such as the country in which patent application is filed, the technological field of patent application, number of independent and dependent claims in the patent application, so on and so forth. On an average it takes anywhere between 2 to 5 years to have a patent granted.

Considering the quantum of time required to have a patent granted, many applicants wish to accelerate the patent examination process. Patent offices of a few countries have the provision of expediting the patent examination. The United States Patent and Trademark Office (USPTO) is one such patent office that offers the provision of speeding up the patent examination process.

The various options offered by the USPTO that can be availed by an applicant to expedite the examination process are:

- Prioritized examination
- Accelerated examination
- First action interview pilot program
- Patent prosecution highway
- Petition to make special

### **Prioritized examination**

Additional fee:

- Micro entity – USD 1,000
- Small entity – USD 2,000
- Non-small entity – USD 4,000

Prioritized examination can be availed at the time of filing original utility and plant patent applications. Prioritized examination for newly filed original utility and plant patent application is also known as “Track One Prioritized examination”. On opting for prioritized examination, the patent application would be granted special status during prosecution of the application.

Eligibility criteria for prioritized examination (Track One):



- The patent application should be an original non-provisional utility or plant patent applications.
- Patent application should not contain more than 4 independent claims.
- Patent application should not contain more than 30 claims in total.
- Patent application should not contain multiple dependent claims.

Type of application eligible for prioritized examination (Track One):

- First filing application
- Continuing application
- Continuation-in-part
- Divisional application

Prioritized examination is also extended to Request for Continued Examination (RCE) of an existing utility or plant patent application. Original non-provisional utility and plant patent applications filed under 35 U.S.C. 111, or having entered the national stage under 35 U.S.C. 371, in which a proper request for continued examination (RCE) has been filed, or is concurrently being filed, are eligible for prioritized examination.

Eligibility criteria for prioritized examination for a Request for Continued Examination (RCE):

- The patent application should be original non-provisional utility or plant patent applications, or national stage application filed under 35 U.S.C. 371
- Patent application should not contain more than 4 independent claims.
- Patent application should not contain more than 30 claims in total.
- Patent application should not contain multiple dependent claims.
- RCE should be filed with or prior to, prioritized examination request.
- No previous special status under prioritized examination program should have been granted to the RCE.
- Request for prioritized examination should be made before mailing of a first office action after filing of RCE.

A maximum limit of 10,000 requests for prioritized examination is granted per fiscal year, and the limit may be subjected to revision. The 10,000 requests include both Track One and prioritized examination for RCE requests. The number of granted prioritized examination requests can be viewed at:

[http://www.uspto.gov/patents/init\\_events/Track\\_One.jsp](http://www.uspto.gov/patents/init_events/Track_One.jsp)



Final disposition is intended to be provided within 12 months on an average, from the date of granting special status to application availing prioritized examination request.

### **Accelerated examination**

Additional fee:

- Micro entity - \$35
- Small entity - \$70
- Non-small entity - \$140

Accelerated examination is one of the procedures established by the USPTO under which examination of a patent application may be accelerated. A grantable petition has to be filed by the applicant to make special under the accelerated examination program to advance an application out of turn for examination.

The applicant must meet the following requirements to qualify for the new accelerated examination program:

- Submit the petition and fee (wherever applicable)
- File the request with respect to an application filed under 35 USC 111(a)
- File the application via the EFS or EFS-Web; also all follow-on submissions
- File a complete application complying with 37 CFR 1.51
- File 3 or fewer independent claims and no more than 20 claims total
- File an application for a single invention or agree to elect without traverse a single invention for examination
- Agree to an interview with the examiner to discuss any outstanding issues arising in the examination process
- Conduct a pre-examination search
- Provide an accelerated examination support document

Applications not eligible for accelerated examination program:

- Plant applications
- Reissue applications
- Applications entering national stage from an international applications after compliance with 35 USC § 371



- Re-examination proceedings
- Petitions to make special based on applicant's health or age or under the PPH program

### **First Action Interview Pilot Program**

Additional fee: None

An applicant has to file a request to participate in the First Action Interview (FAI) Pilot program within six months life of the program and at least one day prior to appearance of first office action on the merits of the application in the Patent Application Information Retrieval (PAIR) system.

Some of the benefits of the program for participants:

- The ability to advance prosecution of the examination
- Enhanced interaction between the applicant and the examiner
- Opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process
- The opportunity to facilitate possible early allowance

Note:

- No additional fee has to be borne by the applicant to avail the First Action Interview Pilot Program
- Application will not be taken out of turn for this program
- Eligibility dates of the application for pilot program will be chosen based on the likeliness of the application to come up for examination during the six month window of the pilot program
- Patent application should not contain more than 3 independent claims
- Patent application should not contain more than 20 claims in total
- Patent application should not contain multiple dependent claims
- The patent application should be directed to single invention.
- If patent application is identified to have claims directed to more than one invention, the applicant should make an election without traverse.

