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Trademark Acceleration

While the USPTO normally processes applications in the order in which they are received, there are two procedures whereby an application can be made “special,” so that initial examination will be expedited.

**TMEP 702.02 “Special” Applications**

Request to Make Special - Registration Inadvertently Cancelled Under 15 U.S.C. §1058, §1059, or §1141k. A new application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired under 15 U.S.C. §1058, §1059, or §1141k will be made “special” upon the request of the applicant if the applicant is the prior registrant or the assignee of the prior registrant. No petition fee is required in this situation. However, *the mark in the new application must be identical to the mark in the cancelled or expired registration, and the goods/services in the new application must be identical to or narrower than the goods/services in the cancelled or expired registration.*

**Post-Registration Timeline:**

- **Mark Registers**
  - 5-6 years
  - 6m grace period w/ $100 fee

- **§8 declaration**
  - Every 10 years
  - 6m grace period w/ $200 fee

- **Combined §8 declaration and §9 renewal**

A request to make an application special because a registration was inadvertently cancelled is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. The applicant should first file the application via the Trademark Electronic Application System (“TEAS”). The applicant should then submit a request to make special that includes the newly assigned serial number and the number of the cancelled registration. To ensure proper routing and processing, the Office prefers that the request also be filed electronically. In TEAS, the Request to Make Special form can be accessed at [http://www.uspto.gov](http://www.uspto.gov).

If it is not possible to file the request electronically, it should be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy at the following fax number: 571-273-0032.
If the request is submitted by mail, it should be submitted separately from the application, marked to the attention of the Deputy Commissioner for Trademark Examination Policy.

_Petition to Make Special._ A petition to make “special” is a request to the Director under 37 C.F.R. §2.146 to advance the initial examination of an application out of its regular order. See _TMEP §§1710 et seq._ regarding the petition requirements and filing procedure.

The examining attorney should promptly examine any application that has been made “special.”

**Accelerating the Trademark Application**

**TMEP 1710 Petition to Make Special**

The USPTO generally examines applications in the order in which they are received. A petition to make “special” is a request to advance the initial examination of an application out of its regular order.

A petition to make “special” must be accompanied by: (1) the fee required by 37 C.F.R. §2.6; (2) an explanation of why special action is requested; and (3) a statement of facts that shows that special action is justified. The statement of facts should be supported by an affidavit or declaration under 37 C.F.R. §2.20.

The petition is reviewed in the Office of the Deputy Commissioner for Trademark Examination Policy. The applicant should first file the application via the Trademark Electronic Application System (“TEAS”) at [http://www.uspto.gov](http://www.uspto.gov). The applicant should then submit a petition to make special that includes the newly assigned serial number. To ensure proper routing and processing, the Office prefers that the petition also be filed electronically. In TEAS, the Petition to Make Special form can be accessed by clicking on the link entitled “Petition Forms.”

Alternatively, the petition should be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy at the following fax number: 571-273-0032. If the petition is submitted by mail, it should be submitted separately from the application, marked to the attention of the Deputy Commissioner for Trademark Examination Policy.

An application for registration of a mark that was the subject of a previous registration that was inadvertently cancelled or expired will be made “special” upon applicant’s request. No petition is required in this situation. See _TMEP §702.02_ regarding the requirements and filing procedure for a Request to Make Special.

**1710.01 Basis for Granting or Denying Petition**

Invoking supervisory authority under 37 C.F.R. §2.146 to make an application “special” is an extraordinary remedy that is granted only when very special circumstances exist, such as a demonstrable possibility of the loss of substantial rights. A petition to make “special” is denied when the circumstances would apply equally to a large number of other applicants.
The fact that the applicant is about to embark on an advertising campaign is not considered a circumstance that justifies advancement of an application out of the normal order of examination, because this situation applies to a substantial number of applicants.

The most common reasons for granting petitions to make “special” are the existence of actual or threatened infringement, pending litigation, or the need for a registration as a basis for securing a foreign registration.

1710.02 Processing Petition

Each petition to make “special,” together with the petition decision, is made part of the record. If the petition is granted, the prosecution history of the application in the Trademark Reporting and Monitoring (“TRAM”) System will reflect that the petition for “special” handling has been granted.
Patent Application Acceleration

Acceleration based on Age
MPEP 708.02 (IV)

An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as ** applicant’s statement >or a statement from a registered practitioner that he or she has evidence that the applicant is 65 years of age or older<. No fee is required with such a petition. See 37 CFR 1.102(c).

