The Patent Process: Get on the Fast Track

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One of the biggest frustrations for patent applicants is the incredibly slow pace at which an application proceeds from filing to receipt of a substantive examination report to allowance. On average it takes 15.7 months for a patent application to receive even a first substantive examination report, though there is significant variability across technology areas. The Patent Office has recognized this problem and implemented several initiatives which attempt to address the problem from different angles. Two programs in particular have gained traction: the Patent Prosecution Highway (PPH) and Track One Prioritized Examination.

The PPH, for which there is no fee, leverages the positive results of examination in one participating jurisdiction to jump start examination of corresponding claims in another participating jurisdiction. Upon receiving an indication of allowability of at least one claim in a first country (for example, Canada, perhaps under their expedited examination program), an applicant may request fast track examination of corresponding claim(s) in a corresponding patent application pending in a second country (e.g., the US). Notably an applicant can capitalize on an indication that a claim meets the requirements for novelty and inventive step even at the PCT stage as the requisite "first country" as long as the examining authority is one of the participating countries. Due to the popularity of this program, there has been a recent backlog in the US in determining that an application qualifies for participation in the program, though the PTO has devoted resources to this problem in an effort to reduce the time to decision to 2-3 months. Once an application has been accepted into the PPH program, a first substantive examination report is typically issued in about half the time it would normally take (7.5 months in PPH applications vs. 15.7 months for non-PPH applications), and that first report is an allowance about 20% of the time (compared with 14% in non-PPH cases). Overall PPH applications have a higher allowance rate than non-PPH cases (84% vs. 68%), owing to the fact that the claims presented have a greater likelihood of novelty and inventive step due to the prior examination in the first country. For those seeking a cost-effective approach and who are willing to conform their claims to the allowed claims of another jurisdiction, the PPH may be a viable option.

The Track One program, on the other hand, requires no connection to another application and does not place limitations on the claims which can be presented (aside from limiting each application to 4 independent claims and 30 total claims). Under the Track One program the goal is to move an application from grant of a petition requesting entry into the program to final disposition within twelve months. The fee for the Track One program is substantial ($4000 for a large entity, $2000 for a small) and is required in addition to all the regular filing and examination fees. Upon grant of a petition to enter the Track One program, which must be made at filing or upon filing a Request for Continued Examination (RCE), the average time to first substantive examination report is 2.1 months. Moreover, the average pendency of the application from entry into the program to final disposition is 6.5 months. One trap for the unwary, however, is that final disposition includes not only Notice of Allowance, but also Notice of Abandonment and Final Rejection. Thus the primary value for the Track One program is in obtaining a first examination report quickly and subsequently achieving a fast response to the

arguments and amendments an applicant may submit in response. Thereafter the benefits end, and the application reverts to the normal timeline. This head start can often be considerable, however, particularly in technology areas in which the time to first substantive examination is measured in years. The Track One program presents a faster, albeit more expensive, option for expediting examination.

To learn more about which program is best suited to get your patent application on the fast track, please contact **Lisa M. Warren**.