

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Sharing session on expedited patent examination mechanisms at IP offices (SCP 33/4):

The United States Patent and Trademark Office

Standing Committee on the Law of Patents: 34th Session
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Geneva

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Agenda

- SCP 33/4 overview
- Expedited patent examination programs at the USPTO
- Other Expedited Programs

Overview

	Inquiries under SCP 33/4
a.	Qualifying grounds for expediting examination
b.	Internal institutional arrangements to facilitate expedited examinations
c.	Staffing and/or resource allocations
d.	Goals behind expedited examination programs
e.	Interplay between existing pendency and expedited examination goals
f.	Cooperation with other patent offices (if any)
g.	Any surcharges for expedited examination

Expedited patent examination programs at the USPTO

- Listing of programs*
 - Track One / Prioritized Examination
 - COVID-19 Prioritized Examination Pilot Program
 - Accelerated Examination (Generally)
 - Petitions to Make Special Based on Age or Health
 - Patents 4 Patients (Cancer Immunotherapy Pilot Program)
 - Climate Change Mitigation Pilot Program
 - Patent Prosecution Highway (PPH)
 - Expanded Collaborative Search Pilot (CSP)

*An Annex to this presentation provides a detailed listing of expedited examination programs, according to each inquiry of SCP 33/4.

Track One / Prioritized Examination

- **Summary:** Eligible applications are accorded “special status” and placed on the examiner’s special docket throughout the entire course of prosecution until a final disposition is reached in the application.
 - A “final disposition” includes the following:
 - mailing of a notice of allowance;
 - mailing of a final Office action;
 - filing of a notice of appeal;
 - completion of examination as defined in regulation;
 - filing of a request for continued examination; and
 - abandonment of the application.
 - Applicant must file a grantable request in compliance with regulatory requirements, including payment of prioritized examination fees.
 - Aims to provide a final disposition within 12 months of prioritized status being granted.

COVID-19 Prioritized Examination Pilot Program

- **Summary:** Prioritized examination of qualifying patent applications covering a product or process related to COVID-19.
 - Applicant must file with a grantable request under the pilot program including a certification that the claim(s) of the patent application cover an invention subject to an applicable FDA approval for COVID-19 use. Examples:
 - Emergency Use Authorization (EUA);
 - New Drug Application (NDA); and
 - Biologics License Application (BLA).
 - Prioritized examination fees waived for small and micro entities.
 - Aims to provide a final disposition within six months of prioritized status being granted if applicants respond within 30 days to a notice from the USPTO.

Accelerated Examination - generally

- **Summary:** Special status granted to eligible patent applications that meet certain requirements. Special status may persist throughout entire course of prosecution until final disposition.
 - Applicant must file a grantable petition to make special complying with the current requirements of the accelerated examination program (for example, examination support document).
 - Petition fee may be charged based on the grounds to make special.
- Aims to provide a final disposition within 12 months of the filing date of the application.

Petitions to make special based on health or age

- **Summary:** Special status granted to applications on the basis of an inventor's health or age.
 - Applicant must file a grantable petition to make special showing that:
 - the state of health of the inventor or joint inventor is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course; or
 - the inventor or joint inventor is 65 years of age, or more.
 - No petition fee.

Patents 4 Patients (Cancer Immunotherapy Pilot Program)

- **Summary:** Special status granted until a final disposition for qualifying patent applications directed to cancer immunotherapy technologies without satisfying all current requirements of the accelerated examination program.
 - Applicant must file a grantable petition to make special under the pilot program, including a certification that the patent application contains at least one claim encompassing a method of ameliorating, treating, or preventing a malignancy in a human subject wherein the steps of the method assist or boost the immune system in eradicating cancerous cells.
 - Petition to make special fee waived.
 - Aims to provide a final disposition within 12 months of special status being granted.

Climate Change Mitigation Pilot Program

- **Summary:** Qualifying patent applications directed to inventions that reduce greenhouse gas emissions are granted special status until first action on the merits without meeting all current requirements of the accelerated examination program.
 - Applicants must file a grantable petition to make special under the pilot program, including certifications:
 - that at least one claim in the patent application covers a product or process that mitigates climate change;
 - that the product or process is designed to reduce greenhouse gas emissions,
 - that they have a good faith belief that expediting examination of the application will likely have a positive impact on the climate, and
 - that the inventor or any joint inventor has not 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.
 - Petition to make special fee waived.

Patent Prosecution Highway (PPH)

- **Summary:** Program for advancing qualifying patent applications out of turn for examination based on the submission of the work product of another participating patent office that made a favorable determination on at least one claim in a corresponding patent application.
 - Applicant must file a grantable petition to make special under the PPH program accompanied by required supporting documents.
 - Applicant must make sure that there is sufficient correspondence between each of the claims before the USPTO and the allowable claim(s) in the corresponding patent application.
 - No petition fee.

Expanded Collaborative Search Pilot (CSP)

- **Summary:** Program allowing applicants who cross-file their patent applications internationally to obtain search results from multiple offices early in the examination process. Qualifying patent applications are granted special status until first action on the merits.
 - Designed to accelerate examination and provide the applicant with more comprehensive prior art by combining the search expertise of examiners at the USPTO and the Japan Patent Office (JPO) or the Korean Intellectual Property Office (KIPO) before issuing a first office action.
 - Before examination commences, applicant must file a grantable petition to make special under the CSP with the USPTO, as well as a request in each designated partner office in accordance with the requirements of that office.
 - No petition fee.

Other expedited programs

U.S. government:

- **Government request:** The USPTO may advance patent applications directed to inventions deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason.

Other expedited programs

Awards:

- **Patents for Humanity Award:**
 - Award recipients receive public recognition and a certificate to accelerate examination, ex parte reexamination, or an ex parte appeal to the Patent Trial and Appeal Board (PTAB).
 - Acceleration certificate is transferable.
 - Categories: medicine; nutrition; sanitation; household energy; & living standards.
 - New category: COVID-19.

Other expedited programs

Appeals:

- **Fast-Track Appeals Pilot:** Ex parte appeals advanced out of turn by the PTAB for an additional fee.
 - Goal of issuing a decision within 6 months of the date a petition is granted and the ex parte appeal is entered into the pilot program.
- **Fast-Track COVID-19 Appeals Pilot:** Companion to the COVID-19 prioritized examination pilot program. Ex parte appeals advanced out of turn by the PTAB without an additional fee.
 - Application must claim a product or process that is subject to an applicable FDA approval for COVID–19 use.
 - Goal of issuing a decision within 6 months of the date a petition is granted and the ex parte appeal is entered into the pilot program.



Thank you!

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