

## Prioritized Examination

### Question PE1: What is prioritized examination?

Prioritized examination is a procedure for expedited review of a patent application for an additional fee. The USPTO's goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted. The rule applicable to prioritized examination is 37 C.F.R. § 1.102(e). Prioritized examination of newly filed applications is also known as "Track One" or Track I".

### Question PE2: Who can I contact if I have questions about a decision dismissing my Request for Prioritized Examination or the requirements for Prioritized Examination?

Contact the person who signed the decision dismissing the request if there is a question about the dismissal. In addition, the Office of Petitions may be contacted about a specific decision dismissing a request for prioritized examination at 571-272-3282. General questions about the prioritized examination program can be directed to the Office of Patent Legal Administration at (571) 272-7704 or at [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov).

### Question PE3: Is applicant required to use the USPTO's certification and request form PTO/AIA/424?

It is strongly recommended that applicants use the USPTO's certification and request form PTO/AIA/424 to request prioritized examination, but the form is not required. The form is available on EFS-Web and on the USPTO's Internet Web site at <http://www.uspto.gov/forms/index.jsp>. Failure to use form PTO/AIA/424 could result in the USPTO not recognizing the request or delays in processing the request. If applicant decides to use an applicant-created form for requesting prioritized examination, applicant's form should be an equivalent to the USPTO's form.

### Question PE4: How will I know if the limit of 10,000 granted requests for prioritized examination for the fiscal year has been reached?

The USPTO posts statistics, including the number of granted prioritized examination requests, on its Web site at [http://www.uspto.gov/patents/init\\_events/Track\\_One.jsp](http://www.uspto.gov/patents/init_events/Track_One.jsp). In addition, the USPTO will post a message in EFS-Web if/when the number of granted requests is close to the limit. If the limit is reached, the USPTO will turn off the ability to file a request for prioritized examination in EFS-Web.

### Question PE 5: The prioritized examination fee set forth in 37 CFR 1.17(c) is \$4,000 for a non-small entity and \$2,000 for a small entity. Is there a micro entity fee available for the prioritized examination fee under 37 CFR 1.17(c)?

Yes. The prioritized examination fee for a micro entity is \$1,000.

**Question PE6:** My application has been granted special status under the prioritized examination (Track One) program. Will the application remain in that special status until either issuance or abandonment of the application?

The prioritized examination program grants special status until one of the following occurs:

- i. Applicant files a petition for extension of time to extend the time period for filing a reply.
- ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
- iii. Applicant files a request for continued examination (RCE).
- iv. Applicant files a notice of appeal.
- v. Applicant files a request for suspension of action.
- vi. A notice of allowance is mailed.
- vii. A final Office action is mailed.
- viii. The application is abandoned.
- ix. Examination is completed as defined in 37 CFR 41.102.

**Question PE7:** My application has been granted special status under the prioritized examination program. When can I expect the final disposition of the application?

The goal of the USPTO is to provide a final disposition within twelve months, on average, of the date that prioritized status was granted.

**Question PE8:** I received a decision dismissing my request for prioritized examination. Can I file a petition if I think the decision is not proper?

Applicant can file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing the request for prioritized examination is not proper. Applicant should review the reason(s) stated in the decision dismissing the request and make a determination that an error was made by the USPTO in not granting the request before filing such a petition under 37 CFR 1.181.

**Question PE9:** May I file a petition for extension of time to extend the time period for filing a reply to an Office action?

While a petition for extension of time will be acted upon as per MPEP 710.02, if applicant files such a petition for an extension of time to file a reply or a request for a suspension of action, the prioritized examination of the application will be terminated.

**Question PE11:** How do I file a Request for Prioritized Examination for utility applications via EFS-Web?

A quick start guide that details the process for filing such requests via EFS-Web is available on the USPTO web site at [http://www.uspto.gov/patents/init\\_events/track-1-quickstart-guide.pdf](http://www.uspto.gov/patents/init_events/track-1-quickstart-guide.pdf). If you have any questions or concerns regarding filing in EFS-Web, please contact the Patent EBC Monday - Friday, from 6:00 a.m. to 12 Midnight Eastern Time, by email at [ebc@uspto.gov](mailto:ebc@uspto.gov), or by telephone at 866-217-9197.

## **Prioritized Examination Track One (for original application filings)**

**Question PE-Track One\_2:** What types of applications are eligible for prioritized examination (Track One)? May I file a request for prioritized examination (Track One) in a continuing application?