Personal/medical information submitted as evidence to support the petition will be available to the public if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14. If applicant does not wish to have this information become part of the application file record, the information must be submitted pursuant to MPEP § 724.02.
Acceleration based on Health
MPEP 708.02 (III)

An application may be made special upon a petition by applicant accompanied by any evidence showing that the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor’s certificate or other medical certificate. No fee is required for such a petition. See 37 CFR 1.102(c).

Personal/medical information submitted as evidence to support the petition will be available to the public if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14. If applicant does not wish to have this information become part of the application file record, the information must be submitted pursuant to MPEP § 724.02.
Track I Prioritized Examination:

RCE Applicability: Changes To Implement the Prioritized Examination for Requests for Continued Examination (Final Rule)
Federal Register Volume 76, Number 243 (Monday, December 19, 2011)¹

SUMMARY: The Leahy-Smith America Invents Act includes provisions for prioritized examination of patent applications. The United States Patent and Trademark Office (Office) implemented the Leahy-Smith America Invents Act prioritized examination provision following the prioritized examination track (Track I) of the proposed 3-Track examination process in a previous final rule. The final rule was made applicable to newly filed patent applications. In order to provide patent applicants with the flexibility to accelerate processing of their applications in which a request for continued examination has been filed, the Office is now permitting applicants to request prioritized examination for applications after the filing of a request for continued examination.

DATES: Effective Date: The changes in this final rule are effective on December 19, 2011. Applicability Date: The changes in this final rule are applicable to any patent application in which a proper request for continued examination has been filed before, on, or after December 19, 2011.

SUPPLEMENTARY INFORMATION: Under the procedure set forth in this final rule, once the application is accorded special status after the filing of a request for continued examination it will be placed on the examiner’s special docket throughout its entire course of continued prosecution before the examiner until a final disposition is reached in the application. The goal for handling applications under prioritized examination for request for continued examination is to, on average, provide a final disposition within twelve months of prioritized status being granted. For purposes of the twelve-month goal, “final disposition” can be any of the following: (1) Mailing of a notice of allowance; (2) mailing of a final Office action; (3) filing of a notice of appeal; (4) completion of examination as defined in 37 CFR 41.102; (5) filing of a subsequent request for continued examination; or (6) abandonment of the application. An application under prioritized examination, however, would not be accorded special status throughout its entire course of appeal or interference before the BPAI, or after the filing of a subsequent request for continued examination. Filing an amendment to the application which results in more than four independent claims, more than thirty total claims, or a multiple dependent claim will terminate the prioritized examination. Upon termination of prioritized examination, the application will be removed from the examiner’s special docket and placed on the examiner’s regular docket in accordance with its stage of prosecution. As the termination of prioritized examination does not cause the prioritized examination fee to have been paid by mistake or in an amount in excess of that required, the termination of prioritized examination will not entitle the applicant to a refund of the prioritized examination fee. See [[Page 78567]] 35 U.S.C. 42(d) and Sec. 1.26(a) (permits refunds only for fees “paid by mistake or any amount paid in excess of that required”). As discussed previously, the

¹ Modified to reduct some non-substantive, administrative content.
submission of an amendment resulting in more than four independent claims or more than thirty total claims is not prohibited, but simply terminates the prioritized examination. Thus, upon mailing of a final rejection (at which point prioritized examination is terminated), applicants may amend the claims to place them in independent form where dependent claims were found allowable, or add new claims, subject only to the limitations applicable to any application under final rejection. See 37 CFR 1.116. Similarly, upon mailing of a notice of allowance, applicants may submit amendments to the claims, again subject only to the limitations applicable to any application that has been allowed. See 37 CFR 1.312. The requirements for requesting prioritized examination after the filing of a request for continued examination are summarized below.

A patent application may be granted prioritized examination status under the following conditions:

1. The request for continued examination must be in an original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) or that has entered the national stage under 35 U.S.C. 371.
2. The request for prioritized examination must be filed via the Office’s electronic filing system (EFS-Web), except in a plant application for which the request must be filed in paper (MPEP 502.05(II)(B)) prior to the mailing of a first Office action after the filing of the request for continued examination under 37 CFR 1.114. The request for prioritized examination may either be filed concurrently with, or subsequently to, the filing of a request for continued examination. (3) At the time of the request for prioritized examination, the application must contain or be amended to contain no more than four independent claims and no more than thirty total claims. In addition, the application must not contain any multiple dependent claims. If an amendment is filed in an application that has been granted prioritized examination that results in more than four independent claims or thirty total claims, or a multiple dependent claim, then prioritized examination will be terminated. (4) The request for prioritized examination must be accompanied by the prioritized examination fee set forth in 37 CFR 1.17(c), the processing fee set forth in 37 CFR 1.17(i), and if not previously paid, the publication fee set forth in 37 CFR 1.18(d). Applicants are advised to use the certification and request form PTO/SB/424 which is available on EFS-Web. (5)

