

PRIORITIZED EXAMINATION: FREQUENTLY ASKED QUESTIONS

OFFICE OF PATENT LEGAL ADMINISTRATION

Overview

1. What is prioritized examination?

Prioritized examination is a procedure for expedited examination of a patent application under 37 CFR 1.102(e). Prioritized examination under 37 CFR 1.102(e) of new applications is also known as the Track One program. A request for prioritized examination request may also be filed with or after a request for continued examination (RCE) but before the mailing of the first Office action subsequent to the RCE in a pending application (see questions 16-20).

2. What types of applications are eligible for the Track One program?

Original nonprovisional utility and plant patent applications filed under 35 U.S.C. 111(a), having no more than four independent claims, thirty total claims, and no multiple dependent claims at the time the request to participate is reviewed by the Office of Petitions, and filed on or after September 26, 2011, are eligible for Track One. The term “original application” includes both first filings and continuing applications; see the Manual of Patent Examining Procedure (MPEP) section 201.02. Thus, continuation, continuation-in-part, and divisional applications are eligible for prioritized examination, but reissue applications are not eligible. Continuing applications are not automatically given prioritized examination status based on a request filed in the parent application; each application must, on its own, meet all the requirements and have a timely request submitted therein.

3. How will I know if the limit of 15,000 granted requests for prioritized examination for the fiscal year has already been reached?

Track One filing rate information is available at [the USPTO Special Program Data Dashboard](#).

4. Does the 15,000 granted request limit set in 37 CFR 1.102(e) apply only to Track One requests filed with original applications, prioritized examination requests filed with requests for continued examination (RCEs), or both?

The 15,000 limit applies to the sum of all granted requests for prioritized examination, including both Track One and prioritized examination for RCEs. For the purposes of 37 CFR 1.102(e), “accept” means “grant”; in other words, the cap limits the total number of granted requests for prioritized examination, not the total number of received requests for prioritized examination.

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5. I have a question about the Track One program that is not answered in this FAQ. Where can I get more information?

Additional details about the Track One program are available at [the Track One microsite](#) and MPEP 708.02(b).

General questions about the prioritized examination program may be directed to the Office of Patent Legal Administration at (571) 272-7704 or at PatentPractice@uspto.gov.

For questions regarding a specific Track One decision in your application, you may contact the Office of Petitions at (571) 272-3282.

Filing a Track One request – general questions

6. How should I submit my Track One request?

Requests for Prioritized Examination of utility patent applications must be filed electronically via the Patent Electronic System (EFS-Web, Patent Center). Requests for Prioritized Examination of plant applications may be filed in paper, or electronically as provided for in [the May 2020 Official Notice](#) (1474 OG 243, May 26, 2020)

The Request for Prioritized Examination must be present on filing of the original utility or plant application under 35 U.S.C. 111(a), or with or after an RCE in compliance with 37 CFR 1.114.

A quick start guide that details the process for filing such requests via EFS-Web is available on the USPTO web site at http://www.uspto.gov/patents/init_events/track-1-quickstart-guide.pdf.

If you have any questions regarding electronic filing, please contact the Patent Electronic Business Center by email at ebc@uspto.gov or by telephone at (866) 217-9197.

7. Am I required to use the USPTO's certification and request form PTO/AIA/424 to request prioritized examination?

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No, use of PTO/AIA/424 is not required, but applicants are nevertheless encouraged to use this form in order to avoid processing delays. If you decide to use your own form for requesting prioritized examination, your form should include the same certification and request information as the USPTO form. If your own form is a modified version of PTO/AIA/424, all text identifying the form as an Office form must be removed and any existing certification language may not be modified. See 37 CFR 1.4(d)(5).

The PTO/AIA/424 form is available within the Patent Electronic Systems and on the [USPTO's Patent Forms website](#).

8. What fees, if any, do I need to pay along with my Request for Prioritized Examination for an original application?

The following fees must be paid for a Request for Prioritized Examination for a new application:

- i. Prioritized examination fee, as set forth in 37 CFR 1.17(c)
- ii. Prioritized examination processing fee, as set forth in 37 CFR 1.17(i)(1)
- iii. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c)
- iv. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m)
- v. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q)
- vi. Excess claim fee (where appropriate), as set forth in 37 CFR 1.16(h) and (i)
- vii. Application size fee (where appropriate), as set forth in 37 CFR 1.16(s)
- viii. Publication fee, as set forth in 37 CFR 1.18(d)
 - Note: This fee is currently set to \$0. The prioritized examination rule still contains the publication fee as a requirement in the event that changes to the publication fee are made in the future.

