

PUBLICATION

Methods for "Fast-Tracking" Patent Applications in the United States

July 10, 2012

Recent developments have provided or improved two simple methods for "fast-tracking" patent applications in the United States.

Patent Prosecution Highway

Do you have claims allowed in a foreign country? If so, you may be able to use those claims to accelerate the prosecution of your U.S. application using the Patent Prosecution Highway (PPH).

Under the original PPH model, prosecution of applications could be accelerated if the claims in the U.S. application sufficiently correspond to allowable claims in an application examined by an "office of first filing." That is:

1. the U.S. application must claim priority to a foreign application or international application examined by a foreign office;
2. the foreign or international application must predate or be filed on the same day as the earliest U.S. application to which priority is claimed; and
3. the foreign office in which the priority document is examined must have indicated that claims "sufficiently similar" to those in the U.S. are allowable.

The original PPH track has been around for some time, but recent modifications increase its flexibility and ease of use. The new "Mottainai" PPH model drops the requirement that the claims be allowed in an "office of first filing." Instead, all that is required is an allowance of claims in a foreign or Patent Cooperation Treaty (PCT) application that shares a common priority with the U.S. application. In addition, the "PPH 2.0" initiative eliminates many of the paperwork requirements under the original model, thus streamlining the process and reducing the possibility for rejected requests. This greatly expands the number of applications eligible for a PPH request.

Track One Examination

If you do not have allowable claims in another country, but are interested in expedited prosecution, Track One Examination under the America Invents Act may be an option.

In order to be eligible for Track One Examination, the application must:

4. be a U.S. national application or a "bypass continuation" of a PCT application;
5. not have more than four independent claims or more than 30 total claims; and
6. be one of the first 10,000 applications for which Track One is granted in the fiscal year in which it is filed.

The request for participation in Track One Examination must be submitted when the application, accompanied by an executed declaration, is filed, and all fees necessary for a completed application are paid. A fee of \$4,800 is required for entry into Track One Examination.

Applications under Track One Examination are entitled to prioritized examination, with a goal of obtaining a final disposition within one year of the application filing date.

If you are interested in evaluating your options for expediting prosecution of your patent applications, please contact one of our experienced Patent Attorneys.