



mcandrews
McANDREWS HELD & MALLOY LTD

Prioritized Examination: A Practical Guide

Joe Barich

McAndrews, Held & Malloy

jbarich@mcandrews-ip.com

(312) 775-8194

Main Points

- Prioritized Examination is now Live!
- Prioritized Examination under the AIA is similar to, but not identical to the PTO's previously proposed Track 1 (April 4, 2011)
 - Nor is it very similar to Accelerated Examination
- It's pretty much what we have been wanting

America Invents Act (AIA)

- Not a lot of detail in the AIA
- Can be utility or plant application
- Fee of \$4,800 – in addition to filing, search, examination, excess claim, size, processing, and publication fees.
- Can't contain or be amended to contain more than 4 independents and 30 total claims
- Only 10,000 in current fiscal year – can be adjusted up
- Half off for small entity – no micro entity

PTO Implementation

- We are a go!
- PTO implemented its rules effective September 26th so you can file a Prioritized Application today!
- Combined previous Track 1 with Prioritized Examination under the AIA – as modified by AIA
- Application will be placed on Examiner's special docket with goal of 12 month resolution

How to File – App Type

- Does not apply to international applications*, design apps, reissues, provisionals, reexams
 - *Apps entering national stage under 35 USC 371 are not eligible, but “bypass” continuations under 25 USC 111(a) ARE eligible.
 - Net impact – just payment of extra fee
- OK to file a continuation or divisional!
 - Not automatically prioritized if parent is prioritized
- Must be filed after Sept 26, 2011, but can file another continuation today

How to File - Fees

- Fees – everything usual plus \$4,800+
 - For regular large app total = \$6,480 (\$3,360 small)
- (1) \$1,250 (\$530 small entity) in filing fees
 - \$380 (\$95 small entity filing by EFS-Web) filing fee
 - \$620 (\$310 small entity) search fee
 - \$250 (\$125 small entity) examination fee
- (2) \$4,800 (\$2,400 small entity) prioritized examination fee;
- (3) \$130 processing fee
- (4) \$300 publication fee
- Will have to pay application size fee if > 100 pages
- Claim fee if more than 3/20 – BUT can't exceed 4/30

How to File – Must Be Complete

- Application must be totally complete at filing
- All fees paid at filing
- Must be filed electronically if utility app
- Must have Oath/Declaration
- Must have drawings suitable for examination
- Request for Prioritized Examination - sb0424
- Max claims 4/30
 - No multiple dependent claims
 - Don't use a Preliminary Amendment to fix claims

How to File

- Need sb0424 form
- Simple form

Doc Code: TRACK1.REQ
 Document Description: TrackOne Request

PTO/SB/424 (09-11)

CERTIFICATION AND REQUEST FOR PRIORITIZED EXAMINATION (TRACK I) (Page 1 of 1)			
First Named Inventor:		Nonprovisional Application Number (if known):	
Title of Invention:			
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION (TRACK I) FOR THE ABOVE-IDENTIFIED APPLICATION.</p> <p>1. (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web.</p> <p>OR</p> <p>(b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application in paper. (Note: Plant applications cannot be filed via EFS-Web.)</p> <p>Note: The following are excluded from the Track I program: design applications, provisional applications, national stage applications, PCT international applications, reissue applications, and reexamination proceedings.</p> <p>2. The following fees (in amounts consistent with the current fee schedule available at http://www.uspto.gov/about/offices/cfo/finance/fees.jsp) are filed with the application: (1) basic filing fee; (2) search fee; (3) examination fee; (4) any required excess claims fees; (5) any required application size fee; (6) publication fee; (7) processing fee (Track I) set forth in 37 CFR 1.17(i); and (8) prioritized examination fee (Track I) set forth in 37 CFR 1.17(c).</p> <p>3. An executed oath or declaration under 37 CFR 1.63 is filed with the application.</p> <p>4. The application contains or is amended to contain no more than four independent claims and no more than thirty total claims, and no multiple dependent claims.</p>			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
<p><i>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.</i></p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

Timeline Goal

- Final disposition in 12 months – goal, not requirement
 - Mailing of a notice of allowance
 - Mailing of a final Office action
 - Filing of a notice of appeal
 - Completion of examination as defined in 37 CFR 41.102 (asking Board for relief)
 - Filing RCE
 - Abandonment of the application.
- No special status during appeal or interference before the BPAI, or after the filing of RCE

Period For Reply

- Time periods for reply will be the same as set forth in 710.02(b) for all Office Actions
 - Note however that it may be as short as 1 month
- You can purchase extensions of time, BUT!!!
 - It terminates prioritized examination
- Compare with Accelerated Exam – 30 days to reply and if no reply, then abandoned

Termination

- If at any time $> 4/30$ or any multiple dependent claim
- Any request for extension of time or suspension of action
- Impact - Removed from Examiner's special docket and placed on regular docket
- No REFUNDS!
- Warning – Don't use the Preliminary Amendment at filing if you need to reduce claims to $4/30$

Adding Claims

- Notice of Allowance or Final OA terminate prioritized examination, so you can add claims after receipt
- Can amend claims to place in allowable form where dependent claims were found allowable
- Can add new claims subject to the limitations applicable to any final Office Action/Allowance
- Example – Adding/copying dependents to other allowed independents

Not Yet Clear

- Drawings – Application must be “complete”
 - PTO objects to drawings at filing? Terminated?
 - PTO requests formal drawings – likely OK
- PTO likely to raise limit on number of filings in future years – Director can change by rule
 - Technically, implemented in 2011 and new fiscal year started Oct 1, 2012

Practical Suggestions

- Don't use a Preliminary Amendment if filing a Continuation or Divisional
- Use plenty of dependent claims – can copy chain for other independents at allowance
- Eliminates main Accelerated Examination issues
 - No Examination Support Document
 - No abandonment if more than 30 days
 - Pretty much no longer a reason to file Accelerated
- Really a great opportunity for clients!



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QUESTIONS?

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