The Leahy-Smith America Invents Act currently limits the number of requests for prioritized examination under Sec. 1.102(e) that the Office may accept to a maximum of 10,000 per fiscal year. This includes both requests for prioritized examination for initial examination (37 CFR 1.102(e)(1)) and requests for prioritized examination after filing of a request for continued examination (37 CFR 1.102(e)(2)). Discussion of Specific Rules Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows: Section 1.102: Section 1.102(e) is revised to set out the general requirements for prioritized examination and the specific requirements for prioritized examination for initial examination (Track I) (37 CFR 1.102(e)(1)) and for prioritized examination after the filing of a request for continued examination (37 CFR 1.102(e)(2)). Section 1.102(e) provides that a request for prioritized examination under Sec. 1.102(e) must comply with the requirements of Sec. 1.102(e) and be accompanied by the prioritized examination fee set forth in Sec. 1.17(c), the processing fee set forth in Sec. 1.17(i), and the publication fee set forth in Sec. 1.18(d). Section 1.102(e) also provides that an application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Section 1.102(e) also provides that prioritized examination under this paragraph will not be accorded to international applications that
have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications, or reexamination proceedings.

Finally, Sec. 1.102(e) provides that a request for prioritized examination must also comply with the requirements of Sec. 1.102(e)(1) or Sec. 1.102(e)(2). Section 1.102(e)(1) provides that a request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a) that is complete as defined by Sec. 1.51(b), with any fees due under Sec. 1.16 paid on filing. If the application is a utility application, it must be filed via the Office’s electronic filing system (EFS-Web).

The request for prioritized examination in compliance with Sec. 1.102(e)(1) must be present upon filing. The discussion in the final rule to implement prioritized examination for initial examination (Track I) (Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures under the Leahy-Smith America Invents Act, 76 FR 59050 (Sept. 23, 2011)) remains applicable to request for prioritized examination under Sec. 1.102(e)(1). Section 1.102(e)(2) provides that a request for prioritized examination may be filed with or after a request for continued examination in compliance with Sec. 1.114.

Only a single such request for prioritized examination under Sec. 1.102(e)(2) may be granted in an application. If the application is a utility application, the request must be filed via the Office’s electronic filing system (EFS-Web). The request must be filed before the mailing of the first Office action after the filing of the request for continued examination under Sec. 1.114. The request must be accompanied by the prioritized examination fee set forth in Sec. 1.17(c), the processing fee set forth in Sec. 1.17(i), and if not already paid, the publication fee set forth in Sec. 1.18(d).
Accelerated Examination – MPEP 708.02(a)

708.02(a) Accelerated Examination [R-5]
All petitions to make special, except those based on applicant’s health or age or the Patent Prosecution Highway (PPH) pilot program, filed on or after August 25, 2006 must meet the requirements set forth in subsection I below. See MPEP § 708.02 subsection III or IV (where appropriate) for the requirements for filing a petition to make special based on applicant’s health or age.

Applications filed prior to August 25, 2006 are not eligible for the accelerated examination program set forth below. A petition to make special filed on or after August 25, 2006 will only be granted if it is based upon applicant’s health or age or is under the PPH pilot program, or if it complies with the requirements set forth below.

I. REQUIREMENTS FOR PETITIONS TO MAKE SPECIAL UNDER ACCELERATED EXAMINATION

A new application may be granted accelerated examination status under the following conditions:

(A) The application must be filed with a petition to make special under the accelerated examination program accompanied by either the fee set forth in 37 CFR 1.17(h) or a statement that the claimed subject matter is directed to environmental quality, the development or conservation of energy resources, or countering terrorism. See 37 CFR 1.102(c)(2). Applicant should use form PTO/SB/28 for filing the petition.

(B) The application must be a non-reissue utility or design application filed under 35 U.S.C. 111(a).

(C) The application, petition, and required fees must be filed electronically using the USPTO’s electronic filing system (EFS), or EFS-Web. If the USPTO’s EFS and EFS-Web are not available to the public during the normal business hours for these systems at the time of filing the application, applicant may file the application, other papers and fees by mail accompanied by a statement that EFS and EFS-Web were not available during the normal business hours, but the final disposition of the application may occur later than twelve months from the filing of the application. See subsection VIII.F. below for more information.

(D) At the time of filing, the application must be complete under 37 CFR 1.51 and in condition for examination. For example, the application must be filed together with the basic filing fee, search fee, examination fee, and application size fee (if applicable), and an executed oath or declaration under 37 CFR 1.63. See subsection VIII.C. below for more information.

