

## IP Frontiers: How to expedite a patent application

■ **Stephen P. Scuderi** SPECIAL TO THE DAILY RECORD



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GENERALLY, the United States Patent and Trademark Office (USPTO) takes about 24 months to make a final decision on the approval of a patent application. Much of this time is due to the long queue that an application must get through prior to being examined by a patent examiner at the USPTO. However, there are several procedures available to inventors and applicants of a patent application which can cut that time by more than half. Utility patent applications and design patent applications are expedited differently. The focus of this article will be on the procedures available to expedite a nonprovisional utility patent application.

### PRIORITIZED EXAMINATION USING TRACK ONE

The Track One (sometimes referred to as Track 1) program promises applicants a final decision on a utility patent application within 12 months of the grant of Track One status. However, under the Track One program, it is not unusual to obtain a decision to grant or deny

patentability to an application within six months. Additionally, this program is potentially available to any applicant.

All an applicant needs to do to obtain Track One status is to complete and file a Track One Request form – which is titled: “Certification and Request for Prioritized Examination Under 37 CFR 1.102(e)” – and pay the required fee. The fee, though, is not inexpensive. For large entities the fee is about \$4,140; for small entities the fee is about \$2,070; and for micro entities the fee is about \$1,035. This fee must be paid in addition to the normal fees associated with preparing and filing the patent application.

The Track One program does have certain strict rules that must be followed, or the applicant will lose their Track One status. For example:

- The application and Track One request must be filed electronically.
- The application must not contain, or be amended to contain, more than four independent claims, more than 30 total claims, or any multiple dependent claims.
- There can be no requests for an

extension of time to respond to an office action from the USPTO.

### PATENT PROSECUTION HIGHWAY FOR FOREIGN APPLICATIONS ENTERING THE U.S. NATIONAL PHASE

The USPTO is a global participant in the Patent Prosecution Highway (PPH). Under PPH, participating patent offices have agreed that when an applicant receives a ruling from a first patent office that at least one claim is allowable, the applicant may request fast track examination of corresponding claims in a corresponding application that is pending in a second patent office. So, for example, if an applicant first files an application in Germany and gets at least one of its claims allowed by the German patent office, then the same applicant may request fast track status in the United States for a later filed corresponding U.S. application having corresponding claims.

To apply for the PPH program, an applicant must fill out a petition to make special under the Patent Prosecution Highway, provide the allowed application from the foreign patent office and provide a cross reference list of the U.S. claims to that of a translation of the allowed claims.

Importantly, there is no fee required under the PPH program. Moreover, the restrictions that apply in the Track One program do not apply to the PPH program.

#### Petition to Make Special for the Age or Health of the Inventor

Normally, patent applications are examined in the order that they are filed in under a “first come, first served” basis. However, a petition to make special may be granted if one of the inventors in a patent application is over the age of 65, or is ill to the point where they may not be available to assist in the prosecution of the patent.

A petition to make special due to an inventor’s age is easy to fill out. The petition is granted almost automatically upon a statement by the inventor that he/she is over 65 years old, or a certification is made by a registered attorney/agent having evidence (such as a copy of a driver’s license) that the inventor is over 65 years old.

An application may also be made special upon a petition that is accompanied by any evidence showing that the state of health of at least one named inventor is such that at least one named inventor might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor’s certificate or other medical certificate. However, petitioners should note that personal/medical information submitted as evidence

to support the petition may be available to the public. If a petitioner does not wish to have this information become part of the application file record, then the information must be submitted as trade secret or proprietary information pursuant to the rules detailed in the U.S. Manual of Patent Examining Procedure (MPEP) 724.02.

Importantly, there is no fee required for either the petition to make special for an inventor’s age or health. Additionally, there are no restrictions placed on the prosecution of the application.

#### **CLIMATE CHANGE MITIGATION PILOT PROGRAM**

The Climate Change Mitigation Pilot Program is designed to positively impact the climate by accelerating examination of patent applications for innovations that reduce greenhouse gas emissions. Under this program, qualifying applications involving greenhouse gas reduction technologies are advanced out of turn for examination (granted special status) until a first action on the merits (typically the first substantive examination) is complete. For qualifying applications, the applicant does not incur the petition to make special fee and is not required to satisfy the other requirements of the accelerated examination program. The United States Patent and Trademark Office (USPTO) will accept petitions to make special under this program

until June 5, 2023, or the date when 1,000 applications have been granted special status under this program, whichever occurs earlier.

The requirements for qualifying for this program are:

- Applications must contain one or more claims to a product or process that mitigates climate change by reducing greenhouse gas emissions.
- The application must be electronically filed.
- Applicants must file the petition to make special with the application or within 30 days of the filing date or entry date of the application.
- Applicants may not file a petition to participate in this pilot program if the inventor or any joint inventor has been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a petition to make special under this program has been filed.

Again, it is importantly to note that under this program, there is no fee required and there are no restrictions placed on the prosecution of the application.

*Stephen P. Scuderi is an associate with the law firm of Heslin Rothenberg Farley & Mesiti P.C. His practice involves all phases of intellectual property law, including the drafting of hundreds of patents in the electrical and mechanical arts. Stephen can be reached at (518) 452-5600 or at [stephen.scuderi@hrfmlaw.com](mailto:stephen.scuderi@hrfmlaw.com).*