DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2025-0009]

RIN 0651-AD86

2025 Increase of the Annual Limit on Accepted Requests for Prioritized Examination

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule.

SUMMARY: The Leahy-Smith America Invents Act (AIA) includes provisions for prioritized examination of patent applications. Those provisions have been implemented by the United States Patent and Trademark Office (USPTO) in previous rulemakings. The AIA provides that the USPTO may not accept more than 10,000 requests for prioritization in any fiscal year (October 1 to September 30) until regulations setting another limit are prescribed. In 2019 and 2021, the USPTO published interim rules that expanded the limit on the number of requests to 12,000 and 15,000, respectively. The current final rule further expands the availability of prioritized examination by increasing the limit on the number of prioritized examination requests that may be accepted in a fiscal year to 20,000.

DATES: *Effective Date:* **[INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

Applicability Date: The limit of 20,000 requests for prioritized examination accepted per year is applicable beginning with fiscal year 2025 and continuing for each fiscal year thereafter, until further notice.

FOR FURTHER INFORMATION CONTACT: Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7757; or Parikha Solanki, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-3248.

SUPPLEMENTARY INFORMATION:

I. Background: Section 11(h) of the AIA provides for prioritized examination of an application. *See* Pub. L. 112-29, 125 Stat. 284, 324 (2011). Section 11(h)(1)(B)(i) of the AIA also provides that the USPTO may, by regulation, prescribe conditions for the acceptance of a request for prioritized examination, and section 11(h)(1)(B)(iii) provides that "[t]he Director may not accept in any fiscal year more than 10,000 requests for prioritization until regulations are prescribed under this subparagraph setting another limit." *Id*.

The USPTO implemented the prioritized examination provision of the AIA for original utility or plant nonprovisional applications under 35 U.S.C. 111(a) in a final rule published on September 23, 2011. *See* 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 (September 23, 2011) (codified in 37 CFR 1.102(e)). Following implementation of that rule, the USPTO improved its processes for carrying out prioritized examination and expanded the scope of prioritized examination in view of those improvements. First, the USPTO implemented prioritized examination for pending applications after the filing of a proper request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114. *See* Changes to Implement the Prioritized Examination for Requests for Continued Examination, 76 FR 78566 (December 19, 2011). Next, the USPTO further expanded the prioritized examination procedures to permit the delayed submission of certain filing requirements while maintaining the USPTO's ability to timely examine the patent application. *See* Changes to Permit Delayed Submission of Certain Requirements for Prioritized Examination, 79 FR 12386 (March 5, 2014).

The number of requests for prioritized examination has been increasing steadily over the years. The USPTO published an interim rule in 2019 expanding the availability of prioritized examination by increasing the limit on the number of prioritized examination requests that may be accepted in a fiscal year from 10,000 to 12,000. *See* Increase of the Annual Limit on Accepted Requests for Track I Prioritized Examination, 84 FR 45907 (September 3, 2019). In response to a

continued rise in these requests, the USPTO published an interim rule in 2021 further increasing the limit on the number of prioritized examination requests that may be accepted in a fiscal year from 12,000 to 15,000. *See* 2021 Increase of the Annual Limit on Accepted Requests for Track One Prioritized Examination, 86 FR 52988 (September 24, 2021).

In fiscal year 2024, the USPTO received more than 15,000 requests for prioritized examination. The current final rule increases the number of prioritized examination requests that may be accepted in a fiscal year to 20,000, so that the USPTO can continue to accommodate the number of applicants wishing to utilize this program.

This increase in the maximum number of prioritized examination requests accepted in any fiscal year will not negatively impact overall pendency across all applications. First, the number of applications accepted for prioritized examination will remain a small fraction of the patent examinations completed in a fiscal year. Second, the USPTO has recently terminated, or allowed to expire, a number of pilot programs that permitted patent applications meeting certain eligibility criteria the opportunity to be advanced out of turn for examination. The USPTO has determined that any potential pendency or workflow impacts of these 5,000 additional prioritized examination applications is offset by the cumulative effect of the termination or expiration of programs such as: the Semiconductor Technology Pilot Program, the Cancer Moonshot Expedited Examination Pilot Program, the First-Time Filer Expedited Examination Pilot Program, and the current suspension of the Climate Change Mitigation Pilot Program. In other words, the additional prioritized examination availability combined with the sunset of these pilot programs is expected to have a net neutral or positive effect on overall pendency. Furthermore, an increase in prioritized examination opportunities provides the USPTO with additional resources for building capacity to examine all patent applications in a more timely manner.

Accordingly, the USPTO is further expanding the availability of prioritized examination by increasing the limit on the number of prioritized examination requests that may be accepted in

a fiscal year to 20,000, beginning in fiscal year 2025 (October 1, 2024, through September 30, 2025) and continuing every fiscal year thereafter until further notice.

II. Discussion of Specific Rule

The following is a discussion of the amendment to 37 CFR part 1.

Section 1.102: Section 1.102(e) is revised to increase the limit on the total number of requests for prioritized examination that may be accepted (granted) in any fiscal year from 15,000 to 20,000.