(E) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must also not contain any multiple dependent claims. By filing a petition to make special under the accelerated examination program the applicant is agreeing not to
separately argue the patentability of any dependent claim during any appeal in the application. Specifically, the applicant is agreeing that the dependent claims will be grouped together with and not argued separately from the independent claim from which they depend in any appeal brief filed in the application (37 CFR 41.37(c)(1)(vii)). The petition must include a statement that applicant will agree not to separately argue the patentability of any dependent claim during any appeal in the application. See form PTO/SB/28.

(F) The claims must be directed to a single invention. If the USPTO determines that all the claims presented are not directed to a single invention, applicant must make an election without traverse in a telephonic interview. The petition must include a statement that applicant will agree to make an election without traverse in a telephonic interview. See form PTO/SB/28.

(G) The applicant must be willing to have an interview (including an interview before a first Office action) to discuss the prior art and any potential rejections or objections with the intention of clarifying and possibly resolving all issues with respect to patentability at that time. The petition must include a statement that applicant will agree to have such an interview when requested by the examiner. See form PTO/SB/28.

(H) At the time of filing, applicant must provide a statement that a preexamination search was conducted, including an identification of the field of search by United States class and subclass and the date of the search, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file or files searched and the database service, and the date of the search.

(1) This preexamination search must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source and includes such a justification with this statement.

(2) This preexamination search must be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation.

(3) The preexamination search must also encompass the disclosed features that may be claimed. An amendment to the claims (including any new claim) that is not encompassed by the preexamination search or an updated accelerated examination support document (see item 1) will be treated as not fully responsive and will not be entered. See subsection IV below for more information.

(4) A search report from a foreign patent office will not satisfy this preexamination search requirement unless the search report satisfies the requirements for a preexamination search.

(5) Any statement in support of a petition to make special must be based on a good faith belief that the preexamination search was conducted in compliance with these requirements. See 37 CFR 1.56 and 10.18.

(I) At the time of filing, applicant must provide in support of the petition an accelerated examination support document.
(1) An accelerated examination support document must include an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims.

(2) For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference.

(3) The accelerated examination support document must include a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c).

(4) The accelerated examination support document must include a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application).

(5) The accelerated examination support document must include a showing of where each limitation of the claims finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification. If applicable, the showing must also identify:

(i) each means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112, paragraph 6; and

(ii) the structure, material, or acts in the specification that correspond to each means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112, paragraph 6. If the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under the first paragraph of 35 U.S.C. 112 in each such application in which such support exists.

(6) The accelerated examination support document must identify any cited references that may be disqualified as prior art under 35 U.S.C. 102(c).

II. DECISION ON PETITION TO MAKE SPECIAL

Applicant will be notified of the decision by the deciding official. If the application and/or petition does not meet all the requirements set forth in subsection I above for the application to be granted special status (including a determination that the search is deemed to be insufficient), the applicant will be notified of the defects and the application will remain in the status of a new application awaiting action in its regular turn. In those instances in which the petition or accelerated examination support document is defective in one or more requirements, applicant will be given a single opportunity to perfect the petition or accelerated examination support document within a time period of one month (no extensions under 37 CFR 1.136(a)). This opportunity to perfect a petition does not apply to applications that are not in condition for examination on filing. See subsection VII.C. below. If the document is satisfactorily corrected in a timely manner, the petition
will then be granted, but the final disposition of the application may occur later than twelve months
from the filing date of the application. Once a petition has been granted, prosecution will proceed
according to the procedure set forth below.

III. THE INITIAL ACTION ON THE APPLICATION BY THE EXAMINER

Once the application is granted special status, the application will be docketed and taken up for
action expeditiously (e.g., within two weeks of the granting of special status). If it is determined that
all the claims presented are not directed to a single invention, the telephone restriction practice set
forth in MPEP § 812.01 will be followed. Applicant must make an election without traverse
during the telephonic interview. If applicant refuses to make an election without traverse, or the
examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first
claimed invention (the invention of claim 1) as constructively elected without traverse for
examination. Continuing applications (e.g., a divisional application directed to the non-elected
inventions) will not automatically be given special status based on papers filed with the petition in
the parent application. Each continuing application must on its own meet all requirements for
special status.

If the USPTO determines that a possible rejection or other issue must be addressed, the examiner
will telephone the applicant to discuss the issue and any possible amendment or submission to
resolve such issue. The USPTO will not issue an Office action (other than a notice of allowance)
unless either: (A) an interview was conducted but did not result in the application being placed in
condition for allowance; or (B) there is a determination that an interview is unlikely to result in the
application being placed in condition for allowance. Furthermore, prior to the mailing of any Office
action rejecting the claims, the USPTO will conduct a conference to review the rejections set forth in
the Office action.

