

LEGAL UPDATES

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# The America Invents Act: Prioritized Examination Is Working "Super-Fast"

On January 3, 2012, Commissioner for Patents Peggy Focarino reported on the U.S. Patent and Trademark Office's (USPTO) "super-fast processing" under prioritized examination. At the time of the report, prioritized examination had been in effect three months. The fastest patent to issue was in 37 days. There had been 1,231 petitions for prioritized examination, 98.9 percent of which were granted. There have been a total of 30 allowances, with 682 applications having received first office actions. These and other facts substantiate Focarino's claim to super-fast processing.

## What is prioritized examination?

Prior to the passage of the America Invents Act, obtaining a patent quickly to meet business needs was an uncertain process. Although there were certain categories of "special" applications, they were not available for all applications, and as a practical matter, the handling of applications that were made special varied across different technologies and even individual examiners.

In Section 11(h) of the America Invents Act, Congress instituted prioritized examination. Congress set a large entity fee of \$4,800 (\$2,400 for small entities), and permitted the USPTO to make regulations and limit the number of applications to be accepted. The default limits set by the statute were four independent claims and 30 total claims, with a default limit of 10,000 prioritized examination applications per year.

The USPTO issued final regulations on December 19, 2011, adopting the same claim limits as the statute: four independent claims and 30 total claims. Rule 102(e) also denies prioritized examination to Patent Cooperation Treaty applications that have not entered the U.S. National Stage, design applications, reissue applications, provisional applications or re-examination proceedings.

Rule 102(e)(1) expressly permits original U.S. utility and plant applications to use prioritized examination. Patent Cooperation Treaty applications will have to enter the U.S. National Stage to be eligible for prioritized examination. Rule 102(e)(2) permits requests for continued examination (RCE) to be made special if the request is made before the first office action after the RCE. Only one prioritized RCE request per patent application may be granted.

### **What This Means to You**

Patent applicants can obtain USPTO consideration of their applications on an expedited schedule. What began as a statutory provision to provide patents rapidly is being realized as a successful program. The precedents indicate that the additional filing fee results in rapid consideration of the application by the USPTO. Patent applicants will need to balance the benefits of rapid consideration of the application with the limited number of claims and additional expense in choosing this course of action.

### **Contact Info**

For additional information about these or any other intellectual property issues, please contact your Husch Blackwell attorney, Erik Flom at 312.526.1635 or Edward Manzo at 312.526.1535.

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