If, at the time the request for prioritized examination is considered by the USPTO, any excess claims fees or application size fees are required but have not been paid, applicant will be notified of the deficiency through a decision on the request. The deficient fees must be paid not later than one month from a first decision on the request for prioritized examination. See MPEP 708.02(b)(1)(B)(4).

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If any of fees (i)-(v) and (viii) noted above are unpaid at the time of filing of the Request for Prioritized Examination and original application, the request will be dismissed. However, if an explicit authorization to charge any of the missing fees has been provided in the papers accompanying the application and the request, those fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

Applicants are encouraged to include with their application an authorization to charge any additional fees under 37 CFR 1.16 and 1.17, to ensure that a Track One request is not dismissed for failure to pay the required fees.

For exact fee amounts and entity discount information please refer to [the current fee schedule](#). For further discussion regarding fees related to prioritized examination, see MPEP 708.02(I)(B)(4).

Filing a Track One request with an original application

9. In order to be considered for the Track One program, what do I need to file?

Your application must include the following items upon filing:

- A Request for Prioritized Examination (e.g., form PTO/AIA/424)
- A specification as prescribed by 35 U.S.C. 112, including at least one claim;
- Any required drawings;
- Either an executed inventor's oath or declaration under 37 CFR 1.63 or 1.64 for each inventor, or a signed Application Data Sheet (ADS) that provides the legal name, mailing address, and residence (if not residing at the mailing address) for each inventor; and
- The fees noted above in question 8.

10. I have a foreign application pending. If I file a U.S. application that claims priority to the foreign application under 35 U.S.C. 119(a)-(d) or (f), will it be eligible for the Track One program?

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Yes. Any original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) and claiming priority to a foreign application under 35 U.S.C. 119(a)-(d) or (f) is eligible for the Track One program.

11. I have a U.S. provisional application pending. If I file a U.S. nonprovisional application claiming benefit of that provisional application, will the nonprovisional be eligible for the Track One program?

Yes. Any original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) and claiming priority to a prior-filed U.S. application is eligible for the Track One program.

12. I have an international application pending. Is there any way that I can file a U.S. application based on that international application, and have the U.S. application be eligible for prioritized examination?

Yes. A request for prioritized examination may be made in a U.S. application filed under 35 U.S.C. 111(a) which claims 1) the benefit of the earlier international application under 35 U.S.C. 365(c) (i.e., a bypass continuation), or 2) the right of priority of the earlier international application under 35 U.S.C. 365(a), subject to the conditions of 35 U.S.C. 365.

However, an applicant may not request prioritized examination of a national stage application of an international application filed under 35 U.S.C. 371. See questions 15 and 18 below for related information regarding RCEs in international and national stage applications.

13. I am filing an application, but one of the joint inventors has refused to execute an oath or declaration. I have prepared a substitute statement for that joint inventor. Can I file a Track One request for this application?

Yes; however, either (1) the substitute statement and the declaration(s) from the other joint inventor(s) or (2) a properly signed ADS that provides each inventor's legal name, mailing address, and residence (if the inventor does not reside at the mailing address), must be submitted on the date the application is filed. See 37 CFR 1.64 for additional details regarding substitute statements.

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For guidance on filing a substitute statement, see Examples 2 and 4 in "[Inventor's Oath or Declaration Examples Featuring 'Best Practices' in Use of Inventor's Oath or Declaration Forms.](#)"

14. Can I file an application under 35 U.S.C. 111(a) with a nonpublication request and a Track One request?

Yes, you may file an application under 35 U.S.C. 111(a) with both nonpublication and Track One requests.

Note that the publication fee set forth in 37 CFR 1.18(d) must be submitted in order to comply with the prioritized examination request requirements (see question 8), even though nonpublication is being requested. This fee is currently set to \$0, but this may change in the future. Please refer to [the current fee schedule](#) to confirm the amount due.

15. I filed a U.S. application under 35 U.S.C. 111(a) and claimed the benefit of an earlier international application under 35 U.S.C. 365(c) (i.e., a bypass continuation). The earlier international application was not filed in English. Can I make a Track One request in the bypass continuation application?

Yes. However, a translation is required in accordance with 37 CFR 1.52(b)(1)(ii).

