

## Expedited Examination Programs of IP Offices

### United States of America

The United States Patent and Trademark Office (USPTO) currently offers several programs for accelerated examination of patent applications.<sup>1</sup> Expedited examination in the United States of America aims to reduce burdens on examiners, improve prosecution efficiency and provide applicants with the ability to prioritize their filings. The information about each of the accelerated examination programs offered by the USPTO is provided below:<sup>2</sup>

#### *Accelerated Examination (AE)*

Last updated in 2016, the USPTO's Accelerated Examination (AE) program corresponds to the general, non-specific program meant to cover all patent applications that are not otherwise eligible for other expedited examination programs, which are more specific in nature. This program is available at the time of filing a utility or design non-provisional application, with the exception of international applications under the PCT that have entered into the national stage.

*Conditions & Fees:* The following conditions need to be met for an application to be eligible for the Accelerated Examination program:

- (i) The application must be complete.
- (ii) The application must contain three (3) or fewer independent claims and twenty (20) or fewer total claims, and must not contain multiple dependent claims.
- (iii) The claims must be directed to a single invention.
- (iv) The petition must include a statement agreeing to have an interview with the examiner to discuss any outstanding issues arising in the examination process.
- (v) The applicant must provide a statement that a pre-examination search was conducted meeting certain requirements.
- (vi) The applicant must provide an AE support document that satisfies certain requirements.

Applications are accorded "special status" and placed on an examiner's special docket and advanced out of turn for examination, and may continue to be treated as special throughout the entire prosecution until a final disposition. A "final disposition" (any action that closes prosecution) includes the following: (i) mailing of a notice of allowance; (ii) mailing of a final Office action; (iii) filing of a notice of appeal; (iv) completion of examination as defined in regulation; (v) filing of a request for continued examination; and (vi) abandonment of the application.

Application, petition, fees, and replies must be filed electronically *via* the USPTO patent electronic filing system. Fees include ordinary fees and an additional petition fee that may be charged, based on the grounds to make special. A shortened statutory period for reply of two months for Office action other than a notice of allowance applies. Extensions of shortened statutory period are permitted, but filing a petition for an extension of time will result in the application being taken out of the AE program. A "petition to make special" fee will be required if grounds for consideration are other than that the invention will materially enhance the quality of the environment, contribute to the development or conservation of energy resources, or contribute to countering terrorism.

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<sup>1</sup> See the USPTO's website, available at: <https://www.uspto.gov/patents/initiatives/accelerated-examination>.

<sup>2</sup> Not including expedited examination under the PPH available to applicants in the United States of America.

*Reduced Pendency:* The USPTO aims to provide a final decision within twelve months of the filing date of the application.

#### *Track One/Prioritized Examination*

*Objectives & Goals:* To provide applicants with greater control over applications concerning utility and plant patent applications, as well as promote greater efficiency in the patent examination process.

*Grounds/Qualification:* This expedited examination program is offered to original non-provisional utility and plant patent applications filed under 35 U.S.C. 111(a), having no more than four independent claims, thirty claims in total, and no multiple dependent claims at the time the request to participate is reviewed by the Office of Petitions, and filed on or after September 26, 2011. This program is not available for design patent applications.

*Conditions & Fees:* A grantable request for prioritized examination (PE) must be filed: (i) at the time of filing an original utility or plant non-provisional application, or (ii) with or after a compliant request for continued examination (RCE) in a utility or plant application, including an application that has entered the national stage under 35 U.S.C. 371. Granting of prioritization status is limited to a maximum number determined by the USPTO.<sup>3</sup>

The application must include:

- (i) a specification as prescribed by 35 U.S.C. 112, having at least one claim;
- (ii) any required drawings;
- (iii) an executed inventor's oath/declaration under 37 CFR 1.63 or 37 CFR 1.64 for each inventor, or an application data sheet (ADS) meeting 37 CFR 1.53(f)(3)(i); and
- (iv) basic filing fee, search fee, examination fee, and any required excess claims fee or application size fee.

