



Intellectual Property & Technology Law Alert

A Corporate Department Publication

November 2011

Prioritized Examination of Patent Applications Under Leahy-Smith America Invents Act

The Leahy-Smith America Invents Act (“AIA”) was enacted on September 16, 2011. The changes implemented by this Act are wide-ranging and significant, and different provisions have different effective dates, with many taking effect September 26, 2011, September 16, 2012, or March 16, 2013. We will be providing additional information in the coming weeks and months.

One of the more immediate and interesting aspects of the AIA is the creation of a *prioritized examination* process which allows applicants to request accelerated examination in exchange for payment of an additional fee. While the U.S. Patent Office had proposed to implement accelerated examination earlier in 2011, that proposal was suspended due to funding limitations. Not only does the AIA now explicitly provide for prioritized examination, it also mandates that the additional fees paid for prioritized examination are automatically credited to the Patent Office’s appropriation account—thus providing the additional funding needed for implementation.

Normally, patent applications are examined in the order they are received. While it varies greatly by technological area, on average it currently takes 28 months for the U.S. Patent Office to issue a first office action. The new prioritized examination track, on the other hand, is intended to result in a notice of allowance or final rejection within 12 months of prioritized status being granted. In theory, the first office action should therefore issue within about 6 months from the application filing date—almost two years sooner than is typical under the normal examination track.

So what’s the catch? Perhaps the biggest is the additional fees required for prioritized examination: \$5,230 (reduced to \$2,830 for small entities). That’s in addition to the normal application filing fees. Thus, the total fee due on filing an application for which prioritized examination is requested is \$6,480 (\$3,360 for small entities), not including any excess claim or application size fees.

Prioritized examination is only available for original utility or plant patent applications filed on or after September 26, 2011. However, for applications pending prior to that date, it is possible to file a continuation or divisional application and request prioritized examination of that application. Additionally, while prioritized examination is not available to a national stage entry of a PCT application, it is available for a continuation application claiming priority to a PCT application which designates the United States.

This IP & Technology Law Alert is intended to provide general information for clients or interested individuals and should not be relied upon as legal advice. Please consult an attorney for specific advice regarding your particular situation.

Martin J. Miller
513-369-4250
mmiller@porterwright.com



In addition, the application must be complete on filing (including the request for prioritized examination, acceptable drawings and payment of all applicable fees), must be filed electronically, and must contain no more than four independent claims or thirty total claims. During prosecution, an application will lose its prioritized examination status if: (1) an amendment results in more than four independent claims or thirty total claims; (2) a petition for an extension of time is filed; or (3) a notice of appeal or request for continued examination is filed.

It is unclear how many applicants will take advantage of prioritized examination, or whether or not the U.S. Patent Office will be able to consistently meet its goal of completing the examination process within 12 months. Because of these uncertainties and the continuing need to hire additional patent examiners, the prioritized examination program is limited to 10,000 applications during at least the first year of implementation.

Porter Wright Morris & Arthur LLP
www.porterwright.com

Cincinnati, Ohio
800-582-5813
Cleveland, Ohio
800-824-1980

Columbus, Ohio
800-533-2794
Dayton, Ohio
800-533-4434

Naples, Florida
800-876-7962
Washington, DC
800-456-7962