Filing a Prioritized Examination request with a Request for Continued Examination (RCE)

16. Under what circumstances may I request prioritized examination when filing an RCE?

You may file a prioritized examination request with an RCE under 37 CFR 1.102(e)(2) if:

- your application is an original, nonprovisional utility or plant patent application filed under 35 U.S.C. 111(a), or an application that has entered the national stage under 35 U.S.C. 371, and
- a proper RCE is filed concurrently with the prioritized examination request, OR the RCE was filed previously but an Office action responsive to that RCE has not yet been mailed, and
- no previous prioritized examination request for an RCE has been granted in the application

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Additionally, your application must contain, or be amended to contain, no more than four independent claims, thirty total claims, and no multiple dependent claims.

Note that an RCE is only proper if prosecution in the application is closed (e.g., the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application). See 37 CFR 1.114(b).

17. What fees are required upon filing a prioritized examination request with an RCE? What happens if one of the required fees is not present upon filing?

In order to make a prioritized examination request with an RCE, the following fees must be paid in addition to any fees required for the RCE:

- i. Prioritized examination fee, as set forth in 37 CFR 1.17(c)
- ii. Prioritized examination processing fee, as set forth in 37 CFR 1.17(i)(1)
- iii. If not previously paid, the applicable publication fee as set forth in 37 CFR 1.18(d). However, since this fee is currently set to \$0, no publication fee is due at this time for a request for prioritized examination for continued examination (RCE). The prioritized examination rule still contains the publication fee as a requirement in the event that changes to the publication fee are made in the future.

If any of the above-noted fees are unpaid when the prioritized examination request is filed, the prioritized examination request will be dismissed (see also Question 28). However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees. Applicants are encouraged to include with their application an authorization to charge any additional fees under 37 CFR 1.16 and 1.17, to ensure that a prioritized examination request is not dismissed for failure to pay the required fees.

For exact fee amounts and entity discount information, please refer to [the current fee schedule](#).

18. Is prioritized examination available when filing an RCE for applications that were filed as a national stage entry under 35 U.S.C. 371?

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Upon filing a proper RCE (which requires prosecution in the application to be closed), prioritized examination becomes available for an application filed as a national stage entry under 35 U.S.C. 371.

19. My application was previously granted special status under the Track One program at the time of original filing. I am now filing an RCE for that application. May I file another prioritized examination request with the RCE?

Yes, if prioritized examination has not been previously granted for an RCE in the application. The prioritized examination program permits a single request to be granted upon filing a new application under 35 U.S.C. 111(a), and a single request to be granted upon filing an RCE under 37 CFR 1.114.

20. My application was previously granted special status under the prioritized examination program for an RCE. I am now filing a second RCE in my application. May I file another prioritized examination request with the second RCE?

No. The prioritized examination program permits only a single request to be granted in association with an RCE under 37 CFR 1.114 in that application. See 37 CFR 1.102(e)(2).

After your Prioritized Examination request is filed

21. My application has been granted special status under the Track One program. Will my application remain in that special status until either issuance or abandonment of the application?

The Track One program grants special status until one of the following occurs:

- i. Applicant files a petition for extension of time for filing a reply.
- ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
- iii. Applicant files an RCE. See also question 19 above.
- iv. Applicant files a notice of appeal.
- v. Applicant files a request for suspension of action.
- vi. A notice of allowance is mailed.
- vii. A final Office action is mailed.
- viii. The application is abandoned.

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ix. Examination is completed as defined in 37 CFR 41.102.

22. My application has been granted special status under the Track One program. When can I expect the final disposition of the application?

The goal of the USPTO is to provide a final disposition within twelve months, on average, from the date that Track One status was granted.

23. I just filed my utility application and the Track One request form through the Patent Electronic System, but I inadvertently omitted an item. Can I supplement my original Patent Electronic System filing with a follow-on submission that supplies the missing item and still be eligible for Track One?

Yes, but only if the follow-on submission is submitted on the same day that the utility application and the prioritized examination request form are filed, such that all necessary items are effectively “present upon filing” as required by 37 CFR 1.102(e)(1).

For example, if the filing fees are inadvertently omitted when the application is filed via the Patent Electronic System, then you may submit the filing fees as a follow-on submission directly into the application on the same day as the filing date of the application.

