



Patent Reform Update Prioritized Patent Examination

As part of the America Invents Act, the U.S. PTO has implemented a new Prioritized Examination procedure. Prioritized Examination was made available this week for original U.S. utility or plant applications and provides for expedited review of a patent application for an additional fee. The PTO's goal for Prioritized Examination is to provide final disposition of a patent application (e.g., allowance or final rejection) within 12 months of prioritized status being granted to the application.

Unlike the Accelerated Examination program with which you may already be familiar, final disposition of the case within 12 months is achieved without requiring an extensive prior art search by the Applicant, and without the need for the Applicant to provide a written analysis of the most relevant references. However, the PTO will require payment of an additional prioritized examination fee of \$4,800.00 (\$2,400.00 for small entities) and processing fee (\$130) to be paid at the time of filing, in addition to full payment of the customary filing, search, examination, publication, application size, and excess claim fees. The number of claims for applications entering the program is limited to 30 total claims, of which up to four may be independent. Additionally, all documents necessary to complete the utility application filing (e.g., executed declaration) must also be submitted with the initial filing. PCT nationalizations are not eligible for the program.

We expect the Prioritized Examination program to be popular. The PTO is expected to limit the number of applications accepted into the program to 10,000 per fiscal year. An additional reason the program may be popular is that any patent granted prior to September 16, 2012, will not be subject to the PTO's new Post Grant Review program, under which third parties will be able to challenge the validity of a patent on any grounds.

If you would like us to evaluate your patent applications in process, to make a preliminary determination of which may benefit from the Prioritized Examination program, or if you would like to discuss any aspect of this new PTO program, please let us know.

Our Patent Law Group

As patent laws and the rights of patent holders and applicants continue to evolve as a result of court decisions and legislative initiatives, the protection and exploitation of this valuable intellectual property remains more important than ever to companies of all types. Our Patent Law Group represents clients in all of their patent needs, from litigation and dispute resolution to patent applications and contested patent office proceedings to transactions and strategic counseling, allowing them to maximize revenue, market position and shareholder value while retaining and growing their core assets.

For more information please contact Joseph Capraro, Kristin Neuman, or any other member of Proskauer's IP Practice Group:

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