If an Office action other than a notice of allowance or a final Office action is mailed, the Office action
will set a shortened statutory period of one month or thirty days, whichever is longer. No
extensions of this shortened statutory period under 37 CFR 1.136(a) will be permitted. Failure to
timely file a reply will result in abandonment of the application. See subsections V and VI for more
information on post-allowance and after-final procedures.

IV. REPLY BY APPLICANT

A reply to an Office action must be limited to the rejections, objections, and requirements made.
Any amendment that attempts to: (A) add claims which would result in more than three
independent claims, or more than twenty total claims, pending in the application; (B) present
claims not encompassed by the preexamination search (see subsection I, item (H) above) or an
updated accelerated examination support document (see next paragraph); or (C) present claims
that are directed to a nonelected invention or an invention other than previously claimed in the
application, will be treated as not fully responsive and will not be entered. See subsection VII.D.
below for more information.
For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document in subsection I, item (I) above, applicant is required to provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing the amendment. Failure to provide such updated accelerated examination support document at the time of filing the amendment will cause the amendment to be treated as not fully responsive and not to be entered. See subsection VII.D. below for more information. Any IDS filed with an updated accelerated examination support document must also comply with the requirements of 37 CFR 1.97 and 1.98.

Any reply or other papers must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the papers are not filed electronically via EFS-Web, or the reply is not fully responsive, the final disposition of the application may occur later than twelve months from the filing of the application.

V. POST-ALLOWANCE PROCESSING

The mailing of a notice of allowance is the final disposition for purposes of the twelve-month goal for the accelerated examination program. In response to a notice of allowance, applicant must pay the issue fee within three months from the date of mailing of the Notice of Allowance and Fee(s) Due (form PTOL-85) to avoid abandonment of the application. In order for the application to be expeditiously issued as a patent, the applicant must also: (A) pay the issue fee (and any outstanding fees due) within one month from the mailing date of the form PTOL-85; and (B) not file any post-allowance papers that are not required by the USPTO (e.g., an amendment under 37 CFR 1.312 that was not requested by the USPTO).

VI. AFTER-FINAL AND APPEAL PROCEDURES

The mailing of a final Office action or the filing of a notice of appeal, whichever is earlier, is the final disposition for purposes of the twelve-month goal for the accelerated examination program. Prior to the mailing of a final Office action, the USPTO will conduct a conference to review the rejections set forth in the final Office action (i.e., the type of conference conducted in an application on appeal when the applicant requests a pre-appeal brief conference). In order for the application to be expeditiously forwarded to the Board of Patent Appeals and Interferences (BPAI) for a decision, applicant must: (A) promptly file the notice of appeal, appeal brief, and appeal fees; and (B) not request a pre-appeal brief conference. A pre-appeal brief conference would not be of value in an application under a final Office action because the examiner will have already conducted such a conference prior to mailing the final Office action. During the appeal process, the application will be treated in accordance with the normal appeal procedures (see MPEP Chapter 1200). The USPTO will continue to treat the application as special under the accelerated examination program after the decision by the BPAI.

Any after-final amendment, affidavit, or other evidence filed under 37 CFR 1.116 or 41.33 must also meet the requirements set forth in subsection IV above. If applicant files a request for continued examination (RCE) under 37 CFR 1.114 with a submission and fee, the submission
must meet the reply requirements under 37 CFR 1.111 (see 37 CFR 1.114(c)) and the requirements set forth in subsection IV above. The filing of the RCE is a final disposition for purposes of the twelve-month goal for the accelerated examination program. The application will retain its special status and remain in the accelerated examination program. Thus, the examiner will continue to examine the application in accordance with the procedures set forth in subsection III above and any subsequent replies filed by applicant must meet the requirements of subsection IV above. The goal of the accelerated examination program will then be to reach a final disposition of the application within twelve months from the filing of the RCE.

VII. PROCEEDINGS OUTSIDE THE NORMAL EXAMINATION PROCESS

If an application becomes involved in proceedings outside the normal examination process (e.g., a secrecy order, national security review, interference, or petitions under 37 CFR 1.181, 1.182, or 1.183), the USPTO will treat the application special under the accelerated examination program before and after such proceedings. During those proceedings, however, the application will not be accelerated. For example, during an interference proceeding, the application will be treated in accordance with the normal interference procedures and will not be treated under the accelerated examination program. Once any one of these proceedings is completed, the USPTO will process the application expeditiously under the accelerated examination program until it reaches final disposition, but that may occur later than twelve months from the filing of the application.

