# Overview of Acceleration Programs at the USPTO Zhengyu Feng, Ph.D., J.D. Zhengyu Feng, Ph.D., J.D. Serving the Creative and Legal Communities

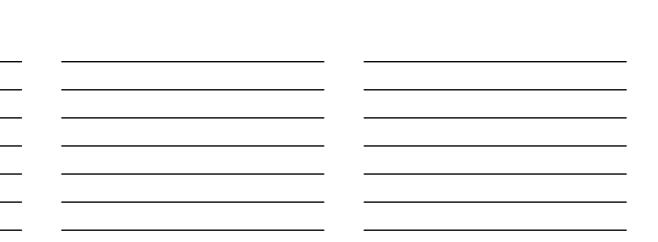
# **AIPLA** Disclaimer

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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?
- o 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

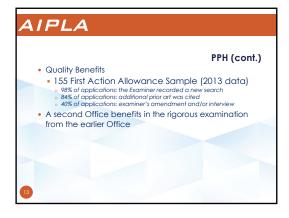
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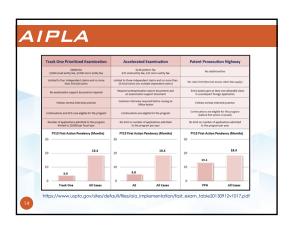
### PPH (cont.)

### **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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# 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 (cor	ıt.)
	Requirements	
•	<ul> <li>≤ 3 independent claims, ≤ 20 total claims, and no multiple independency</li> </ul>	
•	<ul> <li>Must claim only a single invention</li> </ul>	
	Before mailing of the first Office action on the merits	
16		

# 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