Pre-Interview Communication issued by the examiner includes objections or rejections based on relevant prior art cited. Within 30 days from the date of Pre-Interview Communication



receipt, the applicant has to schedule an interview with the examiner to discuss the proposed amendments and/or arguments. If an agreement is not drawn at the end of the interview, the examiner will be issuing a first action interview office action which also includes interview summary.

### **Patent Prosecution Highway**

Additional fee: None

The Patent Prosecution Highway (PPH) program was established by the participating intellectual property offices to expedite the examination process of a patent application which has been filed in one or more of the participating patent offices. USPTO is a member of Global Patent Prosecution Highway and IP5 PPH program. No additional fee has to be paid for applications seeking accelerated examination under PPH program. A PPH request has to be submitted via EFS-Web.

Members of Global PPH program:

- Australia
- Canada
- Denmark
- European Patent Office
- Finland
- Hungary
- Iceland
- Israel
- Japan
- Korea
- Nordic patent institute
- Norway
- People's Republic of China
- Portugal
- Russia
- Spain
- Sweden



- United Kingdom
- United states

Members of IP5 PPH program:

- the European Patent Office
- the Japan Patent Office
- the Korean Patent Office
- the State Intellectual Property Office of the People's Republic of China
- the United States Patent and Trademark Office

An applicant should have filed a patent application in at least two of the participating intellectual property offices to avail PPH program. The applicant on receiving a final ruling from a first patent office that at least one claim is allowed, file a request under PPH program in the second patent office for speeding up of examination process of corresponding claim(s) in a corresponding patent application that is pending in the second patent office.

Eligibility requirements of applications for accelerated examination under Global PPH program:

- The application before the Office of Earlier Examination (OEE) and the office of Later Examination (OLE) should have the same earliest date (first filing date or priority date)
- The OEE has found at least one claim to be allowable. The indication that a claim is allowable will be provided as an explicit statement in any substantive work product from the OEE. The claim(s) determined as novel, inventive and industrially applicable in the PCT work products has/have the meaning of allowable in this document.
- All claims presented for examination under the GPPH pilot must sufficiently correspond to one or more of the claims found allowable by the OEE.
- The OLE has not begun substantive examination of the application. However, OLE's may still choose to allow GPPH requests filed after examination of the OLE application has begun depending on the particular circumstances and needs of the OLE and its stakeholders.
- A request for substantive examination must have been filed at the OLE, either at the time of the GPPH request or previously.



The USPTO in addition with Global PPH and IP5 PPH programs, has PPH agreements with following intellectual property offices:

- Austria
- Colombia
- Czech Republic
- Germany
- Mexico
- Nicaragua
- Philippines
- Singapore
- Taiwan Intellectual Property Office

### **Petition to make special**

Additional fee: None

In furtherance to the above discussed processes for expediting prosecution, a patent application can be made special and patent prosecution can be accelerated on petition to make special based on:

- The applicant's age
- The applicant's health
- The invention which enhances the quality of environment
- The invention that contributes to the development or conservation of energy resources
- The invention that contributes to counter-terrorism

The applicant's age:

An applicant of age 65 or above has to file a petition including any supporting documents stating that the applicant is 65 years of age, or more, such as applicant's statement or a statement issued by a registered practitioner that he or she has evidence that the applicant is 65 years of age or older. No additional fee is required.

The applicant's health:

An applicant's application may be made special upon filing a petition along with supporting documents (such as a doctor's certificate or other medical certificate) stating that the health



condition 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. No additional fee is required.

Environmental quality:

The patent applications for inventions that materially contribute to the enhancement of the environment by restoration and maintenance of the basic life-sustaining elements, i.e., air, water and soil, will be accorded with special status. A petition has to be filed by the applicant for their applications to be accorded with special status. No additional fee is required.

Energy:

All the patent applications for invention which materially contribute to a) the discovery or development of energy resources b) the more efficient utilization and conservation of energy resources will be accorded with special status on filing a petition by the applicant seeking special status. No additional fee is required.

Counter-terrorism:

All the patent applications for invention which materially contribute to counter-terrorism will be accorded with special status on filing a petition by the applicant seeking special status. No additional fee is required.

The types of technology for counter terrorism could include, but are not limited to:

- Systems for detecting/identifying explosives
- Aircraft sensors/security systems
- Vehicular barricades/disabling systems

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