Applications are accorded "special status" and placed on the examiner's special docket throughout its entire course of prosecution until a final disposition is reached in the application.

Utility applications and requests for utility patent applications must be filed electronically via the USPTO Patent Electronic Filing System. Petitioning for an extension of time to file a reply or a request for a suspension of action, or filing an amendment that exceeds program claim limits terminates prioritized examination.

*Reduced Pendency:* The USPTO aims to provide a final disposition within 12 months of the prioritized status being granted.

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<sup>3</sup> According to the presentation made by the Delegation of the United States of America during SCP/34, the limit of requests for prioritized examination being granted was 15,000 at that time.

### *COVID-19 Prioritized Examination Pilot Program*

*Objectives & Goals:* Provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness. Focusing the USPTO's resources on those applicants that may be more resource-constrained because of the pandemic. This is considered to be a version of the Track One program.<sup>4</sup>

*Grounds/Qualification:* This accelerated examination program is intended for patent applications that cover a product or process related to COVID-19. The pilot program is limited to applicants that qualify for either small or micro entity status.

*Conditions & Fees:* The USPTO requires that the patent application complies with the following conditions to be granted prioritized examination status:

- (i) The application must be a non-continuing non-provisional application or a continuing application claiming the benefit of only one prior application which is either a non-provisional application or international application under the PCT designating the United States.
- (ii) The petition to make special must be filed electronically using the USPTO patent electronic filing system.
- (iii) The petition to make special may be filed with an RCE if it is prior to the first action, or at any time prior to final rejection where the claimed cancer immunotherapy is the subject of an Investigative New Drug (IND) application that has entered Phase II or Phase III of FDA clinical trials.
- (iv) The petition to make special must be accompanied by a request for early publication if application is unpublished. If the applicant previously filed a nonpublication request, the applicant must file a rescission thereof no later than the filing date of the petition to make special.
- (v) The request must include certification that the applicant qualifies for small or micro entity status.

The request must also include a certification that the claim(s) of the patent application cover a product or process subject to an applicable FDA approval for COVID-19 use, for example, Investigational New Drug (IND) Application, New Drug Application (NDA), Biologics License Application (BLA), Pre-Market Approval (PMA), Investigational Device Exemption (IDE), and Emergency Use Authorization (EUA).

The request must be accompanied by an Application Data Sheet (ADS), meeting the requirements of 37 CFR 1.53(f)(3)(i). The prioritized examination fee and processing fee are waived.

*Reduced Pendency:* The USPTO aims to be able to provide (on average) a final disposition within twelve months of the prioritized status being granted. A final disposition will be provided

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<sup>4</sup> The USPTO is no longer accepting requests for prioritized examination filed with respect to qualifying patent applications related to COVID-19. Pending petitions will be taken in turn, in the order that the applications are in condition for examination. The USPTO will consider any pending petition with respect to an application that was filed by May 11, 2023. Applicants may instead use the Prioritized Examination (Track One) program or the Accelerated Examination program. Both the Track One and Accelerated Examination programs not only provide advancement of examination, but set a target of reaching final disposition within 12 months from the time advancement is initiated. For more information, see the following website of the USPTO: <https://www.uspto.gov/initiatives/covid-19-prioritized-examination-pilot>.

within six months of the status being granted if the applicant responds within 30 days to notices from the USPTO.

#### *Cancer Moonshot Expedited Examination Pilot Program*

*Objectives & Goals:* To support the National Cancer Moonshot initiative launched on February 1, 2016, which seeks to cut the time it takes to review patent applications pertaining to cancer immunotherapy in half. This program also aims to reduce the cancer mortality rate by at least 50 per cent within 25 years.<sup>5</sup>

*Grounds/Qualification:* This program is intended for patent applications that pertain to the field of oncology (in relation to detecting and treating cancer in general) or smoking cessation. Any applicant can request for special status to be granted under this program.<sup>6</sup> The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a) or an international application under the PCT that has entered the national stage under 35 U.S.C. 371. Concerning the claims, the application must contain no more than three independent claims and no more than 20 total claims, and must not contain any multiple dependent claims.

