

June 28, 2010

## Accelerated Patent Examination Plan Extended

Most patent applicants can now accelerate the examination of a select number of patent applications in exchange for abandoning an equal number of unexamined, pending applications, according to an announcement issued by the U.S. Patent and Trademark Office ("PTO") on June 24, 2010. The PTO's official notice, titled "Expansion and Extension of the Patent Application Backlog Reduction Stimulus Plan" (the "Plan"), eliminates the requirement whereby only small entity applicants could participate in the Plan. The original Plan seems to have helped the PTO successfully reduce the patent application backlog on a small scale, as the Plan is now extended until the earlier of December 31, 2010 or the date that 10,000 applications have been accorded special status for accelerated examination under the Plan. Time is limited for you to examine your patent applications to evaluate whether to take advantage of this opportunity.

There are some requirements and limitations when seeking accelerated examination under the Plan. The original Plan had the following requirements, which still remain applicable:

- the existence of two non-provisional applications owned by the same party or with a common inventor;
- the patent application to be accorded special status must have been filed with all formalities completed by October 1, 2009;
- the filing of a Petition under 37 C.F.R. § 1.102 that identifies the abandonment of a copending application as the basis for expedited examination; and
- the filing of an executed letter of express abandonment under 37 C.F.R. § 1.138(a) in the copending non-provisional application with a statement that no priority claim to the abandoned application will be filed later and that no request for fee refunds will be made.

The current notice, however, adds the following new requirements:

- the letter of express abandonment filed in the copending non-provisional application must include a statement that the applicant has not and will not file a new application that claims the same invention claimed in the abandoned application;
- the applicant has not received special status for more than fourteen applications under this program; and
- the Petition under 37 C.F.R. § 1.102 must also: (i) identify the specific relationship between the applications that qualifies one application for special status; (ii) identify, by application number if known, the application that is being expressly abandoned; (iii) certify that the applicant, as determined by ownership rights, has not filed similar petitions in more than fourteen other applications requesting special status under the Plan; and (iv) state that applicant agrees to make an election without traverse in a telephonic interview if the Office determines that the claims are subject to a restriction requirement. Additionally, if the Examiner cannot reach the Applicant by telephone with regard to the restriction requirement, or if the applicant refuses to make an election, the Examiner will treat the first claimed invention, as based on claim numbering alone, as constructively elected without traverse.

The new requirements add a degree of complexity to the petition process, and applicants should ensure that abandonment of the copending application will not be a significant impediment to their technology protection plans

given that expressly abandoned applications cannot be later revived under the Plan. Interested applicants should also note that claims directed to a non-elected invention are not subject to the accelerated process and that the Plan is limited to fifteen applications per entity. Thus, later-filed divisional applications will require a separate petition and will count against the per entity limit under the Plan.

For more information on the Patent practice group and its members, you may visit the [Patent Prosecution](#) page of the Haynes and Boone, LLP Web site. If you have any questions, please contact:

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