Original nonprovisional utility and plant patent applications filed under 35 U.S.C. 111(a), having no more than 4 independent claims, 30 total claims, and no multiple dependent claims, and filed on or after September 26, 2011, are eligible for prioritized examination (Track One). The term "original application" includes both first filings and continuing applications; see MPEP 201.04(a). Thus, continuation, continuation-in-part, and divisional applications are eligible for prioritized examination, but reissue applications are not.

**Question PE-Track One\_3:** How may I file a Request for Prioritized Examination?

Requests for Prioritized Examination of utility patent applications must be filed using EFS-Web. Requests for Prioritized Examination of plant patent applications must be filed in paper. The Request for Prioritized Examination must be present on filing of the utility or plant application.

**Question PE-Track One\_4:** What fees are required upon filing a Request for Prioritized Examination (Track One)? What happens if one of the required fees is not present upon filing?

Consult the current fee schedule, available at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>, for the correct fee amounts. The fees required to be paid upon filing for Prioritized Examination are:

- i. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c).
- ii. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m).
- iii. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q).
- iv. Publication fee, as set forth in 37 CFR 1.18(d). However, since this fee is currently set to \$0, no publication fee is due at this time for a request for prioritized examination. The prioritized examination rule still contains the publication fee as a requirement in the event that changes to the publication fee are made in the future.
- v. Prioritized Examination processing fee, as set forth in 37 CFR 1.17(i)(1).
- vi. Prioritized examination fee of \$4000.00 (\$2000.00 for small entities, or \$1000.00 for micro entities).

If any of the above fees are unpaid at the time of filing of the application, the Request for Prioritized Examination will be dismissed. However, if an explicit authorization to charge any of the missing fees has been provided in the papers accompanying the application and the request, those fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees. It is recommended that applicant

include an authorization to charge any additional fees under 37 CFR §§ 1.16 and 1.17 to ensure that a Track One request is not dismissed for failure to pay the required fees.

**Question PE-Track One\_5:** I have an international application pending. Is there any way that I can file a U.S. application based on that international application and have the U.S. application be eligible for prioritized examination (Track One)?

Yes. An applicant may file a U.S. application under 35 U.S.C. 111(a), and in that application, claim the benefit of the earlier international application under 35 U.S.C. 365(c), or claim the right of priority of the earlier international application under 35 U.S.C. 365(a), subject to the conditions of 35 U.S.C. 365. Such an application is eligible for prioritized examination. However, an applicant may not request prioritized examination (Track One) of a national stage application (submitted under 35 U.S.C. 371) of an international application.

**Question PE-Track One\_6:** I have a foreign application pending. Is there any way that I can file a U.S. application that claims priority to the foreign application under 35 U.S.C. 119(a)-(d) or (f), and have the U.S. application be eligible for prioritized examination (Track One)?

Yes. Any original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) and claiming priority to a foreign application under 35 U.S.C. 119(a)-(d) or (f) is eligible for prioritized examination.

**Question PE-Track One\_7:** I am filing an application, but one of the joint inventors has refused to execute an oath or declaration. I have prepared a substitute statement for that joint inventor. Can I request prioritized examination (Track One) for this application?

Yes; however, either (1) the substitute statement and the declaration(s) from the other joint inventor(s) or (2) a signed ADS that provides each inventor's legal name, mailing address, and residence (if the inventor does not reside at the mailing address), must be submitted on the date the application is filed. If the signed ADS is not present upon filing, or the substitute statement is defective for any reason, prioritized examination status will not be granted. For guidance in filing a substitute statement, see Examples 2 and 4 in "[Inventor's Oath or Declaration Examples Featuring 'Best Practices' in Use of Inventor's Oath or Declaration Forms.](#)"

**Question PE-Track One\_8:** Can I file an application under 35 U.S.C. 111(a) with a nonpublication request and a request for prioritized examination (Track One)?

Yes. Although the publication fee set forth in 37 CFR 1.18(d) is required by the rule, this fee currently is \$0, so no fee is due. However, if the fee is set to a different amount in the future, that fee amount must be submitted with the request for prioritized examination (along with the other required fees), even though nonpublication is being requested.

**Question PE-Track One\_9:** I filed a U.S. application under 35 U.S.C. 111(a) and claimed the benefit of an earlier international application under 35 U.S.C. 365(c) (a by-pass continuation). Is it necessary that the earlier international application have been filed in English in order to request prioritized examination of the 111(a) application?

