

## **Introduction**

In the past, all newly filed United States patent applications were generally put in the same queue, providing the applicant no control over when their application would be examined. However, the USPTO has responded in recent years to customer input on this issue, with a number of initiatives allowing applicants some control over the speed of examination. This article reviews five options, one per section below, now available to expedite application examination.

### **I. Track One “Prioritized Examination”**

One way to expedite examination, known as Track One, is provided under 37 CFR 1.102(e). Track One allows applicants to get a final disposition (allowance or final rejection) within about 12 months. Track One, however, is very expensive, currently \$4,000 for a non-small entity, \$2,000 for a small entity and \$1,000 for a micro entity. Track One also limits the application to a total of 30 claims and a total of 4 independent claims, and no multiple dependent claims. The Track One request must be filed at the time of filing the application. An exception exists in that a Track One request may be filed with or after a Request for Continued Examination (RCE) and before that application is subsequently examined.

Since a US national stage entry of a PCT application is not a new filing, Track One is not available at the time of PCT US national stage entry. However, this problem may be avoided by the filing of a by-pass US national application claiming domestic benefit to the PCT application, instead of proceeding by PCT US national stage entry.

### **II. PPH (Patent Prosecution Highway)**

Another way of expediting examination is the Patent Prosecution Highway (PPH). The PPH works under agreements signed between various patent offices to enable patent applicants to request a fast track examination procedure under certain circumstances. Generally, the PPH allows an applicant, that receives a final ruling from a patent office that at least one claim is allowed, to obtain fast track examination of an application containing corresponding claim(s) in corresponding patent applications in patent offices of other countries. Therefore, if an applicant has a “positive work product” (an indication that claims are allowed) provided by any examining office of any country with which the United States has a PPH agreement, the applicant can request PPH treatment in the USPTO by amending the claims pending in the USPTO application to “sufficiently correspond” in scope to the claims allowed in the country that issued the “positive work product”.

On the flip side, applications in other countries can benefit from PPH when corresponding claims are allowed in the USPTO.

Some of the PPH agreements require the Office of First Filing (OFF) to provide positive work product, to entitle the applicant to PPH status in the USPTO. Other PPH agreements allow any Office of Earlier Examination (OEE) to be the basis for PPH treatment in the USPTO. Countries in which the OEE "positive work product" is sufficient for PPH treatment of a corresponding US application include: Australia;

Canada; Denmark; Hungary; Iceland; Israel; Japan; South Korea; Nordic; Norway; China; Russia; Sweden; and UK. The EPO is also included. Countries in which OFF "positive work product is sufficient for PPH treatment of a corresponding US application include: Austria; Columbia; Czech; Germany; Mexico; Nicaragua; Philippines; Singapore; and Taiwan.

There is no USPTO fee for requesting PPH treatment. The USPTO will provide PPH treatment if a PPH request filed in an application is granted before the date of a first office action on the merits in the application. PPH treatment remains in force through the entire pendency of the application, which may include appeals and post RCE prosecution.

### **III. Inventor Age or Health; Green Technology, Conservation of Energy, Counter Terrorism**

Yet another procedure for expediting examination is to file a petition to make an application special under 37 CFR 1.102(c). There is no fee for such a petition. 37 CFR 1.102(c) allows for petitions to make special to be granted under the following circumstances. A 102(c) petition to make special may be filed if the applicant's health is such that the applicant might not be available to assist in the prosecution of the application if it were to run its normal course. This kind of petition requires a showing, such as a medical certificate. A 102(c) petition to make special may be filed if the applicant's age is at least 65 years. This kind of petition requires either proof of age or a statement from a registered practitioner that they know the applicant is at least 65 years old.

There are currently three other bases specified by 1.102(c) for petitioning to make an application special. However, petitions under these three bases also require compliance with the stringent Accelerated Examination Program (AEP) requirements noted in the next section, and therefore are generally inadvisable. These bases are as follows. First, the invention materially enhances the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements. Second, the invention materially contributes to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources. Third, the invention materially contributes to countering terrorism.

### **IV. Accelerated Examination Program**

Yet another procedure for expediting examination is the filing of an application with a petition to make special under the AEP. This petition requires payment of a small government fee (a 1.17(h) fee, currently \$140).

However, there are stringent requirements for grant of a petition under the AEP. These requirements include providing an Examination Support Document containing, among other things: an IDS; a claim chart reading all claim limitations on the prior art; detailed explanations of patentability over the prior art noted in the IDS; a claim chart showing support for each claim limitation. In addition, the applicant must limit the number of claims to not more than 20 and the number of independent claims to not more than 3, and agree not to contest any restriction requirement. These AEP requirements are so burdensome and potentially damaging that it is generally inadvisable to use any procedure incorporating AEP requirements.

## V. Glossary Definition Program

The USPTO has experimented with other programs for expediting examination. One newly declared experiment is the new Glossary Definition program. This program starts on June 2, 2014, is scheduled to run through December 31, 2014. Its goal is to determine if addition of a glossary of terms in a patent application enhances claim clarity and provides efficiencies in examination. To qualify, an applicant must include a glossary section in the application specification to define terms used in the patent claims. However, this program is limited to certain technology areas in the computer and internet networking areas (tech centers 2100, 2400, and 2600; 3600) and to the first 200 applications that qualify. PCT national stage filings and continuing applications are excluded from this program.

In summary, the USPTO has several programs in place that allow for expediting examination. Applicants should be aware of when these options are available and how and whether to use them. [For more information on any specific situation contact Neifeld IP Law, PC.](#)

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<sup>1</sup> We can be reached via the firm website: <http://www.neifeld.com/cv.html>