

Client Alert

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Patent Application Process Taking Too Long? Try Fast Tracking Your PTAB Ex Parte Appeal

Patent applicants have the option to appeal adverse decisions received during the prosecution of their applications before the United States Patent and Trademark Office (USPTO). Appeals are heard by the USPTO's Patent Trial and Appeal Board (PTAB).¹

Starting this month, the USPTO is offering a "Fast Track Appeals Pilot Program" that will allow *ex parte* appeals of patent applications to be accorded fast track status.

One of the biggest drawbacks of an appeal to the PTAB is the length of pendency, with a typical appeal lasting approximately 15 months. For a limited number of applicants over the next year, however, the pilot program can drastically accelerate these proceedings.

The popularity of the USPTO's prioritized examination program, Track One, prompted the new Fast Track pilot. Like Track One, the Fast Track Appeals Pilot Program is open to any original utility non-provisional patent application. It is also available for design and plant patent applications.

Fast Track's requirements are straightforward: For an *ex parte* non-provisional patent application, after a notice of appeal is filed and a PTAB docketing notice issues, an applicant may file a petition to fast-track under 37 CFR 41.3, accompanied by a \$400 fee. If granted, the appeal is accorded fast track status and the PTAB targets 6 months from the date of petition grant to issue its decision, which would constitute a 60% reduction in pendency.

While fast-tracked appeals will follow the PTAB's normal procedures, once a hearing is scheduled, it cannot be moved. If an applicant wants to reschedule the hearing, the appeal will lose fast track status.

The Fast Track Appeals Pilot Program will be limited in both time and volume, available for a period of one year or until 500 appeals are accorded fast track status. This volume will be divided over four "quarters" of the year, with no more than 125 fast-track petitions granted per quarter. If the limit is reached for a particular quarter, additional petitions will be held in abeyance until the next quarter.

We expect the Fast Track program to be popular, and believe the 500 appeal volume limit could be reached before July 2021, so filing petitions early, when possible, will be advantageous. Applicants with pending applications who are considering an appeal may conclude that a six-month decision timeframe justifies the \$400 fee and/or is a more productive use of time than a further round of prosecution. For large entities, the cost of an appeal (\$800) plus the petition fee (\$400) roughly equals the cost of a first request for continued examination (\$1,300), exclusive of attorney fees. And the program could greatly benefit strategically important applications or other cases where a quick determination of claim scope patentability is desirable.

¹ Appeals from the PTAB then go to the US Court of Appeals for the Federal Circuit, and ultimately the US Supreme Court.

We recommend patent applicants immediately review their prosecution dockets to identify applications that may benefit from an expedited appeal and strongly consider filing a petition for fast track status.

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