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Getting Your Application Through the USPTO - Expedited Examination Options

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You've developed your new technology, taken care to keep it confidential and are planning to file for patent protection at the US Patent and Trademark Office (USPTO). Everything looks good. Until your patent agent tells you it may be 3 or more years before your patent is granted.

A lot can happen in three years, the worst of which is competitors infringing on your patent-pending invention. Since the exclusive rights of patent protection only come with patent issuance, there's little recourse until you have a granted patent.

Fortunately, the USPTO offers two different options for expediting the prosecution of your patent application. We introduce each of these options below and discuss some of their features:

- *Track 1 Prioritized Examination* – Track 1 involves the payment of a fee (\$4800 or \$2400 for small entities) when filing of the application (including continuations and divisionals, but notably not PCT national phase entries) to place the application on a prioritized prosecution track. The USPTO indicates a target period of twelve months from granting Track 1 Priority until a final step of either issuing a notice of allowance or issuing a final office action.

Responses to Office Actions must be filed within the time set out - a request for extension of time or suspension of prosecution will return the application to the non-prioritized prosecution track and it will be subject to the usual prosecution timelines. Track 1 applications are limited to a total of 30 claims and 4 independent claims.

- *Accelerated Examination* – A request for accelerated examination requires the furnishing of a pre-examination search document (PESD) and accelerated examination support document (AESD), which outline how the claims of the application are allowable over the closest prior art. As such, the initial search and patentability assessment are conducted by the applicant and then considered by the Examiners. The search criteria and arguments in PESD and AESD are reviewed by two examiners and then a third examiner considers allowability of the claims based on these documents. In this sense, Accelerated examination provides a very thorough exam and presumably strong claims.

Prosecution of accelerated applications must adhere to very strict and tight timelines, with the application becoming abandoned if a deadline is missed. While the filing and accelerated exam request costs are only about \$1,500.00 (and about \$700.00 for small entities), there is significantly more cost to conducting the search and preparing PESD and AESD. Accelerated examination applications are limited to a total of 20 claims and 3 independent claims.

Both options require that the application be published at the time of requesting expedited examination. In some cases early publication, ahead of the typical 18 months from priority, may not be desirable and this will have to be weighed against the need for expedited prosecution and early issuance.

At the end of the day choosing to pursue expedited exam and choosing which option is right for you is a business decision and one that should be discussed with your patent agent to determine the best approach for you.

If you want advice on patent prosecution or patent procurement contact [Shohini Bagchee](#) in our Intellectual Property & Technology Group.



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