Applicants are also reminded that only registered users of the Patent Electronic System can submit follow-on documents via the System; follow-on documents are documents filed after the initial submission of the application. Thus, an applicant would need to be a registered user of the Patent Electronic System in order to submit such a follow-on document on the same day the application was filed. See also MPEP 502.05(I)(C)(5) for examples describing possible implications of inadvertently omitting an item when filing an application via the Patent Electronic System.

24. I filed an application with a Track One request and later received a pre-examination notice from the Office of Patent Application Processing (OPAP) that identifies missing items or informalities in my original application filing. Will this affect my Track One request? Can I file an extension of time to respond to the notice?

Requests for prioritized examination will be acted upon once the application has met all formal requirements such that it is ready for examination. Accordingly, any pre-examination notice from the Office of Patent Application Processing will delay a decision on a Track One request until after applicant has filed a complete and timely reply to the pre-examination notice.

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Common situations that cause an application to not be ready for examination include, for example, application papers not being in compliance with 37 CFR 1.52, a missing English-language specification, and missing excess claims fees. These types of informalities or missing items will delay a decision on the request for prioritized examination, but will not cause the request to be dismissed.

For detailed guidance regarding what it means for an application to be in condition for examination, see MPEP 708.02(a)(VIII)(C).

Note that pre-examination notices generally define a period for reply. Any request for an extension of time to reply to such notice will cause the application to be ineligible for further treatment under the Track One program.

25. If I file a preliminary amendment in an application that already includes a Track One request, will the amendment cause the Track One request to be dismissed? Will it cause termination of the special status under prioritized examination if the request has already been granted?

A preliminary amendment filed in an application that included a request for prioritized examination upon original filing will not result in dismissal of such request, or termination of special status if a request has already been granted, so long as the preliminary amendment does not cause the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.

26. If I file an information disclosure statement (IDS) in an application that includes a Track One request, will that cause a pending request to be dismissed? Will it cause termination of the special status under prioritized examination if the request has already been granted?

An information disclosure statement (IDS) filed in an application that includes a request for prioritized examination will not result in dismissal of a pending request, or termination of special status if a request has already been granted. See also 37 CFR 1.97.

27. I filed a Track One request with my application, and later received an Office action or a pre-examination notice, but I am not able to respond by the deadline set by the action/notice. If I petition for an extension of time to reply or request suspension of action, will it affect my Track One request or status?

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Yes. In applications where the Track One request has not yet been decided, any petition for an extension of time or request for suspension of action will cause the Track One request to be dismissed.

In applications where the Track One request was granted, any petition for an extension of time or request for suspension of action will effectively terminate the application's Track One status. Any such petition or request will still be acted upon as set forth in MPEP 708.02(b)(II), even though the application's Track One status has been terminated.

28. My prioritized examination request was dismissed, but I do not think the dismissal was proper. May I request reconsideration of the dismissal?

If you believe that a decision dismissing your request for prioritized examination is not proper, you may file a petition under 37 CFR 1.181. Be sure to review the specific reason(s) for dismissal provided in the decision when considering whether the dismissal may have been made in error before filing your petition under 37 CFR 1.181.

If your prioritized examination request was filed at the time of an RCE, you may alternately file a new Request for Prioritized Examination. The new prioritized examination request must include the proper fees, and it must be timely (i.e., filed prior to the mailing of a first Office action after the filing of the RCE).

The Office of Petitions can assist with questions regarding specific decisions on requests for prioritized examination, and they can be reached by telephone at (571) 272-3282.

29. My prioritized examination request was dismissed. Can I request a refund of fees?

If previously paid, the prioritized examination fee set forth in 37 CFR 1.17(c) will be automatically refunded upon the dismissal of the original request for prioritized examination; you do not need to submit a separate request for such refund.

The prioritized examination processing fee set forth in 37 CFR 1.17(i)(1) will be retained to cover the cost of processing the request.

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If the publication fee is set to an amount other than \$0, you may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).

For a dismissed Track One request filed with an original application, you may additionally request a refund of the search fee and any excess claims fees by filing a petition for express abandonment of the application before an examination has been made in the application in accordance with 37 CFR 1.138(d). See form PTO/AIA/24B. When petitioning for express abandonment, the basic filing fee, examination fee, and any required application size fee cannot be refunded. However, a request for refund of paid search and/or excess claims fees may be considered if that refund request is filed concurrently with, or within two months of the filing date of the declaration of express abandonment. See MPEP 711.01(II).