III. Rulemaking Considerations:

A. Administrative Procedure Act: This final rule revises the procedures that apply to applications for which an applicant has requested Track One prioritized examination. The changes in this final rule do not change the substantive criteria of patentability. Therefore, the changes in this rulemaking involve rules of agency practice and procedure and/or interpretive rules and do not require notice-and-comment rulemaking. *See Perez v. Mortg. Bankers Ass'n*, 575 U.S. 92, 97, 101 (2015) (explaining that interpretive rules "advise the public of the agency's construction of the statutes and rules which it administers" and do not require notice-and-comment when issued or amended); *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice-and-comment rulemaking for "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice"); *In re Chestek PLLC*, 92 F.4th 1105, 1110 (Fed. Cir. 2024) (noting that rule changes that "do[] not alter the substantive standards by which the USPTO evaluates trademark applications" are procedural in nature and thus "exempted from notice-and-comment rulemaking."); and *JEM Broadcasting Co. v. F.C.C.*, 22 F.3d 320, 328 (D.C. Cir. 1994) ("[T]he 'critical feature' of the procedural exception [in 5 U.S.C. 553(b)(A)] 'is that it covers agency actions that do not themselves alter the rights or interests of parties, although [they] may alter the manner in which the parties present themselves or their viewpoints to the agency.'" (quoting *Batterton* v. *Marshall,* 648 F.2d 694, 707 (D.C. Cir. 1980))).

Moreover, the USPTO, pursuant to authority at 5 U.S.C. 553(b)(B), finds good cause to adopt the changes in this final rule without prior notice and an opportunity for public comment, as such procedures would be contrary to the public interest. Delay in the promulgation of this final rule to provide prior notice and comment procedures would cause harm to those applicants who desire to file a request for prioritized examination with a new application or request for continued examination. Immediate implementation of the changes in this final rule is in the public interest because: (1) the public does not need time to conform its conduct, as the changes in this final rule do not add any additional requirement for requesting prioritized examination of an application; and (2) those applicants who would otherwise be ineligible for prioritized examination will benefit from the immediate implementation of the changes in this final rule. *See Nat'l Customs Brokers & Forwarders Ass'n of Am., Inc.* v. *United States*, 59 F.3d 1219, 1223-24 (Fed. Cir. 1995). Thus, the USPTO implements this final rule without prior notice and opportunity for comment.

In addition, pursuant to authority at 5 U.S.C. 553(d)(3), the USPTO finds good cause to adopt the changes in this interim rule without the 30-day delay in effectiveness as such delay would be contrary to the public interest. Immediate implementation of the changes in this interim rule is in the public interest because: (1) the public does not need time to conform its conduct, as the changes in this final rule do not add any additional requirement for requesting prioritized examination of an application; and (2) those applicants who would otherwise be ineligible for prioritized examination will benefit from the immediate implementation of the changes in this final rule.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is required. *See* 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (January 18, 2011). Specifically, and as discussed above, the USPTO has, to the extent feasible and applicable: (1) reasonably determined that the benefits of the rule justify its costs; (2) tailored the rule to impose the least burden on society consistent with obtaining the agency's regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens while maintaining flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 14192 (Deregulation): This regulation is not an Executive Order 14192 regulatory action because it has been determined to be not significant.

F. Executive Order 13132 (Federalism): This rulemaking pertains strictly to federal agency procedures and does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

G. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (November 6, 2000).

H. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

I. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (February 5, 1996).

J. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (April 21, 1997).

K. Executive Order 12630 (Taking of Private Property): This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (March 15, 1988).

L. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rulemaking are not expected to result in an annual effect on the economy of $100 million or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rulemaking is not expected to result in a ‘‘major rule’’ as defined in 5 U.S.C. 804(2).

M. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of $100 million (as adjusted) or more in any one

year, or a Federal private sector mandate that will result in the expenditure by the private sector of $100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See* 2 U.S.C. 1501 *et seq.*

N. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See* 42 U.S.C. 4321 *et seq.*

O. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

P. Paperwork Reduction Act of 1995: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*) (PRA) requires that the USPTO consider the impact of paperwork and other information collection burdens imposed on the public. This final rule does not involve information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the PRA. An applicant who wishes to participate in the prioritized examination program must submit a certification and request to participate in the program, preferably by using Form PTO/AIA/424. OMB has determined that, under 5 CFR 1320.3(h), Form PTO/AIA/424 does not collect "information" within the meaning of the PRA. Therefore, this rulemaking to increase the limit on the number of prioritized examination requests that may be accepted in a fiscal year does not impose any additional information collection requirements under the PRA that are subject to review by OMB.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information has a currently valid OMB control number.

Q. E-Government Act Compliance: The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies, to provide increased opportunities for citizen access to Government information and services, and for other purposes.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

PART 1 - RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

2. Section 1.102 is amended by revising the last sentence of the paragraph (e) introductory text to read as follows:

§ 1.102 Advancement of examination.

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(e) * * * No more than 20,000 requests for such prioritized examination will be accepted in any fiscal year.

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Coke Morgan Stewart,
Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.
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