VIII. MORE INFORMATION

A. Eligibility

Any non-reissue utility or design application filed under 35 U.S.C. 111(a) on or after August 25, 2006 is eligible for the accelerated examination program. The following types of filings are not eligible for the accelerated examination program:

(1) plant applications;
(2) reissue applications;
(3) applications entering the national stage from an international application after compliance with 35 U.S.C. 371;
(4) reexamination proceedings;
(5) RCEs under 37 CFR 1.114 (unless the application was previously granted special status under the program); and
(6) petitions to make special based on applicant's health or age or under the PPH pilot program.
Rather than participating in the accelerated examination program, applicants for a design patent may participate in the expedited examination program by filing a request in compliance with the guidelines set forth in MPEP § 1504.30. See 37 CFR 1.155.

B. Form

Applicant should use form PTO/SB/28 for filing a petition to make special, other than those based on applicant’s health or age or the PPH pilot program. The form is available on EFS-Web and on the USPTO’s Internet Web site at http://www.uspto.gov/web/forms/index.html.

C. Conditions for Examination

The application must be in condition for examination at the time of filing. This means the application must include the following:

1. Basic filing fee, search fee, and examination fee, under 37 CFR 1.16 (see MPEP § 607 subsection I);

2. Application size fee under 37 CFR 1.16(s) (if the specification and drawings exceed 100 sheets of paper) (see MPEP § 607 subsection II);

3. An executed oath or declaration in compliance with 37 CFR 1.63;

4. A specification (in compliance with 37 CFR 1.52) containing a description (37 CFR 1.71) and claims in compliance with 37 CFR 1.75;

5. A title and an abstract in compliance with 37 CFR 1.72;

6. Drawings in compliance with 37 CFR 1.84;

7. Electronic submissions of sequence listings in compliance with 37 CFR 1.821(c) or (e), large tables, or computer listings in compliance with 37 CFR 1.96, submitted via the USPTO’s electronic filing system (EFS) in ASCII text as part of an associated file (if applicable);

8. Foreign priority claim under 35 U.S.C. 119(a)-(d) identified in the executed oath or declaration or an application data sheet (if applicable);

9. Domestic benefit claims under 35 U.S.C. 119(e), 120, 121, or 365(c) in compliance with 37 CFR 1.78 (e.g., the specific reference to the prior application must be submitted in the first sentence(s) of the specification or in an application data sheet, and for any benefit claim to a non-English language provisional application, the application must include a statement that (a) an English language translation, and (b) a statement that the translation is accurate, have been filed in the provisional application) (if applicable);
(10) English language translation under 37 CFR 1.52(d), a statement that the translation is accurate, and the processing fee under 37 CFR 1.17(i) (if the specification is in a non-English language);

(11) No preliminary amendments present on the filing date of the application; and

(12) No petition under 37 CFR 1.47 for a non-signing inventor.

Furthermore, if the application is a design application, the application must also comply with the requirements set forth in 37 CFR 1.151, 1.152, 1.153, and 1.154.

Applicant should also provide a suggested classification, by class and subclass, for the application on the transmittal letter, petition, or an application data sheet as set forth in 37 CFR 1.76(b)(3) so that the application can be expeditiously processed.

The petition to make special will be dismissed if the application omits an item or includes a paper that causes the Office of Initial Patent Examination (OIPE) to mail a notice during the formality review (e.g., a notice of incomplete application, notice to file missing parts, notice to file corrected application papers, notice of omitted items, or notice of informal application). The opportunity to perfect a petition (subsection II above) does not apply to applications that are not in condition for examination on filing.

D. Reply Not Fully Responsive

If a reply to a non-final Office action is not fully responsive, but a bona fide attempt to advance the application to final action, the examiner may provide one month or thirty days, whichever is longer, for applicant to supply the omission or a fully responsive reply. No extensions of this time period under 37 CFR 1.136(a) will be permitted. Failure to timely file the omission or a fully responsive reply will result in abandonment of the application. If the reply is not a bona fide attempt or it is a reply to a final Office action, no additional time period will be given. The time period set forth in the previous Office action will continue to run.

E. Withdrawal From Accelerated Examination

There is no provision for “withdrawal” from special status under the accelerated examination program. An applicant may abandon the application that has been granted special status under the accelerated examination program in favor of a continuing application, and the continuing application will not be given special status under the accelerated examination program unless the continuing application is filed with a petition to make special under the accelerated examination program. The filing of an RCE under 37 CFR 1.114, however, will not result in an application being withdrawn from special status under the accelerated examination program.