No. However, a translation is required in accordance with 37 CFR 1.52(b)(1).

**Question PE-Track One\_11:** I just filed my utility application and the form for the request for prioritized examination (Track One) through EFS-Web, but I inadvertently omitted an item. Can I supplement my original EFS-Web filing with a follow-on submission that supplies the missing item?

Yes, but only if the follow-on EFS-Web submission is submitted on the same day that the utility application and the prioritized examination request form are filed. For example, if the filing fees are inadvertently omitted when the application is filed via EFS-Web, then applicant may submit the filing fees as a follow-on submission directly into the application **on the same day** as the filing date of the application. Applicants are also reminded that only registered users of EFS-Web can submit follow-on documents via EFS-Web and that follow-on documents are documents filed after the initial submission of the application. Thus, applicant would need to be a registered user of EFS-Web to submit such a follow-on document on the same day the application was filed. See also MPEP 502.05, III, D. for examples describing implications raised when applicant inadvertently omits an item when filing an application electronically via EFS-Web.

**Question PE-Track One\_12:** I received a pre-examination notice from the Office of Patent Application Processing that identifies missing items or informalities in my original application filing. When will I receive a decision on my request for prioritized examination? Will my request for prioritized examination (Track One) be dismissed? Can I file an extension of time to respond to the notice?

Requests for prioritized examination will be acted upon once the application has met all formal requirements such that it is ready for examination. A description of what it means for an application to be in condition for examination is provided at MPEP 708.02, subsection VIII.C. Any pre-examination notice from the Office of Patent Application Processing will delay a decision on the request for prioritized examination until after applicant has filed a complete and timely reply to the pre-examination notice.

A proper request for prioritized examination requires that the application include a specification as prescribed by 35 U.S.C. 112 including claim(s), any required drawings. The application must also include either an executed inventor's oath or declaration under 37 CFR 1.63 or 1.64 for each inventor, or a signed ADS that provides the legal name, mailing address, and residence (if not residing at the mailing address) for each inventor. The application must also include the filing, search, and examination fees, and the prioritized examination fee and the processing fee. Failure to submit these required items on the date of filing will cause the request to be dismissed.

Applicants may, however, receive a notice regarding informalities in their application (e.g., a notice to file corrected application papers because the application papers are not in compliance with 37 CFR 1.52, or an English-language specification, or a notice requiring an excess claims fee) that results in the application not being in condition for examination. These other informalities or deficiencies in the application will delay a decision on the request for prioritized examination, but will not cause the request to be dismissed.

Any request for an extension of time, including an extension of time for the purpose of responding to a pre-examination notice (e.g., Notice to File Missing Parts), will cause the application to be ineligible for further treatment under the prioritized examination (Track One) program. A request for an extension of time prior to the grant of prioritized examination status will prevent such status from being granted.

**Question PE-Track One\_13:** If I file a preliminary amendment in an application that includes a request for prioritized examination (Track One), will that cause a pending request to be dismissed? Will it cause termination of the special status under prioritized examination if the request has already been granted?

A preliminary amendment filed in an application that includes a request for prioritized examination will not result in dismissal of a pending request, or termination of special status if a request has already been granted, so long as the preliminary amendment does not cause the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.

**Question PE-Track One\_14:** If I file an information disclosure statement (IDS) in an application that includes a request for prioritized examination (Track One), will that cause a pending request to be dismissed? Will it cause termination of the special status under prioritized examination if the request has already been granted?

An information disclosure statement (IDS) filed in an application that includes a request for prioritized examination will not result in dismissal of a pending request, or termination of special status if a request has already been granted.

**Question PE-Track One\_15:** My request for prioritized examination (Track One) was dismissed. What fees can be refunded?

Only the Track One prioritized examination fee, set forth in 37 CFR 1.17(c), will be refunded upon the dismissal of the original request for prioritized examination. This fee will be refunded automatically (if paid) without the need for applicant to request such a refund. The Track One processing fee, set forth in 37 CFR 1.17(i), will be retained to cover the cost of processing the request. In accordance with 37 CFR 1.26, the application fees, including the basic filing fee, search fee, examination fee, and any required application size or excess claim fees cannot be refunded. Applicant may, however, request a refund of the search fee and any excess claims fees by filing a petition for express abandonment of the application in accordance with 37 CFR 1.138(d). Furthermore, applicant may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).

