

Overview of Acceleration Programs at the USPTO

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Covered USPTO programs

- I. Prioritized Examination (Track One)
- II. Accelerated Examination (AE)
 - "petitions to make special" other than applicant's health, age, and PPH pilot program
- III. PATENT PROSECUTION HIGHWAY (PPH)
- IV. First Action Interview Program (FAIP)

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I. PRIORITIZED EXAMINATION (TRACK ONE)

- GOAL: bring inventions to the marketplace faster
- Final disposition in about 12 months
 - Final disposition: final Office Action or allowance
- "Special Status"
- A maximum of 10,000 applications per fiscal year
- Gaining popularity since 2011

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TRACK ONE (cont.)

Key Requirements

- Original or plant applications
 - National stage (§ 371) applications are ineligible
- Fee: \$4,000/\$2,000/\$1,000 (large/small/micro entity)
- ≤ 4 independent and ≤ 30 total claims; no multiple dependency
- At initial filing or Request for Continued Examination (RCE) filing
 - Request made **before** mailing an Office action responsive to the RCE

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TRACK ONE (cont.)

Track One Status Stops with:

- **An extension of time**
- **Amendments** result in ≥4 independent or ≥30 total claims, or multiple dependency
- **Mailing a final Office Action**
- **Allowance**
- RCE
- Notice of appeal
- Request for suspension of action
- Abandonment
- Examination is completed
 - As defined in 37 CFR § 41.102

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II. ACCELERATED EXAMINATION (AE)

- GOAL: Achieve a final decision within 12 months from the filing date
- The new requirements apply to all petitions to make special, except for:
 - Age and Health
 - Patent Prosecution Highway
- Effective August 25, 2006

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AE (cont.)

Key Requirements

- Be complete at filing
- ≤ 3 independent and ≤ 20 total claims; no multiple dependency
- Petition and fee (\$140/\$70/\$35)
- A statement that a **pre-examination** search was conducted
- An **accelerated examination support document** (AESD)
 - Claim amendments may require an update AESD

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AE (cont.)

AESD

- An **information disclosure statement** (IDS) citing each reference deemed most closely related to the subject matter of each claim
- An identification of **where each limitation disclosed** in the references is found
- A **detailed explanation** of how each claim is patentable over the reference
- A concise **statement of utility** of the invention
- A showing of **support for each claim limitation** in specification and any parent application

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AE (cont.)

USPTO Notice of August 16, 2016

- Fewer than 200 requests annually since 2011 (Track One started)
 - Burdensome?
 - Inequitable conduct and litigation concerns?
 - Roadmap for challengers?
- Seeking public comment whether the accelerated examination program should be maintained

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III. PATENT PROSECUTION HIGHWAY (PPH)

- Second patent office can leverage the search and examination results of the first patent office
- Provide a useful tool to expedite prosecutions of claims toward patentability
- Decrease costs of prosecution

Excluded: plant and design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order

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PPH (cont.)

General Requirements

- Priority connection between applications
 - Claims must "**sufficiently correspond**" to those of the first office
- Office of earlier examination (OEE) work product (translation potentially needed)
- References cited in OEE word product
- **Before** mailing first Office Action on the merits
 - Pay extra petition fee to expedite the grant of a PPH request

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PPH (cont.)

- Quality Benefits
 - 155 First Action Allowance Sample (2013 data)
 - 98% of applications: the Examiner recorded a new search
 - 84% of applications: additional prior art was cited
 - 40% of applications: examiner's amendment and/or interview
- A second Office benefits in the rigorous examination from the earlier Office

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Track One Prioritized Examination	Accelerated Examination	Patent Prosecution Highway
\$4000 fee \$2000 small entity fee, \$2000 micro entity fee	\$1400 portion fee \$70 small entity fee, \$100 micro entity fee	No additional fee
Limited to four independent claims and no more than 30 total claims	Limited to three independent claims and no more than 30 total claims (no multiple dependent claims)	No claim limit (normal excess claim fees apply)
No examination support documents required	Requires presentation search documents and an examination support document	Entry based upon at least one allowable class in corresponding foreign application
Follows normal interview practice	Examiner interview required before issuing an Office Action	Follows normal interview practice
Continuations and I/Cs are eligible for the program	Continuations are eligible for the program	Continuations are eligible for the program (before first action is issued)
Number of applications admitted to the program limited to 10,000 per fiscal year	No limit on number of applications admitted to the program per year	No limit on number of applications admitted to the program per year

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https://www.uspto.gov/sites/default/files/aia_implementation/fast_exam_table20130912v1017.pdf

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VI. FIRST ACTION INTERVIEW PROGRAM (FAIP)

- GOAL: promote personal interviews prior to issuance of a first Office action on the merits
- Eligibility: non-reissue, non-provisional **utility** applications
- Give applicants more options in regards to the amount of notice and procedure needed
- No government fee
- Started April 28, 2008

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FAIP (cont.)

Requirements

- ≤ 3 independent claims, ≤ 20 total claims, and no multiple independency
- Must claim only a single invention
- Before mailing of the first Office action on the merits

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FAIP (cont.)

Procedures

- Applicant files a request
- Examiner conducts a prior art search
- Examiner provides a Pre-interview Communication
- Applicant schedules the first action interview and file a proposed amendment/remarks

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THANK YOU!

QUESTIONS?

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USPTO Dashboard Statistics TRACK ONE

Pendency	Months
From Petition Grant to 1 st Office Action	1.66
From Petition Grant to Final Disposition	6.76
From Petition Grant to Allowance	5.44
From Filing to Petition Grant	1.3

Cumulative for fiscal year 2019

Track One Final Dispositions

April 2019

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Global and IP5 PPH Participants with the USPTO PPH

<https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

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PPH

- PPH between USPTO and Argentina (Bilateral agreement under global principles)
- PPH between USPTO and Brazil (Bilateral agreement with the incoming application to the USPTO following global principles)
- PPH between USPTO and Chile (Bilateral agreement under global principles)
- PPH between USPTO and Czech Republic
- PPH between USPTO and Eurasian Patent Office (EPO)
- PPH between USPTO and Mexico (Bilateral agreement under global principles)
- PPH between USPTO and Nicaragua
- PPH between USPTO and Philippines
- PPH between USPTO and Romania (Bilateral agreement under global principles)
- PPH between USPTO and Taiwan Intellectual Property Office

Cumulative USPTO PPH Data for All Regions
As of April 30, 2019

- 59,075 Total Applications with Petitions
- 50,645 Total Applications with Petitions Granted

<https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

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FAIP

USPTO Dashboard Statistics

May 2018

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