F. The Twelve-Month Goal
The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. The twelve-month goal is successfully achieved when one of the following final dispositions occurs:

1. the mailing of a notice of allowance;
2. the mailing of a final Office action;
3. the filing of an RCE; or
4. the abandonment of the application.

The final disposition of an application, however, may occur later than the twelve-month time frame in certain situations (e.g., an IDS citing new prior art after the mailing of a first Office action). See subsection VII above for more information on other events that may cause examination to extend beyond this twelve-month time frame. In any event, however, this twelve-month time frame is simply a goal. Any failure to meet the twelve-month goal or other issues relating to this twelve-month goal are neither petitionable nor appealable matters.
First Action Interview Program

USPTO: 1367 OG 42 (June 17, 2011)

Full First Action Interview Pilot Program

I. Summary: The United States Patent and Trademark Office (USPTO) conducted the Enhanced First Action Interview Pilot Program in which utility applicants in certain art areas could participate. See Enhanced First Action Interview Pilot Program, 1347 Off. Gaz. Pat. Office 173 (October 20, 2009). The USPTO indicated in the notice the program would run until April 1, 2010. The USPTO extended the program to run until April 1, 2011. See Extension of the Enhanced First Action Interview Pilot Program, 1354 Off. Gaz. Pat. Office 51 (May 4, 2010) and Second Extension of the Enhanced First Action Interview Pilot Program, 1360 Off. Gaz. Pat. Office 56 (November 2, 2010). Under the program, participants were permitted to conduct an interview with the examiner after reviewing a Pre-Interview Communication providing the result of a prior art search conducted by the examiner. Participants experienced many benefits including: (1) the ability to advance prosecution of an application; (2) enhanced interaction between applicant and the examiner; (3) the opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process; and (4) the opportunity to facilitate possible early allowance. Based upon comments and suggestions from the public, including participants and non-participants, as well as the Patent Office Professional Association (POPA), the Office is expanding the Enhanced First Action Interview Pilot Program to all utility art areas. The Full First Action Interview Pilot Program will continue until May 16, 2012.

Normally, granting an interview before first action on the merits of a new application is within the discretion of the examiner and a showing may be required to justify the granting of the interview. See Manual of Patent Examining Procedure (MPEP) § 713.02. As in the Enhanced First Action Interview Pilot Program, the Full First Action Interview Pilot Program will continue to provide a procedure which, if followed, makes the granting of an interview non-discretionary.

For those applicants who are eligible and wish to participate in the pilot program, applicants must file a request electronically. When the application is taken up for examination, the examiner will conduct a prior art search and provide applicant a Pre-Interview Communication that includes citations to prior art references from the prior art search (similar to a search report) and an identification of any rejections and/or objections, if at least one claim is not allowable.

Once the applicant reviews the prior art references, applicant must either file a request to not have a first action interview with the examiner, or schedule the interview and file a proposed amendment or remarks (arguments), within one month or thirty days, whichever is longer, from the mailing or notification date2 of the Pre-Interview Communication. If applicant chooses not to have a first action interview, a First Action Interview Office Action will be promptly entered and applicant will have one month or thirty days, whichever is longer, to reply. If an interview is scheduled, applicant must be prepared to discuss issues related to the patentability of the claims. If
the applicant and the examiner reach agreement during the interview on all claims at issue in regard to patentability, a Notice of Allowability will be issued promptly after the interview. If agreement is not reached on all claims in regard to patentability, at the conclusion of the interview, applicant may be given a courtesy copy of a First Action Interview Office Action, which will set forth the requirements, objections, and rejections. Applicant will be given one month or thirty days, whichever is longer, from the mailing or notification date of the First Action Interview Office Action to reply, with limited extensions of time.

II. Effective Date: Any request for a First Action Interview filed on or after April 1, 2011, and before May 16, 2012, will be granted if all of the requirements set forth in Section III (Requirements) of this notice are satisfied.
**First Action Interview Pilot Program**

**Pre-Interview Communication**

<table>
<thead>
<tr>
<th>Application No.</th>
<th>Applicant(s)</th>
</tr>
</thead>
<tbody>
<tr>
<td>XXXXXXX</td>
<td>XXXXXXX</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Examiner</th>
<th>Art Unit</th>
<th>Page 1 of 2</th>
</tr>
</thead>
<tbody>
<tr>
<td>XXXX</td>
<td>XXXX</td>
<td></td>
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</tbody>
</table>

- **The MAILING OR NOTIFICATION DATE of this communication appears on the cover sheet with the correspondence address - THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION.**

This time period for reply is extendable under 37 CFR 1.136(a) for only ONE additional MONTH. This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

Applicant must, within the time period for reply, file: (1) A letter requesting not to have a first action interview; (2) A reply under 37 CFR 1.111 waiving the first action interview and First Action Interview Office Action; or (3) An Applicant Initiated Interview Request Form (PTOL-413A) electronically via EFS-Web, accompanied by a proposed amendment or arguments, and schedule the interview within 2 months from the filing of the request. A failure to respond to this communication will be treated as a request not to have an interview.

