

Prioritized Examination: A Fast Track to Patent Protection

When It Comes to Your Patent Protection, Time Is Running Out.

In general, the maximum term of protection for an invention in the U.S. under a utility patent is 20 years less than the period of patent pendency.[1] This term begins to run on the day the patent issues and ends 20 years after the day that a first non-provisional application for an invention is filed (this date is called the *earliest effective filing date*).[2] Thus, the patent term continues to run even as the patent application is under examination. According to [data](#) provided by the U.S. Patent and Trademark Office (USPTO), as of May 2020, patent applicants must wait an average of 15.9 months from filing to receive a first Office action and 23.1 months from filing to receive an issued patent. This delay is due, in large part, to the large backlog of unexamined patent applications at the USPTO. As a result, by the time the average patent is received, nearly 10% of its term is already gone. What if we could do better?

Enter “Track One” Prioritized Examination.

What is Track One?

Introduced with the America Invents Act (AIA) in 2011, the Track One prioritized patent examination program expedites the examination of utility patent applications. The goal of this program is to provide a “final disposition” of an application (e.g., a final Office action or a notice of allowance is mailed) within 12 months of Track One status being granted. However, in many cases, applications are examined much more quickly than even that stated goal. For example, we recently filed an application on March 19, 2020, and received a notice of allowance just 46 days after filing the application on May 4, 2020.

How Do I Get Track One Status?

Track One status is not guaranteed. The AIA initially authorized up to 10,000 applications per fiscal year to be approved for Track One status. Effective September 3, 2019, this number has been increased to 12,000 applications per fiscal year. Among other requirements, applying for Track One status requires the applicant to file a request form with the USPTO and to pay a fee (\$4,000 for large entities, \$2,000 for small entities, and \$1,000 for micro entities). According to the [USPTO](#), decisions on Track One requests are provided, on average, after just 37 days and are overwhelmingly positive with 95% of the requests being granted.

Why Should I Use Track One?

Track One examination significantly reduces the delay between filing and examination, and can result in a patent being issued months or years sooner than it ordinarily would have been. Patent rights are only enforceable against third parties after the patent issues. So, the obvious benefit of a speedier issuance is that those rights are enforceable sooner and for a longer period of time. Anecdotally, we have also found examiners assigned to Track One applications to be very helpful in working with patent counsel to identify the patentable subject matter and to ensure compact (i.e., fast) prosecution of patent applications, which has resulted in lower overall prosecution costs for those patent applications.

A quick allowance can also help patent applicants to determine whether and where to file patent applications internationally. Under various multi-national agreements, once a patent applicant has filed a first patent application in one member country, they have up to one year to file subsequent corresponding foreign patent applications in other member countries that claim the right of priority back to the first-filed application. By claiming this right of priority, those subsequent patent applications are treated as if they were filed on the same date as the earlier first-filed patent application. If that first-filed application is a Track One non-provisional patent application filed with the USPTO, the outcome of that examination might serve as a preview of what might result if other corresponding applications are filed in foreign countries. If the U.S. application is finally rejected, patent applicants might save costs and forego international filings. However, if a U.S. patent application is approved and the patent is issued within one year from filing, patent applicants may be more inclined to seek foreign patent protection.

Furthermore, if a patent applicant decides to file foreign patent applications based on a positive outcome in the U.S., the examination of those applications may also be expedited and streamlined via Patent Prosecution Highway (PPH) initiatives that certain patent offices around the world have implemented. Under these PPH initiatives, participating patent offices around the world benefit from the work previously performed by another participating office, such as prior art searches and analyses, in order to reduce the examination workload and to improve overall patent consistency and quality. Patent applicants that receive a favorable ruling on their patent claims in one country often receive similar treatment in foreign countries under those countries' PPH initiatives. Therefore, pairing Track One examination in the U.S. with examination under PPH initiatives in foreign countries could be a one-two punch leading to broad, fast, and less costly patent protection in the U.S. and abroad.

If you have any questions or concerns regarding whether your invention is appropriate for this program, please contact [Stephen Adams](#) or a member of our [Intellectual Property section](#).

[1] – The term of patent protection may be extended (e.g., by a patent term adjustment or patent term extension) or reduced (e.g., by a terminal disclaimer) under certain circumstances that are outside the scope of this article. The full term of a patent also requires the payment of periodic maintenance fees. Also, note that the non-extendable term of a design patent is 15 years.

[2] – The term for any related patent applications (e.g., continuation or divisional applications) also begins on the earliest effective filing date of the earliest-filed patent application.

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