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TRACK ONE – PRIORITIZED EXAMINATION MADE SIMPLE

by Justin White

One of the biggest complaints in modern times about the United States Patent and Trademark Office (USPTO) is the lengthy amount of time that it takes to obtain a patent after a patent application is first submitted. Much of this time is often attributable to the huge backlog of pending applications in the USPTO, which results in significant delays from the time that a patent application is filed until that application is first picked up for substantive examination. This “first office action pendency” time currently averages over a year-and-one-half,¹ and has been known to take over five years or more in some cases. Overall, the pendency time is currently averaging about 28 months² to arrive at a final disposition of a given application.³

Patent applications are typically sent to various technology “art units,” and are then picked up for examination in order by their filing dates. As such, the foregoing averages can vary significantly depending upon the technology that is being patented. There have been ways in the past to avoid this lengthy first-come-first-served queuing process, such as by Petitions to Make Special and the like. These programs, however, have typically required special circumstances, extra burdens of proof, and extra hassle for applicants to have their applications taken up ahead of others that are already in line. This same system has applied to everyone, and it has thus been traditionally frustrating for those applicants who are really wanting and motivated to acquire patents sooner on their significant innovations.

Enter the Track One option. Introduced by the USPTO on September 26, 2011, the Prioritized Patent Examination Program (i.e., “Track One”) effectively allows any applicant simply to elect an option to have his or her application advanced for examination out of turn – for a fee.⁴ Currently, the Track One processing fee is \$4000 for a large entity, \$2000 for a small entity, and \$1000 for a micro entity.⁵ There are also several other requirements in order to enter an application into the Track One program. Present Track One requirements include that the application have no more than four independent claims, no more than thirty total claims, and no multiple dependent claims at all. In addition, the application must be an original application filing, electronically by EFS-Web, and include all inventor declaration(s) (or oath(s)) at the time of filing. All fees (including the Track One fee) must be paid at the time of filing, and the election for Track One status must be made at the time of filing as well. Furthermore,

¹ <http://www.uspto.gov/dashboards/patents/kpis/kpiOverallPendency/main.dashxml>

² Id.

³ Final Dispositions can include Notices of Allowance, Final Rejections, and Notices of Abandonment

⁴ http://www.uspto.gov/patents/init_events/Track_One.jsp

⁵ http://www.uspto.gov/patents/init_events/track1_FAQS.jsp

any extension of time taken by the applicant, or any amendment that places the claims outside of the prescribed limits, will automatically eject the application from the Track One program.⁶

This Track One program can also be elected for any application at a Request for Continued Examination (“RCE”) stage of prosecution – again for the same Track One fee and adherence to similarly simple rules. This Track One election upon RCE can be made at the time of RCE filing or up until a first office action is issued after the RCE is filed. A Track One election upon RCE can be made only once per application (i.e., not for another RCE after one has already been elected), and can be made independently of whether Track One status was elected upon the original filing of the application.⁷

In return, a Track One application is taken up out of turn, and it is a stated goal (not requirement) of the USPTO that a final disposition of the application be reached within 12 months from the date of filing.⁸

And it works! I personally filed five applications that were granted Track One status in the past year, and plan to file many more in this manner. Of the five that I filed, one issued as a patent in less than 7 months, another was indicated as having allowable subject matter (in the first office action) in less than 5 months, and another received a notice of allowance within 9 months. The others were recently filed and have not received a first office action yet. Outside of my own personal experience, the average pendency from a Track One petition grant to a first office action is currently 2.1 months, while the average pendency from a petition grant to a final disposition is currently 6.3 months.⁹

There is thus the ability (at least for now¹⁰) to avoid the huge USPTO application backlog and have a patent application advanced out of turn in exchange for an added fee and adherence to a few extra rules that are not overly burdensome. Given the early success of Track One, it is worthwhile for any patent applicant or practitioner to consider the possibility of using this prioritized examination option when a new patent application or RCE is filed. In addition to getting patents examined and issued faster, other benefits might include an overall cheaper cost of prosecution due to fewer office actions, a more streamlined prosecution resulting in less prosecution history estoppel, and the ability to “lay claim” sooner and faster onto the products of competitors.

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⁶ Id.

⁷ Id.

⁸ Id.

⁹ <http://www.uspto.gov/dashboards/patents/kpis/kpiOverallPendency/main.dashxml>

¹⁰ The Track One program limits entries to 10,000 total per year, a limit that has not been reached in any year – yet.