If applicant waives the First Action Interview Office Action, the instant Pre-Interview Communication is deemed the first Office Action on the Merits. The next subsequent Office action may be made final if appropriate. See MPEP 706.07(a)

**Disposition of Claims**

3) **X** Claim(s) 7-15 is/are pending in the application.

3a) Of the above claim(s) __________ is/are withdrawn from consideration.

4) **X** Claim(s) 25 is/are allowed.

5) **X** Claim(s) 7-14 is/are rejected.

6) ☐ Claim(s) __________ is/are objected to.

7) ☐ Claim(s) __________ are subject to restriction and/or election requirement.

**Application Papers**

8) ☐ The specification is objected to by the Examiner.

9) ☐ The drawing(s) filed on ______ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
<table>
<thead>
<tr>
<th>#</th>
<th>Claim(s)</th>
<th>Reference(s) (if applicable)</th>
<th>Rejection Statutory Basis</th>
<th>Brief Explanation of Rejection</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>1</td>
<td>U,V</td>
<td>103(a)</td>
<td>Reference U discloses claim 1 (see p. 2 lines 35-46 for the grid network, see p.4 lines 11-21 for the grid manager) except for &quot;in response to determining that there are no available (see continuation below)&quot;</td>
</tr>
<tr>
<td>2</td>
<td>2, 4-7, 9-13</td>
<td>U,V</td>
<td>103(a)</td>
<td>Building on the rejection of claim 1, U discloses: claim 2 (see p. 7, section 5.2); claim 4 (see p. 3 lines 15-18); claim 5 (see p. 4, section 3.2), claims 6, 7 and 9-13 (see p. 4, section 5.4 (see cont.))</td>
</tr>
<tr>
<td>3</td>
<td>3</td>
<td>U,V,W</td>
<td>103(a)</td>
<td>U and V do not disclose the plurality of computing devices...is a blade management system. W discloses this at p. 2. It would have been obvious to use W's blade mg system with the combined system of U and V in order to adapt easily. (see cont.)</td>
</tr>
<tr>
<td>4</td>
<td>8</td>
<td>U,V</td>
<td>103(a)</td>
<td>U does not disclose the network is the world wide web. V discloses this limitation at p. 3. It would have been obvious to use V's world wide web in U's network to facilitate information exchange between users efficiently and quickly. (see continuation)</td>
</tr>
<tr>
<td>5</td>
<td>14</td>
<td>U,V,W</td>
<td>103(a)</td>
<td>Reference U and V disclose the limitations of claim 14 (see p. 2 lines 35-46 for the grid network, see p.4 lines 11-21 for the grid manager) except the limitations of using JAVA. (see continuation)</td>
</tr>
</tbody>
</table>

Expanded Discussion/Commentary

1. Computing devices having the specific operating system. Reference V discloses this limitation at p. 3 lines 25-30. It would have been obvious to use reference V's algorithm with reference U's Cluster in order to find a suitable Collection of Resources that meet a user's needs (reference V, p. 2 lines 33-37).

2. - note that 5.4 teaches that a RAM or any other known memory may be used, thus covering claims 10-13)

3. Operate efficiently, and manage seamlessly (see reference W, p. 2).

4. JTAG software instructions on the devices. The said software instructions are provided in parallel with the devices to support functionalities.

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Patent Prosecution Highway

PPH Summary
Under the Patent Prosecution Highway (PPH), an applicant receiving a ruling from the Office of First Filing (OFF) that at least one claim in an application filed in the OFF is patentable may request that the Office of Second Filing (OSF) fast track the examination of corresponding claims in corresponding applications filed in the OSF. PPH will leverage fast-track examination procedures already available in the OSF to allow applicants in the OSF to obtain corresponding patents faster and more efficiently.

Typical PPH Scenario
Favorable International Search Report:

![International Search Report Image]
Since the ISR came from KIPO, use form PPH.PCT.652 and submit (no fee required).
About 1 month later, the petition should be granted:

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed on 14 June 2011, to make the above-identified application special.

The request and petition are GRANTED.

Discussion

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

(1) The U.S. application must have an eligible relationship to one or more PCT applications.

Expect an office action in 2-3 months from the grant of the petition.