**Question PE-RCE2:** For what type of applications, and in which circumstances, may I request prioritized examination when filing an RCE?

Original nonprovisional utility and plant patent applications filed under 35 U.S.C. 111, or having entered the national stage under 35 U.S.C. 371, in which a proper request for continued examination (RCE) has been filed, or is concurrently being filed, are eligible for prioritized examination. A proper RCE can only be filed if prosecution in the application is closed (e.g., the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application). See 37 CFR 1.114(b). A Request for Prioritized Examination must be made before an Office action responsive to the RCE has been mailed. The application must contain, or be amended to contain, no more than 4 independent claims, 30 total claims, and no multiple dependent claims. Requests for Prioritized Examination of utility patent applications must be filed using EFS-Web. Requests for Prioritized Examination of plant patent applications must be filed in paper.

**Question PE-RCE3:** When may I file a Request for Prioritized Examination in a case in which a request for continued examination has been or will be filed?

The Request for Prioritized Examination must be filed prior to the mailing of a first Office action after the filing of a request for continued examination, and either be filed concurrently with, or subsequently to, the filing of a request for continued examination.

**Question PE-RCE5:** What fees are required upon filing a Request for Prioritized Examination in a request for continued examination (RCE)? What happens if one of the required fees is not present upon filing?

Consult the current fee schedule available at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp> for the correct fee amounts. The fees required to be paid upon filing for Prioritized Examination for requests for continued examination are:

- i. If not previously paid, the applicable publication fee as set forth in 37 CFR 1.18(d). However, since this fee is currently set to \$0, no publication fee is due at this time for a request for prioritized examination for continued examination (RCE). The prioritized examination rule still contains the publication fee as a requirement in the event that changes to the publication fee are made in the future.
- ii. Prioritized examination processing fee, as set forth in 37 CFR 1.17(i)(1).
- iii. Prioritized examination fee set forth in 37 CFR 1.17(c) (\$4000.00, or \$2000.00 for small entities, or \$1000.00 for micro entities).

If any fee is unpaid at the time of filing of the request for prioritized examination, the request for prioritized examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

**Question PE-RCE6:** Is prioritized examination now available for applications that were filed as a national stage entry under 35 U.S.C. 371?

Upon filing a proper request for continued examination (which requires prosecution in the application to be closed), prioritized examination becomes available for an application filed as a national stage entry under 35 U.S.C. 371.

**Question PE-RCE7:** Is there a separate limit of 10,000 granted requests for prioritized examination for the fiscal year for RCE filings?

No, the 10,000 limit applies to the sum of all granted requests for prioritized examination, including both Track One and prioritized examination for RCE requests.

**Question PE-RCE8:** My application has previously been granted special status under the prioritized examination (Track One) program. I am now filing an RCE for that application. May I file a request for prioritized examination with that RCE filing?

Yes. The prioritized examination program permits a single request to be granted upon filing a new application under 35 U.S.C. 111(a), and a single request to be granted upon filing a request for continued examination under 37 CFR 1.114.

**Question PE-RCE9:** My application has previously been granted special status under the prioritized examination (RCE) program. I am now filing a second RCE for that application. May I file a request for prioritized examination with that second RCE filing?

No. The prioritized examination program permits only a single request to be granted associated with a request for continued examination under 37 C.F.R. 1.114 in that application.

**Question PE-RCE10:** I received a decision dismissing my request for prioritized examination for a request for continued examination. May I file a petition if I think the decision is not proper? May I file a second request for prioritized examination?

Applicant may file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing the request for prioritized examination is not proper. Applicant should review the reason(s) stated in the decision dismissing the request and make a determination that an error was made by the USPTO in not granting the request before filing such a petition under 37 CFR 1.181.

Alternately, applicant may file a new request for prioritized examination for that same request for continued examination. The new request must include the proper fees and be timely; *i.e.*, be filed prior to the mailing of a first Office action after the filing of the request for continued examination.

**Question PE-RCE11:** My request for prioritized examination was dismissed. What fees can be refunded?

Only the Track One prioritized examination fee, set forth in 37 CFR 1.17(c), will be refunded upon the dismissal of the original request for prioritized examination. This fee will be refunded automatically (if paid) without the need for applicant to request such a refund. The Track One processing fee, set forth in 37 CFR 1.17(i)(1), will be retained to cover the cost of processing the request. Applicant may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).