*Conditions & Fees:* The request to make special must be submitted before a first office action has been issued. The petition to make special may only be made by filing form PTO/SB/465, which must be filed electronically using the USPTO's Patent Center. The following conditions need to be met for an application to be granted accelerated examination status under this program:

- (i) The petition must include a statement that the applicant agrees not to exceed the program claim limits or add any multiple dependent claims throughout the pendency of the application.
- (ii) The petition to make special must include a statement that the application is limited to the field of oncology or smoking cessation and contains at least one method claim that meets the eligibility requirements of the pilot program (which need(s) to be identified within the request).
- (iii) The petition must include a statement that the applicant agrees not to cancel all method claims that meet the eligibility requirements of the pilot program throughout the pendency of the application.
- (iv) The petition must include a statement that if the application contains eligible product or apparatus claims, the eligible method claims depend from or are commensurate in scope with the eligible product or apparatus claims.
- (v) The petition must include a statement that, if a requirement for restriction or unity of invention is made, the applicant will agree to make an election without traverse to an invention that meets the eligibility requirements of the pilot program.
- (vi) The petition must also include a statement that the applicant agrees not to cancel all claims to the elected invention throughout the pendency of the application.

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<sup>5</sup> Information is taken from the 2022 Federal Register notice on the program, available at: <https://www.federalregister.gov/documents/2022/12/09/2022-26776/cancer-moonshot-expedited-examination-pilot-program>. See also the USPTO webpage dedicated to this expedited examination program, at: <https://www.uspto.gov/patents/initiatives/patent-application-initiatives/cancer-moonshot-expedited-examination>.

<sup>6</sup> The program was set to commence on February 1, 2023, and is scheduled to run until either January 31, 2025, or the date by which the USPTO accepts a total of 1,000 grantable petitions, whichever is earlier.

- (vii) The petition must include a statement that the application was not previously granted special status under any program.<sup>7</sup>

If an applicant files the petition to make special on the date of filing of the application, the application may not be filed with a nonpublication request. If the applicant previously filed a nonpublication request in the application, the applicant must file a rescission of the nonpublication request no later than the date the petition to make special is filed.

If the petition is granted, the application will be treated as special on the examiner's docket and will be accorded special status until a first Office action (which may be an Office action containing only a restriction requirement) is issued. After the first Office action is issued, the application will no longer be treated as special during examination.

#### *Petitions to Make Special Based on Age or Health*

**Objectives & Goals:** To ensure prosecution of the patent application in the event that the state of health of the inventor or joint inventor is such that he or she might not be available to assist in prosecution if it were to run its normal course. Additionally, to ensure prosecution of the patent application if the inventor or joint inventor is 65 years of age, or more.

**Conditions & Fees:** The applicant has to make a petition to be granted special status, accompanied by evidence showing that:

- (i) 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, such as a doctor's certificate or other medical certificate; or
- (ii) The inventor or joint inventor is 65 years of age, or more.

For patent applications granted special status in this program, no "petition to make special" fees are required. The USPTO provides the opportunity to file a web-based e-Petition when submitting requests to make special based on the inventor's age. This implies an immediate decision notified to the applicant.

#### *Climate Change Mitigation Pilot Program*

**Objectives & Goals:** This expedited examination program is designed to positively impact the climate by accelerating the examination of patent applications for innovations that reduce greenhouse gas emissions.

**Grounds/Qualification:** Reserved for patent applications that involve technologies that reduce greenhouse gas emissions. To qualify to participate in this program, the underlying application must not claim the benefit of more than one prior non-provisional application. Any applicant can submit the respective petition to be considered under this program.

**Conditions & Fees:** Applicants must use USPTO form PTO/SB/457 which contains the petition and requisite certifications to request participation in this pilot program. The form needs to be filed electronically, using the Patent Center.

