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.[1] 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:[2]

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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[1] See the USPTO's website, available at: https://www.uspto.gov/patents/initiatives/accelerated-examination.
[2] 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.[3]

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.

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.[4]

Grounds/Qualification: This program is intended for patent applications that pertain to the field

[3] 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.
[4] 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.

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.[5] 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.

(vii) The petition must include a statement that the application was not previously granted special status under any program.[6]

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.

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[5] 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.

[6] 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.).

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.

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.[7]

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[8], 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.

(ii) the applicant and the inventor or, where there are joint inventors, the applicant and

[7] 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.
[8] 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.

each joint inventor qualify for micro entity status under the gross income basis requirement.[9]

(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 particular importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason.

Fast-Track Appeals Pilot Program

Objectives & Goals: The Fast-Track Appeals Pilot Program permits appellants with a docketed *ex parte* appeal before the Patent Trial and Appeal Board (PTAB) to file a petition to expedite the review of the appeal, hastening patentability determinations and the potential for commercialization of products or services embodying those patented inventions. This helps spur follow-on innovation, economic growth, and job creation.

The original Fast-Track Appeals Pilot Program, adopted on a temporary basis on July 2, 2020, has been extended until July 2, 2024. After that date, the USPTO may temporarily or permanently extend the Fast-Track Appeals Pilot Program (with or without modification) or discontinue the program.[10]

Grounds/Qualification: The application must be an original utility, design, or plant nonprovisional application. The Fast-Track Appeals Pilot Program is not available for applications or proceedings that are already treated as special during appeal, such as reissue applications, reexamination proceedings, appeals made special due to the age or health of an applicant, or appeals subject to any other pilot program that advances an appeal out of turn.

Conditions & Fees: The original Pilot Program required, among other things, that appellants filed a petition before July 2, 2021, to be able to participate. The Pilot Program also set a maximum number of 500 appeals that could be advanced through Fast-Track petitions. A First Extension to the Pilot Program required that a petition be filed before July 2, 2022, to participate. The First Extension removed the maximum number of 500 appeals, but it maintained the fee and the maximum number of 125 Fast-Track petitions granted per quarter. With the Pilot Program's extension until July 2, 2024, the PTAB maintained its decision to remove the upper limit of 500 appeals. However, the number of granted petitions in the Fast-Track Appeals Pilot Program remains limited to 125 granted petitions per quarter. If a quarterly limit is reached, the PTAB retains the flexibility to accept additional petitions, either for

[9] 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.
[10] Information is taken from the USPTO's webpage on the "Fast-track appeals pilot program (regular)", available at: https://www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program.

consideration in that quarter or in the next quarter.

The appeal for fast-track status must be an ex parte appeal for which a notice of appeal has been filed and a PTAB docketing notice has been issued by the USPTO (i.e., the appeal is pending before the PTAB). To participate in the program, a petition under 37 CFR 41.3 must be filed. Payment of the petition fee specified in 37 CFR 41.20(a) is also required.

The USPTO has made available Form PTO/SB/451, which can be filled and submitted by the appellant who wishes to participate in the Pilot Program. If the appellant does not use the Form, then they must identify the application and appeal by application number and appeal number, respectively, in any written request submitted to the PTAB.

Reduced Pendency: Currently, the average appeal pendency is about 12 months, down from 15 months in 2020, and 30 months in 2015. The Fast-Track Appeals Pilot Program sets a target of reaching decisions on *ex parte* appeals within six months from the date they enter the program.

Statistics: Since the Pilot Program's inception in July 2020 through March 31, 2023, PTAB has decided 369 fast-track appeals with an average decision time of about 2 months from the date the petition for fast-track review was granted, and about 6 months from the date PTAB received the appeal. Thus, the overall decision time is at least 50% faster than the average appeal time for cases not under fast-track review, which currently stands at about 12 months at the end of calendar year 2022.