



# Greenblum & Bernstein, P.L.C.

## CLIENT ADVISORY

### Recent Changes in Rules and Procedures

**September 23, 2011**

### **New U.S. Patent Law Prioritized Examination**

Dear Clients:

As you are no doubt aware from our previous communications, a new patent law was signed by the president on September 16, 2011. Many of the provisions of the law, which will make significant and substantial changes in intellectual property protection practice in the United States, take effect in more than a year from now. However, there is one provision of the law, prioritized examination, which takes effect on September 26, 2011 and accordingly this communication is to provide you with a brief review of the significant details of this provision of the new patent law.

Upon payment of a fee of \$4800 (\$2400 for small entity applications), upon filing of an application together with all the other required fees, an application will be afforded special status until final disposition. It is the Patent Office's goal to achieve "final disposition" of such special status cases within 12 months.

Prioritized examination is available upon the filing of any original utility or plant application. Prioritized examination is not available for international applications (including national stage applications), design applications, reissue applications, provisional applications and re-examinations. However, prioritized examination is available for continuation and divisional applications.

In order to be eligible for prioritized examination, an application must be filed electronically and may contain no more than four independent claims and no more than 30 total claims. Further, no multiple dependent claims are permitted.

Upon filing, the application must be in condition for examination. In other words, the application must be filed with an executed oath or declaration and all appropriate fees must be paid. In addition, an appropriate specification, including a title, an abstract and drawings are required, together with, if appropriate, a claim for foreign priority and/or domestic priority. A petition for a non signing inventor (37 CFR 1.47) is not permitted and a preliminary amendment may not be present on the filing date of the application.

Prioritized examination will be terminated upon filing of a request for extension of time, a request to suspend action, or amending the claims to exceed the program limits.

The Patent Office has defined "final disposition" as filing of an RCE or notice of appeal, mailing of a final office action or a notice of allowance, declaration of an interference or abandonment of the application.

The Patent Office has indicated that the benefits of prioritized examination will be enhanced by an Applicant being prepared to conduct a telephone or personal interview with the examiner early in the prosecution.

**Contact Us:**

www.gbpatent.com  
gbpatent@gbpatent.com  
703-716-1191 (phone)  
703-716-1180 (fax)

We hope this communication clarifies the basic provisions of this provision of the new patent law. Of course if you have any questions regarding this matter, or any other aspect of the new patent law, please feel free to contact us.

Best regards,

GREENBLUM & BERNSTEIN, P.L.C.

The GREENBLUM & BERNSTEIN CLIENT ADVISORY LETTER is issued by GREENBLUM & BERNSTEIN, P.L.C., an intellectual property firm, to notify our valued clients of changes in patent, trademark, and copyright rules and practice. If you believe that your are receiving this fax/email in error or after you have already requested to be removed from our mailing lists, please email us at: **gbpatent@gbpatent.com**. Copyright 2011 GREENBLUM & BERNSTEIN, P.L.C. [J128163]