Applicant must certify all of the following:

- (i) the claimed invention covers a product or process that mitigates climate change;

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<sup>7</sup> A petition to make special under this pilot program may not be filed in an application in which special status was previously granted under this pilot program or any other program (for example, for reasons of age or health, Patent Prosecution Highway, Accelerated Examination, Prioritized Examination, etc.).

- (ii) the product or process is designed to reduce greenhouse gas emissions;
- (iii) applicant has a good faith belief that expediting patent examination of the application will likely have a positive impact on the climate; and
- (iv) the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other non-provisional applications in which a petition to make special under this program has been filed.

In addition, the petition must be accompanied by an Application Data Sheet (ADS) meeting the requirements of 37 CFR 1.53(f)(3)(i), unless previously filed. The payment of “petition to make special” fees is not required under this program.

Applications are advanced out of turn (special status) for first action on the merits without meeting all of the current requirements of the accelerated examination program. After the first action on the merits, the application will no longer be treated as special during examination. (e.g., will be placed on the examiner’s regular amended docket after an amendment).

#### *Patents for Humanity Award*

*Objectives & Goals:* This program is the USPTO’s awards competition recognizing inventors who have used game-changing technology to meet global humanitarian challenges. Participants compete in select categories, including medicine, nutrition, sanitation, household energy, living standards, green energy and COVID-19.

*Conditions & Fees:* Award recipients receive public recognition and a certificate to accelerate certain procedures before the USPTO. Those procedures include examination, *ex parte* reexamination, and an *ex parte* appeal to the Patent Trial and Appeal Board (PTAB). Winners may transfer the acceleration certificate to third parties.

#### *First-Time Filer Expedited Examination Pilot Program*

*Objectives & Goals:* This program is designed to increase accessibility to the patent system for inventors who are new to the patent application process, including those in historically underserved geographic and economic areas.<sup>8</sup>

*Grounds/Qualification:* Applicant must be a micro entity filing an application for the first time before the USPTO. Application must be a non-continuing, original utility non-provisional application that does not claim the benefit of the filing date of any prior-filed non-provisional U.S. applications or international applications under the PCT designating the United States under 35 U.S.C. 120, 121, 365(c) or 386(c).

*Conditions & Fees:* In order to participate in this program, the applicant must file a petition to make special for a qualifying patent application<sup>9</sup>, by filling out Form PTO/SB/464, *via* the Patent Center, certifying all of the following:

- (i) the inventor or, where there are joint inventors, each joint inventor has not been named as the sole inventor or a joint inventor on any other nonprovisional application.

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<sup>8</sup> Information is taken from the USPTO’s webpage on the “First-Time Filer Expedited Examination Pilot Program”, available at: <https://www.uspto.gov/initiatives/first-time-filer-expedited-examination-program>.

<sup>9</sup> The USPTO will accept petitions to make special under this program until March 11, 2024, or until 1,000 patent applications have been granted special status under this program, whichever occurs earlier. See other restrictions and limitations at the USPTO’s website regarding the program.

- (ii) the applicant and the inventor or, where there are joint inventors, the applicant and each joint inventor qualify for micro entity status under the gross income basis requirement.<sup>10</sup>
- (iii) the inventor or, where there are joint inventors, each joint inventor, named on the application is reasonably trained on the basics of the USPTO's patent application process.

The application must be complete under 37 CFR 1.51, no later than the date the petition to make special under this program is filed. The petition to make special may be filed at a later date, so long as it is filed before the examiner sends a first Office action.

Payment of all appropriate fees is required prior to or concurrently with the filing of the petition to make special under this program. The applicant is not required to pay the fee under 37 CF 1.17(h).

*Statistics:* As of September 5, 2023, 27 applications have been granted special status under this program.

#### *Government Request for Expedited Examination*

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.

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<sup>10</sup> Applicant must separately and properly establish micro entity status by filing USPTO Form SB/15A (Certification of Micro Entity Status – Gross Income Basis) no later than the date that the petition to participate in this pilot is filed.