



August 2006

## OBTAINING ACCELERATED PATENT APPLICATION EXAMINATION

### United States Patent & Trademark Office (USPTO) Implements Revised Accelerated Examination Conditions

*Beginning August 25, 2006, patent applicants can petition the USPTO to grant their application accelerated examination or "special status" by submitting the required fee and showing they comply with the revised conditions described in this Alert.*

Prior to August 25<sup>th</sup>, applicants could petition for "special status", only if they met one of the following 5 conditions:

- 1) they had reached the age of 65;
- 2) they were in very ill health;
- 3) there was an ongoing infringement;
- 4) they were ready to manufacture in the U.S. and would not manufacture unless certain a patent will be granted; or
- 5) the invention had a beneficial environmental, public health or anti-terrorism impact, or was related to recombinant DNA, biotechnology for companies with less than 500 employees, or superconductivity.

Because the majority of patent applicants do not meet these requirements, most patent applicants had no recourse but to simply wait for their application to be examined in the order it was received by the USPTO. An applicant could expect to wait at least a year, and frequently much more than a year, for a first office action. Without "special status", the time from patent application filing to patent issuance is typically on the order of several years.

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### **Revised Accelerated Examination Conditions:**

As of August 25, 2006, except for petitions based on an applicant's age or health, all "petitions to make special" must comply with the conditions set forth below. If the conditions below are met, an applicant does not need to show one of the conditions previously required to be granted accelerated examination.

- 1) paying a petition fee of \$130.00 or making a statement that the invention is directed to environmental quality, energy or countering terrorism;
- 2) the application is a non-reissue utility or design application;
- 3) the application, petition and fees are filed electronically;
- 4) the application is complete (i.e., there are no "missing parts");
- 5) the application has no more than 3 independent claims and 20 total claims;
- 6) the applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application process;
- 7) the applicant agrees to have an interview with the examiner if so requested;
- 8) the applicant makes a statement that a preexamination search was conducted concerning all claimed elements, given their broadest reasonable interpretation, and including non-patent literature unless the applicant can justify with reasonable certainty that no references more relevant than those already cited will be found and the applicant includes a justification with this statement;
- 9) the applicant must submit an "accelerated examination support document" including the following:
  - a) an information disclosure statement (IDS) which lists all the references deemed to be most closely related to the claimed invention;
  - b) for each reference cited in the IDS, an identification of all the limitations in the claim that are disclosed by the reference specifying where in the reference the limitation is disclosed;
  - c) a detailed explanation of how each of the claims is patentable over the references cited with the particularity required by 37 C.F.R. §1.111 (b) and (c) (i.e, rather than making broad allegations that the claims are patentable, arguments must be presented that point out the specific distinctions believed to render the claims patentable over any applied references);

- d) a concise statement of the utility of the invention as defined by the independent claims (unless the application is a design application);
- e) where each limitation in the claims finds support under the first paragraph of 35 U.S.C. §112 in the written description of the specification. Furthermore, if there are “means-plus-function” claims, the applicant must state the structure, material or acts in the specification (and/or any previous application which the applicant has claimed priority to and which such support exists) that correspond to each means-(or step-) plus-function claim element; and
- f) identification of any cited references that may be disqualified as prior art under 35 U.S.C. §103(C) as amended by the Cooperative Research and Technology Enhancement (CREATE) Act.

If all the above conditions are met, the USPTO will *endeavor* to issue a first action within 12 months of the filing date. However, this is not a guarantee and the failure of the USPTO to issue an official action within the 12 month time frame is neither petitionable nor appealable. Given this fact, an applicant should carefully weigh the benefit of a potentially quicker examination with the expense of making the required showing outlined above.

**If you have any questions or would like more information regarding the accelerated patent application process discussed in this Alert, or have any other questions about our Intellectual Property practice group, please contact any member of our Intellectual Property practice group:**

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